

FIRST EDITION

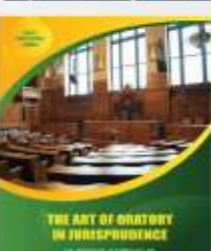
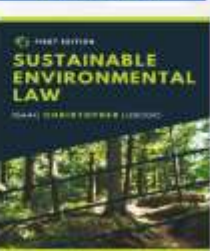
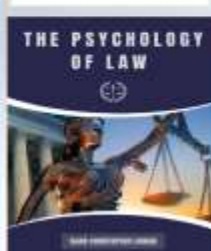
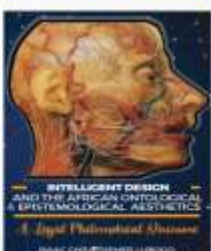
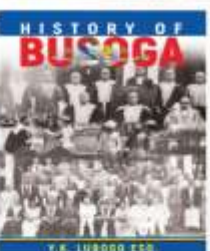
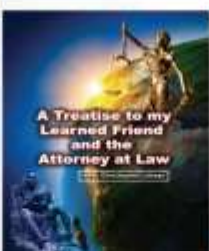
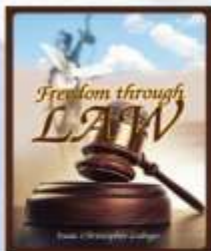
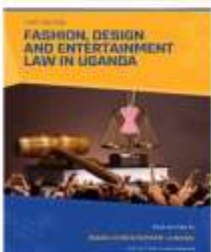
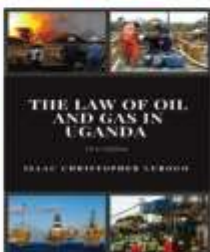
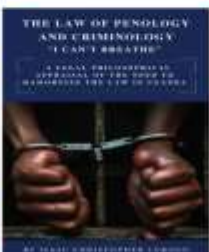
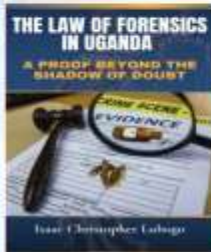
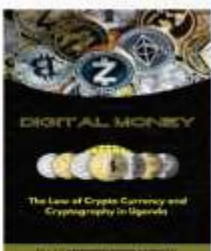
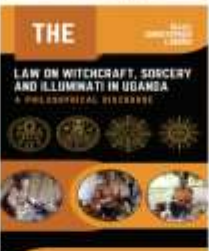
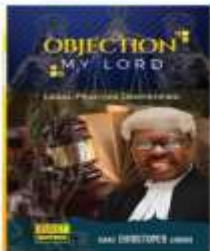
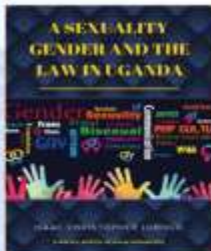
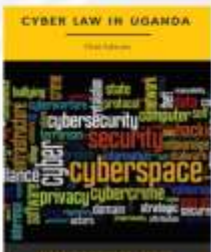
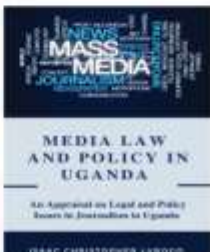
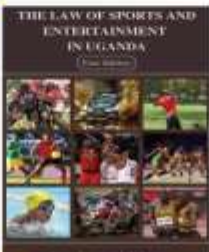
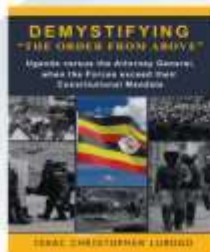
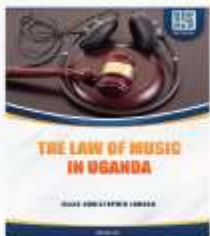
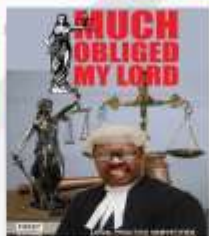
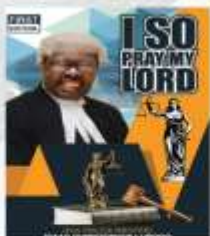
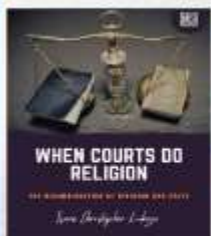
FASHION, DESIGN AND ENTERTAINMENT LAW IN UGANDA



Book written by

ISAAC CHRISTOPHER LUBOGO

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Fashion, Design and Entertainment in Uganda

Isaac Christopher Lubogo

Fashion, Design and Entertainment in Uganda

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Isaac Christophher Lubogo

Dedication



Oh God, Even my God my Hish Tower, my refuge, my Redemeer, my only source of hope. This and many more is for you Oh God of the mighty universe.

CHAPTER ONE



Introduction.

LAW AND FASHION

Law

The term has not succeeded at acquiring any specifically limited and technical meaning that is universally acceptable for all times. The word 'law' implies in Latin: the command of him who is invested with sovereign power. It has been defined or described in various ways which include: A general body of such rules of conduct expressing the will of the ruling class as are established by legislation and such customs and rules of community life as are sanctioned by the government; the application of which body of rules is secured by the coercive force of the state for the protection, consolation, and development of the social relations and the public order, beneficial and desirable for the ruling class (Vyshinsky: Soviet Civil Law). A rule of action prescribed or dictated by some superior which some inferior is bound to obey" and is applied indiscriminately to all kinds of actions, whether animate or inanimate, rational or irrational (Blackstone) A command set either directly or circuitously by a sovereign individual or body to members of some independent political society in which his authority is supreme (John Austin).

A general body of such rules of human conduct established or sanctioned by the government power, the execution of which rules is secured by the coercive power of the state (V. Gsovski: Soviet Textbook of Civil Law)

BRIEF HISTORY OF FASHION LAW

Fashion law is an area of law that deals with intellectual property (copyright and trademark law, including brand licensing), domestic and international business transactions, textiles, merchandising, employment and labor concerns, and customs (import/export problems).

In a 2008 article, Susan Scafidi, arguably the first U.S. law professor ever to offer a course in Fashion Law and later Director of the Fashion Law Institute at Fordham Law wrote that Fashion Law was only then starting to be recognized as a distinct field. Presently, many other institutions have offered courses in the area of fashion law, including New York University School of Law, Benjamin N. Cardozo School of Law and in 2013, Loyola Law School in Los Angeles launched its own Fashion Law Institute. Loyola law dean, Victor Gold said he was skeptical about starting a fashion law program but changed his mind after looking at student demand, the size of the retail market and the fashion industry's increasingly global reach. "It's a place law schools need to be," he said. Kolsun, who wrote the first textbook on fashion law in 2010, cited the industry's world-wide trillion dollar impact as a reason for increased specialization. Also, according to Lois Herzeca "Fashion law is a real career choice,"

Fashion law regulates the relationship between fashion designers, distributors and customers, making them duty bound towards each other so they could act within the scope of the legally binding negotiations that arise due to the contractual obligations between them. It also provides for the protection and ownership of designs created or used by fashion houses, manufacturers and photographers. Fashion Law is a legal specialty that addresses the issues faced in the fashion industry, and its intertwined connection with the engineering and technology sectors, with corporate governance, social media, and e-commerce trends, and with sustainability standards.. Fashion Law encompasses intellectual property principles to protect, monitor, and enforce the interests of fashion brands.

