

# INTEGRATED LEGAL CONSULTANTS

## REQUIREMENTS FOR FILING NOTICE OF OPPOSITION IN GHANA

## **Editor's Note**

Integrated Legal Consultants (ILC) was founded in April 2007, in Accra, Ghana, to offer dedicated and innovative corporate legal services while ensuring that the Ghanaian and West African business community and our network of international clients benefit from the highest quality of corporate and commercial legal services that the Practice provides.

As part of this vision, the firm has introduced the publication of newsletters on legal and economic issues that would be of interest to the client and equally affect their transactions. This is our seventh edition.

Oppositions are an important part of trademark registration. This is because once the trademark is published it leaves it open to opposition for a period of two months before a certificate can be issued. Thus, right holders should keep a watch on the Industrial Bulletins published regularly by the Industrial Property Office to identify trademarks that they may wish to oppose before they proceed to registration.

In this issue, we have highlighted certain aspects of oppositions as well as some grounds of opposition an opponent may rely on when opposing the application for the registration of a trademark under

the Trade Marks Act, 2004, (Act 664) as amended by the Trade Marks Amendment Act, 2014 (Act 876).

We hope you find it informative and educative. Your feedback is welcome.

We wish you a fruitful year 2020!

Happy Reading!

*Esohe Olajide*

**Editor**

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**Editor-In-Chief**



## REQUIREMENTS FOR FILING NOTICE OF OPPOSITION IN GHANA

Under the Trade Marks Act, 2004, (Act 664) as amended by the Trade Marks Amendment Act, 2014 (Act 876), where the Registrar accepts that an application to register a trade mark has fulfilled the requirements under Act 664, the mark is published in the Industrial Bulletin so as to enable any interested person(s) file a notice of opposition within the prescribed period of 2 (two) months from the date of publication, against the registration of the mark (This is provided for in Section 6(2) of Act 664)

A Notice of Opposition can only be filed upon the publication of the marks as indicated above. In order to qualify to file the Notice, the Opponent must have a registered trademark in Ghana.

Where the Opponent's mark is not registered in Ghana, the only way to sustain opposition proceedings is if the mark is well known. **Section 52** of the Trademarks Act, 2004 (Act 664) as amended by **section 12** of the Trademarks (Amendment) Act, 2014 (Act 876) defines a well-known mark as follows:

*“Well-known trademark” means the trademark of a person who is*

*(a) A national of a country that is a party to the Paris Convention; or*

*(b) Domiciled in or has a real and effective commercial establishment in a country that is a party to the Paris Convention, and the trademark is recognized or known in the relevant public sector as belonging to that person.”*

Note that evidence will have to be adduced to show that the mark is indeed well known.

## GROUND OF OPPOSITION

Aside from the more common ground of opposition, which is likelihood of confusion, there are other reasons a party may bring an opposition.

Section 5 of Act 664 provides for grounds for refusal of registration of a mark.

Some of the grounds of opposition an Opponent may rely on are:

- It is a trade name or sign that belongs to the public domain i.e. trademark name is already used so widely that it has become generic.
- It is incapable of distinguishing the goods or services of one enterprise from that of another enterprise.
- It is contrary to public order or morality.
- It is likely to mislead the public or trade circles with particular reference to the geographical origin of the goods or services
- It is identical to or is an imitation of or contains as an element, an armorial bearing, flag, emblem, name, abbreviation or initials of the name, official sign or hallmark adopted by a State, intergovernmental organisation or organisation created by an International convention.
- It is identical to or confusingly similar to or constitutes a translation of a trademark or trade name which is well-known in the country for identical or similar goods or services of another enterprise.
- The trademark is identical to a trademark of another owner already on the register or an application with an earlier filing or priority date for the same goods or services or if it resembles that trademark so closely that it is likely to deceive or cause confusion.

*This newsletter includes general information about legal issues and developments in the law. Such materials are for informational purposes only and may not necessarily reflect the most current legal developments. These informational materials are not intended, and must not be taken, as legal advice on any particular set of facts or circumstances. You need to contact a lawyer licensed in your jurisdiction for advice on specific legal issues and problems.*

There are so many grounds for opposing a trademark, therefore an Opponent must consult an attorney in order to ensure that the grounds filed have a greater chance of succeeding in the opposition proceedings.

The following information needs to be provided in order to draft the Notice of Opposition;

- Details of the opponent's trademark
- The class of goods for which the trademark is registered,
- The details of filings in other jurisdictions,
- Copies of sales figures, advertisements, publications and all relevant information pertaining to the opponent's mark if necessary.

In order to oppose the registration of a mark, a notice of opposition must be filed and submitted at the Industrial Property Office. In this notice, you must plead the grounds of your opposition and explain why the application should not be registered. Once your notice of opposition is filed and a copy sent to the Applicant, the Applicant has 2 (two) months to file a counter statement in response. Upon failure to respond to the notice of opposition, the application will be deemed to have been abandoned by the Applicant.

Where a Counter statement is filed, both Parties have 1 (month) within which to file any evidence they want to adduce by way of Statutory Declaration.

Trademark owners must be diligent in order to prevent a confusingly similar mark from being registered.

If you need help with oppositions in Ghana kindly send an email to [ilc@integratedlegalconsultants.com](mailto:ilc@integratedlegalconsultants.com)