
INDUSTRIAL PROPERTY ORDER, 1989

ARRANGEMENT OF SECTIONS

PART I — PRELIMINARY

SECTION

- 1 Short title and Commencement
- 2 Interpretation

PART II — PATENTS

- 3 Inventions
- 4 Matter Excluded from Patent Protection
- 5 Patentable Inventions
- 6 Right to a Patent, Naming of Inventor
- 7 Applications
- 8 Unity of Invention, Amendment and Division of Applications
- 9 Right of Priority
- 10 Information Concerning Corresponding Foreign Applications for Patents or other Titles of Protection
- 11 Filing Date, Examination
- 12 Grant of Patent
- 13 Rights Conferred by Patent, ARIPO Protocol Patents, Exploitation by Government or other Person Thereby Authorised
- 14 Duration, Annual Fees
- 15 Non-Voluntary Licences
- 16 Invalidation

PART III — UTILITY MODEL CERTIFICATES

- 17 Applicability of Provisions Relating to Patents
- 18 Special Provisions Relating to Utility Model Certificates
- 19 Conversion of Patent Applications or Applications for Utility Model Certificates

PART IV — INDUSTRIAL DESIGNS

- 20 Registrable Industrial Designs
- 21 Right to Registration of Industrial Designs, Naming of Creator
- 22 Application
- 23 Examination, Registration of Industrial Designs
- 24 Rights Conferred by Registration, Duration, Renewal, ARIPO Protocol Industrial Designs
- 25 Invalidation

PART V — MARKS, COLLECTIVE MARKS, AND TRADE NAMES

- 26 Acquisition of the Exclusive Right to a Mark, Registrability
- 27 Application for Registration

-
- 28 Examination, Opposition, Registration of a Mark
 - 29 Rights Conferred by Registration, Duration, Renewal
 - 30 Invalidation, Removal on Grounds of Non-Use
 - 31 Collective Marks
 - 32 Licensing of Marks and Collective Marks
 - 33 Trade names

PART VI — ACTS OF UNFAIR COMPETITION

- 34 Acts of unfair Competition

PART VII — GENERAL PROVISIONS

- 35 Representation by Agent
- 36 Change in Ownership, Licence Contracts
- 37 Registrar
- 38 Functions of the Registrar
- 39 Registers, Gazette
- 40 Correction of Errors, Extension of Time
- 41 Exercise of Discretionary Powers
- 42 Competence of High Court, Appeals
- 43 Infringement, Unlawful Acts, Offences
- 44 Application of International Treaties
- 45 Regulations
- 46 Administrative Instructions
- 47 Repeals, Savings and Transitional Provisions

ORDER NO. 5 OF 1989
INDUSTRIAL PROPERTY ORDER, 1989
(Commencement: See section 1)

ORDER

To provide for the registration and protection of patents, utility model certificates, industrial designs and trade marks and for other matters incidental thereto.

PART I — PRELIMINARY

Short title and commencement

1. This Order may be cited as the Industrial Property Order, 1989, and shall come into operation on a date to be fixed by the Minister by notice in the Gazette.

Interpretation

2. In this Order, unless the context otherwise requires, "agent" means a legal practitioner resident and practising in Lesotho, representing the applicant;

"ARIPO" means African Regional Industrial Property Organization;

"ARIPO protocol" means any Protocol on Patents and Industrial Designs within the framework of ARIPO;

"collective mark" means any visible sign designated as such in the application for registration and capable of distinguishing the origin or any other common characteristic, including the quality, of goods or services of different enterprises which use the sign under the control of the registered owner of the collective mark;

"court" means the High Court of Lesotho established under section 2 of the High Court Act, 1978;

A. 5 of 1978

"exploitation" means,

(a) in respect of a patented invention, any of the following acts,

(i) when the patent has been granted in respect of a product, the making, importing, exporting, offering for sale, selling and using the products or stocking such products for the purposes of offering for sale;

(ii) when the patent has been granted in respect of a process, using the process or doing any of the acts referred to in sub-paragraph (i) in respect of a product obtained directly by means of the process; and

(b) in respect of a registered industrial design, the making, selling or importation of articles, incorporating the industrial design;

"industrial design" means any composition of lines or colours or any three-dimensional form, whether or not associated with lines or colours, where such composition or form gives a special appearance to a product of industry

or handicraft and can serve as a pattern for a product of industry or handicraft but does not include anything in an industrial design which serves solely to obtain a technical results.

“international classification” means the classification according to the Nice Agreement of June, 15, 1957, Concerning the International Classification of Goods and Services for the Purposes of the Registration of marks as last revised;

“invention” means an idea of an inventor which permits in practice the solution to a specific problem in the field of technology;

“mark” means any visible sign capable of distinguishing the goods or services of an enterprise;

“Minister” means the Minister of Law, Constitutional and Parliamentary Affairs;

“patent” means the title granted to protect an invention in accordance with section 5;

“Paris Convention” means the Paris Convention for the Protection of Industrial Property of March, 20 1883, as last revised;

“priority date” means the date of the earlier application that serves as the basis for the right of priority provided for in the Paris Convention;

“registers” means the registers referred to in section 39(1);

“Registrar” means the person holding office in terms of section 37;

“regulations” means regulations made under section 45;

“trade name” means the name or designation identifying and distinguishing an enterprise;

“utility model certificate” means a certificate referred to in section 18.

