

Malawi

## Registered Designs Act

### Chapter 49:05

Legislation as at 31 December 2014

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# Malawi

## Registered Designs Act

### Chapter 49:05

Commenced on 1 December 1958

*[This is the version of this document at 31 December 2014.]*

*[Note: This version of the Act was revised and consolidated in the Fifth Revised Edition of the Laws of Malawi (L.R.O. 1/2018), by the Solicitor General and Secretary for Justice under the authority of the Revision of the Laws Act.]*

**An Act to make Provision Relating to the Registration of Designs and for other purposes Incidental thereto.**

### Preliminary

#### 1. Short title

This Act may be cited as the Registered Designs Act.

#### 2. Interpretation

(1) In this Act, unless inconsistent with the context—

“**article**” means any article of manufacture and includes any part of an article if that part is made and sold separately;

“**artistic work**” means a work of any of the following descriptions, that is to say—

- (a) the following, irrespective of artistic quality, namely, paintings, sculptures, drawings, engravings and photographs;
- (b) works of architecture, being either buildings or models for buildings;
- (c) works of artistic craftsmanship, not falling within paragraph (a) or (b);

“**assignee**” means—

- (a) the person who has derived his title to the design for Malawi directly or indirectly from the proprietor thereof or from the latter’s assignee; or
- (b) the legal representative of such person;

“**Convention**” means the Union Convention of Paris, dated the 20th March, 1883, for the Protection of Industrial Property, revised at Brussels on the 14th December, 1900, at Washington on the 2nd June, 1911, at The Hague on the 6th November, 1925, and at London on the 2nd June, 1934, and any revision thereof to which Malawi may accede in terms of section 7 of the Patents Act;

*[Cap. 49:02]*

“**convention country**” means a country (including any colony, protectorate or territory subject to the authority or under the suzerainty of that country, or any territory over which a mandate or trusteeship is exercised) which has been declared to be a convention country in terms of the Patents Act;

“**copyright**”, in relation to a registered design, has the meaning assigned to it by [section 14\(1\)](#);

“**corresponding design**”, in relation to an artistic work, means a design which, when applied to an article, results in a reproduction of that work;

“**Court**” means the High Court;

“**design**” means features of shape configuration, pattern or ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged solely by the eye, but does not include a method, or principle of construct or features of shape or configurate which are dictated solely by the function which the article to be made in that shape or configuration has to perform;

“**Designs Office**” means the Designs Office established under [section 3](#);

“legal representative means—

- (a) the liquidator or receiver of a company;
- (b) the representative recognized by law of any person who has died, become insolvent or bankrupt, assigned his estate, is an infant or a minor, or of unsound mind, or is otherwise under a disability;

“**Patent Journal**” means the journal for which provision is made in section 95 of the Patents Act;

“**proprietor**” has the meaning assigned to it by [section 8](#);

“**register**” means the register of designs kept under this Act;

“**registered proprietor**” means the person or persons for the time being entered in the register as the proprietor of the design;

“**Registrar**” means the Registrar of Designs appointed under [section 4](#);

“**set of articles**” means a number of articles of the same general character ordinarily on sale or intended to be used together to each of which the same design, or the same design with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof, is applied;

“**Tribunal**” means the Patents Tribunal established under the Patents Act.

[Cap. 49:02]

- (2) Any reference in this Act to an article in respect of which a design is registered shall, in the case of a design registered in respect of a set of articles, be construed as a reference to any article of that set.
- (3) Any question arising under this Act whether a number of articles constitutes a set of articles shall be determined by the Registrar; and notwithstanding anything in this Act any determination of the Registrar under this subsection shall be final.

## Part I – Administration

### 3. Establishment of Designs Office

There shall be established under the direction of the Minister an office to be called the Designs Office.

### 4. Appointment of officers

There shall be appointed—

- (a) a Registrar of Designs who shall exercise the powers and perform the duties assigned to the Registrar by this Act and shall be responsible for its administration; and
- (b) one or more Deputy Registrars of Designs who shall, subject to the control of the Registrar, have all the powers conferred by this Act upon the Registrar; and
- (c) such examiners and other officers as the Minister may consider necessary for carrying out this Act.

## 5. Seal

The seal of the Patent Office kept in terms of the Patents Act shall also be the seal of the Designs Office, and impressions thereof made for the purposes of this Act shall be judicially noticed.

[Cap. 49:02]

## 6. Register of designs

- (1) There shall be kept at the Designs Office for the purposes of this Act a register of designs wherein shall be entered all registered designs with the names and addresses of their proprietors, notifications of assignments and transmissions, and such other matters relating to registered designs as may be prescribed or as the Registrar may think fit.
- (2) Subject to this Act, the register of designs shall, at all convenient times, be open to inspection by the public, and certified copies, sealed with the seal of the Patent Office, of any entry in the register shall be given to any person requiring them on payment of the prescribed fee.
- (3) The register of designs shall be *prima facie* evidence of any matters required or authorized by or under this Act to be entered therein.
- (4) No notice of any trust, whether expressed, implied or constructive, shall be entered in the register, and the Registrar shall not be affected by any such notice.

## Part II – Registrable designs and proceedings for registration

### 7. Designs registrable under Act

- (1) Subject to the following provisions of this section, a design may, upon application made by the person claiming to be the proprietor, his assignee or legal representative, be registered under this Act in respect of any article or set of articles specified in the application.
- (2) Subject to this Act, a design shall not be registered thereunder unless it is new or original and in particular shall not be so registered in respect of any article if it is the same as a design which before the date of the application for registration appears on the register or has been published in Malawi in respect of the same or any other article or differs from such a design only in immaterial details or in features which are variants commonly used in trade.
- (3) Regulations made by the Minister under this Act may provide for excluding from registration thereunder designs for such articles, being articles which are primarily literary or artistic in character, as the Minister thinks fit.

