Registration of Trade Marks Under The Trade Marks Act 1969

By
Inaam Salih Attig

Supervisor
Professor Akolda Man Tier

A Thesis Submitted in Partial Fulfillment of the Requirements for the LLM. Degree

Faculty of Law
University of Khartoum

April 2005
Table of Contents

<table>
<thead>
<tr>
<th>Section</th>
<th>Pages</th>
</tr>
</thead>
<tbody>
<tr>
<td>Table of Contents</td>
<td>i</td>
</tr>
<tr>
<td>Dedication</td>
<td>vi</td>
</tr>
<tr>
<td>Acknowledgement</td>
<td>vii</td>
</tr>
<tr>
<td>Abbreviations</td>
<td>viii</td>
</tr>
<tr>
<td>Preface</td>
<td>ix</td>
</tr>
<tr>
<td>Table of Cases</td>
<td>xi</td>
</tr>
<tr>
<td>Abstract</td>
<td>xii</td>
</tr>
<tr>
<td>Abstract (in Arabic)</td>
<td>xiii</td>
</tr>
</tbody>
</table>

**CHAPTER ONE**

**Historical Development of Trade Marks Law in Sudan**

1. Introduction ........................................................................................................... 1
   (i) The Cautionary Note before the 1931 Ordinance ........................................... 1
   (ii) The Trade Marks Act 1969 ........................................................................ 2
   (iii) The Trade Marks Act 1969 ....................................................................... 3
   (iv) The Trade Marks Rules 1969 ..................................................................... 4
   (v) The Impacts of International Treaties ...................................................... 5
2. The Definitions of a Trade Mark in the Sudan ................................................. 6
   (i) The Statutory Definitions of a Trade Mark in the Sudan ......................... 6
       (a) Visible Sign .................................................................................... 8
       (b) Used or Proposed to Be Used ...................................................... 10
       (c) Upon, in Connection with, or in Relation to Goods ....................... 11
       (d) Distinguishing the Goods of a Person ....................................... 11
   (ii) Judicial Definition of a Trade Mark .................................................... 12
   (iii) Definition of a Trade Mark under English Law ................................... 13
       (a) Any Sign ...................................................................................... 14
       (b) Capable of Being Represented Graphically .................................. 14
(c) Capable of Distinguishing the Goods or Services of One Undertaking from Those of other Undertakings... 15

3. Functions of Trade Marks........................................................................... 16
   (i) The Origin Function ......................................................................... 17
   (ii) The Product Differentiation Function .......................................... 19
   (iii) The Guarantee Function .............................................................. 20
   (iv) The Advertising Function ............................................................ 21

4. Conclusion............................................................................................ 21

CHAPTER TWO
Registerability of Trade Marks

1. Introduction .......................................................................................... 23

2. What May Constitute a Trade Mark...................................................... 23
   (i) Word Marks .................................................................................. 24
   (ii) Name Marks ................................................................................ 26
   (iii) Signature Marks ......................................................................... 26
   (iv) Letters and Numerals Mark ......................................................... 27
   (v) Device Mark ................................................................................ 27
   (vi) Packages and Containers ........................................................... 28

3. Unregistrable Marks.............................................................................. 29
   (i) The Trade Marks Ordinance 1931 ............................................... 29
   (ii) The Trade Marks Act 1969 .......................................................... 30
      (a) Shapes ...................................................................................... 31
      (b) Descriptive Marks ................................................................... 32
      (c) Generic Marks .......................................................................... 33
      (d) Marks Contrary to Morality or Public Order ....................... 34
      (e) Specially Protected Emblems ............................................... 35

4. Unregistrable Marks except with the Consent of a Third Party ....... 36
   (i) Prior Marks .................................................................................. 37
      (a) Similar Marks .......................................................................... 38
(b) Similar Goods ................................................................. 40
(c) Possible Defenses Against Refusal on Ground of
   Misleading Similarity......................................................... 41
(d) Some Decisions of Sudanese Courts Concerning
   Misleading Similarity........................................................ 42
(ii) Well-Known Marks............................................................ 44
(iii) Prior Rights ..................................................................... 45
5. Conclusion............................................................................. 46

CHAPTER THREE
Procedure of Registration of Trade Marks
1. Introduction ............................................................................. 48
   (i) Necessity of Registration.................................................... 48
   (ii) The Registrar..................................................................... 49
   (iii) The Register of Trade Marks............................................. 50
2. Application for National Registration ..................................... 50
   (i) Contents of the Application............................................... 51
   (ii) Application by an Agent................................................... 52
   (iii) Nationality of the Applicant.............................................. 53
   (iv) Representation of the Mark .............................................. 53
   (v) Classification of Goods and Services ............................... 54
   (vi) Date of Filing and Priority Date ....................................... 55
3. Examination of the Application .............................................. 57
4. The Search ............................................................................. 57
   (i) The General Rule ............................................................. 57
   (ii) Search upon Request ....................................................... 58
   (iii) No Liability for the Registrar in Respect of Search Errors .... 58
5. Refusal or Acceptance of the Application ............................... 58
6. Publication ............................................................................. 59
7. Objections to Registration..................................................... 60
8. Registration

(i) Certificate of Registration

(ii) Conditions, Amendments, Modifications, Limitations and Disclaimers Imposed by the Registrar

(iii) Duration and Renewal of Registration

(iv) The Symbol ®

9. Rights Conferred by Registration

(i) The Right to use the Trade Mark

(ii) The Right to Preclude Others From Using the Mark

(iii) Protection of Registered Trade Mark By Courts of Sudan

10. International Registration of Trade Marks

(i) Filing an International Application

(ii) Refusal of Protection

(iii) Dependence on the Basic Mark

(iv) Advantages of the Madrid System

(v) The International Registration System of Trade Marks in the Sudan

11. Conclusion

CHAPTER FOUR

Opposition, Cancellation, Assignment, and Surrender of Registration

1. Introduction

2. Opposition to Registration

(i) The Trade Marks Ordinance 1931

(ii) The Trade Marks Act 1969

(a) Who May Oppose

(b) Grounds for Opposition

(c) Procedure of Opposition

(iii) Some Decisions of Sudanese Courts Concerning Opposition
3. Cancellation of Registration.......................................................... 86
   (a) Who May Request the Cancellation................................... 87
   (b) Grounds for Cancellation .................................................. 87
   (c) Acquiescence ..................................................................... 90
4. Assignment of Registration........................................................... 90
5. Surrender of Registration .............................................................. 91
6. Conclusion .................................................................................... 91

CHAPTER FIVE

Conclusion

Conclusion ........................................................................................ 93
Bibliography ..................................................................................... 97
Dedication

To my beloved late parents,
I dedicate every success in my life
Acknowledgement

No thesis is entirely the product of its writer, and this thesis is no exception. Therefore, I would like to take the opportunity of thanking a number of people who have helped me undertaking this work. Particular thanks must go to Professor Akolda Man Tier who as my supervisor was an unfailing source of advice and encouragement. I must also thank Mr. Abbas Abd El Mageed at the Registrar Office who helped me to inspect the Trade Marks Registry Archives and provided me with all materials and documents from the Registrar Office needed for writing this thesis. I would also like to thank my whole family for supporting me specially my mother in law Mama Raya, my husband Abdullai Taj Elsir Ali Elshiekh, my children Mohamad, Shahd and Ilham, my brother Nazar Attig and my beloved nieces Azza Elfil, Hiba Tamim and Nada Ibrahim. Needless to say however, both the views expressed and responsibility for any errors or omissions are mine alone.
<table>
<thead>
<tr>
<th>Abbreviation</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>S.G.</td>
<td>Sudan Government.</td>
</tr>
<tr>
<td>S.L.J.R.</td>
<td>Sudan Law Journal and Reports.</td>
</tr>
<tr>
<td>S.C.</td>
<td>Supreme Court.</td>
</tr>
<tr>
<td>C.O.</td>
<td>Civil Objection.</td>
</tr>
<tr>
<td>Cr.O.</td>
<td>Criminal Objection.</td>
</tr>
<tr>
<td>D.C.</td>
<td>District Court.</td>
</tr>
<tr>
<td>Cr.Rev.</td>
<td>Criminal Review.</td>
</tr>
<tr>
<td>A.C.Rev.</td>
<td>Appeal Court Review.</td>
</tr>
<tr>
<td>WIPO</td>
<td>World Intellectual Property Organization.</td>
</tr>
<tr>
<td>T.M.</td>
<td>Trade Mark.</td>
</tr>
</tbody>
</table>
Preface

Although trade marks existed in the ancient world they started to play an important role with the industrialization, and they have since become a key factor in the modern world of international trade.

Trade marks not only identify the offeror of goods or service and help consumers to make their choice between the various goods available in the market but also provide assurance of quality and consistency to consumers. For example, consumers expect that the Lux soap they buy in Khartoum is the same as one purchased in Juba. Therefore, it can be said that trade marks encourage their owners to maintain and improve the quality of the goods sold under the trade mark in order to meet consumers expectations.

By association with a successful product or service, a trade mark may be built into an asset of prime value to a business. For instance, the trade marks of the Coca-Cola Company have been valued at more than 30 billion American dollars and are the most recognized commercial symbols in the world.

Trade marks should be protected for the benefit of the traders, consumers and the trade circle at large especially in free-market economics prevailing nowadays. Under Sudanese legal system, protection of trade marks is mainly conferred by virtue of their formal national or international registration which grants the owner of the trade mark an exclusive right to the mark. Registration of a trade mark does not by itself prevent a competitor from entering any market with his own goods or services; it merely prevents him from infringing the protected mark in order to facilitate his market entry.

This study will discuss registration of trade marks in Sudan under the Trade Marks Act 1969. Hopefully, it might be of some assistance to
law students, lawyers, businessmen and officials in the civil service who come in contact with the field of trade marks in the course of their careers. The thesis is divided into five chapters. Chapter One as an introductory chapter gives a brief account of the historical development of the trade marks law in the Sudan and goes on to discuss the definition and the various functions of a trade mark. Chapter Two concentrates on the registrability of trademarks. Chapter Three gives a brief overview of the procedure to be followed in obtaining national or international registration of a trade mark and highlights the rights conferred by registration. Chapter Four is devoted to opposition, cancellation, assignment and surrender of registration. Lastly Chapter Five concludes the thesis with some recommendations in relation to the trade marks law and the practice as well.
Table of Cases

a- Sudanese Cases:
Formageries Bel – LaVache QuiRit v. Trade Marks Registrar
Hamza M. Elshabrawishi v. Sudan Perfumary Company (1963) S.L.J.R.
206.
Kamel Abdel Shaheed and Sons v. Board and Sons A.C. Rev. – 97 (1957)
unreported.
unreported.
Mamoun El Brier Food Products Company Ltd. v. The Trade Marks
Omdurman Optical & Watches Co. v. Mohamed Ali Abbas (1968)
S.L.J.R. 136.

b- Foreign Cases
Bismag Ltd. v. Amblins (chemist) Ltd. (1940) 57 R.P.C. 209.
Abstract

At the core of every successful business are the trade marks the business uses to identify its goods or services. If properly protected, trade marks can last forever; and can provide the business with a unique and immediately visible identification to its customers and the world beyond. A trade mark cannot be protected by the law unless it is registered, since registration is considered as a basis of the legal protection. The Trade Marks Act 1969 together with its Rules organize all matters concerning registration of trade marks and provide the procedure to be followed in obtaining such registration.

This thesis examines the registration of trade marks in Sudan under the Trade Marks Act 1969. Chapter One highlights the historical development of the trade marks laws in the Sudan and discusses the definition of the trade marks under both the Trade Marks Ordinance 1931 and the Trade Marks Act 1969 and the various functions of the trade marks. The discussion in Chapter Two is mainly about the registrability of trade mark. Chapter Three concentrates on the procedure of registration. Since the Trade Marks Act 1969 has adopted the international registration system of trade marks, reference is made in this chapter to the international arrangements concerning this issue namely the Madrid Agreement and the Madrid Protocol. Chapter Four sheds lights on some essential matters concerning registration such as objection, cancellation, assignment and surrender. Lastly Chapter Five concludes the thesis with some recommendations hopefully to be adopted for better protection of trade marks achieved by registration.
الخلاصـة

توجد في قلب كل عمل تجري ناجح العلامات التجارية التي يستخدمها
العمل التجاري لتعريف بسلعه وخدماته فإذا ما توقفت الحماية الصحيحة
للعلامات التجارية فإنها ستقوم إلى ما لا نهاية وأن توفر للعمل التجارية تعريفاً
واصلياً ومتفرداً لسلعه وخدماته بالنسبة لزبائنه والعالم أجمع.

لا يمكن حماية العلامة التجارية بواسطة القانون إلا إذا سجلت حيث أن
tسجيل يعتبر أساس الحماية القانونية . ينظم قانون العلامات التجارية والقواعد
الصادرة بموجب كل المسائل المتعلقة بالعلامات التجارية وإجراءات تسجيلها.
تدرس هذه الرسالة تسجيل العلامات التجارية في السودان بموجب قانون العلامات
التجارية لسنة 1969م. يلقي الباب الأول الضوء على التطور التاريخي لقوانين
العلامات التجارية في السودان ويفق تعريف العلامة التجارية تحت قانون
العلامات التجارية لسنة 1931م وقانون العلامات التجارية لسنة 1969م. كذلك
يناقش الظواهر المختلفة للعلامة التجارية . أما الباب الثالث فهو يركز على
إجراءات تسجيل وما أن قانون العلامات التجارية سنة 1969م قد أخذ بنظام
التسجيل الدولي للعلامات التجارية فستتم الإشارة للاتفاقيات الدولية المتعلقة بهذا
الشأن مثل اتفاقية مدريد وبروكول مدريد . الباب الرابع يلقي الضوء على بعض
المسائل الهامة المتعلقة بالتسجيل مثل الرفض والإلغاء والتحويل والتنازل . وأخيراً
حول الباب الخامس خاتمة الرسالة التي تتضمن بعض التوصيات آملين أن يتم
تبنيها لتوفر حماة أفضل للعلامات التجارية المسجلة.
CHAPTER ONE

Historical Development of Trade Marks Law in Sudan

As an introduction to the discussion of the registration of trade marks in the Sudan under the provisions of the Trade Marks Act 1969, this chapter will highlight the legal progress of the trade marks law in Sudan throughout the last century. It will examine the definitions of the term “trade mark” which had been laid down by the consecutive trade marks law. Lastly, the chapter will be concluded by discussing the various functions of the trade mark.

1. Sudan Legislation in the Field of Trade Marks

The legal and administrative systems in the field of intellectual property in Sudan generally can be considered old and ancient. The legal protection of intellectual property rights started in Sudan Penal Code 1899, which later became the Sudan Penal Code 1925. In the latter code a whole chapter was dedicated to Trade Marks, from section 416 to section 424. The Trade Marks Ordinance 1931 was the first enactment completely concerned with trade marks in Sudan. It has been replaced by the Trade Marks Act 1969 which is still in force.

(i) The Cautionary Note Before the 1931 Ordinance

Before passing any trade marks legislation the practice was that when a trade mark was published in the Sudan Government Gazzette¹ bearing a cautionary note of the High Court after payment of the specified fees, all rights in such a trade mark were presumed to be protected if any dispute arose². Traders at that time used trade marks mainly to identify

---

¹ The Sudan Government Gazzette was issued by the Judicial Secretary.
² The first trade mark protected in this manner was published in The Sudan Gazzette No. 43 (1903).
their goods and to distinguish them from those of other traders. Only a few of them sought the protection for their trade marks by publishing them in the Gazette bearing cautionary notes, and all those traders who were careful to protect their marks were foreigners.

(ii) The Trade Marks Ordinance 1931

The Trade Marks Ordinance 1931 was the first legislation wholly concerned with trade marks in the Sudan. Like any other legislation issued during the colonization era, it was derived from English Common Law. When this Ordinance came into force all the trade marks which were published in the Sudan Gazette bearing cautionary notes were automatically considered registered under the Ordinance, and thus became legally protected. The 1931 Ordinance dealt with the most important issues concerning trade marks such as the definition of a trade mark, registration, conditions of registration and rights conferred by registration.

One of the advantages of the Trade Marks Ordinance 1931 was its attempt to protect the trade business from negative practices, like copying trade marks by adopting some well established legal principles such as the rule of “the prevention of unfair competition”. But it was criticized on the ground that service marks were not covered by its provisions. So owners of service marks were to seek protection for their marks under the umbrella of any law other than the Trade Marks Ordinance 1931.

The Trade Marks Ordinance was repealed and replaced by the Trade Marks Act 1969 after being in force for more than three decades.

(iii) The Trade Marks Act 1969

Since the Trade Marks Ordinance 1931 was enacted under special circumstances in a manner suitable for the needs of that era, it became necessary after a period of time either to amend or repeal such Ordinance
to cope with the substantial changes taking place either locally or internationally. Accordingly, The Council of Ministers issued the resolution No. 1127 dated 22 November 1967 amending the Trade Mark Ordinance 1931\(^3\). Subsequently, The Minister of Commerce and Supply submitted to the Council of Ministers a draft of the Trade Marks Act 1968\(^4\) which was drafted by the Attorney-General Chambers in both Arabic and English Languages, and guided by the Model Law for the Under developed countries 1968, presented by the World Intellectual Property Organization (WIPO)\(^5\). It is worth mentioning that an expert from the World Intellectual Property Organization was specially delegated to participate in drafting the texts of this Act.