PART II — PATENTS

Inventions

3. Subject to section 4, an invention may be or may relate to a product or a process.

Matters excluded from patent protection

4. The following, even if they are inventions in terms of section 2, shall be excluded from patent protection,

- (a) discoveries, scientific theories and mathematical methods;
- (b) plant or animal varieties or essentially biological processes for the production of plants or animals, other than microbiological processes and the products of such processes;
- (c) schemes, rules or methods for doing business, performing purely mental acts or playing games;
- (d) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practised on the human or animal body. This provision shall not apply to products for use in any of those methods.

Patentable Inventions

5. (1) An invention is patentable if it is new, involves an inventive step and is industrially applicable.

(2) An invention is new if it is not anticipated by prior art.

(3) Prior art shall consist of everything disclosed to the public,

(a) anywhere in the world, by publication in tangible form; or

(b) in Lesotho, by oral disclosure, by use or in any other way,

prior to the filing, or where appropriate, the priority date, of the application claiming the invention.

(4) For the purposes of subsection (3), disclosure to the public of the invention shall not be taken into consideration if it occurred within six months preceding the filing date or, where applicable, the priority date, of the application, and if it was by reason or in consequence of acts committed by the applicant or his predecessor in title or of an abuse committed by a third party with regard to the applicant or his predecessor in the title.

(5) An invention shall be considered as involving an inventive step if, having regard to the prior art relevant to the application claiming the invention, it would not have been obvious to a person having ordinary skill in the art.

(6) An invention shall be considered industrially applicable if it can be made or used in any kind of industry.

(7) Industry shall be understood in its broadest sense it shall cover, in particular, handicraft, agriculture, fishery, pharmaceuticals and services.

(8) Inventions that are contrary to public order or morality shall not be patentable.

Right to patent; naming of inventor

6. (1) Subject to this section, the right to a patent shall belong to the inventor.

(2) If two or more persons have jointly made an invention, the right to the patent shall belong to them jointly.

(3) If and to the extent to which two or more persons have made the same invention independently of each other the person whose application has the earliest filing date or, if priority is claimed, the earliest validly claimed priority date and leads to the grant of a patent shall have the right to the patent.

(4) The right to a patent may be assigned, or may be transferred by succession.

(5) Where an invention is made in execution of an employment contract, the right to the patent shall belong, in the absence of contractual provisions to the contrary, to the employer.

(6) When an invention is made in execution of a commission or an employment contract, the right to the patent for that invention shall belong, in the absence of contractual provisions to the contrary, to the person having commissioned

the work or to the employer, as the case may be.

- (7) When the invention has an economic value much greater than the parties could have reasonably foreseen at the time of concluding the contract, the inventor shall have a right to equitable remuneration, which shall be determined by the court in the absence of agreement between the parties.
- (8) Notwithstanding subsections (6) and (7), when an employee, whose employment contract does not require him to engage in inventive activity, makes, in the field of activities of his employer, an invention by using data or means available to him through his employment, the right to the patent for that invention shall belong, in the absence of contractual provisions to the contrary, to the employer:

Provided that the employee shall have a right to equitable remuneration taking into account his salary, the economic value of the invention and any benefit derived from the invention by the employer. In the absence of agreement between the parties, the remuneration shall be determined by the court.

- (9) Any contractual provision which is less favourable to the inventor than the provisions of this section shall be null and void.
- 10 The inventor shall be named as such in the patent, unless in a special written declaration addressed to the Registrar he indicates that he wishes not to be named. Any promise or undertaking by the inventor made to any person to the effect that he will make such a declaration shall be without legal effect.

Applications

7. (1) An application for a patent shall be filed with the Registrar and shall contain a request, a description, one or more claims, one or more drawings, where required, and an abstract. It shall be accompanied by the payment of the prescribed application fee.

- (2) The request shall contain a petition to the effect that a patent be granted, the name of the applicant and other prescribed data concerning the applicant, the inventor and the agent, if any, and the title of the invention.
- (3) Where the applicant is not the inventor, the request shall be accompanied by a statement justifying the applicant's right to the patent.
- (4) The description shall disclose the invention in a manner sufficiently clear and complete for the invention to be evaluated, and to be carried out by a person having ordinary skill in the art, and shall, in particular, indicate at least one mode known to the applicant for carrying out the invention.
- (5) The claim or claims shall determine the scope of the protection. The description and the drawings may be used to interpret the claims.
- (6) Claims shall be clear and concise and shall be fully supported by the description.
- (7) Drawings shall be required when they are necessary for the understanding of the invention.
- (8) The abstract shall merely serve the purpose of technical information; in

particular, it shall not be taken into account for the purpose of interpreting the scope of the protection.

- (9) The applicant may withdraw the application at any time during its pendency.

Unity of invention; amendment and division of applications

8. (1) The application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

- (2) The applicant may amend the application, but the amendment shall not go beyond the disclosure in the initial application.
- (3) The applicant may divide the application into two or more applications, namely, divisional applications, but each divisional application shall not go beyond the disclosure in the initial application.
- (4) Each divisional application shall be entitled to the filing date and, where applicable, the priority date of the initial application.

Right of priority

9. (1) The application may contain a declaration claiming the priority, as provided for in the Paris Convention, of one or more earlier national, regional or international applications filed by the applicant or his predecessor in title in or for any State party to the said Convention.

- (2) Where the application contains a declaration under subsection (1), the Registrar may require that the applicant furnish, within the prescribed time limit, a copy of the earlier application certified as correct by the office with which it was filed.
- (3) The effect of the said declaration shall be as provided in the Paris Convention.
- (4) If the Registrar finds that the requirements under this section and the regulations pertaining thereto have not been fulfilled, the said declaration shall be considered not to have been made.