Fashion law, as can otherwise be referred to as ‘apparel law’, is indeed an emerging arena of legal specialty, encompassing the legal issues with regard to every aspect of a garment. Right from the conception of the idea to design a particular garment, to getting it stitched into clothing materials, styling and publishing it and obtaining brand protection on it, legal assistance is needful. Fashion law is an area of law that combines intellectual property law (copyrights, trademarks, trade dress, trade secrets, and licensing) with the laws of business, employment, Internet, import, and export. The fashion industry includes many different types of apparel and products, such as perfumes, home furnishing, footwear, clothing, and jewelry and accessories, furnishings, and more. Fashion is a massive industry that thrives in a competitive global environment despite minimal legal protections for its creative design. While many people dismiss fashion as trivial and ephemeral, its economic importance and cultural influence are enormous. The fashion industry is a global phenomenon, with an international language understood by millions of people. Up to date, the fashion scene brings more and more fans willing to pay large sums of money to feel and to look good about their appearance and adornments. This increased interest has caused the fashion industry to face challenges that were not common in the past decades. Consequently, it came necessary to set the rules to make this a bigger and more effective business. As a result, Fashion law came as brand new legal specialty that involves several issues of intellectual property rights, particularly trademark law and copyright law though it can include patents and trade secrets. Patent and trade secrets become relevant when the fashion company has developed new manufacturing process or method as the fashion industry functions on the basis of collaboration, primarily between designers, manufacturers, merchandisers and retailers from all around the world to deliver to consumers’ clothing, footwear and accessories.

The word fashion means different things to different people. Fashion is an art. It’s a religion. It’s a job. It’s a peek into a personality. It’s playfulness. It’s an escape or a disguise. It is a feast for the eyes. But ultimately, fashion is an individual statement of expression for each of us... Fashion can define who

you are or want to be. French fashion designer Coco Chanel once said, "Fashion is not something that exists in dresses only. Fashion is in the sky, in the street, fashion has to do with ideas, the way we live, what is happening."¹¹ It's true. Fashion isn't defined solely by our clothing choices, but is also conveyed through the way we carry ourselves, our personalities and our views of the world. So, who exactly answers the question "what is fashion"? Who decides what's fashionable and what isn't? What's in or what's out?¹²

Fashion Designers The iconic fashion houses - Prada, Gucci, Chanel - are referred to as haute couture, French for "high sewing." These designers lead the way in creating trend-setting fashion. While some of their designs are outrageous and completely unrealistic when it comes to everyday wear, generally the theme is adapted into versions suitable for wearing. Media Fashion trends are often sparked by characters on popular television shows and movies as well as adopted from magazine pages. "Sex and the City," "The Devil Wears Prada," these shows introduced us to new, cutting-edge designs.

Musicians Musicians have always been very influential when it comes to dictating fashion. Rock 'n' roll is fashion. Elvis is an iconic example. In the 1950s, everyone wanted to dress like Elvis. What about the heavy metal hair bands so popular in the 1980s? Axl Rose reinvented the head bandana while Poison, Motley Crue and Bon Jovi set the pace for big, rocker hair.

Law The term has not succeeded at acquiring any specifically limited and technical meaning that is universally acceptable for all times. The word 'law' implies in Latin: the command of him who is invested with sovereign power. It has been defined or described in various ways which include: A general body of such rules of conduct expressing the will of the ruling class as are established by legislation and such customs and rules of community life as are sanctioned by the government; the application of which body of rules is secured by the coercive force of the state for the protection, consolation, and development of the social relations and the public order, beneficial and desirable for the ruling class (Vyshinsky: Soviet Civil Law). A rule of action prescribed or dictated by some superior which some inferior is bound to obey" and is applied indiscriminately to all kinds of actions, whether animate or

inanimate, rational or irrational (Blackstone) A command set either directly or circuitously by a sovereign individual or body to members of some independent political society in which his authority is supreme (John Austin). A general body of such rules of human conduct established or sanctioned by the government power, the execution of which rules is secured by the coercive power of the state (V. Gsovski: Soviet Textbook of Civil Law) Brief history of fashion law Fashion law is an area of law that deals with intellectual property (copyright and trademark law, including brand licensing), domestic and international business transactions, textiles, merchandising, employment and labor concerns, and customs (import/export problems).¹³ In a 2008 article, Susan Scafidi, arguably the first U.S. law professor ever to offer a course in Fashion Law and later Director of the Fashion Law Institute at Fordham Law wrote that Fashion Law was only then starting to be recognized as a distinct field. Presently, many other institutions have offered courses in the area of fashion law,¹⁴ including New York University School of law, Benjamin N. Cardozo School of Law and in 2013,¹⁵ Loyola Law School in Los Angeles launched its own Fashion Law Institute.¹⁶ Loyola law dean, Victor Gold said he was skeptical about starting a fashion law program but changed his mind after looking at student demand, the size of the retail market and the fashion industry's increasingly global reach. "It's a place law schools need to be," he said. Kolsun, who wrote the first text book on fashion law in 2010, cited the industry's world-wide trillion dollar impact as a reason for increased specialization. Also, according to Lois Herzeca "Fashion law is a real career choice.

Fashion is literally defined to mean a popular or the latest style of clothing, hair, decoration or behavior. Fashion law can be defined as an amalgamation of various kinds of laws viz contract law, employment law, consumer protection law but most importantly intellectual property law, which can be regarded as the major tenet of fashion law.' It also includes related areas such

as textile production, modelling, media and the cosmetics and perfume industries.¹

Fashion law is a specific field of law that deals with legal issues that impact the fashion industry. Fundamental issues in fashion law include intellectual property; business and finance, with subcategories ranging from employment and labor law to real estate; international trade and government regulation, including questions of safety and sustainability; dress codes and religious apparel; consumer culture; privacy and wearable tech; and civil rights. Fashion law also includes related areas such as textile production, modeling, media, and the cosmetics and perfume industries.

It is a specific field of law that deals with legal issues that impact the fashion industry.² Fashion is a popular aesthetic expression in a certain time and context, especially in clothing, footwear, life style, accessories, make up, hairstyle and body proportions. A trend often connotes a specific aesthetic expression and often lasting shorter than a season. Style is an expression that lasts over many seasons and is often connected to cultural movements and social makers, symbols, class and culture.³ Fashion is generally transient of short lasting in nature and involves continuous change.

HISTORY OF FASHION.

Fashion has been subject to legal regulation throughout history, from sumptuary laws that limit who can wear certain garments to trade restrictions and varying degrees of intellectual property protection. However, the conceptualization of fashion law as a distinct legal field is relatively recent.

¹A B Scafidi, Susan (2014). "Introduction: Fashion Law Triumphant-Designing success in a New Legal Field." *Navigating Fashion Law: leading Lawyers on Developing Client Brands in a changing Market and Monitoring Key Legal Developments* (2015 ed.). Thomson Reuters. ISBN 978-0-314-29318-3., p.8.