The main features of the Trade Marks Act 1969 can be summarized as follows:

1. Service marks registry system was introduced for the first time by this Act\(^6\).
2. The Act adopted the rule for “the prevention of unfair competition” by prohibiting the registration of any mark contrary to such rule, except with the consent of the interested third party\(^7\).
3. The schedules attached to the Trade Marks Rules, “which were made under the provision of section 29 of this Act”, adopted the classification of goods and services for the purpose of registration according to Nice Agreement concerning the international classification of goods and services for the purposes of the registration of marks.

\(^3\) Trade Marks Registry Archive. File (General) No. 18.
\(^4\) Trade Marks Registry, The Explanatory Note.
\(^5\) The WIPO is one of the sixteen specialized United Nations Agencies. It is concerned with the protection of intellectual property rights. The WIPO’s headquarter is in Geneva.
\(^6\) S. 1 and 25 of The Trade Marks Act 1969.
\(^7\) S. 8(2)(c) of the Trade Marks Act 1969.
4. The international registration system of trade marks was introduced to Sudan for the first time by this Act.\footnote{S. 12 of the 1969 Act.}

5. The Act of 1969 largely participates in applying the boycott policy of the Sudan Government by providing that, when the registered owner of any trade mark is or becomes a national of a boycotted country, all his rights in the trade mark shall cease, be sequestrated and vest in the Minister of Finance and National Economy as custodian thereof.\footnote{S. 30 of the 1969 Act.}

(iv) The Trade Marks Rules 1969

These Rules were issued by the Minister of Finance and National Economy under the power granted to him by section 29 of the Trade Marks Act 1969, which authorized him, and subject to the provisions of the Act, to make from time to time such rules, prescribe such forms, and generally do such things as he may think fit:

(a) For regulating the procedure under this Act,
(b) For classifying goods and services for the purpose of registration of trade marks,
(c) For fixing the prescribed fees in accordance with the provisions of this Act,
(d) For making or requiring duplicates of trade marks and other documents,
(e) For securing and regulating the publication and sale or distribution of copies of trade marks and other documents in such manner as the Registrar thinks fit,
(f) Generally for regulating the business of the registry in relation to trade marks and all things placed by this Act under the direction or control of the Registrar.\textsuperscript{10}

The Trade Marks Rules 1969 consists of 46 sections. Three schedules are attached to the Rules. The first schedule concerns with the fees to be paid according to the provisions of the Act\textsuperscript{11}. The second schedule specifies the forms to be used and such forms can be amended by the Registrar as he may think expedient\textsuperscript{12}. The third schedule classifies the goods and services for the purpose of registration\textsuperscript{13}.

Generally it can be said that the Act together with the Rules enable the Registrar to perform the duties delegated to him by the law efficiently.

(v) The Impacts of International Treaties on The Trade Marks Act 1969

The Trade Marks Act 1969, like other legislations concerning intellectual property in many under-developed countries, is based on the principles laid down by the relevant international agreements. For example, although the Sudan was not a party to Nice Agreement nevertheless schedule 3 attached to the Rules of the Trade Marks Act 1969 adopted the classification of goods and services provided by Nice Agreement for the purposes of registration of trade marks.

Section 12 of 1969 Act recognizes any international agreement for the mutual protection of trade marks to which the Sudan is or shall become a party. The Act states clearly that any person who has duly filed a first application for registration of a mark in another state which is a

\textsuperscript{10} S. 29 of the 1969 Act.
\textsuperscript{11} S. 3 of the Trade Marks Rule 1969.
\textsuperscript{12} S. 4 of the Trade Marks Rule 1969.
\textsuperscript{13} S. 5 of the Trade Marks Rule 1969.
party to such agreement shall be deemed to have applied for registration in Sudan in the same date of such first application, and his trade mark is presumed to be registered in Sudan on the same day of its registration abroad.

The international registration system of trade marks, which was organized by Madrid Agreement concerning the International Registration of Marks 1891, is applicable to the Sudan since the Sudan joined it on 16 May 1984.

Furthermore, Sudan Courts in some judicial precedents, referred to international agreements to interpret some provisions of intellectual property law of the Sudan. In *Bajaj Automotive v. Abdu Rahman Abdalla “unreported case”*\(^{14}\), the Supreme Court referred to Article 316 of Paris Convention which provides that, the registration of a trade mark in any member state is considered an independent registration of that mark in any other member state, and held that the trade mark is governed by the principle of territorial jurisdiction, since it can be registered according to the domestic law of a certain country, or according to a regional agreement granting protection for the trade mark in several countries. So the registration of a trade mark will not confer protection except within the specified jurisdiction.

2. The Definitions of a Trade Mark in the Sudan

(i) The Statutory Definitions of a Trade Mark in the Sudan

The first statutory definition of the term “trade mark” in Sudan was laid down by section 2 of the Trade Marks Ordinance 1931, which adopted the definition provided by section 3 of the English Registration Act of 1905, with slight variations.

Section 2 of the ordinance of 1931 defined a “trade mark” as

A mark used upon or in connection with the goods for the purpose of indicating that they are the goods of the proprietor of such trade mark by virtue of manufacture, selection, certification dealing or offering for sale.

This definition, as it has been said before, was extracted from the Common Law definition of a trade mark embodied in section 3 of the Registration Act of 1905, which contained the following definitions

“A mark shall include a device, brand, heading label, ticket, name, signature, word, letter, numeral, or any combination thereof:

A “Trade Mark” shall mean a mark used or proposed to be used upon or in connection with goods of the proprietor of such mark by virtue of manufacture, selection, certification, dealing with, or offering for sale”15.

It is obvious that the definition laid down by section 2 of the 1931 Ordinance was narrow, since it referred only to marks that had been already “used upon or in connection with goods”, whereas the English Law definition was stretched to include marks which “were proposed to be used”. Also no reference was made to what may constitute a trade mark in contrast to the Registration Act of 1905 which gave examples of what may amount to a trade mark.

The Trade Marks Act 1969 provides a more progressive definition of a trade mark than that of 1931 Ordinance. The explanatory section 3 of the Act defines a “trade mark” as follows:

Trade mark means any visible sign used or proposed to be used upon, in connection with, or in relation to goods for the purpose of distinguishing the goods of a person from those of others;

Provided that, if it is not inadmissible, a trade mark may consist of any distinctive sign, including a word, name, pseudonym, device, brand, arbitrary or fictitious designation, heading, label, ticket, signature, numeral, slogan, package, emblem, container or any combination thereof.

According to this definition, four requirements are to be fulfilled by a sign in order to qualify as a trade mark. The mark must be (a) visible sign; (b) used or proposed to be used; (c) upon, in connection with or in relation to; (d) distinguishing the goods of a person from those of others.

(a) Visible Sign

The word “sign” is defined by The New Shorter Oxford English Dictionary 1993 as:

A mark, symbol or device used to represent something, or distinguish the object on which it is put.

The first requirement for a mark to comply with before it can be elevated to the status of a trade mark, is a “visible sign”. So traders who wish to apply for registration must select visible signs for their goods. This requirement of visibility arises from important practical considerations concerned with certainty. Firstly, it will enable the Registrar to determine precisely what the sign is that the applicant uses or proposes to use, and to fulfil his functions of examination and publication of application. Secondly, applicants will be able to inspect the Register of The Trade Marks and the Gazette to ascertain what other traders have registered. So they can avoid applying for identical or similar trade marks. Thirdly, consumers can easily identify goods by their visible trade marks.\(^{16}\)

By using the term ‘visible sign’, all types of usual signs, that may constitute a trade mark, are included in this definition and thus are registerable. Sound, smell, touch and taste marks (sensory marks), are not registerable because they do not fall within the statutory meaning of the term ‘trade mark’ laid down by section 3 of the 1969 Act which requires a trade mark to be a visible sign. Perhaps such sensory marks were ignored by the legislature on grounds of impracticality and lack of demand. However, this should not prevent the widening of the scope of the definition to include such marks, in order to cope with the global progress in the trade business taking place world wide. Owing to these global progresses, in some countries like U.S.A., Japan and England, sound and smells are prima facie registerable as trade marks. For example, in the U.S.A. in 1950, NBC “a radio station” received the first sound registration in the world for its famous three-note chime. Similarly, the sound of a roaring lion heard at the beginning of Metro-Goldwyn-Mayer movies is registered. Recently, also in the U.S.A., the first “smell” registration in history was granted in respect of embroidery yarn for “a high impact, fresh floral fragrance reminiscent of plumeria blossoms”.

As a suggestion, the definition of “a Trade mark” in section 3 of the Act of 1969 should be amended in order to include all types of signs as long as they are “capable of being graphically represented”, by

---

17 With refernce to the Trade Marks Registry Archives, no application concerning sensory mark has been submitted for registration.
19 Id.
21 The English legislature used such phrase in defining the term “trade mark” in the 1994 Act, and this allowed the registration of all types of marks including sound and smell marks.
replacing the requirement of visibility by the requirement of graphic representation, knowing that both requirements are no more than a procedural requirement of registration.

(b) Used or Proposed to Be Used

By virtue of section 3 of the Trade Marks Act 1969, and subject to the other requirements of the section, a mark can be registered as a trade mark if it is used or proposed to be used as such. In this connection, and as it had been said before, the Trade Mark Act 1969 is more comprehensive than the Trade Marks Ordinance 1931, since the later referred only to marks that already had been used upon or in connection with the goods.

The term ‘used’ means the actual use of the trade mark as such by the proprietor before applying for registration, whereas the term “proposed to be used” only requires a present intention to use the trade mark as such. What may amount to “proposed to be used” is a question of fact to be determined by the Registrar or the Court as the case may be. Failure to prove bona fide intention to use the mark at the time of application will render it irregistrable\(^\text{22}\). So traders will not be able to put marks on the Register merely to prevent other traders from using and appropriating them\(^\text{23}\).

The phrase “used or proposed to be used” was interpreted in England by the Court of Appeal in Imperial Group Ltd v. Philip Morris & Co. Ltd\(^\text{24}\) to mean:

“use or an intention to use the mark with a view to driving trading profit and prevented, inter alia, the registration of “ghost’ marks, that is, marks applied for in order to protect

\(^{22}\) S. S. 18(1)(2) of the Trade Marks Act 1969.

\(^{23}\) T. A. Blanco White & Robin Jacob, supra note 14, at 24.

an unregistered mark, or to block a competitor’s use of a
similar mark (in imperial, for example, Nerit to guard
against Merit”.

(c) Upon, in Connection with, or in Relation to Goods

The definition expressly requires that a trade mark must be a
visible sign upon, in connection with or in relation to goods, this may be
construed to require that a trade mark must be something distinct from the
thing marked. So a thing itself cannot be a mark of itself. This
construction may cause difficulty over the registerability of the colour or
colours of the product and preclude the registration of containers and
shapes as trade marks, but the Sudanese Legislature solve this problem by
accepting expressly containers as trade marks\textsuperscript{25}, and make it possible for
a trade mark to be registered with limitations as to colours to be used
thereon\textsuperscript{26}.

(d) Distinguishing the Goods of a Person

In order to qualify as a trade mark under section 3 of the 1969 Act,
the sign must be used or proposed to be used by the applicant for
registration to distinguish his goods from those of other competitors in
the market. To perform this identifying function, the sign must be
distinctive\textsuperscript{27}. Distinctiveness may arise in two ways. First, the sign itself
may possess a natural ability to distinguish or inherent distinctiveness\textsuperscript{28},
this will be the case when the sign is an invented (fanciful or coined)
mark which has no meaning other than in connection with goods or
services in question, or when the sign has ordinary meaning, but such
meaning is completely foreign to its trade mark context, i.e. it has no

\textsuperscript{25} S. 3 of the Trade Marks Act 1969.
\textsuperscript{26} S. 7 of the Trade Marks Act 1969.
\textsuperscript{27} Ruth Annand &H. Norman, supra note 20 at 69.
\textsuperscript{28} Id.
relationship with the applicant’s goods or services (arbitrary mark). The classic example of the former is the invented word KODAK for photographic equipments. An example for the latter is Apple for computers.  

Secondly, through the usage of the sign, the consumer has learned to recognize the sign as identifying the goods or services of the applicant (factual distinctiveness). In other words, a secondary meaning of the sign replaced the ordinary meaning when the sign is used in conjunction with the applicants goods or services. The JIF lemon is the best example of a sign which is distinctive in fact, but not by nature.

Section 3 of the 1969 Act emphasizes the distinguishing function of the trade mark which seems to be essential to identify and distinguish identical goods from different sources. The Act recognizes the distinctiveness of the trade mark as entitling the applicant to register his mark, in the absence of any of the ground for refusal of registration stated in Section 8 of the Act.

(ii) Judicial Definition of a Trade Mark

The term ‘trade mark’ has never been defined by courts of Sudan. Judges have been concerned only with interpreting the provisions of the laws of trade marks and applying them. They refer to the relevant rules of Common law, and English judicial precedents since most laws of the Sudan were originally derived from English Laws. So such reference is regarded as natural and logical extension to the adoption of common law rules in the Sudan.

Although a considerable number of judicial precedents is inherited, unfortunately many of the precedents concerning trade marks are unreported.

(iii) Definition of a Trade Mark Under the English Law

The first statutory definition of a trade mark was laid down by section 3 of the Registration Act 1905, already quoted above\(^{31}\).

This definition was developed by the subsequent Act of 1938 which was repealed a number of times and is now the Trade Marks Act 1994. Section 1 of the Act of 1994 provides a more advanced definition than the ones provided by the previous Acts. It defines a “trade mark” to mean:

“Any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings”

It goes further to provide that:

“A ‘trade mark’ may, in particular, consist of words (including personal names), design, letters, numerals or the shapes of goods or their packaging”.

According to section 1(2) of the Act, the definition of a trade mark includes collective and certification marks.

The definition of a ‘trade mark’ as stated by the Trade Mark Act 1994, applies to all types of marks\(^{32}\). It contains three requirements to be fulfilled by the candidate mark. The candidate mark must be (a) any sign; (b) which is capable of being represented graphically; and (c) which is capable of distinguishing the goods or services of one undertaking from those of other undertakings.

---

\(^{31}\) T. A. Blanco White & Robin Jacob, *supra* note 15 at 15.

(a) Any Sign

The word sign used in the definition as a general term makes it flexible and open-ended, subject only to the other requirements, so as to include all types of signs which may constitute a trade mark.

“Signs” is an expression wide enough to include a wide range of unusual marks, such as marks consisting of a single colour, a smell, a sound or a moving image. The challenge for such unusual signs is in satisfying the other requirements for registration.”

(b) Capable of Being Represented Graphically

In order to qualify as a trade mark, the candidate sign must be capable of being represented graphically. The requirement of graphic representation enables the interested parties to ascertain the scope of existing trade marks rights either by reference to the Trade Marks Journal or by inspecting the Register. Also it helps owners of existing marks to check Trade Marks Journal for new similar applications. By this requirement the relevant Trade Mark Office will be able to fulfil its functions of examination and publication of applications for registration and to maintain an accessible Register of trade marks. In the case of usual marks (word, device numeral … etc), the requirement of graphic representation will be satisfied by a facsimile of the mark. Three dimensional signs (shapes … etc.) are normally expected to be graphically represented by a line drawing or photograph. Similarly, sound marks can be graphically represented in conventional musical notation if they are musical sounds. Non-musical sound may be

33 Id., at 9.
34 Ruth Anand & Helen Norman, supra note 20, at 63.
36 Ruth Annand & Helen Norman, supra note 20, at 63.
represented by being described in words. An example from the United States of America is the mark “clop, clop, clop, moo” for restaurant services.\footnote{Id.}

Olfactory marks taste and feels might present initial problem, because any graphical representation for them is likely to be rejected unless phrased using every day terms.\footnote{Id., at 15.} The American experience suggests that these types of marks can be described adequately in words.\footnote{Ruth & Helen, supra note 20, at 63.} Perhaps the best example of smell mark is the sign which consists of “the smell of fresh cut grass” for tennis ball.\footnote{Registered in U.S.A., cited in Dichin & D. Llewelyn & J. Meller & R. Meade & Th. Moody-Staurt, supra note 16, at 15.}

\textbf{(c) Capable of Distinguishing the Goods or Services of One Undertaking From Those of Other Undertakings}

In order to constitute a trade mark under the Act of 1938, a sign had to be used to indicate a connection in the course of trade, between the goods and some person having the right in the mark either as a proprietor or as a registered user. Section 3 of the 1905 Registration Act (which was replaced by Section 68(1) of the 1938 Act) specified the necessary trade connection as one of manufacture, selection, certification, dealing with, or offering for sale. Accordingly, it had been long settled that “in the light of the previous Act of 1905” the trade mark must be used to denote the source or origin of the relevant goods.\footnote{Bismag Ltd. V. Amblins (chemist) Ltd (1940) 57 RPC 209, cited in Ruth & Helen, supra note 20, at 63.}

According to the above requirement it was held that the actual source of the goods did not have to be known. The important thing is the
ability of the consumers to recognize that goods bearing the same mark emanated from the same source\textsuperscript{43}.

Section 1(1) of the 1994 Act omits a reference to an indication of a connection in the course of trade. It requires that the trade mark must be “capable of distinguishing goods or services of one undertaking from those of other undertakings which seems to be applicable to identical goods or services from different sources. So, under the new Act emphasis has shifted from the function of indicating a connection in the course of trade between goods or services and a proprietor of a mark (an origin function) to that of distinguishing the goods or services of one undertaking from that of other undertakings a “distinguishing function”\textsuperscript{44}.