Information concerning corresponding foreign applications for patents or other titles of protection

10. (1) The applicant shall, at the request of the Registrar, furnish him with the date and number of any application for a patent or other titles of protection filed by him abroad herein referred to as "foreign applications," relating to the same or essentially the same invention as that claimed in the application filed with the Registrar.

(2) The applicant shall, at the request of the Registrar, furnish him with the following documents relating to one of the foreign applications referred to in subsection (1);

- (a) a copy of the patent or other title of protection granted on the basis of the foreign application;
- (b) a copy of any communication received by the applicant concerning the results of any search or examination carried out in respect of the foreign application;
- (c) a copy of any final decision rejecting the foreign application or refusing

- the grant requested in the foreign application; and
- (d) a copy of any final decision invalidating the patent or other title of protection granted on the basis of the foreign application referred to in subsection (1).

Filing Date; Examination

11. (1) The Registrar shall accord as the filing date, the date of receipt of the application, provided that, at the time of receipt, the application fee is paid and the application contains,

- (a) the name of the applicant;
- (b) a part which on the face of it appears to be a description;
- (c) a part which on the face of it appears to be a claim or claims.

(2) If the Registrar finds that the application did not, at the time of receipt, fulfill the requirements referred to in subsection (1), he shall invite the applicant to file the required correction and shall accord as the filing date the date of receipt of the required correction, but if no correction is made, the application shall be treated as if it had not been filed.

(3) Where the application refers to drawings which in fact are not included in the application, the Registrar shall invite the applicant to furnish the missing drawings.

(4) If the applicant complies with the invitation referred to in subsection (3), the Registrar shall accord as the filing date, the date of receipt of the missing drawings. Otherwise the Registrar shall accord as the filing date, the date of receipt of the application and shall treat any references to the said drawings as non-existent.

(5) After according a filing date, the Registrar shall examine whether the application complies with the requirements of section 7(1), (2) and (3) and the regulations pertaining thereto and those requirements of this Order and the regulations which are designated as formal requirements for the purposes of this Order.

(6) Where the Registrar is of the opinion that the application complies with the requirements indicated in subsection (5), the Registrar shall cause the application to be examined as to whether the requirements of section 3, 4, 5, 7(4), (5), (6), (7), 8 and 10 and the regulations pertaining thereto are fulfilled.

(7) The regulations may prescribe that, in respect of some categories of inventions, the examination shall not cover the requirement of novelty and inventive step under section 5(2) and (5).

Grant of patent

12. (1) Where the Registrar finds that, subject to section 11(7), the conditions referred to in section 11(5) and (6) are fulfilled, he shall grant the patent. Otherwise, he shall reject the application and notify the applicant of that decision.

- (2) When he grants a patent, the Registrar shall,
 - (a) publish the fact that he has granted the patent;
 - (b) issue to the applicant a certificate of the grant of the patent and a copy of the patent;

- (c) record the patent; and
- (d) make available copies of the patent to the public, on payment of the prescribed fee.

Rights conferred by patent, ARIPO Protocol patents, exploitation by Government or person thereby authorized

13. (1) Subject to subsection (5) and section 15, the exploitation of the patented invention in Lesotho by persons other than the owner of the patent shall require the latter's agreement.

(2) The owner of the patent shall, in addition to any other rights, remedies or actions available to him, have the right, subjects to subsections (3) and (5) and section 15, to institute court proceedings against any person who exploits the patent without his agreement, in terms of section 2, or who performs acts which make it likely that infringement will occur.

(3) The rights under the patent shall not extend,

(a) to acts in respect of articles which have been put on the market in Lesotho by the owner of the patent or with his consent;

(b) to the use of articles on aircraft, land vehicles, or vessels of other countries which temporarily or accidentally enter the airspace, territory or waters of Lesotho; or

(c) to acts done for scientific research.

(4) A patent in respect of which Lesotho is a designated State, granted by ARIPO by virtue of the ARIPO Protocol shall have the same effect in Lesotho as a patent granted under this Order unless the Registrar has communicated to ARIPO in respect of the application therefor, a decision in accordance with the provisions of the Protocol, that if a patent is granted by ARIPO that patent shall have no effect in lesotho.

(5) Where the public interest, in particular, national security, nutrition, health or the development of other vital sector of the national economy so require, the Minister may decide that, even without the agreement of the patent owner, a government agency or a third person designated by the Minister may exploit the invention, subject to the payment of an equitable remuneration to the said owner.

(6) The decision of the Minister with regard to remuneration may be the subject of an appeal before the High Court.

Duration, Annual fees

14. (1) Subject to subsection (2), a patent shall expire 15 years after the date of the application for the patent.

(2) Upon request, made not more than twelve months and not less than one month before the expiration of the period provided for in subsection (1), and on payment of the prescribed fee, the Registrar shall extend the duration of that patent for a period of five years, provided that the person making the request so to work the invention. Importation shall not constitute such request or that there are circumstances which justify the failure proves, to the satisfaction of the Registrar,

either that the invention is being worked sufficiently in Lesotho at the date of the circumstance.

(3) The Registrar shall decide on the said request within a period of six months from the date the request is received. He shall, in writing, notify the person making the request of the decision and in the case of a rejection, state the reasons therefor; however, the patent shall be deemed to have been extended for a period of five years as long as the Registrar takes no decision within the prescribed six-months period.

(4) For the purposes of this Order, the invention is worked if the patented product is made or the patented process is used, as the case may be.

(5) In order to maintain the patent or patent application, an annual fee shall be paid in advance to the Registrar for each year, starting one year after the filing date of the application for the grant of the patent. A period of grace of six months shall be allowed for the late payment of the annual fee on payment of the prescribed surcharge. If an annual fee is not paid in accordance with the provisions of this subsection, the patent application shall be deemed to have been withdrawn or the patent shall lapse.