### 7A. Designs registered under the Protocol

- (1) A design registered under the Protocol shall, subject to the provisions of the Protocol, have effect in Malawi as if it were a design registered under this Act.
- (2) In this section, “Protocol” means the Protocol on Patents and Designs within the Framework of the Industrial Property Organization for English-speaking Africa adopted on 10th December, 1982, at Harare in the Republic of Zimbabwe to which Malawi acceded on 3rd January, 1984, and any revision thereof to which Malawi has acceded.

[9 of 1985]

## 8. Proprietorship of designs

- (1) Subject to this section, the author of a design shall be treated for the purposes of this Act as the proprietor of the design:

Provided that where the design is executed by the author for another person for valuable consideration, that other person shall be treated for the purposes of this Act as the proprietor.

- (2) Where a design, or the right to apply a design to any article, becomes vested, whether by assignment, transmission or operation of law, in any person other than the original proprietor, either alone or jointly with the original proprietor, that other person, or, as the case may be, the original proprietor and that other person, shall be treated for the purposes of this Act as the proprietor of the design or as the proprietor of the design in relation to that article.

## 9. Proceedings for registration

- (1) An application for the registration of a design shall be made in the prescribed form and shall be lodged at the Designs Office in the prescribed manner.
- (2) For the purpose of deciding whether a design is new or original, the Registrar may make such searches, if any, as he thinks fit.
- (3) The Registrar may refuse any application for the registration of a design or may register the design in pursuance of the application subject to such modifications, if any, as he thinks fit.
- (4) An application which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within such time as may be prescribed shall be deemed to be abandoned.
- (5) Except as otherwise expressly provided by this Act, a design when registered shall be registered as of the date on which the application for registration was made, or such other date (whether earlier or later than that date) as the Registrar may in any particular case direct:

Provided that no proceedings shall be taken in respect of any infringement of copyright in that design committed before the date on which the certificate of registration thereof under this Act is issued.

- (6) An appeal shall lie from any decision of the Registrar under subsection (3).

## 10. Registration of same design in respect of other articles, etc.

- (1) Where the registered proprietor of a design registered in respect of any article makes an application —
  - (a) for registration in respect of one or more other articles, of the registered design; or
  - (b) for registration in respect of the same or one or more other articles, of a design consisting of the registered design with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof,

the application shall not be refused and the registration made on that application shall not be invalidated by reason only of the previous registration or publication of the registered design:

Provided that the period of copyright in a design registered by virtue of this section shall not extend beyond the expiration of the original and any extended period of copyright in the original registered design.

- (2) Where any person makes an application for the registration of a design in respect of any article and either—
  - (a) that design has been previously registered by another person in respect of some other article; or

- (b) the design to which the application relates consists of a design previously registered by another person in respect of the same or some other article with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof,

then, if at any time while the application is pending the applicant becomes the registered proprietor of the design previously registered, subsection (1) shall apply as if at the time of making the application the applicant had been the registered proprietor of that design.

## 11. Provisions for secrecy of certain designs

- (1) Where an application for the registration of a design has been made, and it appears to the Registrar that the design is one of a class notified to him by the Minister as relevant for defence purposes, he may give directions for prohibiting or restricting the publication of information with respect to the design, or the communication of such information to any person or class of persons specified in the directions.
- (2) Regulations shall be made by the Minister under this Act for securing that the representation or specimen of a design in the case of which directions are given under this section shall not be open to inspection at the Designs Office during the continuance in force of the directions.
- (3) Where the Registrar gives any such directions as aforesaid, he shall give notice of the application and of the directions to the Minister, and thereupon the following provisions shall have effect, that is to say—
  - (a) the Minister shall, upon receipt of such notice, consider whether the publication of the design would be prejudicial to the defence of Malawi and unless a notice under paragraph (c) has previously been given by the Minister to the Registrar, shall reconsider that question before the expiration of nine months from the date of lodging of the application for registration of the design and at least once in every subsequent year;
  - (b) for the purpose aforesaid, the Minister may, at any time after the design has been registered or with the consent of the applicant, at any time before the design has been registered, inspect the representation or specimen of the design lodged in pursuance of the application;
  - (c) if upon consideration of the design at any time it appears to the Minister that the publication of the design would not, or would no longer, be prejudicial to the defence of Malawi, the Minister shall give notice to the Registrar to that effect;
  - (d) on the receipt of any such notice the Registrar shall revoke the directions and may, subject to such conditions, if any, as he thinks fit, extend the time for doing anything required or authorized to be done by or under this Act in connexion with the application or registration, whether or not that time has previously expired.
- (4) No person ordinarily resident or domiciled in Malawi shall, while in Malawi, except under the authority of a written permit granted by or on behalf of the Registrar, make or cause to be made any application outside Malawi for the registration of a design of any class prescribed for the purposes of this section unless—
  - (a) an application for registration of the same design has been made in Malawi not less than six weeks before the application outside Malawi; and
  - (b) either no directions have been given under subsection (2) in relation to the application in Malawi or all such directions have been revoked.
- (5) If any person fails to comply with any direction given under this section or makes or causes to be made an application for the registration of a design in contravention of this section, he shall be guilty of an offence.
- (6) Where an offence under this section is committed by a body corporate, every person who at the time of the commission of the offence is a director, general manager, secretary or other similar officer of the body corporate, or is purporting to act in any such capacity, shall be deemed to be

guilty of that offence unless he proves that the offence was committed without his consent or connivance and that he exercised all such diligence to prevent the commission of the offence as he ought to have exercised having regard to the nature of his functions in that capacity and to all the circumstances.