The definition of a trade mark in section 1(1) of the 1994 Act also omits any reference to the use or intention to use the trade mark, but section 32(3) of the Act states that the application for registration of a trade mark must be accompanied by a statement of use, or bona fide intention to use the mark in question by the applicant, or with his consent.

3. Functions of Trade Marks

Some economic changes in business practice which have taken place in many parts of the world especially in Western Europe and United States of America during the last forty years, affected the role played by the trade marks. For example, the dramatic increase of advertisement, the rapid increase of the self-service shops which changed the method of selling and purchasing many products, particularly foodstuff, manufacturing methods became more centralized and distribution methods became more diverse, and lastly the volume of purchases made by individual consumers have rapidly increased\textsuperscript{45}. Thus, owing to these

\textsuperscript{43} Id., at 64.

\textsuperscript{44} Ruth & Helen, supra note 20, at 64.

\textsuperscript{45} Id., at 13.
changes, trade marks perform a variety of economic functions. These functions are often taken as starting point in discussing the proper scope for the legal protection of trade marks\(^{46}\).

Frank Schechter outlined his fear in his seminal work on trade marks “The Rational Bases of Trade Mark Protection”\(^{47}\) that the orthodox view of trade mark theory that “the primary and proper function of a trade mark was to identify the origin or ownership of goods to which it is affixed”\(^{48}\), failed to take into account new commercial practices\(^{49}\). He argued that the trade mark’s prime function was not to designate source, but to create and retain custom. He wrote that:

> The true functions of the trade mark are … to identify a product as satisfactory and thereby to stimulate further purchases by the consuming public\(^{50}\).

As a result of this analysis, a trade mark is presumed to perform one or more of four functions, namely origin function, differentiation function, guarantee function, and advertising function\(^{51}\).

(i) The Origin Function

The common law view was that the only function of a trade mark was to indicate the source from which goods or services come or connected in some other way\(^{52}\).

The origin function has the following inconveniences:


\(^{48}\) Ruth & Helen, supra note 20, at 13.

\(^{49}\) C.D.G. Pickering, supra note 29, at 43.

\(^{50}\) Id.

\(^{51}\) Ruth & Helen, supra note 20, at 14.

\(^{52}\) W. R. Cornish, supra note 46, at 612.
(a) Nowadays with the immense growth of trade and the advertising that accompanies it, the average consumers neither know nor care about the precise identity of the supplier\(^{53}\). To them “information about origin is only a means towards an end, their main concern is in the quality of what they are buying”\(^{54}\).

In practice it is common and indeed advantageous for a producer to create product’s identities different from his own. This can be illustrated by Haggar Holding Company\(^{55}\) which produces cigarettes in Sudan under the brand name Bringi. This trade mark has become more famous than the producer itself. Most of the consumers of these cigarettes know nothing about Haggar Holding Company. They are only concerned with the brand name (Bringi) they know and desire. Another example from the United Kingdom is Proctor and Gamble which produces brands ranging from Ariel detergent to Pringles Crisps. In fact it is the trade marks “Ariel” and “Pringles” which are given more prominence in comparison with the corporate name itself\(^{56}\).

On the other hand, it can not be denied that in some cases part of the quality may depend on the source, for example, when the goods will need servicing (like cars) and the manufacturer or supplier is supposed to provide that service\(^{57}\).

(b) Insisting that the prime function of the trade mark is to denote the origin of the goods ignores the practice of trade mark licensing. Because trade mark licensing undermines the source theory since it allows the

\(^{53}\) Ruth & Helen, supra note 20, at 14.

\(^{54}\) W.R. Cornish, supra note 44, at 613.

\(^{55}\) A Sudanese registered company produces a wide range of products.

\(^{56}\) Ruth & Helen, supra note 20, at 44.

trade mark to be used by some one other than the proprietor from whom the mark originally emanated\(^{58}\).

In spite of all these inconveniences it is argued that the most effective way to rationalize trade marks functions is by reference to trade mark’s source-denoting quality\(^{59}\). Because in most cases when the source of the goods or services is indicated by the mark, the purchaser will be able to link goods or services to “a range of personal expectation about quality which derive from previous dealings, recommendation of others, attractive advertising and so on”\(^{60}\).

(ii) The Product Differentiation Function

A trade mark may be used to identify one seller’s goods or services, and to distinguish them from those of others\(^{61}\), and this is the basic criterion for registerability of trade marks in all laws concerning registration of trade marks. Section 3 of the Trade Marks Act 1969 defines a trade mark as “any visible sign used or proposed to be used … for the purpose of distinguishing the goods of a person from those of others”. The equivalent English provision is Section 1 of the Trade Marks Act 1994 which defines a trade mark as “any sign … which is capable of distinguishing goods or services of one undertaking from those of other undertakings”. Lack of the distinguishing ability of the mark will render it unregisterable as a trade mark under the Trade Marks Act 1969\(^{62}\) and constitute an absolute ground for refusal of registration under the English Law\(^{63}\).

\(^{58}\) C.D.G. Pickering, supra note 29, at 45.

\(^{59}\) Id., at 45.


\(^{61}\) Ruth & Helen, supra note 20, at 15.

\(^{62}\) S. 8(1) of the Trade marks Act 1969.

\(^{63}\) S. 3 of the 1994 English Act.
(iii) The Guarantee Function

The guarantee function of a trade mark is to indicate that all goods or services bearing the trade mark are of an equal level of quality\textsuperscript{64}, thus guaranteeing that the product or service in question will be of a certain quality\textsuperscript{65}.

It is a basic assumption in a competitive economy that the consumer benefits by being able to choose among a wide range in quality and price of goods or services. The consumer can choose rationally when he is aware of all relevant differences which is in many cases not practical since it is time-consuming. Thus qualities have to be taken on trust\textsuperscript{66}.

According to the guarantee theory trade marks signify consistent quality and this aspect seems to be economically beneficial, because if consumers recognize trade marks as signifying consistent quality, producers will be given the incentive to create and maintain brand of that particular standard\textsuperscript{67}.

Misconception may arise as to the way in which the guarantee function theory is used to render the practice of trade mark licensing legitimate. In section 22 of the Trade Marks Act 1969, the legislature left to the registered owner of the trade mark and the licensees to regulate the relationship between them and make the necessary arrangements therefore, but it states clearly that such relations or arrangements must ensure an effective quality control of the goods by the owner, and the trade mark in question shall not be used in a manner as to deceive the

\textsuperscript{64} Ruth & Helen, supra note 20, at 15.
\textsuperscript{65} C.D.G. Pickering, supra note 29 at 46.
\textsuperscript{66} W.R. Cornish, supra note 60, at 469.
\textsuperscript{67} C.D.G. Pickering, supra note 29, at 46.
public. By this way it is guaranteed that the licensed trade mark continue to signify the level of quality that it originally represented.

(iv) The Advertising Function

Since producers are concerned with creating identities for their brands, it is natural that this should take place through using the trade marks in advertising. Trade marks are considered one of the important means of advertising goods or services. Therefore through advertising his brand, the trader attracts the consumer’s attention.

In recent discussions about trade marks it was suggested that the real function of trade marks in modern commerce was either to guarantee quality, or to protect the investment which went into advertising whether the public understood the trade mark advertised in term of origin or quality or both.\textsuperscript{68}

4. Conclusion

To consumers trade marks play an effective role in reaching a decision of what to buy. As The Sunday Times puts it:

A survey last year by the Henley Centre revealed that the public trust brand names such as Kellogg’s, Heinz and Marks and Spencer more than parliament, the police and the legal system.\textsuperscript{69}

In the light of these comments traders should exercise great care to select the strongest mark they can for their goods or services to achieve the widest possible market penetration.

Trade marks do not only identify the product or its origin, but also provide assurance of quality and consistency to consumers. For example,

\textsuperscript{68}  W.K. Cornish, supra note 60, at 472.

\textsuperscript{69}  Sunday Times, “A can of worms is a bad diet”, 5 April 1998, cited in C.D.G. Pickering, supra note 29, at 50.
consumers should be assured that the Coca Cola they buy in Khartoum is the same one they purchase in Port Sudan.

Registration is the strongest way to protect the rights of the trade mark’s proprietor in most countries. All matters concerning registration are organized by trade marks laws. The first step towards that is to define the trade mark itself. Although the Trade Marks Act 1969 provides a more comprehensive definition of a trade mark in comparison with that provided by the Trade Marks Ordinance 1931, such definition should be amended to be more flexible in order to include all types of unusual marks like sound, smell and taste marks. This can take place by replacing the requirement that the trade mark must be a “visible sign” by the requirement that the trade mark must be “capable of being represented graphically”.

CHAPTER TWO
Registrability of Trade Marks

1. Introduction

Trade marks are powerful tools for achieving consumer recognition and market share. An average consumer may encounter many trade marks during his day. For example, it has been estimated that most American consumers encounter more than one thousand trade marks during a day\(^1\). The marks are found on the clothes they wear, on the packaging for the food they eat, on the cars they drive, and the marks they encounter in magazines and on the radio and television. Therefore, to traders the selection of a trade mark presents unique challenges. The natural tendency is to select a trade mark that has some connection with the product or services that will be associated with the mark such a tendency may lead to conflict of interests. Therefore, great care should be taken in selecting a mark in order to comply with the trade marks law, which lays down some conditions concerning registrability of trade marks.

In this chapter we will discuss signs which may constitute a registrable trade mark, and the restrictions imposed by the Trade Marks Act 1969, which render a mark unregistrable.

2. What May Constitute a Trade Mark

The Trade Marks Ordinance 1931 briefly stated that a trade mark may consist of character, device, or mark, or combination thereof which have a distinctive character\(^2\). On the other hand after defining the term “trade mark”, the explanatory section 3 of the Trade Marks Act 1969,

---


\(^2\) S. 5(1) of the Trade Marks Ordinance 1931.
goes further to illustrate what may constitute a trade mark by providing the following:

…….., If it is not inadmissible a trade mark may consist of any distinctive sign, including a word, name, pseudonym, device, brand, arbitrary or fictitious designation, heading, label, ticket, signature, letter, numerals, slogan, package, emblem, container or any combination thereof.

The examples listed above, are of signs used most frequently by traders to identify their goods or services, provided that such signs are distinctive characters, and must not be inadmissible according to the provisions of the 1969 Act.

The above mentioned list is not exclusive. The examples given are a practical illustration of what can be a trade mark. It follows from the purpose of the trade mark that virtually any sign that can serve to distinguish goods is capable of constituting a trade mark, and if there are to be limitations as to its registrability, they should be based on practical consideration only.\(^3\)

We will highlight some of the illustrations provided by the section mentioned above, which are commonly used by Sudanese traders.

(i) Word Marks

Section 3 of the Trade Marks Act 1969 specifically refers to word mark, which will continue to represent the most important category of mark.\(^4\) Words are highly valued as trade marks when they are well chosen. A trade mark may consist of single word or multiple words. The style or particular lettering in which the words are presented is also protectable.

\(^3\) WIPO, Intellectual Property Reading Material, 63(1998).

Known words are perfectly acceptable as trade marks as long as they did not directly describe the goods or services on which they were to be used. For instance, laudatory words are not acceptable as trade marks.

Invented words are often highly valuable distinctive marks. They have always made the best and the strongest trade marks, since they are invented for the sole purpose of functioning as trade marks\(^5\). It is impossible for another user to claim that he or she innocently created the same or similar mark. Thus, they are readily protected against infringing uses. The classical examples of invented words are “Kodak”, “Pepsi” and “Exxon”.

Misspelling, slight or gross, of a known word does not bring privilege attaching to invention\(^6\). Foreign equivalent of a known word is not an invented word\(^7\), but an invented mark could comprise two foreign words conjoined, and the languages in question are not commonly known\(^8\).

The word, in order to qualify as an invented word, need not to be “wholly meaningless”, but could contain a skillful and convert allusion to the nature of the goods or services\(^9\).

The practice in the Registrar of Trade Marks Office shows that when an applicant states that the word he applied for to be registered is invented or has no meaning, such word could be treated as an invented word, and be registered as such without limitation as to its meaning. For example, the word “Topri” was registered after the applicant stated, during the procedure of registration, that the word “Topri” is wholly

---

\(^5\) Deborah E. Bouchoux, *supra* note 1, at 27.
\(^7\) Amanda Michaeles, *supra* note 4, at 17.
\(^8\) Ruth Annand & Helen Norman, *supra* note 6, at 77.
invented\textsuperscript{10}. The same procedure took place when the owner of the trade mark “Nilped”, in his application to register it in the Sudan, stated that the word “Nilped” has no specific meaning\textsuperscript{11}.

(ii) Name Marks

A trader may adopt as his trade mark his own name or any other name of a real or fictional person. For example, “Ford” and “Mercedes” for cars and El Shebrawishi for perfumes are names of real persons. Also Captain Magid, who is a fictional football player in series of cartoon films, is a famous trade mark for biscuits in Sudan.

According to section 3 of the Trade Marks Act 1969, a name mark, like any other trade mark, must be distinctive. Therefore, the name must be represented in special and particular manner to be capable of distinguishing the goods of one trader from those of other traders.

(iii) Signature Marks

Although a signature is usually nothing more than a barename, it could serve as a trade mark when it is presented in a distinctive way. For example, it could be more distinctive when it consists of a device rather than merely a name in script form. A signature as a trade mark may be the signature of the proprietor of the mark or any other person.

However, there are potential drawbacks in the use of a signature as a trade mark when the original applicant may break off the business, which registered his signature as a trade mark, and then wish to trade separately using such signature as a trade mark. In the famous English case \textit{Barry Artist}\textsuperscript{12}, Mr. Artist was a dress designer whose work had been the mainstay of the fashion sold by Barry Artist limited. The company’s

\textsuperscript{10} App. No. 15260 T.M. Registry Archive Kh. (1974).
\textsuperscript{11} App. No. 14608 T.M. Registry Archive Kh. (1975).
\textsuperscript{12} \textit{Barry Artist} (1978) R. P. C. 703 as cited in Amanda Michaels, supra note 4, at 17.
trade mark consisted of a facsimile of Mr. Artist’s signature. After leaving the company’s employment, he applied to register his signature as a mark for his own designs. The application failed because of the likelihood, that his mark would be confused with the company’s mark.

(iv) Letters and Numerals Mark

Letters and numbers are registrable as trade marks as long as they are distinctive. Initials of a name of a trader, manufacturer or even a company may constitute a trade mark. The success of an application to register initials depends upon the distinctiveness of their presentation\(^{13}\).

A trade mark may be a combination of letters and numbers, and by this way a mark may acquire some distinctiveness. The best examples of marks consisting of letters, numerals or combination thereof may be, “B. M. W” for cars, “555” for a perfume and “7up” for beverages.

(v) Device Mark

Devices are the oldest, and, in many ways, they form the most valuable kind of trade marks\(^{14}\). Like any other mark, a device to be registered as a trade mark should be distinctive. So devices descriptive of the goods to which they are to be applied are not registerable.

A device to be successfully accepted as a trade mark, should be sufficiently simple and striking to fix itself in the customers memory. For example, a device of Lotus flower was registered as a trade mark for stationeries\(^{15}\).

A mark may consist of a combination of devices, which are common to the trade, but they form together a distinctive device. For instance, a Japanese company “Kanebo Limited” succeeded to register

\(^{13}\) Id., at 20.

\(^{14}\) T.A. Blanco White & Robin Jacob, Kerely’s Law of Trade Mark and Trade Names, 135 (1972).

their trade mark “Kanebo” in Sudan for textile, which consisted of two devices, a camel and a shining sun\textsuperscript{16}.

Portraits of persons, such as the portrait of the manufacturer of the goods in question, may constitute a distinctive device, and therefore can be registered. But to register a portrait of a person other than the proprietor of the mark, a written consent of such person is required.

The practice in the Registrar of Trade Marks Office is that the protection of a registered device extends to include its corresponding name, for example, if a trader registered a device of a lion as a trade mark for his goods, his competitors are precluded from registering the correspondent name, the lion, as a trade mark for their goods. So it is practical to register the device and the corresponding name, if any, to avoid disputes.

\textbf{(vi) Packages and Containers}

According to section 3 of the 1969 Act, packaging may serve as a trade mark. It also seems that the section is applicable to other distinctive features of trade dress or get up. Packaging may consist of more than one element combined in a distinctive way. It would be practical to register all these elements as together constituting the mark\textsuperscript{17}.

Containers as such are not registrable trade marks, such as a square box containing the product, unless they acquire some distinctiveness, for example, by being designed in a creative way or being combined with some devices, words, slogans or any other element. For example, the container with a distinctive cap of the well-known moisturizing hairdressing “Brylcreem” was registered as a trade mark\textsuperscript{18}. Another

\textsuperscript{17} Amanda Michaels, \textit{supra} note 4, at 22.
\textsuperscript{18} App. No. 22272 T.M. Registry Archive Kh. (1988).
example is the contour plastic container of mineral water “Soba” was registered as a trade mark for Coca Cola Company\(^\text{19}\).

In sum, any of the elements or any combination of elements provided by Section 3 of the 1969 Act, can serve as a trade mark and be registered, provided that it is distinctive and does not fall within the restrictions of registration imposed by section 8 of the Act.