Non-voluntary licences

15. (1) On the request of any person who proves his ability to work a patented invention in Lesotho, made to the Registrar after the expiration of a period of four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period expires last, the Registrar may grant a non-voluntary licence if the patented invention is not worked or is insufficiently worked in Lesotho.

(2) Notwithstanding subsection (1), a non-voluntary licence shall not be granted if the owner of the patent satisfies the Registrar that circumstances exist which justify the non-working or insufficient working of the patented invention in Lesotho. Importation shall not constitute such a circumstance.

(3) The beneficiary of the non-voluntary licence shall have the right to exploit, other than to import, the patented invention in Lesotho according to the terms set down in the decision granting the licence and, shall commence the working of the patented invention in Lesotho within the time limit fixed in the said decision and, thereafter, shall work the patented invention sufficiently in Lesotho, subject to the payment of an equitable remuneration therefor as determined in the said decision.

(4) The grant of the non-voluntary licence shall not exclude,

(a) the conclusion of a licence contract by the owner of the patent or the grant of other non-voluntary licences: or

(b) the exploitation of the patented invention under section 13(5).

Invalidation

16. (1) Any interested person may request the court to invalidate a patent.

(2) The court shall invalidate the patent if the person requesting the invalidation

proves that any of the requirements of sections 3,4,5, and 7(4) (5), (6), and (7) and the regulations pertaining thereto is not fulfilled or if the owner of the patent, is not the inventor or his successor in title.

(3) Any invalidated patent, or claim or part of a claim, shall be regarded as null and void from the date of the grant of the patent.

(4) The final decision of the court shall be notified to the Registrar who shall record it and publish the decision as soon as possible.

PART III – UTILITY MODEL CERTIFICATES

Applicability of provisions relating to patents

17. (1) Subject to section 18, the provisions of Part II shall apply, **mutatis mutandis**, to utility model certificates or applications therefor, as the case may be.

(2) Where the right to a patent conflicts with the right to a utility model certificate in the case referred to in section 6(3), the said provision shall apply as if the word “patent” were replaced by the words “patent or utility model certificate”.

Special provisions relating to utility model certificates

18. (1) An invention qualifies for a utility model certificate if it is new and is industrially applicable.

(2) Section 5(1) shall not apply in the case of inventions for which utility model certificates are requested.

(3) Section 11(6) shall not apply in the case of applications for utility model certificates.

(4) A utility model certificate shall expire, without any possibility of renewal, at the end of the seventh year after the date of the filing of the application.

(5) With the exception of subsection (5) thereof, section 14 shall not apply in the case of utility model certificates.

(6) In proceedings under section 16, the court shall invalidate the utility model certificates on the following grounds,

(a) that the claimed invention did not qualify for a utility model certificate, having regard to subsection (1) and to section 5(2), (3), (4), (6) and (8);

(b) that the description and the claims do not comply with the requirements prescribed by section 7(4), (5) and (6) and the regulations pertaining thereto;

(c) that any drawing which is necessary for the understanding of the invention has not been furnished;

(d) that the owner of the utility model certificate is not the inventor or his successor in title.

(7) Section 16(2) shall not apply in the case of utility model certificates.

Conversion of patent applications or applications for utility model certificates

19. (1) At any time before the grant or rejection of a patent, an applicant

for a patent may, upon payment of the prescribed fee, convert his application into an application for a utility model certificate, which shall be accorded the filing date of the initial application.

(2) At any time before the grant or rejection of a utility model certificate, an applicant for a utility model certificate may, upon payment of the prescribed fee, convert his application into the initial application.

(3) An application may not be converted under subsection (1) more than once.

PART IV — INDUSTRIAL DESIGNS

Registrable industrial designs

20. (1) An industrial design is registrable if it is new.

(2) An industrial design shall be new if it has not been disclosed to the public,

(a) anywhere in the world, by publication in tangible form; or

(b) in Lesotho, by description or by use or in any other way, prior to the filing date or, where applicable, prior to the priority date of the application for registration.

(3) For the purposes of subsection (2), disclosure to the public of an industrial design shall not be taken into consideration if it occurred within six months preceding the filing date or, where applicable, the priority date of the application, and if it was by reason or in consequence of acts committed by the applicant or his predecessor in title or of an abuse committed by a third party with regard to the applicant or his predecessor in title.

(4) Industrial designs that are contrary to public order or morality shall not be registrable.

Right to registration of industrial designs, naming of creator

21. (1) Subject to this section, the right to registration of an industrial design the right to the registration of the industrial design shall belong to the creator of that industrial design.

(2) If two or more persons have jointly created an industrial design, the right to the registration of the industrial design shall belong to them jointly.

(3) If and to the extent to which two or more persons have created the same industrial design independently of each other, the person whose application has the earliest filing date or, if priority is claimed, the earliest validly claimed priority date and leads to the grant of a certificate of registration of the industrial design shall have the right to the registration of the industrial design.

(4) The right to the registration of an industrial design may be assigned, or may be transferred by succession.

(5) Where an industrial design is made in execution of an employment contract, the right to the registration of the industrial design shall belong, in the absence of contractual provisions to the contrary, to the employer.

(6) When an industrial design is made in execution of a commission or an employment contract, the right to the registration of the industrial design shall

belong, in the absence of contractual provisions to the contrary, to the person having commissioned the work or to the employer, as the case may be.