²<https://www.hg.org/fashion-law.html> referred at 10/01/2022

³ Handbook on fashion law by Sanjeev Kumar

In May 2004, a group of French lawyers led by Annabelle Gauberti published a supplement entitled "Droit du luxe" (which translates into either "law of luxury goods" or "luxury law") in the prestigious French legal magazine *Revue Lamy Droit des Affaires*. This supplement explored various specific legal and tax issues at stake in the fashion and luxury goods sectors and was the second conceptualization ever of the interactions between the legal field and the fashion and luxury goods industries.

In 2006, Professor Susan Scafidi offered the first course in Fashion Law at Fordham Law School, thus creating a brand new field of law. Fashion Law courses were also developed and offered to designers at the Fashion Institute of Technology (by Guillermo Jimenez) and Parsons School of Design (by Deborah McNamara) at this time as well. In 2008, Susan Scafidi wrote that fashion law was only then starting to be recognized as a distinct area of law

In 2010, the world's first academic center dedicated to fashion law, the Fashion Law Institute, launched with the support of Diane von Furstenberg and the Council of Fashion Designers of America. Since then, a number of other institutions around the world have offered courses or programs in the area of fashion law. These include the University of Milan, the University of Insubria, the Instituto Brasileiro de Negócios e Direito da Moda, University at Buffalo Law School, Benjamin N. Cardozo School of Law, New York Law School, New York University, the Fashion Law Project at Loyola Law School, the Moda Hukuku Enstitusu in Turkey, the annual Fashion Law Week at Howard University, and McGill University Faculty of Law.

Fashion law has also developed into an established field of practice and study. In 2010, designer-turned-lawyer Brittany Rawlings headed up the first Fashion Law practice group dedicated entirely to issues that arise throughout the life of a fashion business. The New York City Bar Association has had a dedicated Fashion Law Committee since January 2011, and the New York County Lawyer's Association has had a Fashion Law Subcommittee since September 2011

While double-digit turnover growth is being generated by many companies involved in the fashion and luxury goods sectors, an increasing number of lawsuits are filed in this industry and, as a result, more and more legal practitioners focus their practice on this particular industry and sector. An organization called "The international association of lawyers for the creative industries," or ialci, was founded in 2013 during Paris Fashion Week. The goal of the association is to provide relevant and useful business and legal knowledge as well as solutions regarding the creative industries, including fashion and luxury goods.

SEGMENTS OF FASHION LAW

Intellectual Property

Intellectual property protection has been a substantial legal concern in fashion since the emergence of fashion brands in the 19th century. It has been the subject of congressional debate, multiple academic articles, and the first fashion law blog, as well as a major exhibit at the Fashion Institute of Technology Museum in New York.

Key issues include:

- the scope of copyright protection
- trademark infringement and counterfeit goods
- utility patents, particularly in connection with advances in technology
- the use of design patents as an alternative or supplement to copyright protection, and
- comparative international standards

A prominent related issue has been cultural appropriation, such as the use of Native American or religious designs by commercial fashion brands.

Financing and Corporate Structures

Fashion law encompasses the broad spectrum of issues pertinent to starting and funding a fashion business, such as:

- the widespread use of factoring
- the influx of private equity investment, and
- initial public offerings by major fashion brands

Manufacturing

Legal issues in the production of clothing and accessories include:

- worker safety and other labor practices
- garment district zoning and
- source indication

Marketing

Legal issues addressed in connection with marketing include:

- labeling requirements,
- licensing and
- deceptive advertising

Retail

Legal issues connected with the retail environment include:

- consumer data privacy and the security of credit card information
- discrimination based on racial profiling, and
- real-estate leasing and ownership

Ethics, Sustainability, and Economic Development

Concerns pertaining to fashion ethics, sustainability and economic development have had a substantial impact on the industry, affecting both the legal framework and self-regulation initiatives. Important issues have included:

- organic certification
- greenwashing
- supply-chain monitoring and certification standards, such as the Higg Index and SA8000 certification
- the regulation of digitally altered images
- fair trade fashion and
- the impact of philanthropic initiatives and clothing donation programs, such as the buy-one-give-one business model

International Trade

In addition to the international implications of issues noted above, fashion law also addresses other matters connected to international business transactions, including:

- grey market goods
- import and export quotas
- transfer pricing taxation and
- customs duties.

Modeling Law

The legal status of models has become a prominent issue in fashion law, as exemplified by:

- The regulation of models' weight in places, such as Madrid, Milan, and Israel,
- New York's enactment of a statute giving underage models protection under the state's child labor law,
- antitrust enforcement in relation to model pay rates, and
- efforts to curb fashion-related human trafficking

HISTORY AND BACKGROUND OF FASHION LAW

Fashion has been subject to legal regulation throughout history, from sumptuary laws that limit who can wear certain garments to trade restrictions and varying degrees of intellectual property protection.⁴

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⁴ Haun, Alan (1996). *Governance of the consuming Passions: A History of Sumptuary law*. St. Martins Press. ISBN 978-0-31212-922-4.

luxury goods or “luxury law”) in the prestigious French legal magazine *Revue Lamy Droit des Affaires*. This supplement explored various specific legal and tax issues at stake in the fashion and luxury goods sectors and was the second conceptualization ever of the interactions between the legal field and the fashion and luxury goods industries.⁵

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⁵https://en.m.wikipedia.org/wiki/Fashion_law

⁶“About” fashion Law institute.2012-03-14. Retrieved 2020-10-01.

⁷<http://www.nyls.edu/innovation-center-for-law-and-technology/faculty/>

⁸ “Couture in the classroom”. *Wall Street Journal*.20 August 2010. Retrieved 11 December 2014.

⁹https://en.m.wikipedia.org/wiki/Fashion_law

¹⁰ “Law Gets Fashionable as Lawyers Learn to Love Litigation” *Agence France Press*. 16 November 2014. Archived from the original on 3 December 2014. Retrieved 12 December 2014.

¹¹ Rawlings,Brittany. “B.Rawlings”

¹² “IP Attorneys Develop Niche Practice for Fashion Industry”

¹³ Rawlings, Brittany. “Fashion Law House.com”

has had a dedicated Fashion law Committee since January 2011,¹⁴ and the New York County Lawyers Association has had a fashion law subcommittee since September 2011.¹⁵ In 2014 in London, Tania Phipps-Rufus¹⁶ Fashion and law expert founded Fashion Law and Business and delivers lectures, masterclasses, events and workshops for those that want to know more about the business of fashion and law. In the same year, The Global Fashion Project in Miami launched their Fashion law initiative.¹⁷

While double-digit turnover growth is being generated by many companies involved in the fashion and luxury goods sectors, an increasing number of lawsuits are filed in this industry and as result more and more legal practitioners focus their practice on this particular industry and sector. An organization called “the international association of lawyers for the creative industries,” or ialci, was founded in 2013 during Paris Fashion week.¹⁸ The goal of the association is to provide relevant and useful business and legal knowledge as well as solutions regarding the creative industries, including fashion and luxury goods.¹⁹

Fashion law, also known as apparel law, is an emerging legal specialty that encompasses issues surrounding the life of a garment from conception to brand protection. Fashion law clients include designers, fashion houses, distributors, manufacturers, modeling agencies, retailers, and photographers.