3. Unregistrable Marks

(i) The Trade Marks Ordinance 1931

Section 6 of the Trade Marks Ordinance 1931 listed the symbols which are unregistrable as trade marks, namely:

1- Public armorial bearings, crests, insignia or decoration of the Sudan or of foreign state or nation unless authorized by the competent authorities.

2- Official hall marks or signs indicating an official warranty, unless put forward or authorized by the competent authority owing or controlling the mark.

3- Marks which are identical with or similar to British or Egyptian flags, the military or novel flag of the Sudan or commendatory medals or badges or national military or naval flags of foreign countries.

4- Marks which consist of letters or words which are in common use in trade to distinguish or describe goods or class of goods or which are directly descriptive of their character and quality, words whose ordinary signification is geographical.

5- Marks which may be injurious to public order or morality or which are calculated to deceive the public or marks of unfair trade competition or contain false indication of origin.

6- Marks which are similar to sign of Red Cross or Red Crescent.
7- Marks which are similar to emblem of exclusively religious significant.
8- Marks which contain the portrait, name of a person or the name of body corporate unless their consent is obtained.
9- A mark identical with or belonging to a different proprietor which is already on register, or so nearly resembling such trade mark as to be calculated to deceive.

(ii) The Trade Marks Act 1969

Sections 3 and 8 of the Trade Marks Act 1969 define the trade mark and unregistrable marks respectively. It is quite obvious from the wording of section 8 that a trade mark may be refused registration either on grounds relating to the nature of the mark itself, which are referred to under the English Law as absolute grounds, or on grounds relating to prior existing rights belonging to others, which are referred to under the English Law as relative grounds.

Section 8(1) of the Trade Marks Act 1969, lists signs which can not be registered. They are absolutely unregistrable. Their unregistrability does not depend upon a comparison with any particular prior trade mark or other earlier right, but depends only upon their nature.

Section 8(1) reads:
The following cannot be validly registered as trade marks;
a- marks which consist of shapes or forms imposed by the inherent nature of the goods or by their industrial functions,
b- marks which consist exclusively of a sign or an indication which may serve, in the course of trade, to designate any particularity, such as quality, quantity, purpose, value and place of origin,
c- marks which have become, in the current language or in the bona fide and established practices of the trade of the country, a customary designation of the goods concerned,
d- marks which are contrary to morality or public order and which, in particular, are calculated to deceive the trade circles or the public as to nature, source, manufacturing process, characteristics of suitability for their purpose, of the goods concerned,
e- marks which reproduce or imitate armorial bearings, flags and other emblems, initials, names or abbreviation of names of any state or of any inter-governmental or international organization or any organization created by an international convention, unless authorized by the competent authority of that state or international organization,
f- marks which reproduce or imitate official signs or the official seal of any state unless authorized by the competent authority of that state,
g- marks identical with or similar to emblems of exclusively religious, sectarian or tribal organization,
h- marks which resemble or depict the portrait of a religious or tribal leader or of any sectarian significance.

(a) Shapes

Shapes, which result from the inherent nature of the goods in respect of which the mark is to be used, are excluded from registration. Shapes which are functional are also excluded from registration as trade marks. A shape is functional if it affects manufacture, use or performance. Thus, the Coca-Cola company has registered as a trade mark the shape of a curved bottle for its famous beverage “Coca-Cola”.

---

20 See Sub-section 8(1)(a) of the Trade Marks Act 1969.
21 Deborah E. Bouchoux, supra note 1, at 20.
The shape of Coca-Cola bottle does nothing to promote or enhance use of the beverage and therefore is not functional. Competitors have a wide variety of other shapes to use, so the market place is not harmed by exclusive appropriation of one particular shape for a beverage container. On the other hand, a producer of tyres cannot register the circular shape of the tyre as a trade mark because it is functional, but can register as a trade mark an irregularly shaped hubcap.

In practice, traders in Sudan prefer to register the shapes of their products as industrial designs and to be protected as such.

(b) Descriptive Marks

In practice traders are generally fond of brand names that generate a positive association with the product in the mind of the consumer. Therefore, they tend to choose more or less descriptive terms. If a sign is exclusively descriptive, it lacks distinctiveness and should not be registered as a trade mark. For example, a photograph of a cup full of orange juice on a bottle of orange juice, cannot be registered as a trade mark for such juice.

Section 8(1)(b) expressly provides that marks are to be refused registration where they consist of “signs” or “indication” which may serve in the course of trade to indicate any particularity, such as:

1- Quality of the goods or services. The best example of such marks might be “5 Stars” for hotel services.

2- Quantity of the relevant goods or services. Any direct or exclusive reference to weight, length … etc, would fall under this heading. Particularly, it is hard to think of any simple and exclusive

---

22 See S. 8(1)(b) of the Act of 1969.
23 WIPO, supra note 3, at 65.
indication of quantity which a trade mark proprietor might wish to register.

3- Intended purpose of the relevant goods or services. This will catch most purely descriptive marks, such as the examples of “sleeping Tablets” for sleeping tablets or “Washing Soap” for detergents.

4- Value of the goods. It may be hard to distinguish it from “quality” above. However, any direct or exclusive reference to the value of the goods for which the mark is sought to be registered, would bar such mark from registration.

5- Geographical origin. When marks make reference to place of origin, they convey to the consumer an association with the geographical name indicated either as the place of manufacture of the goods in question or of ingredients used in their production\(^\text{24}\). In both cases marks are not registrable. For example, a trader who trades with cotton can make reference to its place of origin “AlGaziera” but has no right to register it as a trade mark, and his competitors can indicate the same geographical name for their competing goods.

Geographical areas, whether known or unknown, where nobody would expect the goods concerned to be manufactured or originated, can be registered as a trade mark for such goods\(^\text{25}\). For instance, Darfur can be registered as a trade mark for rice.

(c) Generic Marks

Section 8(1)(c) of the Trade Marks Act 1969 provides that marks which have become, in current language or in the bona fide and established practices of the trade of the country, a customary designation

\(^{24}\) Id.

\(^{25}\) Id.
of the goods concerned, should not be registered. These kind of marks are called generic marks. It is essential to the trade and also to consumers that nobody should be allowed to monopolize such marks. Since they are defining, in the current language or in the course of trade, the category or type to which the goods belong. “Soda” for beverages, “T.V.” for television set and “C.D.” for compact disk may be some of the best examples of term that became generic in most part of the world.

(d) Marks Contrary to Morality or Public Order

Section 8(1)(d) excludes from registration a mark which when considered on its own individual merits, is contrary to accepted principles of morality or against the public policy. Marks contrary to morality may consist, for example of obscene picture or drawing, vulgar words or terms with sexual implications. Doubtless, principles of morality are not absolute, they change with time. Therefore, morality is to be judged against current thinking and susceptibility. A very interesting example can be provided by the trade mark “Meso”. It was registered for the first time in Sudan in 1959 under the Trade Mark Ordinance 1931 for essential oils. It consisted of a device of an Indian girl wearing a brassiere and a transparent skirt. When the Trade Marks Act 1969 entered into force the mark was automatically registered, as it was under the new Act. On application to renew the registration of the mark in 1979, the applicants (Licensee) were asked to amend the device by covering the girl’s semi-naked body. Upon the consent of the proprietor of the mark (licensor), the applicants amended the device as required.

26 Ruth Annand & Helen Norman, supra note 6, at 88.
27 App. No. 5677, 5672, 5673.
Marks contrary to public order may include, marks which affront religious believes and marks which constitute a risk to public safety like racist marks.

Marks that are calculated to deceive the trade circles or the public, do not qualify for registration since they suggest characteristics which the goods or services do not possess. Section 8(1)(d) of the 1969 Act expressly provides that the public may be deceived as to the nature, source, manufacturing process, characteristics or suitability for the purpose of the goods concerned.

(e) Specially Protected Emblems

A country generally protects its national flag, armorial bearings, official name and the names of official institutions. Furthermore, countries are also obliged by article 6 ter of the Paris Convention to protect the notified flags and signs of other member states, international and inter-governmental organization, such as the United Nation Organization\textsuperscript{28}.

Section 8(1)(e) prohibits the registration of any mark which reproduces or imitates armorial bearings, flags and other emblems, initials, names or abbreviation of names of any state or of any inter-governmental or international organization unless authorized by the competent authority.

According to Section 8(1)(f), marks which reproduce or imitate official signs or the official seal of any state are unregistrable unless authorized by the competent authority of that state.

In \textit{S.G.v. Eisha Ahmed Khalil}\textsuperscript{29}, the High Court held that, the rhinoceros, emblem of the Sudan, may not be registered as a trade mark.

\textsuperscript{28} WIPO, \textit{supra} note 3, at 70.

\textsuperscript{29} (1963) S.L.J.R. 99.
unless authorized by competent authority under Trade Marks Ordinance 1931, section 6(1), and the Registrar of trade marks is not a competent authority to authorize use of Sudanese emblems.

Sub-section 8(1)(g) prohibits the registration of marks identical with or similar to emblem of exclusively religious, sectarian or tribal organization.

Marks which resemble or depict the portrait of a religious or tribal leader or of any sectarian significance can not be registered as trade marks owing to section 8(1)(h) of the 1969 Act. This provision was introduced for the first time by the Trade Marks Act 1969. With reference to Registry Archives we find that, this category of marks were registrable. For example, the portrait of Elsayed Ali, a sectarian leader of khatmiya, was registered as a trade mark for a perfume, and AlKaaba AlMusharafaa for soap.

4. Unregistrable Marks Except with the Consent of a Third Party

Section 8(2) of the Trade Marks Act 1969 sets out the grounds, “called relative grounds under the English law”, on which registration may be refused. They are relative in the sense that they are concerned with existing rights belonging to others. Their existence depends upon a comparison between the mark applied for and any particular prior trade mark or other earlier rights. Section 8(2) reads:

Except with the consent of the interested third party the following marks are not registrable;

a- Marks which resemble, in such a way as to be validly filed or registered by a third party or by a person validly claiming priority in respect of the same goods, or of other goods in connection with which use of such mark might be likely to mislead the public,
b- Marks which constitute a reproduction in whole or in part, an imitation, a translation, or a transcription, likely to mislead the public, of a mark which is well-known in the country and belonging to a third party,

c- Marks which infringe other third party rights or are contrary to the rules for the prevention of unfair competition.

There are three distinct situations mentioned by section 8(2) in which the registration of a trade mark is prohibited except with the consent of a third party. Each of these situations constitutes a ground for refusal of registration, which may be raised either ex-officio by the registrar, as a result of the search of prior rights carried out under section 42 of the Rules of the Trade marks Act 1969, or by any interested party, in opposition proceeding under section 18 of the 1969 Act.

The interested third party mentioned in section 8(2) of the Act can always give consent to the registration of a later mark. Such consent will enable the later application to proceed, and it is no longer open to the Registrar to exercise overriding discretion and refuse the application.

Marks which cannot be registered except with the consent of the interested third party, are as follows:

(i) Prior Marks

By virtue of section 8(2)(a) of the Trade Marks Act 1969 the existence of a prior trade mark will be a bar to registration of a later mark if the later mark resembles the prior one, in such away as to mislead the public. The rationale behind this prohibition is that, if the consumer is confused by similar marks, the distinguishing role of the trade mark is not functioning, and the consumer may fail to buy the product, that he wants, which is bad for both the consumer and the trade mark’s owner who loses the sale. The protection granted by section 8(2)(a) to prior trade marks
against subsequent misleading marks, includes both registered and validly
filed trade marks.

“Registered trade mark” means any trade mark registered and
entered in the Trade Marks Register according to section 4 of the Trade
Marks Act 1969. Also it means any trade mark which has been registered
with the International Bureau of the WIPO under the Madrid
Agreement\(^{30}\), and to be protected in the Sudan according to article 4 of
the Agreement.

The term “validly filed” refers to pending applications for
registration of national and international trade marks, which would
benefit from earlier priority date if accepted. Such marks are to be treated
as prior registered trade marks, and be protected against resembling
subsequent marks.

In order to consider the resemblance of the marks as a ground for
refusal of registration, two requirements are to be fulfilled. First, the later
mark must resemble a prior one, in such a way as to be likely to mislead
the public. Secondly, the goods or services specified in the later
application are either identical to those of which the prior trade mark is
registered, or not identical but in connection with which use of such
similar mark may mislead the public.

(a) Similar Marks

The simple case is where a mark is identical to an earlier one, and
the goods or services specified in the later application are identical to
those for which the earlier mark is registered or validly filed. Such later
mark shall not be registered except with the consent of the interested third
party. This will happen, comparatively, rarely.

\(^{30}\) The Madrid Agreement concerning the International Registration of Marks, adopted in Madrid on
April 4, 1891 the Sudan joined this agreement in 1984.
The case will be more complicated, but it often happens, where there is no identification but only resemblance between the marks. The Registrar or the competent court has to decide whether such resemblance will mislead or confuse the public. To reach such decision the Registrar and the court should ignore their own specialist knowledge and approach the matter from the point of view of the potential customers. 

Although each case is to be decided on its own facts, and there is no litmus test to determine misleading resemblance. The following factors are to be considered.

First, the similarity of the marks in their entireties as appearance, phonetics, ideas and commercial impression. The global appreciation of the misleading similarity of the marks must be based upon the overall impression created by them. The perception of marks in the mind of the average consumers of the category of goods or services in question plays a decisive role in the global appreciation of the likehood of confusion. Goods bearing competing mark might well not be sold side by side, so that the consumer could see himself differences between marks. It is, therefore, maintained that the comparison which has to be made is between the essential features of the marks.

Secondly, the similarity and nature of the goods or services used in connection with the marks.

The third factor is straight forward. It is the channel of trade in which the marks are used.

Fourthly the condition under which and the class of buyers to whom sales are made, namely whether the items are impulse purchases or

---

31 Amanda Michaels, supra note 4, at 35-36.
33 Amanda Michaels, supra note 4, at 36.
whether they are the result of careful and sophisticated purchasing. For example, the purchaser, of ordinary intelligence, when buying an expensive item, such as a car, would no doubt be more attentive than the purchaser of a cheap item, such as cigarettes, so he cannot be mislead, whereas unsophisticated, poorly –educated customers and children are more liable to be confused.

The final factor is the fame of the prior mark. It should be judged by sales, advertising, and length of use. The later mark may take unfair advantage of the reputation of the prior one. This will happen in cases where the public are confused into thinking that there is a commercial connection between the suppliers of the goods supplied under the prior trade mark, and the later mark.

Marks may be confusingly similar even though letters or words are added, deleted, or substituted. If a mark includes both wording and a device element, greater weight is often accorded to the wording because it is used by purchasers in requesting the goods or services. If a mark is weak in that it uses descriptive wording or common devices, similar marks may be able to co-exist with it. If there is any doubt as to whether there is a likelihood of misleading, the doubt must be resolved against the later mark, and this is the practice in Registrar Office in Sudan.

(b) Similar Goods

In order to apply the provision of section 8(2)(a), the goods or services in question should be either identical or related in some matter to the extent that the use of the later mark might be likely to mislead the public.

34 Deborah E. Bouchoux, supra note 1, at 44.
35 Id., at 45.
36 Id.
37 Id., at 46.
The test of whether goods are similar is based on the assumption that identical marks are used\textsuperscript{38}. As a general rule, goods are similar if, when offered for sale under an identical mark, the potential consumer would be likely to believe that they came from the same source. It extends to include cases where the public wrongly make a connection between the proprietors of the sign applied for and those of the prior mark and confuse them\textsuperscript{39}. This connection must be in the nature of an economic link. Therefore, if the public believe that the goods or services in question are under the control and license of the proprietors of the prior mark, that would seem to be enough to reject the later mark\textsuperscript{40}.

Although each case is to be decided on its own merits, some factors relating to the goods or services themselves may be of assistance,

1- the use of the respective goods or services;
2- the users of the respective goods or services;
3- the physical nature of the goods or acts of services;
4- the trade channels through which the goods or services reach the market; and
5- the extent to which the respective goods and services are in competition.

\textbf{(c) Possible Defenses against Refusal on Ground of Misleading Similarity}

If the Registrar refuses registration on the basis that the mark applied for is confusingly similar to another, the applicant may argue that the marks are not similar to the extent that the public is likely to be misled or the prior mark is weak, in the sense that the mark or its portion is suggestive or descriptive. So, a similar mark may co-exist and be

\textsuperscript{38} WIPO, \textit{supra} note 3, at 70.
\textsuperscript{40} Id., at 244.
registered. If the Registrar continues to refuse to register the mark, the applicant may attempt to obtain the consent of the proprietor of the prior mark to use and register the later mark. The consent agreement is generally accepted by the Registrar.

Another possibility left for the applicant is to enter into a concurrent use agreement with the proprietor of the prior mark, and the application of the proprietor of the later mark will be amended to state that concurrent use is being sought. Concurrent use proceedings are somewhat rare.

(d) Some Decisions of Sudanese Courts Concerning Misleading Similarity

Courts of Sudan used to apply the test of misleading similarity of marks, which is laid down by the English jurisprudence and courts throughout the years. In Kamel Abdel Shaheed and Sons v. Board and Sons, Stanely Baker J. in summing up the reasons which are to be taken into account to determine deceptiveness and ambiguity between two trade marks, adopted from Halsbury, Laws of England, the following quotation;

A mark will be rejected if there is liability to confusion by eye or ear, and further whether the marks may suggest the same idea or lead to the goods being described by the same name. In making the comparison the tribunal bears in mind that the marks will not normally be seen side by side and guards against the danger that a person seeing the new mark may think that it is the same as the one has been seen before, or even that

41 Deborah E. Bouchaux, supra note 1, at 46.
42 A. C-Rev- 97/(1957) unrepted
it is a new or associated mark of the proprietor of the former mark.