(7) When the industrial design has an economic value much greater than the parties could have reasonably foreseen at the time of concluding the contract the person who created the industrial design shall have a right to equitable remuneration, which shall be determined by the court in the absence of agreement between the parties.

(8) Notwithstanding subsections (6) and (7), when an employee, whose employment contract does not require him to engage in inventive activity, makes, in the field of activities of his employer, an industrial design by using data or means available to him through his employment, the right to registration of that industrial design shall belong, in the absence of contractual provisions to the contrary, to the employer;

Provided that the employee shall have a right to equitable remuneration taking into account his salary, the economic value of the industrial design and any benefit derived from the creation of such industrial design by the employer. In the absence of agreement between the parties, the remuneration shall be determined by the court.

(9) Any contractual provision which is less favourable to the creator of the industrial design than the provisions of this section shall be null and void.

10 The creator of the industrial design shall be named as such in the registration of the industrial design, unless in a special written declaration addressed to the Registrar, he indicates that he wishes not to be named. Any promise or undertaking by the creator made to any person to the effect that he will make such a declaration shall be without legal effect.

Application

22. (1) The application for registration of an industrial design shall be filed with the Registrar and shall contain a request, drawings, photographs or other adequate graphic representations of the article embodying the industrial design and indication of the kind of products for which the industrial design is to be used. It may be accompanied by a specimen of the article embodying the industrial design and shall be accompanied by the payment of the prescribed fee.

(2) Where the applicant is not the creator, the request shall be accompanied by a statement justifying the applicant's right to the registration of the industrial design.

(3) Section 9 shall apply *mutatis mutandis* to applications for registration of industrial designs under this section.

(4) The applicant may withdraw the application at any time during its pendency.

Examination, registration of industrial design

23. (1) The Registrar shall accord as the filing date the date of receipt of the application:

Provided that, at the time of receipt, the application contains the name of the applicant and a pictorial representation of the article embodying the industrial design or a specimen thereof. Section 11(2) shall apply *mutatis mutandis* to the application under this subsection.

(2) After according a filing date, the Registrar shall examine whether the application complies with the requirements of section 22(1) and (2) and the regulations pertaining thereto.

(3) The Registrar shall examine whether the industrial design is an industrial design as defined in section 2 and whether it complies with the requirements of section 20(4) and the regulations pertaining thereto.

(4) Where the Registrar finds that the conditions referred to in subsections (2) and (3) are fulfilled, he shall register the industrial design, publish the fact of the registration and issue to the applicant a certificate of registration of the industrial design. Otherwise, he shall reject the application.

Rights conferred by registration, duration, renewal, ARIPO Protocol Industrial Designs

24. (1) The exploitation of a registered industrial design shall not extend to acts in respect of articles which have been put on the market in Lesotho by the registered owner of industrial design or with his consent.

(3) The registered owner of an industrial design shall, in addition to any other rights, remedies or actions available to him, have the right to institute court proceedings against any person who exploits the industrial design or who performs acts which make it likely that infringement will occur.

(4) The registration of an industrial design shall be for a period of five years from the filing date of the application for registration. The registration may be renewed for two further consecutive periods of five years through the payment of the prescribed fee. A period of grace of six months shall be allowed for the late payment of the renewal fee on payment of the prescribed surcharge.

(5) An industrial design in respect of which Lesotho is a designated State, ARIPO by virtue of the ARIPO Protocol shall have the same effect in Lesotho registered as an industrial design registered under this Order unless the Registrar has communicated to ARIPO, in respect of the application therefor, a decision, in accordance with the provisions of the Protocol, that if a registration is made by ARIPO that registration shall have no effect in Lesotho.

Invalidation

25. (1) Any interested person may request the court to invalidate the registration of an industrial design.

(2) The court shall invalidate the registration if,

(a) the person requesting the invalidation proves that,

- (i) the industrial design is not an industrial design as defined in section 2;
- (ii) any of the requirements of section 20 or the regulations pertaining thereto is not fulfilled; or

(b) the registered owner of the industrial design is not the creator or his successor in title.

(3) An invalidated registration of an industrial design shall be regarded as null and void from the date of the grant of the certificate of registration of the

industrial design.

(4) The final decision of the court shall be notified to the Registrar who shall record it and publish it as soon as possible.

PART V — MARKS, COLLECTIVE MARKS AND TRADE NAMES

Acquisition of the exclusive right to a mark, registrability

26. (1) The exclusive right to a mark, as conferred by this Order, shall be acquired by registration in accordance with this order.

(2) A mark cannot be validly registered,

- (a) if it is incapable of distinguishing the goods or services of one enterprise from those of other enterprises;
- (b) if it is contrary to public order or morality;
- (c) 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;
- (d) if it is identical with, or is an imitation of, or contains as 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 authorised by the competent authority of that State or organization;
- (e) if it is identical with, or confusingly similar to, or constitutes a translation of, a mark or trade name which is well known in Lesotho for identical or similar goods or services of another enterprise;
- (f) if it is identical with a mark belonging to a different proprietor and already on the register, or with an earlier filing or priority date, in respect of the same goods or services, or closely related goods or services, or if it so nearly resembles such a mark as to be likely to deceive or cause confusion.

Application for registration

27. (1) The application for registration of a mark shall be filed with the Registrar and shall contain a request, a reproduction of the mark and a list of the goods or services for which registration of the mark is requested, listed under the applicable class or classes of the International Classification. It shall be accompanied by the payment of the prescribed application fee.

(2) The application may contain a declaration claiming the priority, as provided for in the Paris Convention, of an earlier national or regional application filed by the applicant or his predecessor in title, in which case, the Registrar may require that the applicant furnish, within the prescribed time limit, a copy of the earlier application, certified as correct by the office with which it was filed.