## 12. Provisions as to confidential disclosure, etc.

- (1) An application for the registration of a design shall not be refused, and the registration of a design shall not be invalidated, by reason only of—
  - (a) the disclosure of the design by the proprietor to any other person in such circumstances as would make it contrary to good faith for that other person to use or publish the design;
  - (b) the disclosure of the design in breach of good faith by any person other than the proprietor of the design;
  - (c) in the case of a new or original textile design intended for registration, the acceptance of a first and confidential order for goods bearing the design; or
  - (d) the communication of the design by the proprietor thereof to a Government department or to any person authorized by the Minister to consider the merits of the design, or of anything done in consequence of such a communication.
- (2) Where copyright under any written law relating to copyright subsists in an artistic work, and an application is made by, or with the consent of, the owner of that copyright for the registration of a corresponding design, that design shall not be treated for the purposes of this Act as being other than new or original by reason only of any use previously made of the artistic work, unless—
  - (a) the previous use consisted of or included the sale, letting for hire, or offer for sale or hire of articles to which the design in question (or a design differing from it only as mentioned in [section 7 \(2\)](#)) had been applied industrially, other than articles of a description specified in regulations made under [section 7 \(3\)](#); and
  - (b) that previous use was made by, or with the consent of, the owner of the copyright in the artistic work.

## 13. Convention arrangements

- (1) Any person who qualifies under Article 2 or 3 of the Convention and who has applied for protection for any design in a convention country, or his legal representative or assignee (if such assignee is also so qualified), may make an application for registration of that design in priority to other applicants; and the registration shall have the same date as the date of the application in the convention country or, where more than one such application for protection has been made, the date of the first such application:  
Provided that—
  - (a) the application for registration is made within six months from the date of the application for protection in the convention country or, where more than one such application for protection has been made, from the date of the first application;
  - (b) no proceedings shall be taken in respect of any infringement of copyright in that design committed before the date on which the certificate of registration thereof under this Act is issued.
- (2) An application for the registration of a design made by virtue of this section shall not be refused, and the registration of a design on such an application shall not be invalidated, by reason only of the registration or publication of the design in Malawi during the period specified in subsection (1) (a) as that within which the application for registration may be made.
- (3) Where an applicant referred to in subsection (1) has applied for protection for any design by an application which, in accordance with the law of any convention country, is equivalent to an

application duly made in that convention country, he shall be deemed for the purposes of this section to have applied in that convention country.

### Part III – Effect of registration, etc.

#### 14. Right given by registration

- (1) The registration of a design under this Act shall give to the registered proprietor the copyright in the registered design, that is to say, the exclusive right in Malawi to make or import for sale or for use for the purposes of any trade or business, or to sell, hire or offer for sale or hire, any article in respect of which the design is registered, being an article to which the registered design or a design not substantially different from the registered design has been applied, and to make anything for enabling any such article to be made as aforesaid.
- (2) Subject to this Act, the registration of a design shall have the same effect against the Government as it has against a subject.

#### 15. Period of copyright

- (1) Copyright in a registered design shall, subject to this Act, subsist for a period of five years from the date of registration.
- (2) The Registrar shall extend the period of copyright for a second period of five years from the expiration of the original period and for a third period of five years from the expiration of the second period if an application for extension of the period of copyright for the second or third period is made in the prescribed form before the expiration of the original period or the second period, as the case may be, and if the prescribed fee is paid before the expiration of the relevant period or within such further period (not exceeding three months) as may be specified in a request made to the Registrar and accompanied by the prescribed additional fee.
- (3) Where in the case of a registered design it is shown—
  - (a) that the design, at the time when it was registered, was a corresponding design in relation to an artistic work in which copyright subsisted under any written law;
  - (b) that, by reason of a previous use of that artistic work, the design would not have been registrable under this Act but for [section 12 \(2\)](#); and
  - (c) that the copyright in that work under any written law relating to copyright expired before the date of expiry of the copyright in the design,

the copyright in the design shall, notwithstanding anything in this section, be deemed to have expired at the same time as the copyright in the artistic work, and shall not be renewable after that time.

#### 16. Exemption of innocent infringer from liability for damages

- (1) In proceedings for the infringement of copyright in a registered design damages shall not be awarded against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable ground for supposing, that the design was registered; and a person shall not be deemed to have been aware or to have had reasonable ground for supposing as aforesaid by reason only of the marking of an article with the word “registered” or any abbreviation thereof, or any word or words expressing or implying that the design applied to the article has been registered, unless the number of the design accompanied the word or words or the abbreviation in question.
- (2) Nothing in this section shall affect the power of the Court to grant an injunction in any proceedings for infringement of copyright in a registered design.

## 17. Compulsory licence in respect of registered design

- (1) At any time after a design has been registered any person interested may apply to the Registrar for the grant of a compulsory licence in respect of the design on the ground that the design is not applied in Malawi by any industrial process or means to the article in respect of which it is registered to such an extent as is reasonable in the circumstances of the case; and the Registrar may make such order on the application as he thinks fit.
- (2) An order for the grant of a licence shall, without prejudice to any other method of enforcement, have effect as if it were a deed executed by the registered proprietor and all other necessary parties, granting a licence in accordance with the order.
- (3) No order shall be made under this section which would be at variance with any of the provisions of the Convention.
- (4) An appeal shall lie from any order of the Registrar under this section.