In the case of Formageries Bel-LaVache QuiRit v. Trade Marks Registrar an application by formageries Bel-La Vache Qui Rit to register the mark “Vache Qui Rit and cow device” was refused by the Registrar, on the ground that the cow device was used in another mark “Avanti Label” for the same goods. The applicant contested the decision of the Registrar and requested to be revised, for the following reasons. First, the nominations of “La Vache Qui Rit Label” and “Avanti” are completely different, and the consumer can differentiate between them, so he cannot be confused. Secondly, the cow’s head appearing in La Vache Qui Rit is very distinctive and can easily be recognized, while the cow’s head appearing in “Avanti Label” is common and not distinctive. Thirdly, non-distinctive common features devices are not registrable in many countries, so it should be legally presumed that the trade mark “Avanli label”, was registered subject to the condition that, not to monopolize the use of the cow’s head in its ordinary form.

The Registrar replied that the mark was refused because it also falls within the provision of section 8(1)(b) of the Trade Marks Act 1969 since it is descriptive and may indicate the goods it serves, so he refused to revise his decision.

The applicant appealed to the court against the decision of the registrar. Before the court reached a decision, the dispute was settled between the parties to the effect that the mark “La Vache Qui Rit” shall be registered under the condition that the proprietors of the mark should not monopolize the device of the cow or the shape generally. Another case is Mamoun El Brier Food Products Company Ltd. v. The Registrar

of the Trade Marks\textsuperscript{45}. The facts can be summarized as follows. The appellant applied to register the mark “Forcost” under class 29. According to section 8(1)(a), the Registrar refused to register the mark on the ground that it resembles another trade mark “Foremost” which is already registered under the same class. The appellant (applicant) contested the decision of the Registrar before the Khartoum Commercial and Intellectual Property Rights Court, which upheld the decision of the Registrar and dismissed the appeal. In reaching this decision the court made a comparison between the two marks and realized, firstly, that in both marks the colour blue, in dark and in light, is used, and both marks “foremost” and “Forcost” are written in English letters with dark blue on backgrounds in light blue. Secondly, the general appearance of the two marks is nearly identical. Thirdly, at the bottom of the mark “Forcost” the applicant added meadow, a cow device, and the term “instant powdered whole milk” written in both Arabic and English. Fourthly, a cup full of milk device is included in both marks.

Upon the above comparison, the court concluded that, there is an obvious resemblance between the two marks, in such a way as to be likely to mislead the customer, and the additional details introduced by the applicant in his mark “Forcost” are not more than persistence to mislead the public.

(ii) Well-Known Marks

A mark may become so well-known in its field that the use of an identical or similar mark in a different field might cause consumers to infer that there is a trade connection\textsuperscript{46}. They might assume that the owner of the well-known mark has diversified or has licensed someone else to

\textsuperscript{45} C.A. 10/(2003) unrepted.

use the mark. In this case the use of the mark would take unfair advantage of, or be detrimental to, the distinctive character or the reputation of the well-known mark. Section 8(2)(b) of the 1969 Act provides that marks which constitute a reproduction in whole or in part, an imitation, a translation or a transcription, likely to mislead the public of a mark which is well-known in the country and belongs to a third party, are not registrable except with the consent of such third party\(^47\).

It seems from the wording of section 8(2) (b) of the 1969 Act that a mark, to be protected, need not to be registered in the Sudan if it is well-known in the country. The 1969 Act does not define what may amount to “well-known mark”. It leaves the matter to be decided by the competent authority. Also the provision omits any reference to the goods or services, which may lead to the assumption that a mark which reproduces imitates, translates, or transcribes a well-known mark may not be registered, even for goods or services, which are not similar to those for which the well-known mark is used, such assumption is contrary to Article 6 bis(1) of the Paris Convention\(^48\), which prevents the registration of identical or similar mark, liable to create confusion, of well-known mark, used for identical or similar goods.

(iii) Prior Rights

Contrary to the Ordinance of 1931, the Trade Marks Act 1969 in section 8(2)(c) covers other earlier rights. It prevents the registration of any mark which infringes other third party rights, such as copyright, patents and industrial designs rights. For example, no one may validly register a trade mark if it consists of a work protected by someone else’s copyrights, or rights in a design.

\(^{47}\) There is no equivalent of this provision in Trade Marks Ordinance 1931.

\(^{48}\) The Sudan joined this convention in 1984.
Section 8(2)(c) of the 1969 Act also prevents the registration of marks which are contrary to the rule for prevention of unfair competition. When a trader has gained a high reputation for his products, either because of the excellence thereof, or by reason of extensive advertisement, the activities of other competitions designed purposely to reap the advantage of that reputation is unfair and actionable\textsuperscript{49}. Thus, an application of a trader to register a trade mark that benefits from the reputation of his competitor will fail and such a mark will not be registered except with the consent of the interested third party.

5. Conclusion

Any sign which is capable of distinguishing the goods of one trader from those of other competing traders in the market place, can serve as a trade mark. Traders have a wide range of signs to choose from what they think suitable for their goods or services.

For practical consideration, the legislature provides a list of elements which may constitute a trade mark. Such a list is not conclusive. Traders always have the choice in composing their trade marks, to use any element or a combination thereof, or even elements not included in the list, as long as they comply with the definition of the trade mark.

Not every trade mark can be registered. The 1969 Act imposes some restrictions concerning registrability of trade marks. Unfortunately, many traders are not aware of such restrictions. Moreover, they often do not understand that the standard for trade mark infringement is not identicality, but confusing similarity. So they believe that by changing a few words or a spelling, they have created a new mark. Therefore, a considerable number of applications are rejected by the Registrar annually. Some traders, in the process of selecting trade marks for their

\textsuperscript{49} Leon H. Amdur, \textit{Trade Mark Law and Practice}, 27(1948).
goods or services and before applying for registration, used to consult the Registrar Office employees about the marks they have chosen, which may consume the working hours of the employees. The existence of professional firms which may compose trade marks, advertisement experts and artist to assist traders in selecting and registering trade marks for their goods may be useful for both trader and the Registrar Office.
CHAPTER THREE

Procedure of Registration of Trade Marks

1. Introduction

(i) Necessity of Registration

Registration of trade marks is not compulsory. It is optional. An owner of a trade mark always has the choice, either to register it, or to leave it unregistered. The protection granted by the Trade Marks Act 1969 covers registered trade marks only. Unregistered trade marks cannot be protected by the Act. Its owner can rely only on the law of torts to bring an action for unfair competition in respect of his trade, but he shall not be entitled to recover damages for infringement of his unregistered mark.¹

Advantages of registration may be summarized as follows: First, the exclusive right to a mark is acquired by registration. Therefore registration is a prima facie evidence of the right to a mark.² Secondly, registration makes it possible to bring an action for infringement without proof of actual damage. Thirdly, registration enables persons who wish to apply for registration to ascertain what other marks have been adopted by their competitors. Finally, the national registration of a trade mark is used as a basis to obtain international registration.³

On the other hand, relying on the law of torts to protect unregistered marks is perceived to have four disadvantages: The first is

---
¹ S. 27(5) of the Trade Marks Act 1969.
² S. 27(2) of the Trade Marks Act 1969.
³ S. 7 of the Trade Marks Act 1969.
⁴ Art. 1 of the Madrid Agreement, and Article 2 of the Madrid Protocol.
that proof of the right to the mark, reputation of the mark and good will are required. Secondly, no action can be brought in respect of unused mark. Thirdly, the suit will only succeed upon proof of actual or likely damage to the good will of the business. Fourthly, no damages can be recovered for infringement of an unregistered trade mark.

A quick glance at the Trade Mark Registry archive will show that the amount of applications submitted to the Registrar Office is increasing year by year. This means that traders are becoming more aware of their rights in trade marks, and tend to protect such rights by registration. The Trade Marks Act 1969 together with its Rule provide the procedure of registration and organize all matters concerning such registration.

(ii) The Registrar

The Registrar of trade marks, who is the head of the Department of Trade Marks, is appointed by the Minister of Justice to keep the Register and carry out the functions conferred upon him by the Trade Marks Act 1969. The Department of Trade Marks, which consists of two offices, one for the national registration and the other for international registration of trade marks, is one of the three departments composing the Registrar General of Intellectual Property Office, which is one of the administrative departments of the Ministry of Justice.

The Registrar is empowered by section 16 of the 1969 Act to refuse the application for registration of a trade mark or accept it absolutely or subject to such conditions, amendments, modifications or limitations as he may think fit. Any refusal, conditions, amendments, modifications or limitations imposed by the Registrar shall be subject to appeal to the

---

6 S. 4 A of The Trade Marks Act 1969.
court. Before exercising his discretionary powers, the Registrar may hear any person who might be affected by such powers.\(^7\)

(iii) The Register of Trade Marks

Sub-section 4(1) of the Trade Marks Act 1969 provides the following:

There shall be for the purpose of this Act, a Register of trade marks wherein shall be entered all registered trade marks with the names and addresses of their owners, notification of assignments, the name and addresses of all registered users, assignors, conditions, limitations, renewals, renunciations, cancellations, and such other matters relating to trade marks as may be prescribed.

The Register of Trade Marks shall be kept at the Trade Marks Office or at such other places as may be approved by the Minister of Justice by order published in the Gazette.\(^8\) The Register shall be open to the public for inspection, subject to such rules as may be prescribed by the Registrar and upon payment of the prescribed fee. Certified copies of any entry in the Register can be given to any person who requests them.\(^9\)

2. Application for National Registration

Section 9(1) of the Trade Marks Act 1969 states that the application and all other correspondence should be addressed to the Trade Marks Registrar. The application must be filed on form T.M. No.1,\(^10\), and the fee to be paid for filing an application is prescribed by schedule 1 attached to the Trade Marks Rules 1969.\(^11\) The application form must be

---

\(^7\) S. 38 of the Rule of the Trade Marks Act 1969.

\(^8\) S. 4(2) of the Trade Marks Act 1969.

\(^9\) S. 6 of The Trade Marks Act 1969.

\(^10\) S. 27 of The Trade Marks Act 1969.

\(^11\) S. 3 of the Trade Marks Act 1969.
signed by the applicant himself or his authorized agent\textsuperscript{12}. In cases where the applicant is an institution or a partnership, the application may be signed by any member or members thereof, and where the applicant is a corporation or a company the application may be signed by its director; secretary or any member of its senior staff\textsuperscript{13}.

Section 7 of the Trade Marks Rules 1969 provides that the application and all other correspondence should be filed by registered mail. In practice applicants file their applications by hand delivery to the Registrar Office, and to follow up the application’s progress personally. This practice consumes the time of the officials at the Registrar Office and interrupts their work.

If the application is not completed within three months from its filing, the Registrar may give a notice of non-completion to the applicant on form T.M. No 7, to complete it within a period of thirty days, otherwise he will consider the application as abandoned\textsuperscript{14}. If the applicant resides abroad, the period of thirty days may be extended\textsuperscript{15}. In both cases the date of filing will be the date on which the application has been completed.

(i) Contents of the Application

The application must contain the following:

(a) A request for registration of the mark\textsuperscript{16}. The Registrar may request the applicant to prove his ownership of the mark applied for to be

\textsuperscript{12} S 11(3) of the Trade Marks Act 1969.
\textsuperscript{13} S. 11(1) of the Trade Marks Rules 1969.
\textsuperscript{14} S. 9(3) of the 1969 Act.
\textsuperscript{15} S. 29 of the Trade Marks Rules 1969.
\textsuperscript{16} S.S. 9(1)(a) of the Trade Marks Act 1969.
registered as his, and to prove the existence and ownership of the relevant business name\textsuperscript{17}.

(b) The name and address of the applicant\textsuperscript{18}.

(c) The goods or services in relation to which the registration is sought\textsuperscript{19}.

(d) A representation of the trade mark\textsuperscript{20}.

(ii) Application by an Agent

The application for registration and any other communication with the Registrar may be made either by the owner of the trade mark or through an agent\textsuperscript{21}. Section 15 of the Act of 1969 specifies the qualifications of the trade mark agent, namely:

1- Sudanese advocates practicing in the Sudan,

2- Sudanese chartered accountants, practicing in the Sudan.

3- With the written consent of the Minister which may be withdrawn at any time and subject to such conditions as he may think fit:

(a) University or a higher institute Sudanese graduates, who studied commercial law,

(b) Sudanese who have had at least five years training in a public or private trade marks office,

(c) such other persons whom the Minister may think fit.

When the application is made through an agent, a signed authority to that effect is required\textsuperscript{22}. When the application is made through an agent

\textsuperscript{17} S. 36 of the Trade Marks Rule 1969.

\textsuperscript{18} S.S. 9(1)(b) of the Trade Marks Act 1969.

\textsuperscript{19} S. 5(1) of the Trade Marks Act 1969.

\textsuperscript{20} S. 14 of the Trade Marks Rules 1969.

\textsuperscript{21} S. 14(1) of the Trade Marks Act 1969.

\textsuperscript{22} S. 14 (2) of the Trade Marks Act 1969.
other than a member of the Sudanese Bar Association, it must be accompanied by a power of attorney signed by the applicant\(^{23}\).

(iii) Nationality of the Applicant

Nationality of the applicant must be stated on the application, and as proof thereof every such application must be accompanied by a certificate of incorporation, certificate of partnership registration, extract from an official commercial register or such other document as should satisfy the Registrar\(^{24}\). If any of the documents mentioned above is neither in Arabic nor in English, a certified translation into Arabic or English, must be supplied\(^{25}\).

Before issuing a certificate of registration, the applicant must furnish to the Registrar a declaration on oath that his nationality has not changed since the date he filed his application\(^{26}\). May be, such declaration on oath is required to ascertain that the applicant has not become a national of a boycotted country, since section 30 of the 1969 Act provides for sequestration of marks when a registered owner becomes a national of a boycotted country.

(iv) Representation of the Mark

A representation of the mark, should be affixed to the square contained for that purpose in form T. M. No. 1\(^{27}\). If the size of the representation is larger than the size of the square, the representation should be amounted upon linen or any other material that the Registrar may think fit. Part of the amounting should be affixed to the square, and the rest may be folded over.

\(^{23}\) S. 9(2) of the Trade Marks Act 1969.

\(^{24}\) S. 10(1) of the Trade Marks Act 1969 and s. 11(2) of the Trade Marks Rule 1969.

\(^{25}\) S. 10(3) of the Trade Marks Act 1969.

\(^{26}\) S. 10(4) of the Trade Marks Act 1969.

\(^{27}\) S. 14 of the Trade Marks Rules 1969.
The application form should be accompanied by eight additional representations of the mark on form T. M. No. 2. Such representation should be identical to that affixed to the application form. If the Registrar is not satisfied with the representation of the mark submitted to him, he may request it to be substituted by a more comprehensive one. If it is not possible, a specimen of the mark may be submitted.

Specimen is an actual example of how the mark is used in commerce or in connection with the relevant goods or services. When the Registrar requests a specimen to be submitted, the applicant must submit only the specimen and not the product itself.

(v) Classification of Goods and Services

Since the classification of goods and services is an administrative measure, designed to aid the process of searching, the Trade Marks Register, under both the Trade Marks Ordinance 1931 and the Trade Marks Act 1969, has been divided into a number of different classes of goods and services.

The current classification is to be found in schedule 3 to the Trade Marks Rules 1969 as provided by the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of Registration of Trade Marks 1957 (as amended from time to time). According to the last amendment made by WIPO, there are 465 classes of

---

29 S. 18 of the Trade Marks Rules 1969.
30 S. 19 of the Trade Marks Rules 1969.
32 Nice Agreement is one of the International Agreements directed by the WIPO. The Sudan joined this Agreement in 1984, but the classification system provided by such Agreement has been adopted in Sudan since 1969.
goods and services contained in schedule 3 to the Trade Marks Rules 1969.

Section 5(1) of the Trade Marks Act 1969 provide that a trade mark must be registered for any particular goods for which the mark will be used, with an indication of the appropriate class, as set out in the classification of goods in schedule 3 to the Rules. Any question as to the class within which any goods fall is decided by the Registrar\textsuperscript{33}. A trade mark may be registered for different goods in the same class, but one and the same registration cannot validly cover all the goods in one class\textsuperscript{34}.

A trade mark may be registered for goods in different classes by different applications, an application for particular goods in each class, and these applications must be treated as distinct and separate applications\textsuperscript{35}. For example the famous trade mark “Sharp” owned by “Sharp Corporation” was registered for goods and services in three different classes by three distinct applications\textsuperscript{36}.

(vi) Date of Filing and Priority Date

The date of filing is the date on which all the documents required for registration by the Trade Marks Act 1969 and the Rules thereof have been submitted to the Registrar office. If they are filed on different dates, the filing date of the application is the date on which the last document is submitted. Under both, the Trade Marks Ordinance 1931 and the Trade Marks Act 1969, if a mark has been accepted to be registered, it should be

\textsuperscript{33} S. 5(2) of the Trade Marks Act 1969.
\textsuperscript{34} S. 5(10) of the Trade Marks Act 1969.
\textsuperscript{35} S. 17 of the Trade Marks Rules 1969.
\textsuperscript{36} App. No. 30685 for particulars goods in class 1, app. No. 30686 for particular goods in class 2, and app. No. 30685 for particular services in class 37. all these applications are dated on 23.4.2002- Trade Marks Registry Archive Kh. (2002).
registered as on the date of the application had been filed, and such date, “date of filing”, is to be the date of registration\textsuperscript{37}.