(3) The effect of the said declaration shall be as provided in the Paris Convention; if the Registrar finds that the requirements under this subsection and the regulations pertaining thereto have not been fulfilled, the said declaration shall be considered not to have been made.

(4) The applicant may withdraw the application at any time during its pendency.

Examination, opposition, registration of mark

28. (1) The Registrar shall examine whether the application complies with the requirements of section 27(1) and the regulations pertaining thereto.

(2) The Registrar shall examine and determine whether the mark is a mark as defined in section 2 and is registrable under section 26(2) and the regulations pertaining thereto.

(3) Where the Registrar finds that the conditions referred to in subsections (1) and (2) are fulfilled, he shall forthwith cause the application, as accepted, to be published in the prescribed manner.

(4) 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, and section 26(2) and regulations pertaining thereto are not fulfilled.

(5) The Registrar shall send forthwith a copy of such a notice to the applicant, and, within the prescribed period and in the prescribed manner, the applicant shall send to the Registrar a counter-statement of the grounds on which he relies for his application. If he does not do so, he shall be deemed to have abandoned the application.

(6) If the applicant sends a counter-statement, the Registrar shall furnish a copy thereof to the person giving notice of opposition and, after hearing the parties, if either or both wish to be heard, and considering the merits of the case, shall decide whether the mark should be registered.

(7) After the application is published and until the registration of the mark, the applicant has the same privileges and rights as he would have if the mark had been registered; however, it shall be a valid defence to an action brought hereunder in respect of an act done after the application was published, if the defendant establishes that the mark could not validly have been registered at the time the act was done.

(8) Where the Registrar finds that the conditions referred to in subsections (1) and (2) are fulfilled, and either,

- (a) the registration of the mark has not been opposed within the prescribed time limit; or
- (b) the registration of the mark has been opposed and the opposition has been decided in the applicant's favour,

the Registrar shall register the mark, publish the fact of the registration and issue to the applicant a certificate of registration. Otherwise, he shall reject the application.

Rights conferred by registration, duration, renewal

29. (1) The use of a registered mark, in relation to any goods or services for which it has been registered, by any person other than the registered owner shall require the agreement of the latter.

(2) The registered owner of a mark shall, in addition to any other rights, remedies or actions available to him, have the right to institute court proceedings against any person who infringes the mark by using, without his agreement, the mark as aforesaid or who performs acts which make it likely that infringement will occur. The right shall extend to the use in relation to goods and services similar to the registered mark and to the use in relation to goods and services confusion may arise in the public.

(3) The rights conferred by registration of a mark shall not extend to acts in respect of articles which have been put on the market in Lesotho by the registered owner or with his consent.

(4) The registration of a mark shall be for a period of ten years from the filing date of the application for registration.

(5) The registration of a mark may, upon request, be renewed for consecutive periods of ten years, provided that the registered owner pays the prescribed renewal fee.

(6) A period of grace of six months shall be allowed for the late payment of the renewal fee on payment of the prescribed surcharge.

Invalidation, removal on grounds of non-use

30. (1) Any interested person may request the Registrar to invalidate the registration of a mark.

(2) The Registrar shall invalidate the registration if the person requesting the invalidation proves that,

(a) any of the requirements of a mark as defined in section 2; or

(b) any of the requirements of section 26(2) and of the regulations pertaining thereto, is not fulfilled

(3) Any invalidation of a registration of a mark shall be deemed to have been effective as of the date of registration, and it shall be recorded and published as soon as possible.

(4) Any interested person may request the Registrar to remove a mark from the register, in respect of any of the goods or services for which it is registered, on the grounds that up to one month prior to filing the request the mark had, after its registration, not been used by the registered owner or a licence during a continuous period of three years or longer:

Provided that a mark shall not be removed if it is shown that special circumstances prevented the use of the mark and that there was no intention not to use or to abandon the same in respect of those goods or services.

Collective marks

31 (1) Subject to subsections (2) and (3), the provisions of sections 26 to 30 relating to marks shall apply to collective marks.

(2) An application for registration of a collective mark shall designate the mark as a collective mark and shall be accompanied by a copy of the conditions governing the use of the collective mark.

(3) The registered owner of a collective mark shall notify the Registrar of any changes made in respect of the conditions referred to in subsection (2).

(4) In addition to the grounds provided in section 30(2), the Registrar shall invalidate the registration of a collective mark if the person requesting the invalidation proves that only the registered owner uses the mark, or that he uses or permits its use in contravention of the conditions referred to in subsection (2) or that he uses or permits its use in a manner liable to deceive trade circles or the public as to the origin or any other common characteristics of the goods or services concerned.

Licensing of marks and collective marks

32. (1) Any licence contract concerning the registration of a mark, or an application therefor, shall provide for effective control by the licensor of the quality of the goods or services of the licensee in connection with which the mark is used. If the licence contract does not provide for such quality control or if such quality control is not effectively carried out, the licence contract shall not be valid and the exclusive right referred to in section 29(1) and (2) may not be exercised.

(2) The registration of a collective mark, or an application therefor, may not be the subject of a licence contract.

Trade names

33. (1) A name or designation may not be used as a trade name if by its nature or the use to which it may be put, it is contrary to public order or morality and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

(2) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(3) In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public shall be deemed unlawful.

PART VI — ACTS OF UNFAIR COMPETITION

Acts of unfair competition

34. (1) Any act of competition contrary to honest practices in industrial or commercial matters shall be unlawful.