¹⁴ “city Bar Creates New Committee on Fashion Law”

¹⁵ New York County Lawyers Association Launches Fashion Law Subcommittee: Pitch Engine: Get the Word Out”. PitchEngine. 2011-11-02. Archived from the original on 2012-06-01. Retrieved 2012-03-09.

¹⁶ “Selected Work”. Tania Phipps-Rufus. Retrieved 2015-12-29

¹⁷<http://tgfp.org>

¹⁸ “The international association of lawyers for the creative industries”ialci. Retrieved 2020-10-01.

¹⁹ Stewart, Mary Lynn (2005). “Copying and copyrighting Haute Couture.” French Historical Studies. 28:103-130. Doi:10.1215/00161071-28-1-103

New York Senator Charles Schumer introduced the Innovative Design Protection and Piracy Protection Act (IDPPPA) in August 2010. The IDPPPA protects designs that are deemed to be "unique" and "original."

Responsibilities and Duties of a Fashion Lawyer

Fashion attorneys advise clients on legal issues facing the fashion, textile, apparel, luxury, footwear, jewelry, and cosmetics industries. These run the gamut from licensing, merchandising, distribution, and franchising agreements to intellectual property, employment, and labor relation issues. They include safety, sustainability, and consumer protection issues. Various aspects of corporate, real estate, tax, and business law also come into play.

Fashion lawyers perform a broad range of duties from drafting and negotiating contracts to addressing and litigating trademark, copyright, and other intellectual property issues. They're in charge of forming and dissolving business entities and advising on branding development and protection.

Fashion lawyers also consult on design protection, import-export, licensing and other issues.

Education Opportunities

Education programs do exist that are exclusively dedicated to fashion law, but they're admittedly few and far between.

Fordham Law School launched the world's first Fashion Law Institute in late 2010 with the support of the Council of Fashion Designers of America and Diane von Furstenberg. The Institute offers J.D. and LL.M. students the opportunity to study fashion-related legal issues.

The Fashion Law Institute also provides pro bono legal counseling for designers in need. Specialty courses include topics such as Fashion Law and Finance and Fashion Ethics, Sustainability, and Development, as well as Fashion Retail Law and the Fashion Law Practicum.

The institute offers a public seminar series for design and legal professionals, as well as a summer intensive course that's open to both degree and non-degree students.

A few other schools have launched curriculum and coursework in the area of fashion law as well, including Loyola Law School, the University of Buffalo Law School, New York Law School, and New York University.

Why Fashion Law Is Growing

The internet age has exacerbated many of the legal issues that designers and fashion companies encounter, fueling the necessity for fashion-specific legal advice and protection. For example, design piracy and copycat litigation have grown in recent years, prompting new legislation that provides legal protection for fashion designs. These issues are of particular importance to those in the fashion industry.

New York Senator Charles Schumer introduced the Innovative Design Protection and Piracy Protection Act (IDPPPA) in August 2010. The IDPPPA protects designs that are deemed to be "unique" and "original."

How to Break into the Field

Fashion law is a unique specialty that's growing, but very few law firms specialize in this area.

Copyrightability in Fashion

According to the Merriam-Webster Dictionary, fashion is defined as "the prevailing style of a particular time." In the fashion industry, trends and designs change from season to season in the form of various elements, which usually manifests itself in a variety of colors, silhouettes, types of fabrics, unique cuts of fabric, and prints.

When determining whether and how fashion is protected by copyright law, it's important to understand the scope of copyright protection for fashion items. The Copyright Act does not protect ideas, concepts, or facts. If the color of chartreuse, polka dots, or a simple balloon sleeve is the latest trend, copyright law protections do not extend to those design elements alone. In fact, the Copyright Office Compendium notes that the Copyright Office generally refuses to register “[c]ommon patterns, such as standard chevron, polka dot, checkerboard, or houndstooth designs, “geometric figures and shapes,” “alphabetic or numbering characters,” or simple arrangements of such unprotectable elements.

For example, the Copyright Office rejected Coach’s registration application for a fabric design containing “a pattern consist[ing] of two linked ‘C’s’ facing each other alternating with two unlinked ‘C’s’ facing in the same direction.” A New York federal district court held in *Coach, Inc. v. Peters*, that the Copyright Office exercised its proper judgement in rejecting Coach’s application since the Copyright Office reasoned that under copyright law, mere letters of the alphabet and the arrangements of that letter, “C,” were not sufficiently creative or original enough so that the design was protectable under copyright law.

Fashion As a “Useful Article”

The Copyright law also does not extend protection to useful articles, which is defined as “an article that has an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.” There was a time in the not-too-distant past when the Copyright Office generally refused to register claims to copyright in clothing or costume designs on the “ground[s] that articles of clothing and costumes are useful articles that ordinarily contain no artistic authorship separable from their overall utilitarian shape.”

But the Office changed its policy in 1991 when it released a Policy Decision about its examining practices with respect to “fanciful costumes.” Specifically, the Office noted that it would register these works “if they contain separable pictorial or sculptural authorship. The separable authorship may be physically separable, meaning that the work of art can be physically removed from the costume, or conceptually separable, meaning that the pictorial or sculptural work is independently recognizable and capable of existence apart from the overall utilitarian shape of the useful article.”

But in 2016, the U.S. Supreme Court abandoned the physical separability test in the case, *Star Athletica v. Varsity Brands*. The Court set out a standard for determining copyrightability in fashion designs and for useful articles in general in a case about the copyrightability of cheerleader uniforms. According to the Court, while copyright law may not protect the general notion of “style” it does protect design elements which:

- “can be perceived as two- or three-dimensional works of art separate from the” fashion item itself; and
- “qualify as a protectable pictorial, graphic, or sculptural work, either on its own or fixed in some other tangible medium.”

This is the standard the Copyright Office and courts must use when evaluating copyrightability in useful articles like clothing and fashion accessories (including jewelry).

So What Fashion Designs Are Protectable Under Copyright Law?

By way of illustration, here are some design elements where fashion may be protectable under copyright law:

- **Graphic Designs:** Copyright law would protect the designs on the surface of fashion items just as it protects designs on the surface of a

canvas or sheet of paper. For such protections to apply, copyright law only requires that the designs on the surface of fashion items (like the designs contained on the surface of any other medium) demonstrate a very minimal amount of creativity. The U.S. Supreme Court also addressed this issue in *Star Athletica v. Varsity Brands*, stating that “two-dimensional designs appearing on the surface of [clothing]” including “combinations, positionings, and arrangements” of shapes, colors, lines, etc. are protectable by copyright.”