The date of filing of an application is important, since it gives the applicant precedence over later applications. Section 7(2) of the Trade Marks Act 1969 reads:

> Registration of a mark can validly be granted only to the person who has first fulfilled the conditions of a valid application or who is the first to claim validly the earliest priority for such application.

The importance of the theory of priority date will increase in problematic situation of rival claims. Rival claims arise where each of several persons claims to be the proprietor of the same trade mark, or of nearly identical trade mark in respect of the same goods, or description of goods, and to be registered as such proprietor. According to section 11 of the 1969 Act, the whole issue should be referred by the Registrar to the court which, in determining the rights of the parties, should have regard to the date of the registration in the country of origin and the priority of user of the mark in the Sudan.

If at any time the Sudan becomes a party to any international agreement for the mutual protection of trade marks, then any person who has duly filed a first application for registration of a mark in another state which is a party to such agreement, may claim the right of priority in Sudan i.e. he will be considered to have applied for registration in Sudan on the day of such first application, provided that the application in Sudan is filed within six months from the first application but the registered owner of the mark should not be entitled to recover damages for infringement prior to the date on which the mark is registered in Sudan.

\textsuperscript{37} S. 11(2) of the Trade Marks Ordinance 1931 and S. 18(7) of the Trade Marks Act 1969.
3. Examination of the Application

After an application has satisfied all the formal requirements for filing an application the Registrar, in exercising the powers granted to him by section 16 of the Trade Marks Act 1969, must examine the application as to substance to determine whether it meets the requirements of the 1969 Act and the Rules made under it. He must be satisfied that:

1- what is applied for is a “trade mark” under section 3 of the Trade Marks Act 1969 which defines the trade mark,

2- the mark applied for does not fail under one of the grounds for refusal of registration embodied in section 8(1) of the 1969 Act, which includes the objections that the mark is descriptive, deceptive, generic or contrary to law or public policy and morality,

3- the mark applied for does not conflict with a prior right belonging to a third party under section 8(2) of the Trade Marks Act 1969.

In connection with this last point a search of earlier marks must be conducted by the Registrar in accordance with sections 21 and 42 of the Trade Marks Rules 1969.

4. The Search

(i) The General Rule

Upon receipt of an application for registration of a trade mark, the Registrar must order that a search should be conducted among registered trade marks and pending applications in the Register, to check whether there is a trade mark in respect of goods of the same or similar descriptions, identical or similar to the mark applied for to the extent that the public may be deceived or misled by the later mark. This general rule is embodied in section 21 of the Trade Marks Rules 1969.
(ii) Search upon Request

Upon request by any person to the Registrar on form T. M. No. 15, and after payment of the prescribed fees, the Registrar may conduct a search in any class for marks which may be identical or similar to the mark in respect of which the search is requested\(^{38}\).

In practice traders used to request the Registrar to conduct a search before filing applications for registration of trade marks in order to avoid potential conflict of their proposed marks with prior marks and hence they save time and money.

(iii) No Liability for the Registrar in Respect of Search Errors

In all cases, the Registrar is not responsible before the law in respect of any error that may appear in the result or informing the result of any search conducted in accordance with the Trade Marks Rules 1969\(^{39}\).

5. Refusal or Acceptance of the Application

After examining an application for registration of a trade mark and conducting the necessary search, the Registrar is empowered to refuse to accept such application, if he considers that it does not meet the requirements for registration provided by the 1969 Act\(^{40}\). The applicant should be informed with the Registrar’s decision of refusal\(^{41}\), and he has the right to appeal to the court\(^{42}\). In \textit{Leyland Daf Limited v. Trade Marks Registrar}\(^{43}\), the Registrar exercised the discretionary power granted to him by section 16(1) of the Trade Marks Act 1969 and refused to register

\(^{38}\) S. 42 of the Trade Marks Rules 1969.

\(^{39}\) S. 43 of the Trade Marks Rules 1969.

\(^{40}\) S. 16(1) of the Trade Marks Act 1969.

\(^{41}\) S. 25 of the Trade Marks Rules 1969.

\(^{42}\) S. 16(2) of the Trade Marks Act 1969.

the trade mark “Comet” for buses, spare parts and some other goods produced by the appellants. The Registrar’s decision was based on section 8(1) of the 1969 Act, that is, on the ground that the trade mark ‘Comet’ has become in the current language of the country a customary designation of jet airplanes, and the registration of such mark for buses and the other goods specified in the application form would deceive the public as to the origin of such goods. Against this decision the appellants appealed to the court which upheld the registrar’s decision and dismissed the case.

If it appears to the Registrar that an application complies with all requirements for registration, he must accept it. Section 16 of the Trade Marks Act 1969 grants the Registrar a discretionary power to accept the application for registration of a trade mark either absolutely or subject to such conditions, amendments, modifications or limitations as he may think fit. If the Registrar accepts an application subject to such conditions, amendments, modifications or limitations, the applicant may appeal to the court, within one month from the date on which he was informed with the Registrar’s decision, otherwise his consent to such decision will be presumed.

6. Publication

Advertisement of applications for registration of trade marks, as accepted, in an official gazette enables owners of prior rights to take the necessary steps, such as opposition, to protect their rights. Section 17 of the Trade Marks Act 1969 together with section 28 of the Trade Marks Rules 1969, provide that when an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or

---

44 S. 24 of the Trade Marks Rules 1969.
limitations, the Registrar must, as soon as possible after such acceptance, cause the application as accepted to be advertised in the Sudan Gazzette at the expense of the applicant. The advertisement must set forth all conditions or limitation subject to which the application has been accepted.

The advertisement in the Gazzette is not an evidence of ownership of the mark, since the Registrar has the power to withdraw his acceptance of registration of a trade mark upon a successful objection raised by any interested person. Such withdrawal must also be published in the Gazzette.

7. Objections to Registration

Section 18 of the 1969 Act provides that after an application for registration of a trade mark has been published in the Sudan Gazzette as accepted, any interested person within six months if resident in the Sudan or eight months if resident abroad from the date of such advertisement, may file with the Registrar an opposition to such registration. The Registrar must inform the applicant with such opposition and after being informed with the objections raised against his application, the applicant may send to the Registrar a counter statement of the grounds on which he relies for registering his mark, otherwise, he is deemed to have abandoned his application.

If the applicant fails to overcome all the objections raised against his application, the Registrar must reject such application. The decision of the Registrar is subject to appeal to the competent Court. If no opposition is filed within the prescribed period or after the applicant has overcome the objections raised against his application, the Registrar must proceed to register the mark.

Objection to registration will be discussed in details in the next chapter.
8. Registration

Once any opposition to the registration of a trade mark has been overcome, or the time for filing an opposition has expired, section 18(7) of the Trade Marks Act 1969 states that the mark must be registered either absolutely or subject to any conditions, amendments, modifications or limitations as the Registrar may think fit. Such a mark must not be registered and entered into the Trade Marks Register unless the registration fees prescribed by schedule 1 to the Trade Marks Rules 1969 have been paid. In addition to the details required by section 4 of the Trade Marks Act 1969 to be contained in the Register, such as the name and address of the owner, assignments, conditions, limitations, renewals, cancellations and other matters relating to the marks, section 30 of the Trade Marks Rules 1969 provides that the date of registration, the goods in respect of which the mark is registered and the trade, professional or job of the owner of the mark must also be contained in the Register.

According to section 18(7) of the 1969 Act, when a trade mark is registered, the date of registration is the date on which the application for registration has been filed.

(i) Certificate of Registration

Once a trade mark is registered and entered into the Register, the registered owner of such mark is entitled to a certificate of registration bearing the priority date. According to section 32 of the Trade Marks Rules 1969, the Registrar must issue the certificate of registration on form T. M. No. 9 upon payment of the prescribed fees.

Before the issue of a certificate of registration of a trade mark, the applicant must furnish to the Registrar a declaration on oath, that his nationality has not changed since he filed his application47.

---

47 S. 10(4) of the Trade Marks Act 1969.
(ii) Conditions, Amendments, Modifications, Limitations and Disclaimers Imposed by the Registrar

Section 16 of the Trade Marks Act 1969 authorizes the Registrar to register a trade mark subject to such conditions, amendments, modifications or limitations as he may think fit. Subject to his own discretion, the Registrar may impose any conditions on the Registration of a trade mark. With reference to the Trade Mark Registry, it will appear that the most common conditions imposed by the Registrar are “not to monopolize” certain element of the trade mark and the condition “to connect” the mark applied for with another registered trade mark. For example, the trade mark “Mona Lisa” which consists of the name of Mona Lisa, the letters M & S, the number 2000 and a girl device, was registered under the condition “not to monopolize the letters, number and the girl device in any other position”. Also the trade mark “Tang” was registered under class 32 with the condition “it should be connected with the trade mark number 9510”.

A trade mark may be registered subject to any amendment or modifications required by the Registrar. For example, the trade mark “Habieba”, which is a label that consists of the word “Habieba” and the term “Haj Mahmoud Habieba and Son’s Sweets”, was registered under class 30 subject to the removal of the descriptive term “Haj Mahmoud Habieba and Son’s Sweets”.

The Registrar is authorized by section 16(1) of the 1969 Act to impose limitations as to mode or place of use or otherwise as he may think fit. Furthermore, section 7(3) of the Act expressly provides that a trade mark may be registered with limitation as to colours to be used.

The practice at the Registrar Office is that, if there is no limitation as to colours to be used on the mark, then it is deemed valid for all colours. The effect of such a limitation is that the owner of the trade mark can sue for infringement only if the exact colour scheme of the trade mark is copied. But if there is no limitation as to colour then the owner can sue for infringement, no matter what colour scheme is used by the infringer.

Limitation as to colour may be made voluntarily by the applicant. For example, the trade mark “Snickers” was registered, as required by the applicants, with limitation as to the colours brown, blue and white.

Section 26 of the Trade Marks Rules 1969 states that the Registrar may require an applicant for registration of a trade mark, to add any disclaimer to his application. When the applicant makes a disclaimer, he disclaims his right to the exclusive use of any specified element of the mark. This is likely to happen where there are doubts about the distinctiveness of an element of a mark, then a disclaimer of the disputed element may be a way to resolve the problem. For instance the trade mark “Doctor Mama” was registered under class 3 with a disclaimer of the “word Mama”.

Where a registration is subject to a disclaimer or a limitation the rights of the owner are accordingly restricted. The difference between a disclaimer and a limitation is that, a disclaimer is related to the composition of the mark, and a limitation on how it is to be used.

---

51 Such limitation was also provided by S. 5(3) of the Trade Marks Ordinance.
52 Ruth Annand & Helen Norman, supra note 5, at 47.
55 App. No. 31242 Trade Mark Registry Archive Kh. 2002.
56 Ruth Annand & Helen Norman, supra note 5, at 47.
The applicant may appeal against any conditions, amendments, modifications or limitations imposed by the Registrar, within one month from the date on which he has been notified with the Registrar decision, otherwise he is deemed to have accepted such conditions, amendments, modifications or limitations.\(^{57}\)

(iii) Duration and Renewal of Registration

Since the registration of a trade mark does not grant a monopoly right, there is no need to limit its validity, but for administrative and practical reasons, a time limit is generally provided for in trade marks laws with the possibility of renewal when the time limit expires.\(^{58}\) The fees charged for renewal of registrations, which is a welcome source of revenue to the Registrar Office, may be one of the reasons for imposing such time limit. Furthermore, the duration of the registration for unlimited time, would lead to a huge amount of undesirable trade mark’s registrations that are no longer of any interest to their owners.

Under the Trade Marks Act 1969, the duration of registration of a trade mark is 10 years, to be calculated from the date of registration (date of filing), whereas such period was 20 years under the Trade Marks Ordinance 1931. Section 19(1) of the Trade Marks Act 1969 reads:

> The period of duration of the registration of a trade mark shall be ten years from the date of registration, and at any time before the expiration of such term or any subsequent term of ten years, the registration may be renewed upon filing an application therefore in the prescribed form and upon payment of the prescribed fee.

\(^{57}\) S. 24 of the Trade Marks Rules 1969.

\(^{58}\) WIPO, supra note 45, at 75.
The application for renewal of a registration of a trade mark must be made on form T.M. No. 13\(^59\), provided that, at the time of renewal, no change may be allowed in the mark or in the list of goods in respect of which the mark is registered, except that goods may be eliminated from the list\(^60\).

According to section 19(3) of the 1969 Act, a period of grace of six months shall be allowed for the renewal of a registered trade mark after its term has expired. Extra charge for the delay should be paid as prescribed by schedule 1 of the 1969 Rules.

If no application for renewal has been filed, the Registrar is obliged by section 33(2)(a) of the Trade Marks Rules 1969 to send a renewal notice, on form T. M. No. 14, to the proprietor before the expiry of the registration. If the renewal fee has not been paid until the expiry date of the registration, the Registrar must advertise such matter in the Gazzette. The Registrar must renew the registration if he has received, within two months from the date of such advertisement an application for renewal of such registration, accompanied by the prescribed renewal fee and the extra fee for the delay\(^61\), otherwise, the mark will be removed from the Register\(^62\).

(iv) The Symbol ®

Although it is advisable to identify a registered trade mark by a trade mark notice, only a few laws of trade marks all over the world provide for such notices\(^63\). Making the use of trade marks notices on goods compulsory is prohibited by Article 50 of the Paris Convention.

\(^{59}\) S. 33(1) of the Trade Marks Rules 1969.

\(^{60}\) S. 19(3) of the Trade Marks Act 1969.

\(^{61}\) S.S. 33(2)(b) of the Trade Marks Rules 1969.

\(^{62}\) S. 34(1) of the Trade Marks Rules 1969.

\(^{63}\) WIPO, supra note 45, at 72.
The Trade Marks Law in the United States of America allows the use of a long statement, such as “registered with the United States Patents and Trade Marks Office”, to be replaced by a short symbol, namely, the circled R. Over the years this symbol “®”, has spread throughout the world, and become a widely recognized symbol for a registered trade mark. It is recommended to allow the use of the symbol ® for a registered trade mark as a warning to competitors not to infringe the mark.

9. Rights Conferred by Registration

Under the Trade Marks Ordinance 1931, the registered owner of a trade mark has the exclusive right to use the mark. Section 20 of the 1931 Ordinance provided the following:

Subject to any limitations and conditions entered upon the Register, the registration of a person as appropriator of a trade mark, shall, if valid give to such person the right to the exclusive use of such trade mark upon or in connection with the goods in respect of which it is registered.

From the provision of this section, it can be inferred that since the registered owner of a trade mark has the exclusive right to use the mark he has the right to exclude others from using it, and any use of such mark by others will infringe his exclusive right to the mark. The same exclusive right continues to exist under the Trade Marks Act 1969, section 7(1) of which reads:

The exclusive right to a mark, conferred by this Act shall be acquired by registration in accordance with the provision of this Act.

According to the wording of the above mentioned section, the registration of a trade mark entitles the registered owner to the exclusive

---

64 Id.
right to the mark. The term “the exclusive right to a mark” may be construed as “the exclusive right to use the mark”. Section 20 of the 1969 Act goes further and provides that the registered owner of a trade mark has the right to preclude others from using the mark.

(i) The Right to Use the Trade Mark

As has been said before, the registered owner of a trade mark has an exclusive right in the mark, which means that he has the right to use the mark. This positive right of use is recognized in most trade marks laws. It would indeed be contradictory not to grant such a positive right of use while imposing an obligation to use.65

The Sudanese Legislature omitted any reference to activities which may constitute use of a mark. By contrast, the English Trade Marks Act 1994 clearly defines what may constitute use of a mark. Therefore, the Registrar and the Court may refer to the English Act to answer any question which may arise as to the right to use the mark. The following activities may constitute use of the mark under section 40(4) of the English Trade Marks Act 1994:

1- to affix the mark on goods, containers, packagings, labels … etc., or use it in any other way in relation to the goods for which it is registered,

2- to offer or expose goods for sale, put them on the market or stock them for those purposes under the mark, or to offer or supply services under the mark,

3- to import or export goods under the mark,

4- to use the mark on business papers, such, as delivery notes and invoices, or to use it in advertising.

65 Id., at 77.
(ii) The Right to Preclude Others From Using the Mark

It follows from the basic function of the trade mark of distinguishing the goods of one trader from those of others that the owner of the trade mark must be able to object to the use of confusingly similar marks in order to prevent consumers and the public in general from being misled. This is the essence of the exclusive right afforded to the trade mark’s owner by registration.\footnote{\textit{Id.}, at 78.}

Section 20 of the Trade Marks Act 1969 provides the following:

Registration of the trade mark shall confer upon its registered owner the right to preclude any third parties from the following acts:

a- any use of the mark, or of a sign resembling it in such away as to likely to mislead the public, for goods in respect of which the mark is registered, or other goods, in connection with which the use of the mark or sign is likely to mislead the public;

b- any other use of the mark, or of a sign or a trade name resembling it, without just cause and in conditions likely to be prejudicial to the interest of the registered owner of the mark.