## Part IV – Use of registered designs for services of Government, etc.

### 18. Use of registered designs for services of the Government

- (1) Notwithstanding anything in this Act, any Government department or any person authorized in writing by the Minister may use any registered design for the services of the Government in accordance with this section.
- (2) If and so far as the design has before the date of registration thereof been duly recorded by or applied by or on behalf of a Government department otherwise than in consequence of the communication thereof directly or indirectly by the registered proprietor or any person from whom he derives title, any use of the design by virtue of this section may be made free of any royalty or other payment to the registered proprietor.
- (3) If and so far as the design has not been so recorded or applied as aforesaid, any use of the design made by virtue of this section at any time after the date of registration thereof, or in consequence of any such communication as aforesaid, shall be made upon such terms as may be agreed upon, either before or after the use, between the Minister and the registered proprietor with the approval of the Minister of Finance, or as may in default of agreement be determined by the Tribunal on a reference under [section 21](#) (1).
- (4) The authority of the Minister in respect of a design may be given under this section either before or after the design is registered and either before or after the acts in respect of which the authority is given are done, and may be given to any person, whether or not he is authorized directly or indirectly by the registered proprietor to use the design.
- (5) Where any use of a design is made by a Government department or any person authorized by the Minister under this section, then, unless it appears to the Minister that it would be contrary to the public interest so to do, the Minister shall notify the registered proprietor as soon as practicable after the use is begun, and furnish him with such information as to the extent of the use as he may from time to time require.
- (6) For the purposes of this Part any use of a design for the supply to the government of any country outside Malawi in pursuance of any agreement or arrangement between the Government of Malawi and the government of that country, of articles required for the defence of that country shall be deemed to be a use of the design for the services of the Government, and the power of a Government department or a person authorized by the Minister under this section to use a design shall include power—
  - (a) to sell such articles to the government of any country in pursuance of any such agreement or arrangement as aforesaid; and

- (b) to sell to any person any articles made in the exercise of the powers conferred by this section which are no longer required for the purpose for which they were made.
- (7) The purchaser of any articles sold in the exercise of powers conferred by this section, and any person claiming through him, shall have power to deal with them in the same manner as if the rights in the registered design were held on behalf of the Government.

## 19. Right of third parties in respect of Government use

- (1) In this section “exclusive licence” means a licence from a registered proprietor which confers on the licensee or on the licensee and person authorized by him, to the exclusion of all other persons (including the registered proprietor), any right in respect of the registered design.
- (2) In relation to any use of a registered design, or a design in respect of which an application for registration is pending, made for the services of the Government—
  - (a) by a Government department or a person authorized by the Minister under [section 18](#); or
  - (b) by the registered proprietor or applicant for registration to the order of a Government department,

the provisions of any licence, assignment or agreement made, whether before or after the commencement of this Act, between the registered proprietor or applicant for registration or any person who derives title from him or from whom he derives title and any person other than a Government department shall be of no effect so far as those provisions restrict or regulate the use of the design, or any model, document or information relating thereto, or provide for the making of payments in respect of any such use, or calculated by reference thereto; and the reproduction or publication of any model or document in connexion with the said use shall not be deemed to be an infringement of any copyright subsisting in the model or document.
- (3) Where an exclusive licence granted otherwise than for royalties or other benefits determined by reference to the use of the design is in force under the registered design then—
  - (a) in relation to any use of the design which, but for this section and [section 18](#), would constitute an infringement of the rights of the licensee, [section 18](#) (3) shall have effect as if for the reference to the registered proprietor there were substituted a reference to the licensee; and
  - (b) in relation to any use of the design by the licensee by virtue of an authority given under [section 18](#), that section shall have effect as if subsection (3) thereof were omitted.
- (4) Subject to subsection (3), where the registered design or the right to apply for or obtain registration of the design has been assigned to the registered proprietor in consideration of royalties or other benefits determined by reference to the use of the design, then—
  - (a) in relation to any use of the design by virtue of [section 18](#), subsection (3) of that section shall have effect as if the reference to the registered proprietor included a reference to the assignor, and any sum payable by virtue of that subsection shall be divided between the registered proprietor and the assignor in such proportion as may be agreed upon between them or as may in default of agreement be determined by the Tribunal or a reference under [section 21](#); and
  - (b) in relation to any use of the design made for the services of the Government by the registered proprietor to the order of a Government department, [section 18](#) (3) shall have effect as if that use were made by virtue of an authority given under that section.
- (5) Where, under [section 18](#) (3), payments are required to be made by a Government department to a registered proprietor in respect of any use of a design, any person being the holder of an exclusive licence under the registered design (not being such a licence as is mentioned in subsection (3) of this section) authorizing him to make that use of the design shall be entitled to recover from the registered proprietor such part, if any, of those payments as may be agreed upon between

that person and the registered proprietor, or as may in default of agreement be determined by the Tribunal under [section 21](#) to be just having regard to any expenditure incurred by that person—

- (a) in developing the said design; or
- (b) in making payments to the registered proprietor, other than royalties or other payments determined by reference to the use of the design, in consideration of the licence;

and if, at any time before the amount of any such payment has been agreed upon between the Government department and the registered proprietor that person gives notice in writing of his interest to the department, any agreement as to the amount of that payment shall be of no effect unless it is made with his consent.

## 20. Special provisions as to Government use during emergency

- (1) In this section “period of emergency” means any period beginning on such date as may be declared by the Minister by notice published in the *Gazette* to be the commencement, and ending on such date as may be so declared to be the termination, of a period of emergency.
- (2) During any period of emergency the powers exercisable in relation to a design by a Government department or a person authorized by the Minister under [section 18](#), shall include power to use the design for any purpose which appears to the Minister necessary or expedient—
  - (a) for the efficient prosecution of any war in which Malawi may be engaged;
  - (b) for the maintenance of supplies and services essential to the life of the community;
  - (c) for securing a sufficiency of supplies and services essential to the well-being of the community;
  - (d) for promoting the productivity of industry, commerce and agriculture;
  - (e) for fostering and directing exports and reducing imports or imports of any classes, from all or any countries and for redressing the balance of trade;
  - (f) generally for ensuring that the whole resources of the community are available for use, and are used, in a manner best calculated to serve the interests of the community; or
  - (g) for assisting the relief of suffering and the restoration and distribution of essential supplies and services in any part of the Commonwealth or any foreign countries that are in grave distress as the result of war;

and any reference in this Part to the services of the Government shall be construed as including a reference to the purposes aforesaid.