- **Textile Designs:** Similarly, a producer of fabrics can rely on copyright to protect “designs imprinted in or on fabric—if the design contains a sufficient amount of creative expression.” In fact, the case *Unicolors v. H&M*, which is currently pending in the U.S. Supreme Court on registration issues, concerns an infringement of intricate geometric patterns that were designed by the pattern-making company Unicolors.
- **Logos:** Copyright law can protect logos. But the key is that logos must have sufficient creativity and originality under copyright law. The Copyright Office has refused to register copyrights in logos when the logos were deemed have simply contained common letters, typography, and geometric shapes without any elaborate or intricate arrangements that would amount to sufficient creativity under copyright law. For example, the Copyright Office has refused to register various logos of famous brands including Adidas’s “3 Bars” logo and Tommy Hilfiger’s “Flag” logo. However, designers can still generally find protections for their brands’ logos under trademark law.

And then there are some design elements that copyright law would not protect. For those design elements, it’s important to remember that other types of intellectual property laws, including trademark and patent law, may provide protections for designers.

- **Color:** Copyright protection does not extend to colors. If a designer wants to protect a signature color or a unique color scheme, copyright is not the avenue. But that doesn't mean there are no options for protection of the designer's intellectual property. Trademark protection may be available in these instances.
- **Cut:** The way that design elements are cut and pieced together is not protected by copyright. The U.S. Supreme Court recently addressed this topic in the *Star Athletica* case, stating that copyright affords "no right to prohibit any person from manufacturing [clothing] of identical shape, cut, and dimensions." But, again, that doesn't mean there aren't other kinds of protections that cover cuts. Design patents may afford protections for this type of design element. (And unlike copyright, a design patent can prevent others from creating fashions that resemble a sketch of the original design.)

Whatever the trend, designers work hard to stay competitive and on top of the spirit of the times by laboring on their collections in time for Fashion Week 2022. It's clear that the creativity and originality in a designer's expression is what copyright law was meant to protect.

INTELLECTUAL PROPERTY RIGHTS FOR DESIGN

Design protection can only be sought when the intangible creative idea – e.g. a novel pattern - is embodied in physical form, such as in a specific fabric or item of clothing. (Snowflake-like pattern: registered Community Design no. 000772058-0003. OHIM)

A creative idea, for example for a certain flowered cloth pattern, is intangible and can be reproduced without any asset erosion. Therefore, exclusive rights to specific physical things, like the flowered cloth pattern, would not suffice to grant the design IP protection. The intellectual idea itself must be protected. This can only be achieved by prohibiting the imitation of the physical things through which we perceive the intellectual good. The ban of

imitation for a certain time period “enables people to reap where they have sown. Without that prospect the incentive to sow is diminished.”⁴

On the other hand, since we can only perceive intellectual goods if they are incorporated in physical things, non-materialized ideas cannot be protected. As a consequence, fashion styles like mini-skirts or jeans in general as much as manufacturing processes, such as innovative techniques to cut, sew or print clothing, which allow the manufacturing of a wide range of different physical results, cannot be protected as such under design law. Protection can only be sought as far as the idea is materialized in a specific physical thing.

From royal privileges to the Community design regulation

The development of European design law goes hand in hand with the history of the textile industry. In the 15th century, the French King granted exclusive rights, or privileges, for the fabrication of textiles. A government ordinance penalized the counterfeiting of weaving patterns for the first time in 1711 in Lyon. In England and Scotland, the first statute concerning the protection for designs was initiated by textile producers in 1787. In 1876, Germany issued a law concerning the copyright on patterns and models, again mainly as a consequence of requests of the textile industry. More recently, the drive to harmonize Europe’s design laws led to the European Regulation on Community designs, which came into force in 2002.⁵

The European Community Design Regulation protects only designs that are new and have individual character. The degree of visual difference from pre-known designs, resulting from one-to-one comparisons and examined from the perspective of an informed user, is the only decisive criterion as to whether or not a design can be protected. Differences between two designs which are of minor importance to a casual observer, such as the arrangement of buttons, the shape of a collar or the length of a skirt, may produce a different overall impression in the eye of an informed fashion user.⁶

To register or not to register

Few new designs on the market are truly exceptional in form. Unlike this extraordinary evening gown by Pierre Cardin, 1988.

Fashion designers are actually quite limited in their scope for creativity: clothing must fit the human body; and the general social need to conform to accepted dress codes tends to lead to uniformity. Thus few new designs on the market are truly exceptional in form. But since difference is assessed by one-to-one comparisons, a single distinguishing feature - such as an embroidered jeans pocket, an oversized zipper or a dominant print - may be enough to produce a unique overall impression and justify the protection either of the extraordinary feature or of the whole item.

In 2007, WIPO registered only 29 international designs (2.5% of total registrations) under class 2 of the Locarno Classification (clothing and haberdashery) through The Hague System, while the EU Office for Harmonisation in the Internal Market (OHIM) registered 7'421 (9% of total). Yet, most of the designs registered by fashion houses are not for clothing, but for accessories – watches, bags, sunglasses, etc., which fall under several different Locarno classes – an important source of income for fashion labels. The majority of fashion designers consider that, with fashion seasons lasting only a few months, the five-year minimum protection period offered by these registration systems is not appropriate for often ephemeral fashion designs, and that their time and money would therefore be better spent on creating new designs than on registration.

European designers do have an effective solution in the unregistered Community design. This is obtained without any formalities simply by making the design available to the public, and lasts for three years. Since most designers become concerned with protection only after becoming a victim of counterfeiting, the unregistered Community design provides a welcome alternative to registration.

Design vs trademark protection

In conclusion, design registration tends to be appropriate primarily for protecting exceptional designs or features, or those which might be expected to become long lasting icons. However, if a design is counterfeited, the endless numbers of designs on the market make it hard to detect violations. Instead of design protection, most fashion designers rely much more on their fashion labels, applied directly on their products and often protected under trademark law. Fashion labels make it easier for designers to detect imitations and help fashion users to identify preferred items. Fashion houses invest large amounts in advertisements to promote the attributes of their trademarks in order to attract fashion users. But it is no surprise that counterfeiters also try to free-ride on the sales-promotional effects of trademarks by copying both the designs and the corresponding labels. For this reason, major fashion designers incorporate special treated yarn or other security elements into their labels, so facilitating the distinction between originals and imitations.

Fashion is a medium through which art transcends into our wardrobes. It is a form of art that thrives on new creations and ideas of designers. The intellectual property laws grant exclusivity and ownership to the creator for gaining economic and moral benefits. Furthermore, these laws provide remedies against fashion knock-offs and counterfeits, which is becoming a serious threat for designers. Having said this, let us examine how far is the existing legislation able to permeate through the fashion industry to protect the intellectual property of fashion designs.

Intellectual property (IP) law is grounded in incentive theory, giving exclusivity to the creator, enabling them to profit from their work, incentivizing the creator to create more work. The fashion industry has been described by many scholars as IP's "negative space" areas where creation and innovation thrive without significant protection from IP law. "Many areas of creation function in the absence of intellectual property protection. A smaller group—those residing in IP's negative space—are enhanced by that absence. Recent case studies have explored a number of these areas, which include such diverse industries as fashion, cuisine, magic tricks, stand-up comedy, typefaces, open-source software, sports, wikis, academic science, jam

bands, hip hop mixtapes, and even roller derby pseudonyms.” (Rosenblatt 2010, 319-320)

Fashion designers and their IP tussle

It is a usual thing to hear about buying the first copy of some well-known designer of the fashion industry at much cheaper rates. Delhi’s Gaffar Market, Bangalore’s Brigade Road, Mumbai’s Linking Road, and Kolkata’s Vardhman market are places where one can find top-notch designers’ first and second copies at a minuscule price compared to the actual design article. Plagiarism in this industry exists between the designers as well, where there are many instances of one big design house copying the designs of another big design house. In 2017, Rohit Bal was the first designer to get copyright over his entire collection, and later, many prominent designers followed.