It appears from the provision of this section that the owner of a registered trade mark has the right to object any use of his trade mark by a third party for goods for which it is registered. Furthermore, he has the right to object the use of signs resembling his mark for the same goods in respect of which his mark is registered, or for other goods, in connection with which the use of such mark is likely to mislead the public.

According to section 20 of the 1969 Act, the owner of registered trade mark has the right to preclude third parties from any other use of a mark, a sign or a trade name resembling his trade mark, provided that,
such use without due cause, is likely to be detrimental to his interest. Identification or similarity of goods is not required by the section. It is enough to prove that such use of a similar mark, sign or trade name is harmful to the interest of the owner of the registered mark for example, by being detrimental to the distinctive character or reputation of the registered trade mark.\(^{67}\)

The exclusive right of the trade mark owner may be exercised by means of an infringement action. The trade mark is infringed if there is a risk or a likehood of the public being misled, owing to the use of an identical or similar mark for identical or similar goods.\(^{68}\) The test to be applied here has to deal with the reality of infringement in the marketplace. The Trade Marks Act 1969 also enables the trade mark owner to exercise his exclusive right through an administrative opposition procedure against an application for the registration of a confusingly similar trade mark. The test to be applied in this case, is concerned with the potential risk of confusion that could arise from any use that the applicant might possibly make of his mark if it was registered.\(^{69}\)

(iii) Protection of Registered Trade Mark by Courts of Sudan

Sudanese Courts protect the rights of the registered owners of trade marks either through criminal proceedings against infringement under section 27 of the Trade Marks Act 1969 or through opposition proceeding against the registration of a subsequent mark under section 18 of the 1969 Act.


\(^{68}\) WIPO, supra note 45, at 78.

\(^{69}\) Id.
For example in the Trial of Israel Metry and Another\(^70\), the Courts protected, in three levels of litigation, the exclusive right of the owner of the trade mark “Temby” against infringing acts by third parties “the accused”. The facts of this case could be summarized as follows: The accused had imported from China electric sockets and plugs bearing the mark “Tembi” which were similar to sockets and plugs existing in the market place under the trade mark “Temby”, imported from England by an English company also named “Temby”. Both the trade mark and the business name “Temby” were registered in the Sudan. The English company through its agent in Sudan instituted an infringement proceeding against the accused. The court of the first instance convicted the accused under sub-section 27(6)(e) and (g) of the Trade Marks Act 1969 and section 170 of the Criminal Procedure Act 1991. The accused appealed to the Court of Appeal and then to the Supreme Court, The Supreme Court in revision proceeding concluded that the marks and goods in question were similar to the extent that it became difficult to differentiate between them, thereby the public would be confused, and such confusion would cause great damage to the complainant “the English company” which should be protected since it had registered its trade mark in accordance with the law. Therefore, the Supreme Court confirmed the conviction and dismissed the application for revision.

10. International Registration of Trade Marks

The system of international registration of marks is governed by two treaties: the Madrid Agreement Concerning the International Registration of Marks, which dates from 1891, and the Protocol Relating to the Madrid Agreement, which was adopted in 1989, and entered into force on December 1. 1995, and came into operation on April 1, 1996.

This system is administered by the International Bureau of WIPO, which maintains the International Register and publishes the WIPO Gazzette of International Marks.\(^{71}\)

The Madrid Agreement provides a system whereby a national of a member country of the Agreement, who had registered a trade mark in any contracting state could make a single international application, to be submitted to his national trade mark office and forwarded to the International Office at Geneva, specifying those countries party to the Agreement in which he would wish to have his mark registered.\(^{72}\)

Some of the major countries in the trade marks field, like Japan, the United Kingdom and the United States of America have not ratified the Madrid Agreement, and the membership is limited to about 30 countries,\(^{73}\) which affects the performance of the Agreement. As a result of the unsatisfactory performance of the Madrid Agreement, the Madrid Protocol was adopted in 1989 which effectively provides an alternative system for international registrations acceptable to more countries.\(^{74}\) The original Madrid Agreement will remain in force alongside the Madrid Protocol although ultimately the Protocol will replace the Agreement, when the Protocol will have been in operation for at least 10 years.\(^{75}\) The Protocol differs from the Agreement in four main respects: First, under the Protocol the international registrations may be based on national applications, and not only on national registration. Secondly, a period of 18 months provided by the Protocol, instead of one year under the Agreement, for contracting parties to refuse protection, with the

\(^{71}\) WIPO, supra note 45, at 279.


\(^{73}\) WIPO, supra note 45, at 279.

\(^{74}\) Id.

\(^{75}\) Amanda Michaels, supra note 72, at 76.

\(^{76}\) WIPO, supra note 45, at 279-280.
possibility of a longer period in case of a refusal based on an opposition. Thirdly, a designated Contracting Party may receive, under the Protocol, instead of a share in the revenue from the standard fees, an “individual fee”. Finally, the Protocol may be joined not only by States, but in addition by any intergovernmental organization which has an office for registering trade marks with effect in its territory.

(i) Filing an International Application

The procedure for registration of a trade mark at the international Bureau is governed by the “Common Regulation” adopted under the Madrid Agreement and the Madrid Protocol, which as stated above came into force on April 1, 1996.\(^77\)

An application for international registration may be filed only by a natural person or a legal entity which has a real and effective industrial or commercial establishment in, or is domiciled in, or is a national of, a country which is a party to the Madrid Agreement or the Madrid Protocol, or who has such an establishment in, or is domiciled in the territory of an intergovernmental organization which is a party to the Protocol or is a national of a member State of such an organization.\(^78\)

A mark may be the subject of an international application only if it has already been registered or, where the international application is exclusively governed by the Protocol has been applied for registration, in the office of origin.\(^79\)

An international application must designate the countries in which the mark is to be registered, provided that the designated countries and

\(^{77}\) Amanda Michaels, supra note 72, at 76.

\(^{78}\) Article 1 of the Madrid Agreement and Article 2 of the Madrid Protocol.

\(^{79}\) Article 1 of the Madrid Agreement and Article 2 of Madrid Protocol.
the country whose office is the office of origin are all parties to the same treaty\(^{80}\).

An international application must be presented to the International Bureau through the office of origin. Article 3 of both the Agreement and the Protocol provides that an application must be made on a form to be prescribed by the Common Regulations. It must contain a representation of the mark which must be identical with that in the basic registration or basic application, and a list of goods or services for which protection is sought, classified in accordance with Nice Classification. If the international application is governed exclusively by the Agreement, it must be in French, if it is governed exclusively by the Protocol or by both the Agreement and the Protocol, it may be made in either English or French\(^{81}\). An international application may claim priority under Article 4 of the Paris convention, according to Article 4(3) of the Agreement and Article 4(2) of the Protocol.

The International application is subject to the following fees\(^{82}\):

1- the basic fee,

2- a complementary fee in respect of each designated contracting party for which no individual fee is payable,

3- an individual fee in respect of any contracting party which is designated under the Protocol and had declared that it wishes to receive such a fee,

4- a supplementary fee in respect of each class of goods and services beyond the third class.

\(^{80}\) Id.

\(^{81}\) Rule 6 of the Common Regulations under the Madrid Agreement and Madrid Protocol.

\(^{82}\) Article 8 of the Madrid Agreement and Article 8 of the Madrid Protocol.
These fees may be paid direct to the International Bureau or, where
the office of origin accepts to collect and forward such fees to the
International Bureau.

Under Article 3(4) of both the Madrid Agreement and the Madrid
Protocol the International Bureau will immediately register the mark filed
in accordance with Article 1 of the Agreement and Article 2 of the
Protocol and the registration will bear the date on which the international
application was received in the office of origin, as long as it was received
by the International Bureau within two months from that date. The
International Bureau notifies all national trade mark offices concerned
and the mark is to be published in the WIPO Gazzette of International
Trade Marks.

By Article 4(1) of both, the Madrid Agreement and Madrid
Protocol, from the date of registration at the International Bureau, the
protection of the mark in each of the contracting states which were
designated by the international application, will be the same as if the
mark had been deposited directly in that contracting state.

According to Articles 6 and 7 of both the Madrid Agreement and
the Madrid Protocol the duration period of the registration of a trade mark
at the International Bureau is 10 years with the possibility of renewal for
further period of 10 years on payment of the prescribed fees.

(ii) Refusal of Protection

Articles 5 of both the Madrid Agreement and the Madrid Protocol
gives each national office a right to refuse to register the mark in its
territory, but only on a basis upon which it would refuse to register a
national application. Any refusal must be notified to the International
Bureau by the national office concerned within the time limit specified by
the Agreement or the Protocol. The refusal must be recorded in the
International Register and published in the WIPO Gazzette of International trade marks and a copy should be transmitted to the holder of the international registration. Any subsequent procedure, such as review or appeal, is carried out directly between the holder and the national office concerned, without any involvement on the part of the International Bureau. The national office concerned must, however, notify the International Bureau of the final decision taken in respect of such review or appeal. Such final decision must be recorded in the International Register and published in the Gazzette. If no refusal is notified within the prescribed time limit the protection of the mark in the relevant country is the same as if the mark had been registered by the office of that country.

The time limit for a national office of a contracting party to notify a refusal is generally 12 months from the date on which the office was notified of the designation. But under the Protocol, the national office may declare that this period is to be extended to 18 months, or longer in the case of a refusal based on an opposition.

(iii) Dependence on the Basic Mark

Under Article 6 of both the Madrid Agreement and the Madrid Protocol an international registration of a trade mark will remain dependent on the mark registered or applied for in the office of origin for a period of 5 years from the date of its registration. If, the basic registration ceases to have effect, whether through cancellation or non-renewal, within this five years period, the international registration will no longer be protected. After the expiry of this period of 5 years, the international registration becomes independent of the basic registration or the basic application.
(iv) Advantages of the Madrid System

The owner of a trade mark after registering the mark, or filing an application for registration with the office of origin, may achieve a number of national registrations by filing one single application, in one language, to one office, and paying fees to one office, instead of filing separate applications to trade marks offices in various countries (Contracting Parties) in different languages and paying fees in each office. Similar advantages exist when the registration has to be renewed or modified.

International registration has several advantages to the trade marks offices. For example, they do not need to examine applications for compliance with formal requirements, or classify the goods or services, or publish the marks.

(v) The International Registration System of Trade Marks in the Sudan

The Sudan adopted the international registration system of trade marks by joining the Madrid Agreement in 1984. Accordingly, in 2001 the International Registration of Trade Marks Office\(^\text{83}\) was established to deal with all matters concerning the international registration of trade marks. The work at the Office is governed by both, the Trade Marks Act 1969 and the Madrid Agreement.

French is the official language under the Madrid Agreement. Therefore, all the transactions, registration procedure and communications between the International Bureau and the International Registration Office of Trade marks must be in French.

The International Bureau used to notify international applications which designated the Sudan to the International Registration Office

---

\(^\text{83}\) It is one of the Offices of the Registrar General of Intellectual Property.
through periodicals sent in compact discs (CDs) called “Romarin”. When the International Registration Office receives such notice of designation, it must examine the application and conduct the necessary search to determine whether there is any ground for refusal of protection. If such ground for refusal exists a notification of refusal must be sent to the International Bureau otherwise, the mark concerned will be protected as if it had been registered in the Sudan.

Unfortunately the practice at the International Registration office is completely non-professional since it used not to respond to notifications of designation sent by the International Bureau. The International Registration Office in Sudan neither examines the international applications nor conducts search for prior marks in respect of such international marks. It just ignores the received notifications. Consequently 26,000 trade marks were presumed to be protected in the Sudan since no refusal has been notified to the International Bureau within the period of one year from the date of notification of designation. Many of these trade marks ought not to be registered in the Sudan, for being contrary to the law like trade marks for alcoholic drinks. On the other hand only three Sudanese trade marks were internationally registered at the International Bureau namely, “Krip” owned by Tag Cosmetics, “Kenana” owned by Kenana Sugar Company and “Bringi” owned by Haggar Holding Company.

Lately, there have been serious attempts from the Trade Marks Office to improve and develop the performance of the International Registration of Trade Marks Office. Moreover and on a larger scale,

---

85 International application no. 728652 dated 27/10/1999.
86 International application no. 781060 dated 5/1/2002.
preparations are taking place to join the Madrid Protocol in order to avoid all the flaws resulting from being a party only to the Madrid Agreement.

11. Conclusion

A trade mark once registered properly and in accordance with the law, enjoys full legal protection. The Trade Marks Act 1969 together with the Trade Marks Rules 1969 provide a comprehensive registration system. The practice at the Registrar of Trade Marks Office needs to benefit from the current technology, like many other countries, for an easier work flow. For the time being it is recommended to adopt an electronic archive and an electronic Register in order to save man power consumed in conducting the search and save the time of both the Registrar Office employees and the Public.

For example, applicant in the United State of America may use the trade mark electronic application system. By using such electronic system, he may fill out one application form and then submits the application directly to the Patents and Trade Marks Office over the Internet, paying the prescribed fee by credit card or an existing deposit account.

---

CHAPTER FOUR
Opposition, Cancellation, Assignment, and Surrender of Registration

1. Introduction

After an application for registration of a trade mark has been accepted and published in the Sudan Gazzette and before completion of registration, any person may object to the registration of such trade mark on any of the grounds for objection provided for in section 18 of the Trade Marks Act 1969. When the registration is completed any interested person or the Registrar may request the Court to cancel such registration in accordance with section 24 of the 1969 Act. As long as the registration of a trade mark is valid, its registered owner has the right to assign it to any other person, license its use or even surrender it. Owing to the importance of the issues above mentioned this chapter will discuss them (objection, cancellation, assignment and surrender of registration) in details.

2. Opposition to Registration

I will discuss this problem first under the Trade Marks Ordinance 1931 and then under the Trade Marks Act 1969.

(i) The Trade Marks Ordinance 1931

According to section 10 of the 1931 Ordinance, within 6 months from the date of the advertisement of an application for the registration of a trade mark in the Sudan Gazzette, any person may file with the Court a notice of opposition to such registration. The notice should include a statement of the opposition. Copies of the notice should be sent to the Trade Marks Registrar and the applicant for registration. Filing and service of the notice of opposition should constitute the commencement
of the court proceeding. The court after hearing the parties and weighing the evidence adduced before it, may reject or accept the opposition absolutely or may direct that the registration should be allowed subject to such conditions, amendments, modifications or limitations as to mode or place of use.

(ii) The Trade Marks Act 1969

Objection to registration under the Trade Marks Act 1969 is to be made, unlike the Trade Marks Ordinance 1931, to the Trade Mark Registrar and not to the Court. The grounds for opposition and the procedure relating to such opposition are governed by both section 18 of the Trade Marks Act 1969 and section 23 of the Trade Marks Rules 1969.

(a) Who May Oppose

According to section 18(1) of the 1969 Act “any interested person” may oppose a trade mark application for registration. This means that opponents are not limited to owners of earlier rights. Any person who feels sufficiently interested could theoretically oppose the application for registration, but realistically only those who have a vested interest to protect their earlier rights are likely to wish to go through the lengthy procedure of opposition provided by section 18 of the 1969 Act.

(b) Grounds for Opposition

Section 18(1) of Trade Marks Act 1969 states the grounds on which an application for registration of a trade mark may be opposed. It reads:

When an application is advertised as accepted any interested person if resident in the Sudan or any interested person outside the Sudan may, within six months or eight months respectively from the date of such advertisement, file
with the Registrar an opposition to such registration on any of the following grounds;

(a) That the mark is not entitled to registration under the provisions of the Act;
(b) That the mark has been obtained by fraud;
(c) That at date of application there was no bona fide intention to affectively abandoned his work.

Practically, the grounds of opposition relied on by most opponents are likely to be; the mark applied for is identical with a trade mark already on the Registrar with respect to the same goods or description of goods or so nearly resembles such a mark as to be likely to deceive or mislead the public (section 8(2)(a) of the 1969 Act); the mark consists exclusively of a shape, a descriptive or a deceptive matter (sections 8(1)(a), 8(1)(b) and (d) of the Act) and lastly, the mark conflicts with a mark well-known in the country and belongs to a third party.

It is obvious that the provision of section 18(1)(a) of the 1969 Act is flexible since it could be construed to include many grounds for objection under the umbrella term “not entitled to registration under the provisions of this Act” used by the Legislature therein. According all the grounds for refusal of registration of a trade mark embodied in section 8(1) and (2) of the 1969 Act are included as grounds of opposition to registration.

(c) Procedure of Opposition

Any interested person within 6 months if resident in the Sudan or 8 months if resident outside the Sudan from the date of advertisement of an application for registration of a trade mark as accepted in the Gazzette, may file with the Registrar a “notice of opposition” stating therein the ground relied upon for such opposition¹. A copy of the notice of

¹ S. 18(1) of the Trade Mark Act 1969.
opposition should be sent by the Registrar to the applicant for registration\textsuperscript{2}.

Within one month after receipt of the notice of opposition, the applicant should send to the Registrar a “counter – statement” of the grounds on which he relies for registration, and if he does not do so, he should be deemed to have abandoned his application\textsuperscript{3}. A copy of the counter-statement should be furnished to the opponent\textsuperscript{4}.

According to section 18(4) the Registrar should set a date for hearing the parties if the circumstances so require. Like any hearing before the court, the hearing before the Registrar should be held in public, unless the Registrar otherwise directs. Since the proceedings of opposition before the Registrar are of a judicial nature\textsuperscript{5}, the evidence should be given by affidavit and witnesses should give oral evidence on oath\textsuperscript{6}.