## 21. Reference of disputes as to Government use

- (1) Any dispute as to—
  - (a) the exercise by a Government department or a person authorized by the Minister of the powers conferred by [section 18](#);
  - (b) the terms for the use of a design for the services of the Government thereunder; or
  - (c) the right of any person to receive any part of a payment made in pursuance of [section 18](#) (3),may be referred to the Tribunal by any party to the dispute in such manner as may be prescribed.
- (2) In any proceedings under this section to which a Government department is a party, the Government department may—
  - (a) if the registered proprietor is a party to the proceedings, apply for cancellation of the registration of the design upon any ground upon which the deletion of a design may be ordered by the Tribunal under [section 24](#);

- (b) in any case, put in issue the validity of the registration of the design without applying for its cancellation.
- (3) If in such proceedings as aforesaid any question arises whether a design has been recorded or applied as mentioned in [section 18](#) and the disclosure of any document recording the design, or of any evidence of the application thereof, would, in the opinion of the Government department, be prejudicial to the public interest, the disclosure may be made confidentially to counsel appearing for the other party or to an independent expert agreed upon by the parties.
- (4) In determining under this section any dispute between a Government department and any person as to terms for the use of a design for the services of the Government, the Tribunal shall have regard to any benefit or compensation which that person or any person from whom he derives title may have received, or may be entitled to receive, directly or indirectly from any Government department in respect of the design in question.

## Part V – Assignments, corrections and cancellation

### 22. Registration of assignments, etc.

- (1) Where any person becomes entitled by assignment, transmission or operation of law to a registered design or to a share in a registered design, or becomes entitled as mortgagee, licensee or otherwise to any other interest in a registered design, he may apply to the Registrar in the prescribed manner for the registration of his title as proprietor or co proprietor or, as the case may be, of notice of his interest, in the register.
- (2) Without prejudice to subsection (1), an application for the registration of the title of any person becoming entitled by assignment to a registered design or a share in a registered design, or becoming entitled by virtue of a mortgage, licence or other instrument to any other interest in a registered design, may be made in the prescribed manner by the assignor, mortgagor, licensor or other party to that instrument, as the case may be.
- (3) Where application is made under this section for the registration of title of any person, the Registrar shall, upon proof of title to his satisfaction—
  - (a) where that person is entitled to a registered design or a share in a registered design, register him in the register as proprietor or co-proprietor of the design, and enter in that register particulars of the instrument or event by which he derives title; or
  - (b) where that person is entitled to any other interest in the registered design, enter in that register notice of his interest, with particulars of the instrument, if any, creating it.
- (4) Subject to any rights vested in any other person of which notice is entered in the register of designs, the person or persons registered as proprietor of a registered design shall have power to assign, grant licences under, or otherwise deal with the design, and to give effectual receipts for any consideration for any such assignment, licence or dealing.
- (5) Except for the purposes of an application to rectify the register under this Act, a document in respect of which no entry has been made in the register under subsection (3) shall not be admitted in any proceedings as evidence of the title of any person to a registered design or share of or interest in a registered design unless the Tribunal or Court concerned otherwise directs.

### 23. Power of Registrar to authorize corrections

- (1) The Registrar may authorize the correction of any clerical error or omission or error in translation in any application for the registration or in the representation of a design, or any error in the register.
- (2) A correction may be made in pursuance of this section, either upon a request in writing made by any person interested and accompanied by the prescribed fee, or without such a request.

- (3) Where it is proposed to make a correction otherwise than upon such a request, the Registrar shall give notice of the proposal to the registered proprietor or the applicant for registration of the design, as the case may be, and to any other person who appears to him to be concerned, and shall give any such person an opportunity of being heard before the correction is made.

#### **24. Rectification of register**

- (1) The Tribunal may, on the application of any person aggrieved, order the register to be rectified by the making of any entry therein or the variation or deletion of any entry therein.
- (2) The Tribunal may determine any question which it may be necessary or expedient to decide in connexion with the rectification of the register.
- (3) Notice of any application to the Tribunal under this section shall be given in the prescribed manner to the Registrar and to any other person appearing from the register to be interested in the design and the Registrar and any such person shall be entitled to appear and be heard on the application.
- (4) A notice of any order made by the Tribunal under this section shall be served on the Registrar in the prescribed manner, and the Registrar shall, on receipt of the notice, rectify the register accordingly.

#### **25. Cancellation of registration**

- (1) The Registrar may, upon a request made in the prescribed manner by the registered proprietor, cancel the registration of a design.
- (2) At any time after a design has been registered any person interested may apply to the Registrar for the cancellation of the registration of the design on the ground that—
  - (a) the design was not, at the date of the registration thereof, new or original;
  - (b) the design, at the time when it was registered, was a corresponding design in relation to an artistic work in which copyright subsisted under any written law relating to copyright;
  - (c) by reason of a previous use of that artistic work, the design would not have been registrable under this Act but for [section 12](#) (2), or
  - (d) the copyright in that work under any written law relating to copyright has expired;or on any other ground on which the Registrar could have refused to register the design; and the Registrar may make such order on the application as he thinks fit.
- (3) An appeal shall lie from any order of the Registrar under subsection (2).

### **Part VI – Functions of Registrar in relation to certain evidence, documents and powers**

#### **26. Evidence of certain entries and documents**

- (1) A certificate purporting to be signed by the Registrar and certifying that any entry which he is authorized by or under this Act to make has or has not been made, or that any other thing which he is so authorized to do has or has not been done, shall be *prima facie* evidence of the matters so certified.
- (2) A copy of any entry in the register or of any representation, specimen or document kept in the Designs Office or an extract from the register or any such document, purporting to be certified by the Registrar and to be sealed with the seal of the Patent Office, shall be admitted in evidence without further proof and without production of the original.