(2) The following acts, in particular, shall be deemed to constitute acts of unfair competition,

- (a) all acts of such nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor;
- (b) false allegations in the course of trade of such nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor;
- (c) indications or allegations the use of which in the course of trade is liable

to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity of the goods.

PART VII — GENERAL PROVISIONS

Representation by agent

35. Where the applicant's ordinary residence or principal place of business is outside Lesotho, he shall be represented by an agent.

Changes in ownership, licence contracts

36. (1) Any change in the ownership of a patent, a utility model certificate, the certificate of registration of an industrial design or the certificate of registration of a mark or collective mark or in the ownership of an application therefor, shall be in writing and shall, at the request of any interested party to the Registrar, be recorded and, except in the case of an application, be published by the Registrar. Such change shall have no effect against third parties until such recording is effected.

(2) Any change in the ownership of the registration of a collective mark or in the ownership of an application therefor, shall require previous approval by the Minister.

(3) Any change in the ownership of a trade name shall be made with the transfer of the enterprise or the part thereof identified by that name and shall be in writing.

(4) A change in the ownership of the registration of a mark or in the ownership of a collective mark shall, however, be invalid if it is likely to deceive or cause confusion, particularly in regard to the nature, origin, manufacturing process, characteristics, or suitability for their purpose, of the goods or services in relation to which the mark or collective mark is intended to be used or is being used.

(5) Any licence contract concerning a patent, a utility model certificate, a registered industrial design or a registered mark, or an application therefor, shall, on pain of invalidity, be submitted to the Registrar who shall keep its contents confidential but record it and publish the fact of having recorded such licence contract.

(6) Where the Registrar, after consultation with the Minister, is of the opinion that any clause in a licence contract or relating to such a contract imposes unjustified restrictions on the licensee, with the consequence that the contract, taken as a whole, is harmful to the economic interests of Lesotho, the Registrar shall notify the parties to the contract accordingly and invite them, several times if he deems it necessary, to modify the contract so that it does not contain any such clause and, if they fail to do so, he shall declare the clause to be null and void.

(7) For the purposes of this Order, "unjustified restrictions" are restrictions which entail for the licensee, in the industrial or commercial field, restrictions not deriving from the rights conferred by the grant of a patent or a utility model certificate or the registration of an industrial design or a mark or restrictions unnecessary for the safeguard of those rights.

(8) In the examination of contracts under subsection (6), the Registrar, with regard to licence contracts relating to patents and utility model certificates, shall take into consideration, in particular, any clause contained in a contract the effect of which would be,

(a) to import technology from abroad when substantially similar or equivalent

technology may be obtained on the same or more favourable conditions without any importation of the technology from abroad;

- (b) to oblige the licensee to give consideration which is disproportionate to the value of the technology to which the contract relates;
- (c) to oblige the licensee to acquire any materials from the licensor or from sources designated or approved by the licensor unless it is otherwise impossible, for all practical purposes, to ensure the quality of the products to be produced and provided that the said materials are supplied at a reasonable price;
- (d) to restrict the licensee's freedom to acquire any materials from any source, unless it is otherwise impossible, for all practical purposes, to ensure the quality of the products to be produced;
- (e) to restrict the licensee's freedom to use any materials which are not supplied by the licensor or by source designated or approved by the licensor, unless it is otherwise impossible, for all practical purposes, to ensure the quality of the products to be produced;
- (f) to oblige the licensee to sell the products produced by him exclusively or principally to persons designated by the licensor;
- (g) to oblige the licensee to make available to the licensor, without appropriate consideration, any improvements made by the licensee with respect to the technology to which the contract relates;
- (h) to limit the quantity of the products produced by the licensee;
- (i) to restrict the licensee's freedom to export or to allow others to export the products produced by him, provided that if the licensor owns, in a country to which such a restriction applied, a patent which would be infringed in case of importation of the said products into the said country, if the licensor has a contractual obligation not to allow others to export the said products to such a country or if the licensor already supplies the market in such a country with the same products, such facts shall be taken into account;
- (j) to oblige the licensee to employ persons designated by the licensor not needed for the efficient transfer of the technology to which the contract relates;
- (k) to impose restrictions on research or technological development carried out by the licensee;
- (l) to restrict the licensee's freedom to use any technology other than the technology to which the contract relates;
- (m) to extend the coverage of the contract to technology not required to achieve the objective of the contract and to oblige the licensee to give consideration for such technology;
- (n) to fix prices for the sale or resale of the products produced by the licensee;
- (o) to exempt the licensor from any liability resulting from any defect inherent in the technology to which the contract relates or to restrict such liability

unreasonably;

- (p) to restrict the licensee's freedom to use, after the expiration of his contractual obligations, the technology acquired as a result of the contract, subject, however, to any right of the licensor under a patent;
- (q) to establish the duration of the contract for a period which is unreasonably long in relation to the economic function of the contract, provided that any period which does not exceed the duration of the patent to which the contract relates shall not be regarded as unreasonably long.

Registrar

37. There shall be a Registrar whose office shall be an office in the public service.

Functions of the Registrar

38. (1) The Registrar shall,

(a) perform all functions relating to;

(i) The grant of patents and utility model certificates;

(ii) the registration of industrial designs, marks and collective marks;

(b) Superintend and perform such other duties and exercise such other powers as are conferred by this Order or the regulations made thereunder; and

(c) be responsible for the carrying out of studies, programmes or exchanges of items or services regarding domestic and international industrial property legislation.

(2) Decision of the Registrar shall be signed by the Registrar or an official designated by him.

(3) The Minister shall determine the organisational structure and regulate all questions concerning the financial and budgetary systems of the Registry.