With this scenario, many questions arise regarding the standing of IP Laws in India in the context of fashion designs. Designers who create a design for economic leverage are at a loss when the design becomes common due to copying. Why don’t designers protect their designs through intellectual property laws? Do Indian intellectual property laws offer any protection to the fashion industry? If yes, then to what extent? And, why aren’t the designers finding incentives to protect their designs? I will be discussing all these questions in this article.

Understanding the law

Fashion designs can be copyrighted under two laws in India, the Copyright Act, 1957 as ‘creative works’ and the Design Act, 2000 as designs. Primarily, there are two aspects of clothes designs, which can be protected through these laws. Firstly the drawings/colour combinations on the garment can be protected as ‘artwork’ under the Copyright Act. Secondly, the shape of the garment attributing to its distinctive fabric and couture can be protected under the Design Act. In India, the Copyright Act, 1957 doesn’t make registration of artwork mandatory. Another vital aspect of the design is its

logo. The Trademark Act in India allows protection to the logos, which become constituent of designer clothing and accessories.

Understanding the state of affairs in detail from the perspective of the Copyright and Neighboring Act 2006, makes things all the vaguer. One wonders if there is a special provision regarding copyright in designs stating that copyright shall not subsist under this Act if registered under any other Act such as the United Kingdom Designs (Protection Act Cap 218) Industrial Design Act, No. 22 of 2016. It appears the Acts makes it apparent that design registration and copyright over an article cannot co-exist. This restricts the tenure of the design, and a possible restriction of the copyrightable limits based on production quantities of the design.

It is not contested that the moral rights of the copyright holder do not get affected, there is a possible grant of full authorship/ownership of their original artistic work for lifetime plus 60 years. Having said this, another aspect is about the improvisations on original works. The fashion industry thrives on improvisations of existing styles of clothes. Many big names in the fashion industry get inspiration from the existing designs.

For analyzing the United Kingdom Designs (Protection Act Cap 218) Industrial Design Act, No. 22 of 2016, with reference to fashion designs is vital. It is envisaged that the Act should prohibit piracy of a registered design by making it unlawful to use the registered design or any fraudulent or obvious imitation unless consent is obtained from the registered proprietor. Further, it should also prohibit imports of pirated designs for the purpose of sale. Furthermore, there should be Design Rules, which should mention particular classes of articles under which various designs would be registered. Under these rules, "Articles of clothes and haberdashery" fall in classes and that the design proposed to be filed needs to be unique and novel.

The boundaries of IP protection in the fashion industry are very fuzzy and difficult to comprehend.

A question arose in *Rajesh Masrani v. Tahiliani Designs Pvt Limited* (2008 PTC (38) 251 (Del.)) whether patterns printed on fabrics qualify as artistic work or not and can these be protected under the Copyright Act and the Design Act? The present case was an appeal against the single judge interim injunction granted in favour of Tahiliani Designs, where Rajesh Masrani was prohibited from producing, selling, or advertising similar fabric. There were very cogent arguments raised by the defendant-appellant worthy of discussion. The first argument was that the garments and drawings were not ‘artistic works’ for the purpose of copyright protection, and the second argument was that the drawings are required to be registered as designs as per Section 15(2) of the Copyright Act. The Delhi High Court opined that such designs come under the ambit of copyright protection if produced below 50 in number and if not produced for commercial use, implying that the objective of creating a work is decisive for qualifying it to be copyright worthy. The fashion brand of Tarun Tahiliani created only 20 such pieces with the specific design due to which protection was granted, and printing, selling, or advertising of a similar design was prohibited.

Section 2(d) of the Design Act, 2000, while elaborating on the definition of a “design,” excludes any artistic work defined under Section 2 (c) of Copyright Act, 1957. The cross reading of these sections from these two acts defines the boundaries of intellectual property where artistic work is excluded from the design aspects. Design aspects require mandatory registration under the Design Act to protect against infringements.

INTERNATIONAL OUTLOOK

The UK Copyrights Designs and Patent Act 1988 protects drawings and graphic works on an item and 2-D items such as textiles during the lifetime of the owner and 70 years thereafter. Similarly, in the US, fabric prints are protected for a term spanning the life of a designer plus 70 years thereafter. Another form of IPR in the US, which is protected, as Design patents are “ornamental designs of a functional object,” such as ornamental designs on

watches, mobile phones, jewellery, etc. The term of protection for design patents is 14 years and they are rarely granted to garments. The European Union grants three years of protection to fashion designs and creators can apply for an extension of up to 25 years.

A garment design comprises two elements- artistic design element and usability element. In order to be copyrightable, the original design elements must be separable from the useful nature of the article. An illustrative case, as cited in (Scruggs 2007, 124), is *Masquerade Novelty*. In *Masquerade Novelty*, at issue were “nose masks” designed to resemble the noses of a pig, elephant, or parrot. The district court held that the masks were “useful articles” that could not be protected under copyright law. The Third Circuit reversed this ruling, reasoning that “the only utilitarian function of the nose masks is in their portrayal of animal noses.”

IP PREDICAMENT FOR THE FASHION INDUSTRY

It's a catch 22 situation for designers to seek design patents for their apparel for reasons which are apparent if the ground reality is considered. Firstly, the design patent applied for registration should qualify as distinct from the prior art already existing. Secondly, the fashion life cycle is very small and by the time the design patent is obtained, the fashion styles change. It is a very big de-motivator for the designers. This makes the fashion industry susceptible to piracy and plagiarism. Fashion designers invest their time and money to create designs, and the *fruits of their labour* dissipate into the hands of copycat designers. The pain of the designer is further aggravated if they decide to file infringement suits against *knock-off designers* due to the high litigation costs, energy, and time they would need to invest. By the time the court concludes a case, the fashion style would have changed and it wouldn't offer any benefit to the designer. Moreover, the pecuniary damages granted by the court do not exceed more than 50,000 rupees.

On the contrary, Kal Raustiala & Christopher Sprigman argued that copycat designers benefit the fashion industry by pushing the fashion cycle forward

by creating trends incentivizing the fashion houses to create the next big fashion trend. They termed this as the “piracy paradox.” The fashion industry is very dynamic. We all know that fashion trends get exhausted when everybody starts wearing similarly styled clothes. Knock-off/copycat designers help to make the design common quickly by flooding its respective market with counterfeits. For a designer, the sooner the trend ends, the better it gets for them to bring new trends into the market, ultimately leading to people demanding a new style of clothing, bringing economic gains for the designers.

Ugandan IP laws do not protect the design as a whole since most fashion apparel is deemed functional. Instead, IP laws protect the rare elements of the garment design that are physically and conceptually separable from the garment’s function. For example, fabric, patterns, sketches, graphics, logos, etc. The IP of a fashion design exists through these various ingredients and not for the design as a whole.