## 27. Inspection of registered designs

- (1) Subject to this section and to any regulation made by the Minister in pursuance of [section 11](#) (3), the representation or specimen of a design registered under this Act shall be open to inspection at the Designs Office on and after the day on which the certificate of registration is issued.
- (2) In the case of a design registered in respect of an article of any class prescribed for the purposes of this subsection, no representation or specimen of the design lodged in pursuance of the application shall, until the expiration of such period after the day on which the certificate of registration is issued as may be prescribed in relation to articles of that class, be open to inspection at the Designs Office except by the registered proprietor, a person authorized in writing by the registered proprietor, or a person authorized by the Registrar, the Tribunal or by a court:

Provided that where the Registrar proposes to refuse an application for the registration of any other design on the ground that it is the same as the first-mentioned design or differs from that design only in immaterial details or in features which are variants commonly used in the trade, the applicant shall be entitled to inspect the representation or specimen of the first-mentioned design lodged in pursuance of the application for registration of that design.

- (3) In the case of a design registered in respect of an article of any class prescribed for the purposes of subsection (2), the representation or specimen of the design shall not, during the period prescribed as aforesaid, be inspected by any person by virtue of this section except in the presence of the Registrar or of an officer acting under him; and except in the case of an inspection authorized by the proviso to that subsection, the person making the inspection shall not be entitled to take a copy of the representation or specimen of the design or any part thereof.
- (4) Where an application for the registration of a design has been abandoned or refused, neither the application for registration nor any representation or specimen of the design lodged in pursuance thereof shall at any time be open to inspection at the Designs Office or be published by the Registrar.

## 28. Information as to existence of copyright

On the request of any person furnishing such information as may enable the Registrar to identify the design, and on payment of the prescribed fee the Registrar shall inform him whether the design is registered, and, if so, in respect of what articles, and whether any extension of the period of copyright in relation to that design has been granted and shall state the date of registration and the name and address of the registered proprietor.

## 29. Certificate of registration

The Registrar shall grant a certificate of registration in the prescribed form to the registered proprietor of a design when the design is registered.

## 30. Copies of certificates of registration

The Registrar may, in a case where he is satisfied that the certificate of registration referred to in [section 29](#) has been lost or destroyed, or in any other case in which he thinks it expedient, furnish one or more copies of the certificate.

## 31. Exercise of discretionary powers of Registrar

Without prejudice to any provisions of this Act requiring the Registrar to hear any party to proceedings thereunder, or to give to any such party an opportunity to be heard, the Registrar shall give to any applicant for registration of a design an opportunity to be heard before exercising adversely to the applicant any discretion vested in the Registrar by or under this Act.

### 32. Proceedings before Registrar

- (1) Subject to [section 55](#), evidence in any proceedings before the Registrar under this Act shall be given by affidavit, so, however, that the Registrar may, if he thinks fit in any particular case, take oral evidence on oath in lieu of or in addition to such evidence as aforesaid and may allow any witness to be cross-examined on his affidavit or oral evidence.
- (2) The powers, rights and privileges of the Registrar in proceedings before him under this Act shall be the same as those conferred upon commissioners by the Commissions of Inquiry Act and sections 9, 10 and 12 of that Act shall, *mutatis mutandis*, apply in relation to the hearing and determination of any matter before the Registrar under this Act and to any person summoned to give evidence or giving evidence before him.

[Cap. 18:01]

### 33. Power of Registrar to award costs

In all proceedings before the Registrar under this Act, the Registrar shall have power to award to any party such costs as he may consider reasonable and to direct how and by what parties they are to be paid. Any costs awarded by the Registrar shall be taxed by the registrar of the Tribunal and payment thereof may be enforced in the same manner as if they were costs allowed by the Tribunal.

### 34. Power of Registrar to fix time and place of sitting, etc.

The Registrar may in any proceeding held before him decide the hours, times and places at which he will sit and he may adjourn any proceedings for such time and to such place as he may think fit.

## Part VII – Appeals and legal proceedings

### 35. Patents Tribunal to hear appeals

- (1) Where this Act provides for an appeal from a decision of the Registrar, such appeal shall be made to the Tribunal.
- (2) The Tribunal shall in connexion with any proceedings before it under this Act have all the powers of the High Court and without prejudice to the foregoing and to the other powers conferred upon it by this Act the Tribunal shall have power to make any order for the purpose of securing the attendance of any person, the discovery or production of any documents, or the investigation or punishment of any contempt of court which the High Court has power to make.
- (3) The procedure and practice of the Tribunal shall, save as otherwise provided for by rules made under this Part, be those prevailing in the High Court, in so far as the same are applicable, and if any matter should arise which is not contemplated by such procedure, practice or rules, the Tribunal may give instructions regarding the course to be pursued which instructions shall be binding on all parties.
- (4) Upon appeal to the Tribunal, the Tribunal may—
  - (a) confirm, set aside or vary the order or decision in question;
  - (b) exercise any of the powers which could have been exercised by the Registrar in proceedings in connexion with which the appeal is brought;
  - (c) make such order as to costs as it may think fit.
- (5) For the purpose of this Act, the Tribunal shall sit at such times and places as it may appoint.

- (6) In any proceedings before it, the Tribunal may, subject to [section 55](#), accept evidence by affidavit or take oral evidence on oath and allow any witness to be cross-examined on his affidavit or oral evidence.