Registers, Gazette

39. (1) The Registrar shall maintain separate registers for patents, utility model certificates, industrial designs and marks. Collective marks shall be registered in a special section of the register of marks. All the recordings provided for in this Order shall be effected in the said registers.

(2) The registrar may be consulted by any person, and any person may obtain extracts therefrom, under the conditions prescribed in the regulations.

(3) The registers shall publish in the Gazette all matters required to be published under this Order.

Correction of errors, extension of time

40. (1) The Registrar may, subject to any provisions in the regulations, correct any error of translation or transcription, clerical error or mistake in any application or document filed with the Registrar or in any recording effected pursuant to this Order or the regulations.

(2) If the Registrar is satisfied that the circumstances justify it, he may, upon

receiving a written request, extend the time for doing any act or taking any proceeding under this Order and the regulations made thereunder upon notice to the parties concerned and upon such terms as he may direct. The extension may be granted though the time for doing the act or taking the proceeding has expired.

Exercise of discretionary powers

41 (1) The Registrar shall give any party to a proceeding before him an opportunity of being heard before exercising adversely to that party any discretion vested in the Registrar by this Order or the regulations.

Competence of High Court Appeals

42. (1) The High Court shall have jurisdiction in cases of dispute relating to the application of this Order and regulations and in matters which under this Order are to be referred to the court.

(2) Any decision taken by the Registrar under this Order, in particular, the grant of a patent or of a utility model certificate of registration of an industrial design or of a mark or collective mark, or the rejection of an application for such a grant or registration, may be the subject of an appeal by any interested party before the High Court and such appeal shall be filed within two months of the date of the decision.

Infringement, unlawful acts, offences

43. (1) Subject to sections 13(3) and (5), (15), 24(2) 29(3), an infringement shall consist of the performance, in Lesotho, by any person other than the owner of the title of protection, without the agreement of the latter, of any act referred to in sections 13, 24, and 29.

(2) On the request of the owner of the title of protection, or of a licensee if he has requested the owner to institute court proceedings for a specific relief and the owner has refused or failed to do so, the court may grant an interdict to prevent infringement, an imminent infringement, or an unlawful act referred to in sections 33(2) and (3) and 34, award damages and grant any other remedy provided for in the general law.

(3) On the request of any competent authority or any interested person, association or syndicate, in particular, of producers, manufacturers or traders, the court may grant the same relief in case of an act of unfair competition referred to in section 34.

(4) Any person who performs an act which constitutes an infringement as defined in subsection (1) or an unlawful act as defined in section 32(2) and (3), and section 34, commits an offence and is liable to a fine of M10,000 or to imprisonment for a term of 10 years or both.

Application of international treaties

44. The provisions of any international treaty in respect of industrial property to which Lesotho is a party shall apply to matters dealt with by this Order and, in case of conflict with the provisions of this order, the provisions of the international treaty shall prevail.

Regulations

45. (1) The Minister may make regulations for the better carrying into effect of the purposes of this Order.

- (2) Regulations made under subsection (1) may, in particular, prescribe,
 - (a) application fees for the grant of patents, utility model certificates and for the registration of industrial designs, marks and collective marks;
 - (b) specified categories of inventions for the purposes of section 11(7);
 - (c) the fees for copies of patents for the public;
 - (d) the surcharge payable in respect of late payment of maintenance or renewal fees;
 - (e) conditions under which a person may obtain extracts from registers in terms of section 39(2); and
 - (f) any other matter required to be prescribed under this Order.

Administrative instructions

46. The Registrar may issue administrative instructions relating to the procedures under this Order and the regulations as well as to other functions of his office.

Repeals, savings and transitional provisions

47. (1) The following enactment are repealed,
 - (a) the patents Act, 1984;

A. 30 of 1984 A. 31 of 1984

- (b) the Trade Marks Act, 1984

Cap. 92

(2) Notwithstanding the repeal of the patents, Trade marks and Designs Protection Proclamation, 1919 by the patents Act, 1984, patents, trade marks and industrial designs registered thereunder shall remain in force but shall, subject to subsections (3) and (4), be deemed to have been granted or registered under this Order.

(3) Patents and industrial designs registered under the said Proclamation shall remain in force for the unexpired portion of the period of protection provided thereunder, subject, respectively, to the payment of annual maintenance fees or renewal fees provided for in this Order.

(4) Trademarks registered under the said Proclamation shall be due for renewal within the same period as under the said Proclamation or ten years from the entry into force of this Order, whichever period first expires, and, upon renewal, shall be reclassified in accordance with the International Classification.

- (5) A person who, on the date of entry into force of this Order,
 - (a) is the owner of a patent granted in the United Kingdom or has filed an application for the grant of a patent in the United Kingdom; or

(b) is the proprietor of an industrial design registered in the United Kingdom or has filed an application for registration of an industrial design in the United Kingdom,

may, within 12 months of the entry into force of this Order, file an application for the grant of a patent for the same invention or for the registration of the same industrial design under this Order and such application shall be accorded the filing date or priority date accorded to the application, grant or registration in the United Kingdom.

(6) Notwithstanding the repeal of the Patents, Trade marks and Designs Protection Proclamation, 1919 by the Patents Act, 1984, applications for the registration of patents, trademarks and industrial designs filed in Lesotho between October 1, 1985, and the date of entry into force of this Order shall be in accordance with the provisions of that Proclamation, and, upon being granted, shall be subject to the provisions of this Order.

(7) Within 18 months from the entry into force of this Order, the Minister may by notice in the Gazette, make any further transitional or saving provisions which appear to him to be necessary or desirable.

Moshoeshoe II