We have seen an increase in IP litigation due to the designer not being able to get credit for the article she creates without being able to exploit his work. The design labels like H&M, Zara, Levis, Uniqlo, and the like should be proactive to file for registration of their designs if the design is new or original, as they produce in bulk quantities. Designers who produce under 50 in quantity should also register their designs under copyright law.

Intellectual property protection promotes innovation. Without the protection of IP, there is no incentive for the creator to create novel artwork or designs. Creativity and innovation are indicators of a healthy society. The fashion industry is in need of a *sui generis* protection of its IP similar to the proposed fashion law in the US to protect the rights of designers. There is a need for comprehensive fashion law. If policymakers are not keen enough to bring separate legislation categorically dealing with fashion law, they can at least initiate amendments in the existing legal mechanisms to make them more conducive to the fashion industry.

Fashion law in the United States of America has traditionally and historically been denied the copyright protection.²⁰ The basis for this denial lies in the belief that garments and clothes are items of utility devoid of any copyright elements.²¹ Fashion has been an integral part of the copyists' regime although it stands more in current years. In United States of America several forms of intellectual property are available for designers. Under the trademark law, a designer may protect his fashionable goods by investing in a distinctive logo and trade name that the consuming public recognizes as an indicator of the fashion article's resource.²² A designer can seek trade dress protection in United States of America in the overall look of the product to the consumers. Designers may apply for the design patent which protects new and original designs of the manufacturer. The most recent protection that is granted is Innovative Design Act of 2012. This act grants protection to the fashion designers for a period of three years and would prohibit the claim that a fashion design was copied from a protected design.²³ The Fashion Foundation of India a newly constituted body consisting of the leading designers from India seeks protection of the Intellectual Property Rights against infringement and rampant copying.²⁴ The intellectual property regime in India provides for the protection under the design act 2000, the copyright act 1957 and the Geographical Indications of Goods (registration and Prohibition act) 1999. Although there seems to be three different legislations that protect the regime of fashion apparel and designs. The artistic works in the sketches of the designs is protected under the Copyright Act 1957.²⁵ The Design Act 2000, provides protection to the nonfunctional

²⁰ Concept of fashion law and its background by Pranav Kaushal

²¹Ibid.

²²Michael p. Ryan, PhD, introduction: intellectual property and the creative and innovative economy

²³Fashion Law Institute' (Fashion Law Institute, 2017) <http://fashionlawinstitute.com/fashion-law-pop-up-clinic> accessed 25 January 2019.

²⁴<https://lawcorner.in/concept-of-fashion-law-and-its-background//>

²⁵<https://lawcorner.in/concept-of-fashion-law-and-its-background//>

aspect of non-object having visual appearance which include the features of shape configuration, pattern, and composition of line and color pattern. The third schedule of the Design Rules 2001 provides an exhaustive list of products and articles in respect of which an application can be made to the controller. Such design right remains in force for a period of ten years extendable to the certain conditions for a total period of 15 years.²⁶

Creativity is an intrinsic part of human nature, not a byproduct of the intellectual property system. Poets would continue to write, musicians to sing, and fashion designers to sew even if all copyright protection were eliminated tomorrow. While the concept of intellectual property is only a few hundred years old, archaeologists have recently discovered 100,000-year-old shell necklaces, which they interpret as the first evidence of human symbolic thinking. The goal of the IP system, however, is not merely to ensure that authors put pen to paper or needle and thread to fabric, but to encourage and reward individuals so that they can continue to develop their ideas and skills in a productive manner. In other words, intellectual property law ideally serves as a tool for harnessing and directing creativity. For this reason, the Constitution empowers

Congress “[t]o promote the progress of science and useful arts.” It is this “progress” over time that is hindered by the lack of legal protection for fashion design.

Young designers attempting to establish themselves are particularly vulnerable to the lack of copyright protection for fashion design, since their names and logos are not yet recognizable to a broad range of consumers. These aspiring creators cannot simply rely on reputation or trademark protection to make up for the absence of copyright.

²⁶<https://lawcorner.in/concept-of-fashion-law-and-its-background//>

Instead, they struggle each season to promote their work and attract customers before their designs are copied by established competitors. Fashion design is now recognized as a form of creative expression.

The origins of copyright law date back to the Enlightenment era, a

period that also articulated the Western distinction between art and craft. As copyright developed and extended to include various forms of literary and artistic works, it continued to maintain the division between legally protected, high status "fine art" and mere "decorative arts" or handicrafts. The design and manufacture of clothing, which for most families was a household task, did not rise to the level of creative expression in the eyes of the law.

Even after fashion design became increasingly professionalized during the nineteenth century, with the development of both haute couture and ready-to-wear sectors, the U.S. failed to recognize its creative status. Contributing to this low valuation was fashion's association with women rather than men, a shift influenced by the Industrial Revolution. By the end of the nineteenth century, American sociologist Thorstein Veblen famously linked fashion with "conspicuous consumption," concluding that the role of the female was "to consume for the [male] head of the household; and her apparel is contrived with this object in view." \4\ Both the feminizing of fashion and the intellectual attention to consumption rather than production prevented the legal recognition of fashion as a serious creative industry.

The internet era calls for new strategies to protect creativity

Creative fashion designers in earlier periods fought copyists by relying on strategic measures like speed and secrecy, the social norms of the industry, and perhaps patterns of consumer behavior. In the absence of sufficient copyright

protection under Ugandan law, these extralegal mechanisms are an important part of the fashion business. Today, however, the same speed and accuracy of information transfer that affects the music and film industries is also having an impact on fashion. Would-be copyists no longer have to smuggle sketch artists into fashion shows and send the results to clients along with descriptions of color and fabrication. Instead, high-quality digital photos of a runway look can be uploaded to the internet and sent to copyists anywhere in the world even before the show is finished, and knockoffs can be offered for sale within days--long before the original garments are scheduled to appear in stores. Fifty years ago, design houses may have been able to impose somewhat successful embargoes on the press; now, such efforts are futile.

Similarly, the claim that knockoffs enhance demand for ever-newer luxury goods among status-seeking consumers, an economic argument dating back to at least 1928,⁵ fails to take into account the modern speed of production. Once upon a time it may have been that the adoption of a new luxury item by affluent trendsetters was imitated first by wealthy consumers, then by the middle class, and then in form of knockoffs by everyone else, at which point the fashion-forward would abandon the item and demand the next new thing--which producers were happy to provide. Today, however, this "fashion cycle" scenario is rendered obsolete by the fact that poor quality knockoffs can be manufactured and distributed even more quickly than the originals, leaving creative designers little opportunity to recover their investment before the item is already out of style. Even if the fashion cycle were ever sufficient to support the design industry, that is no longer the case.

EFFECTS OF DESIGN PIRACY

The lack of copyright protection for fashion design negatively affects both individual designers whose expressions are copied and the intellectual property system as a whole. As a law professor with a website dedicated to IP and fashion, I frequently receive messages from young designers whose work has been stolen or who hope to prevent the copying of their designs. It is with

regret that I must repeatedly explain that while that law can protect designers' trademarks against counterfeiters, in the U.S. the actual designs are fair game for copyists.