### **36. Right of audience**

In any proceedings before the Tribunal under this Act, the parties to such proceedings may appear in person, or be represented and appear by a legal practitioner, and in any case where the Tribunal deems fit it may grant to the Registrar leave to intervene and he may thereafter appear or be so represented.

### **37. Assessors**

The Tribunal may appoint any person with special expert knowledge to act as an assessor in an advisory capacity in any case where it appears to such Tribunal that such knowledge is required for the proper determination of the case.

### **38. Rules**

The Minister may make rules for regulating generally the practice and procedure of the Tribunal and with respect to appeals or references to such Tribunal as to the time within which any requirement of the rules is to be complied with, as to the costs and expenses of and incidental to any proceedings in such Tribunal, as to the fees to be charged in respect of proceedings therein, as to the fees to be paid to assessors, and in particular may make rules providing for the summary determination of any appeal which appears to the Tribunal to be frivolous or vexatious or to be brought for the purpose of delay.

### **39. Time for appeals**

Appeals under this Part, whether from decisions of the Registrar or orders or decisions of the Tribunal, shall be brought within three months after the date of the decision or order in question, or within such further time as the Tribunal or Court may allow upon application by the appellant concerned.

### **40. References to Tribunal by Registrar**

When any matter to be decided by the Registrar under this Act appears to him to involve a point of law or to be of unusual importance or complexity, he may, after giving notice to the parties, refer such matter to the Tribunal for a decision and shall thereafter, in relation to such matter, act in accordance with the decision of the Tribunal or any decision substituted therefor on appeal to any court.

### **41. Certification of validity**

In any legal proceeding in which the validity of the registration of a design is contested and is decided in favour of the registered proprietor of the design, the Tribunal or Court may certify to that effect and, if it so certifies, then, in any subsequent legal proceeding in which the validity of the registration comes into question, the registered proprietor of the design, on obtaining a final order or judgment in his favour, shall have his full costs, charges and expenses as between solicitor and client, unless in that subsequent proceeding the Tribunal or Court directs that he ought not to have them.

### **42. Infringement action to be heard in High Court**

Any action or legal proceeding relating to the infringement in Malawi of copyright in a registered design shall be brought in the High Court.

### **43. Remedy for groundless threats of infringement proceedings**

- (1) Where any person (whether entitled to or interested in a registered design or an application for registration of a design or not) by circulars, advertisements or otherwise threatens any other person

with proceedings for infringement of the copyright in a registered design, any person aggrieved thereby may bring an action against him in the High Court for any such relief as is mentioned in subsection (2).

- (2) Unless in any action brought by virtue of this section the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute, an infringement of the copyright in a registered design, the registration of which is not shown by the plaintiff to be invalid, the plaintiff shall be entitled to the following relief, that is to say—
  - (a) a declaration to the effect that the threats are unjustifiable;
  - (b) an injunction against the continuance of the threats; and
  - (c) such damages, if any, as he has sustained thereby.
- (3) For the avoidance of doubt, it is hereby declared that a mere notification that a design is registered does not constitute a threat of proceedings within the meaning of this section.
- (4) The defendant in any such action as aforesaid may apply, by way of counterclaim in the action, for any relief to which he would be entitled in a separate action in respect of any infringement by the plaintiff of the design to which the threats relate.

#### **44. Security for costs and taxation of costs**

- (1) When a party to proceedings before the Registrar or the Tribunal or an appellant is resident outside Malawi, the Registrar or the Tribunal may order such party or appellant to give security, within such time as may be directed, for the costs of the proceedings or appeal.
- (2) If the party or appellant ordered to give security for costs fails to do so within the time directed, the Registrar or the Tribunal may treat the proceedings or appeal as abandoned.
- (3) Where a bond is to be given as security for costs, it shall, unless the Registrar or the Tribunal otherwise directs, be given to the party requiring the security.
- (4) Unless otherwise agreed between the parties, any costs awarded in terms of [section 35 \(4\)](#) shall be taxed by the Registrar of the Tribunal in accordance with rules made under this Part which taxation shall be subject to appeal to the Tribunal, and any such costs may be recovered by action in a court of competent jurisdiction.

#### **45. Costs of Registrar**

In all proceedings before the Tribunal under this Act, the costs of the Registrar shall be in the discretion of the Tribunal, but the Registrar shall not be ordered to pay the costs of any of the other parties.

#### **46. Appeals to High Court**

- (1) Any party to any proceedings before the Tribunal may appeal in accordance with rules made under this Part from any order or decision of such Tribunal to the High Court.
- (2) Upon the hearing of an appeal under this section, the High Court may, without prejudice to its other powers—
  - (a) confirm, set aside or vary the order or decision in question;
  - (b) remit the proceedings to the Tribunal with such instructions for further consideration, report, proceedings or evidence as the High Court may think fit to give;
  - (c) exercise any of the powers which could have been exercised by the Tribunal in the proceedings in connexion with which the appeal is brought;
  - (d) make such order as it may think just as to the costs of the appeal or of earlier proceedings in the matter before the Tribunal.

## Part VIII – Offences and penalties

### 47. Falsification of entries in register

Any person who makes or causes to be made a false entry in the register, or a writing falsely purporting to be a copy of an entry in the register, or who produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, shall be guilty of an offence.

### 48. Penalty for falsely representing a design as registered

(1) Any person who—

- (a) falsely represents that a design applied to any article sold by him is registered in respect of that article; or
- (b) after the copyright in a registered design has expired, marks any article to which the design has been applied with the word “registered,” or any word or words implying that there is a subsisting copyright in the design, or causes any such article to be so marked,

shall be liable to a fine of £50 and to imprisonment for six months.

(2) For the purpose of this section a person who sells an article on which he has, or has caused to have, stamped, engraved or impressed or to which he has, or has caused to have, otherwise applied the word “registered”, or any other word expressing or implying that the design is registered, shall be deemed to represent that the design applied to the article is registered in respect of that article.