The onus of proof rests upon the applicant for registration who must establish that the opposition is not justified\textsuperscript{7}. He also may have to establish that the mark is registrable as a trade mark\textsuperscript{8}.

According to section 18(4) of the 1969 Act the Registrar should, after hearing the parties and considering the evidence adduced before him, decide whether, and subject to what conditions, amendments, modification or limitation, if any, the registration shall be permitted. The Registrar is to give his decision in writing, stating the reasons for such decision. A written notice of the decision of the Registrar should be

\textsuperscript{2} S. 18(3) of the Trade marks Act 1969.
\textsuperscript{3} S. 18(3) of the 1969 Act and S. 23 of the 1969 Rule.
\textsuperscript{4} S. 18(4) of the Trade Marks Act 1969.
\textsuperscript{6} S. 18(5) of the Trade marks Act 1969.
\textsuperscript{7} T. A. Blanco White & Robin Jacob, \textit{Kerly’s Law of Trade Marks and Trade Names}, 60 (1972).
\textsuperscript{8} Hamza M. ElShabrawishi v. Sudan perfumery Company Ltd. (1963) S.L.J.R. 206.
furnished to the applicant and the opponent. Such decisions of the Registrar are subject to appeal to the court\textsuperscript{9}.

(iii) Some Decisions of Sudanese Courts Concerning Opposition

In Hassan Mamoun v. Hilal Factory for Elastic & Cords\textsuperscript{10} the respondent was the owner of the registered trade marks of an antelope, a rabbit and a crocodile. He had been using these trade marks on his products of elastic and cords since 1965. In 1975 the appellants registered their trade marks double antelopes, double rabbits and double crocodiles for their product of elastic and cords. After more than four years the respondent instituted an action before the Province Court requesting cancellation of the registration of the trade marks belonging to the appellants, contending that they were registered by way of fraud since the appellants knew that they were already registered and owned by him (the respondent). After hearing the parties, examining the witnesses and weighing the evidence adduced, the Court ordered that the registration of the appellants’ trade marks should be cancelled. Against this decision the appellants appealed to the Court of Appeal on the ground that the Court of first instance failed to weigh the evidence properly and hence reached a wrong decision, and further that the Court did not take into account or ignored section 18 of the Trade Marks Act 1969 since the respondent failed to raise any objection and remained silent throughout the six months period specified by that section for raising an objection against a registration. Finally, the appellants argued that they had acquired a right for which no one can deprive them since the respondent was silent for a period of more than four years. The Court of Appeal held that “an

\textsuperscript{9} S. 18(6) of the Trade Marks Act 1969.

objection against an application for registration of a trade mark comes under section 18 of the Trade Marks Act 1969, and such objection must take place within a period of 6 months from the date of the advertisement of such application as accepted in the Gazzette. But even if the interested third party does not raise the objection within the period mentioned, nothing will bar him from applying thereafter for the cancellation of the registered trade mark in accordance with section 24 of the Trade Marks Act 1969, whether or not the application for cancellation is based on reasons resembling or similar to those on which an objection was supposed to have been made”.

Another case to be refereed to is Hamza Mahmoud ElShabrawishi v. Sudan Perfumary Company Ltd.11 The applicant registered the French word “Bienaime” as a trade mark for a perfume in Egypt, and the Arabic equivalent رائحة الحبيبة (Al Habieba) in Sudan. The respondent applied to register the French word “Bienaime” as a trade mark for a perfume in the Sudan. Against the respondent’s application, the applicant lodged an application of objection to registration under section 10 of the Trade Marks Ordinance 1931 to the Court on the grounds that the mark applied for is identical with or resembling his registered trade marks, “Bienaime” which was registered in Egypt and its Arabic equivalent رائحة الحبيبة which was registered in Sudan. The applicant argued that both trade marks should be protected in the Sudan and therefore the respondent’s trade mark should not be registered. The Court found that the objection should fail in connection with both of the applicant’s trade marks. As for the one registered in Egypt under the French word “Bienaime”, it could not be protected since it had be registered outside the Sudan. As for the

one registered in the Sudan under the terms “راحة الحبيبة” the identity or resemblance claimed was in the meaning of the words “Bienaime” and “حبوبة جداً” (Mahboub) and the evidence adduced proved that the exact meaning of the word “Bienaime” is “Mahboub” (Mahboub) and the meaning of the word “حبوبة” in French is “L’amour euse”. Finally, the Court concluded that:

From the above it can safely be stated that there is no identity regarding the meaning of these words, though there may be some similarity. In this connection the question of similarity or resemblance is not the decisive factor, all the circumstances must be taken into consideration, first and foremost the category of the customers. Evidence was adduced by the respondent that “Bienaime” would be a costly refined brand which it is intended to sell to a certain refined and elite category of people, the category of people who would ask for “Biename” and would do so in French and most probably using the correct accent. D.W.I gave evidence in this respect, he said: “if I want to buy this perfume I will say the word in French and not in Arabic”.

Such category is not likely to be deceived when a bottle of perfume is presented to them bearing the mark “حبوبة”.

Therefore the Registrar of Trade Marks was ordered by the Court to proceed with the registration of the respondent’s trade mark “Bienaime” as published.

---

12 Id., at 209.
3. Cancellation of Registration

The Sudanese registration system allows considerable range both to official and to third party objections before registration takes place. Once that event occurs, the mark is presumed valid. Any objector seeking to have the mark cancelled bears the onus of making a sufficient case since the cancellation of a trade mark registration is a serious matter for its owner, as it leads to a loss of his rights under the registration. Nevertheless, there are a number of grounds on which a trade mark registration can be cancelled, and these grounds are embodied in section 17 of the repealed Trade Marks Ordinance 1931 and section 24 of the Trade Marks Act 1969.

Under the Trade Marks Act 1969 the Legislature gives the Court the power to order the cancellation of the registration of a trade mark in accordance of the provision of section 24 thereof. The Registrar does not enjoy such power. He may, like any interested person, request the Court to cancel the registration. Section 24 of the Trade Marks Act 1969 states:

The cancellation of the registration of a trade mark shall be ordered by the Court on the request of any interested person or the Registrar.

(a) If the mark was not entitled to registration under the provision of this Act provided that grounds which did not exist at the time of registration shall not be taken into account;

(b) If the mark has been obtained by fraud;

(c) If the mark has, without legitimate reason, not been used in the Sudan, after registration, during five consecutive years preceding the allegation of non-use, the burden of proof regarding the allegation of non-use of the mark or the use of it shall be decided by the Court according to the circumstances of the case.
(a) Who May Request the Cancellation of Registration

Under the Trade Marks Act 1969 an application for cancellation may be made either by the Registrar, or by any interested person. The 1931 Ordinance did not expressly mention the Registrar. Section 17 thereof stated that the application for cancellation of registration may be made by any interested person.

The term “any interested person” could be widely interpreted by the Court to include any trade competitor whose business interests are adversely affected by the existence of a mark on the Register. Cancellation of registration most commonly is sought by the proprietors of earlier rights, who had failed to oppose the registration of the mark in the first place, or proprietors of later marks who wish to clear a conflicting earlier mark from the Register, with a view to use and register the mark themselves.

Neither the Trade Marks Ordinance 1931 nor the Trade Marks Act 1969 imposes any penalty on a person who attacks the registration of a trade mark without reasonable cause, although, of course, a cost liability might be imposed.

(b) Grounds for Cancellation

According to section 24 of the 1969 Act the registration of a trade mark should be cancelled if the mark was not entitled to registration, obtained by fraud or has not been used.

Cancellation of the registration of a trade mark on the ground that the mark is not entitled to registration will arise only where an application has wrongly slipped through the initial net and reached registration. The registration of such mark may be cancelled on the basis that the mark

---

13 Amanda Michaels, supra note 5, at 61.
should not have been registered at all under the provisions of the 1969 Act.

A mark should not have been registered if it does not fall within the definition of the trade mark provided by section 3 of the Trade Marks Act 1969 or if it is not registerable according to section 8(1) and (2) of the 1969 Act. Owing to the wording of section 24 of the 1969 Act the Court is concerned only with the grounds that exist at the time of registration, which render the mark unregisterable, and not with the grounds that exist at the time of the petition for cancellation.

In the case of fraud, the cancellation of the registration of a trade mark should be ordered by the Court on the request of any interested person or the Registrar. As it has been said before, the Trade Marks Act 1969 does not define what may constitute acts of fraud. It is left to the Court to determine the existence of fraud according to the circumstances of each case.

Under section 24 of the Trade Marks Act 1969 it is always possible to attack a registered trade mark at any time on the basis that it was not entitled to registration or it was obtained by fraud, since the section does not provide any time limit, unlike section 17 of the Trade Marks Ordinance 1931 which provided that application for cancellation based on the ground that the mark was not entitled to registration or it has been obtained by fraud should be made within 5 years from the date of the registration of the mark.

As to non-use of the mark, any interested person or the Registrar may request the Court to cancel the registration of a trade mark on the ground that the mark has, without legitimate reason, not been used in the Sudan, after registration, during 5 consecutive years. Therefore, a shorter than 5 years registration cannot be attacked under section 24(c) on the ground of non-use. This would be frustrating for an applicant for
registration to find the way blocked by an existing unused registration which is not yet 5 years old.

As it has been said in the previous chapter neither the Trade Marks Act 1969 nor the judicial precedents define the term “use”.

Section 46(2) of the English Trade Marks Act 1994 provides that, use for the purposes of section 46(1)(a) and (b) (which deals with revocation of registration) includes:

… use in a form differing in elements which do not alter the distinctive charter of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

English Courts distinguish between genuine efforts to start trading and purely colourable use designed to keep rights alive. If the proprietor falls in the former category, then to supply goods under the mark on a single occasion, or to make some other definite marketing effort may amount to use. On the other hand, if the underlying motive is to keep up a “ghost” registration, so as to protect another unregistrable mark, even quite high sales for a limited period may be deemed colourable rather than genuine. For example in Imperial Group v. Philip Morris, cigarettes manufacturers who wished to use the laudatory mark, “Merit”, and hoped to gain protection by registering and actually using for a while the mark “Nerit”, were unable to show that this amount to genuine use.

Non-user may, however, be excused if there is a legitimate reason for non-use. No guidance is given in the 1969 Act or in the Rules made under it as to what might constitute a “legitimate reason” for non-use. It is

---

left for the Court to determine whether there is a legitimate reason for non-use. If the proprietor is able to show and convince the Court that there is a legitimate reason for non-use of the mark, cancellation can be avoided.

The burden of proof regarding the allegation of use or non-use of the mark should be decided by the Court according to the circumstances of the case.

(c) Acquiescence

There is no provision in the Trade Marks Act 1969 which provides acquiescence as a statutory defense against cancellation of the registration of a trade mark.

Silence or relaxation in point of time regarding presentation of a petition for cancellation of registration does not prevent or bar such right since there is no provision in the 1969 Act specifying a period for instituting a suit for cancellation of the registration.

In Hassan Mamoun v. Hilal Factory for Elastic and Cords\textsuperscript{17}, the facts of which are referred to above, the Court of Appeal held that:

Silence in itself is not a bar for the plaintiff to request the cancellation of the registration of the trade marks registered by the defendant since no evidence has been adduced to prove that the plaintiff has abandoned his marks by consent or surrendered them to the defendant.

4. Assignment of Registration

A trade mark may be assigned or transferred in whole or in part, in respect of all or part of the goods for which the mark is registered,
independently of the transfer of all or part of the business of the owner of the mark\textsuperscript{18}.

Like any other transaction concerning registered trade marks, the assignment must be entered into the Register, upon an application made by either party within 6 months from the date of signing the assignment agreement\textsuperscript{19}. The application to record such assignment should be made on form T.M. No.11\textsuperscript{20}. attached to the Trade Marks Regulation. Failure to record the assignment agreement at the Registrar Office will render it null and void\textsuperscript{21}.

5. Surrender of Registration

According to section 23 of the Trade Marks Act 1969, the registered owner of a trade mark may renounce the registration, either wholly or in part, of the goods for which the mark is registered, by sending appropriate notice in writing to the Registrar an upon payment of a publication fee. The notice of surrender should be entered into the register and published in the Gazzette as soon as possible\textsuperscript{22}. Surrender comes into force immediately after being entered into the Register.

6. Conclusion

When an application for registration of a trade mark is advertised as accepted in the Gazzette, any interested person has the right to oppose the registration of such trade mark in accordance with section 18 of the Trade Marks Act 1969 before the Registrar. After the registration is completed the right to object will continue to exist but under section 24 and not section 18 of the 1969 Act. Section 18 provides the manner in

\textsuperscript{18} S. 21(1) of the Trade Mark Act 1969 and S. 14 of the Trade Mark Ordinance 1931.

\textsuperscript{19} S. 21(2) of the Trade Mark Act 1969.

\textsuperscript{20} S. 35(1) of the Trade Marks Rules 1969.

\textsuperscript{21} S. 21(2) of the Trade Marks Act 1969.

\textsuperscript{22} S. 27(4) of the Trade Marks Rules 1969.
which opposition to registration is to be made from the very beginning when the application for registration is accepted, while section 24 provides for cancellation of the registration after its compilation. The reasons for request of cancellation may be the same as those which should have been raised at the opposition proceedings before the Registrar.

The Trade Marks Act 1969 considers the trade mark as an independent property since it allows its ownership to be assigned or surrendered with or without the good will of the business.
CHAPTER FIVE

Conclusion

The use of trade marks in Sudan developed long before their legal protection. Marks were used by traders to identify their goods, and such use developed over time and became needed by consumers to distinguish between competing goods and services in a market place. To traders, trade marks are becoming increasingly valuable in the fight to secure and retain share of the market. Therefore, traders should exercise great care to select the strongest marks they can to attract consumers recognition to achieve the widest possible market penetration.

A century ago and before the issuing of any trade marks law in Sudan, traders started to be attentive to the importance of protecting their marks. At that time the only way to protect a trade mark was to publish it in the Sudan Gazzette bearing a cautionary note, and by such publication all rights in the mark were presumed to be protected if any dispute arose.

Trade marks registration system was introduced to the Sudan for the first time by the Trade Marks Ordinance 1931 as a basis for the legal protection of the trade mark. The Trade Marks Act 1969 which replaced the Trade Marks Ordinance 1931 together with its Rules organize all the essential matters concerning the trade marks and the procedure to be followed in registration of trade marks.

The trade marks registration system since its introduction to the Sudan had attracted the attention of the traders. Over the past five years the Trade Marks Registration Office has witnessed an increased rate in applications for registration, and this is testament to the increasing importance of trade marks and the critical need for traders to protect their rights in their trade marks.
In order to achieve a successful application for registration, the mark applied for must be a trade mark within the statutory definition of a trade mark, and registrable in accordance with the provisions of the law. In this connection, although the Trade Marks Act 1969 provides a more comprehensive definition of the trade mark than the one laid down by the 1931 Ordinance, visible signs are the only kind of marks included in the definition. So invisible marks, such as sensory marks, are not registrable.

It is also to be noted that the Act uses some terms without interpreting them such as “use” “public” “resemble” and “infringement”, which compels the court to refer to the English Common Law and English cases to interpret them.

With regard to the work process in the Trade Marks Registration Office we find that the administrative work still depends on the personal effort of the officials who have acquired their experience through practicing without being given the opportunity to benefit from the advantages of development in technology especially in the field of computer technology. Therefore, the registration procedure and all related matters are still conducted in a traditional manner depending mainly on paper work.

Under the globalization invading the world nowadays the local market has been freely open for imported goods especially those coming from eastern and south eastern Asia. In the absence of the adequate administrative control of the state bodies concerned, the local market has been flooded with imported and locally manufactured goods that are counterfeit goods and trade marks which have good reputation in the country and offered for sale at low prices. As a result of this practice consumers may be misled by these counterfeiting goods or attracted by the low prices. In both cases the producer of the goods will be harmed by losing his market share.
After discussing all the important issues concerning registration of trade marks in Sudan through out this thesis, some recommendations can be inferred, which if adopted may improve the process of registration and afford better protection to registered trade marks. These recommendations can be summarized as follows:

First, the definition of a “trade mark” included in section 3 of the Trade Marks Act 1969 should be amended to be wider in order to include all types of invisible signs which are capable of being graphically represented, by replacing the requirement of visibility with the requirement of graphic representation. Secondly, the Act must provide specific definitions of some terms that play an important role in determining the registrability of the trade mark and the rights conferred by registration such as “use”, “public”, “resemble” and infringement”.

Thirdly, the practice at the Trade Marks Registration Office should benefit from the current technology especially in computer field by adopting an electronic archive and electronic register in order to save man power consumed in conducting the search and the time of both the officials and the public. Fourthly, as it has been explained in Chapter Three of this thesis in regard to international registration of trade marks, serious preparations should take place to join the Madrid Protocol in order to avoid all the flaws resulting from being a party only to Madrid Agreement.

Fifthly, there is an essential need for collaboration between some of the state bodies such as the Ministry of Justice, the Police Authorities, the Customs Authorities and the Sudanese Specifications and Metrology Organization in order to achieve better protection for trade marks against illegal practices like infringement of trade marks which affect the interest of both the trade marks owners and the customers. Finally, the performance of the officials at the Registrar General of Intellectual
Property should be improved and developed through training and participation in local, regional and international conferences and workshops concerning trade marks especially those administered by the WIPO.
Bibliography