### 49. Deceiving or influencing the Registrar or an officer

(1) Any person who—

- (a) for the purpose of deceiving the Registrar or any other officer of the Designs Office in the execution of this Act; or
- (b) for the purpose of procuring or influencing the doing or omission of anything in relation to this Act or any other matter thereunder,

makes or submits a false statement or representation, whether orally or in writing, knowing the same to be false, shall be guilty of an offence.

(2) Any person who, having innocently made a false statement or representation, whether orally or in writing, for the purpose of procuring or influencing the doing or omission of anything in relation to this Act or any matter thereunder and who on becoming aware that such statement or representation was false fails to advise the Registrar forthwith of such falsity, shall be guilty of an offence.

### 50. Witness giving false evidence

Any person who, after having been sworn or having in lieu thereof made an affirmation or declaration, wilfully gives false evidence before the Registrar or the Tribunal concerning the subject-matter of the proceeding in question, knowing such evidence to be false or not knowing or believing it to be true, shall be guilty of an offence.

### 51. Penalties

Save where otherwise provided in this Act, any person who is guilty of an offence under this Act shall be liable to a fine of £500 and to imprisonment for three years.

## Part IX – Miscellaneous

### 52. Recognition of agents

Where by this Act any act has to be done by or to any person in connexion with a design or any procedure relating thereto, the act may under and in accordance with the regulations or, in particular cases, by special leave of the Registrar be done by or to an agent of that person duly authorized in the prescribed manner.

### 53. Lodging and authentication of documents

- (1) Any application, notice or document authorized or required under this Act to be lodged, made or given at the Designs Office or to the Registrar or to any other person may be delivered by hand or sent by registered post.
- (2) No authentication shall be required in respect of any document lodged in the Designs Office under this Act or used in proceedings before the Tribunal.

### 54. Provisions as to fees

- (1) Where under this Act—
  - (a) a fee is payable in respect of the performance of any act by the Registrar, the Registrar shall not perform that act until the fee has been paid;
  - (b) a fee is payable in respect of the doing of any act by any person other than the Registrar, the act shall be deemed not to have been done until the fee has been paid; or
  - (c) a fee is payable in respect of the lodging of a document, the document shall be deemed not to have been lodged until the fee has been paid.
- (2) All fees shall be paid at the Designs Office in such manner as the Registrar, with the approval of the Minister, may accept.

### 55. Oaths and affirmations

Any person who is required under this Act to take any oath or swear to the truth of any affidavit may, in lieu thereof, make an affirmation or declaration in accordance with the law relating to affirmations or declarations.

### 56. Journal

The Minister may direct the publication by the Registrar in the Patent Journal of any reports of cases on designs and other relevant matters as the Minister may deem fit.

### 57. Savings

- (1) Nothing in this Act shall be construed as authorizing or requiring the Registrar to register a design the use of which would, in his opinion, be contrary to law or morality.
- (2) Nothing in this Act shall affect the right of the Government or of any person deriving title directly or indirectly from the Government to sell or use articles forfeited to the Government under any enactment in force in Malawi.

## 58. Power to make regulations

- (1) The Minister may make regulations prescribing anything which under this Act is to be prescribed and generally for the better carrying out of the objects and purposes of this Act or to give force or effect to its provisions or for its better administration.
- (2) Without derogation from the generality of subsection (1), regulations made by the Minister may provide for—
  - (a) the form of applications for registration of designs and of any representations or specimens of designs or other documents which may be lodged at the Designs Office, and for requiring copies to be furnished of any such representations, specimens or documents;
  - (b) the procedure to be followed in connexion with any application or request to the Registrar, or any proceeding before him, and the authorizing of the rectification of irregularities of procedure;
  - (c) the service of notices and other documents required to be served in connexion with proceedings under this Act;
  - (d) the conduct of the business of the Designs Office;
  - (e) authorizing the publication and the sale of copies or representations of designs and other documents in the Designs Office.
- (3) The Minister may prescribe a tariff of the fees which shall be payable in respect of any application, registration or other matter under this Act and the fees shall be payable as so prescribed.

## Part X – Application and transitional provisions

### 59. Application of Act and transitional proceedings

- (1) Any design which immediately before the 1st January, 1964, was registered in the former Federation of Rhodesia and Nyasaland under any enactment relating to registered designs and was protected under the former Registered Designs legislation and any design which immediately before the date of commencement of the said legislation was registered in the United Kingdom under any enactment relating to registered designs and was protected in Malawi under the United Kingdom Designs (Protection) Ordinance (now repealed) shall be deemed to be registered under this Act and the copyright in that design shall subsist in Malawi while copyright therein would have subsisted in the said Federation or subsists in the United Kingdom as the case may be.

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- (2) The Registrar may register a design referred to in subsection (1) upon application made before the 31st December, 1964, by a person appearing to the Registrar to be the registered proprietor of that design in terms of the former Registered Designs legislation or of an enactment relating to registered designs in the United Kingdom.
- (3) The copyright in a design registered under subsection (2)—
  - (a) shall subsist in Malawi until the expiration of the current five-year period for which it would have subsisted at the date of such registration under the said Act or as the case may be for which it is at the date of such registration subsisting in the United Kingdom.
  - (b) may on application be extended in terms of [section 15 \(2\)](#). For the purposes of determining the period for which the copyright may be so extended the date of registration under subsection (2) shall be deemed to be the date of registration in the said Federation or in the United Kingdom as the case may be.

- (4) Every application under this section shall be made in the prescribed form and shall be accompanied by the prescribed fee.
- (5) In this section, the expression “the former Registered Designs legislation” means this Act as in force from time to time prior to the 1st January, 1964.