A. Impact on Designers

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Instead, they struggle each season to promote their work and attract customers before their designs are copied by established competitors.

Over the past century successive waves of American designers have entered the industry, but few fashion houses have endured long enough to leave a lasting impression comparable to the influence of French fashion. While it is difficult to quantify or even identify designers who give up their businesses, particularly for reasons of piracy, there is strong anecdotal evidence that design piracy is harmful to the Uganda fashion industry.

UGANDAN CASES

Migoo industrial and Trading Company (U) Limited V Rida international Industry (U) Limited Civil Suit Number 0359 of 2019(unreported). This was the first landmark Ugandan case to deal with particularly an infringement of industrial design rights before Hon. Justice Stephen Mubiru. The plaintiff was claiming an infringement of his industrial design and passing off by the defendant for starting to manufacture and sell gumboots similar to that of the Plaintiff in 2018. The Plaintiff had way back in 2012 started to manufacture the said Gumboots. The issue before court was whether there was an infringement on the plaintiffs' industrial design.

In his ruling, Hon. Justice Stephen Mubiru relied on Section 71 of the Industrial Property Act 3 of 2014 to give a literal meaning of industrial design. He further ruled that on the examining the Gumboots they looked similar and it would need a very keen eye to tell the difference. It is also important to note that court leaned with the test of an ordinary user who is likely to face a confusion of the tow gumboots, an average consumer would believe that the goods in question come from the same undertaking. Be that as it may court granted the remedies sought by the Plaintiff including an injunction stopping the defendant from infringing on the plaintiff industrial design.

Confoam Uganda Limited V Megha Industries (U) Limited Civil Application Number 020 of 2015, Following the consent judgement in

H.C.C.S Number 269 of 2011 where the respondent had successfully sued, the Applicant then sought an order staying the execution of paying exemplary damages worthy Uganda shillings 300M and a fine of 100M Until the determination of the intended appeal. In the consent judgement, the applicant had been stopped from manufacturing, sell or distribute mattresses which court determined to be a replica of the respondent registered trade mark. The court in this application, albeit granted the order for staying the execution but gave an order to the applicant to use a design cover which has only one plain color and a company log until the Appeal is determined.

In another case of Britania Allied industries limited V Aya Biscuits (U) Limited (HCT-00-CC-CS 24 OF 2009) [2012] The plaintiff a manufacturer and marketing company of biscuits known “Marie Classic” and “Big Maria”, the plaintiff had dropped the claim for trade mark infringement but maintained that the defendants had deliberately been passing of their product under the name “Marie” disguised in the same color and packing layout as those of the plaintiffs. During the trial the parties had placed a lot of emphasis on the get up of the two brands of Marie biscuits. On determining the crux of the matter in court based the law of passing off and trade mark law having common roots and therefore similar however a passing off actions arise strictly out of unregistered marks to which the plaintiffs’ goods now fall into. The court relied on section 34 of the Trade Mark Act (No.17 of 2010) providing that no action can be maintained for an unregistered mark under the Act provides that it does not affect a right of action for passing off goods to another. Court found out that the defendant tendered get-ups of maries in a number of color packages ranging from blue, green, gold, purple, white, blue, colorless among others. Court found out that the get-ups were indeed similar. However even when there are competitors of similar products goodwill in an existing product should be protected. And for Marie biscuits as other colors are also used in different parts of the world and is therefore not sufficient to displace the test of misrepresentation

Vision Impex Limited V Sansa and Anor (Civil Suit Number 303 of 2013) [2017] the plaintiff sued for an infringement and passing off the Trade mark of “FEATHERS” sanitary pads which the plaintiff had widely advertised in Uganda and had a big reputation in its color. The company dealt in sanitary pads –marketing and promoting the product ABC “Feathers’ sanitary pads. Described as Ultra Compact Sanitary Pads with wings and are light blue in color. The product was registered in June 2003, and when the certificate expired in 2010, it was renewed for another 14 years. The plaintiff got information by the UNBS staff that similar sanitary pads had been imported on the Spedag interfreight (U) limited and the consignee was Sansa Ambrose the first defendant. Upon checking, it was noted that the pads are similar to those marketed by the plaintiff company, the name being similar “Feathers”, the color is the same, and the style of the font is the same like that on the products of the Plaintiff company. The plaintiff asserted that the defendants’ “FEATLHERS” sanitary pads imported from Malaba were meant to mislead the public as goods of the Plaintiff. It sought an order of permanent injunction. Among the issues to be determined included whether the plaintiff had right to exclusive use of the trade Marks by the plaintiff. Court held that the plaintiff being the undisputed “proprietor” of the disputed Trade Marks has the exclusive right or title to the use of the same. The court had used the definition of a trade mark under section 1(1) of the Trade Marks Act to give its literal meaning. Court further held on the other issue of infringement of the Plaintiffs’ trade mark that goods as imported by the Defendant were so similar to those of the Plaintiff that there was a great like hood of confusion by those wishing to buy the Plaintiffs’ goods. Court further held that the customer seeing the name “Feathers” or “Featlhers” at a quick glance would probably assume it’s the same. Therefore, the importation and selling of “Feathers” sanitary pads by the defendant was an infringement of the Plaintiff trade mark of sanitary pads in its color.

Anglo Fabrics (Bolton) Limited and Anor V African Queen Limited and Anor (HCT-00-CC-CS 632 OF 2006) [2008]. The 1st plaintiff is registered Company under the Laws of United Kingdom and 2nd Plaintiff is a sole registered user in Uganda of the 1st plaintiff registered Trade Marks. the plaintiffs claimed there was an infringement of the 1st plaintiffs' trade mark for trading, selling and disposing off in Uganda medicated soap bearing its registered trade mark "Mekako" by the defendants. Court among other issues to be determined included whether the product imported by the defendants infringes on the plaintiffs' trademark in Uganda, the court on examining the packaging of the plaintiffs' product and the defendants' product and the get-ups of the two products are the same, the visual features which distinguish a trader's goods, and court determined the issue in Affirmative that there was infringement by the defendant importing into the country a soap product known as mekako. Another issue was whether the word Mekako is registered as an international trademark. The plaintiff was contended that the rights in trademarks accrue on registration of a trademark. Court held that the existence of a trademark must be supported by proof of registration of the same. The defendants had not adduced any evidence either orally or documentary to prove thatr the soap they imported for sale in Uganda and which bears the plaintiff's registered marl Mekako was imported under an international trademark. In the absence of any evidence showing that the mark Mekako used by the defendants had been registered under the relevant protocol or that Uganda was a designated member state for purposes of the trademark, the court found out that the word "Mekako" is registered as an international trademark and failure to prove this by the evidence adduced.

The infringing soap which was in the custody of the Uganda Revenue Authority, justice Yokoramu Bamwine ordered them to be delivered upto the plaintiffs for destruction under the supervision of the officials of the Uganda National Bureau of Standards.

From a legal perspective, little has changed in almost seventy years. Handbag designer Jennifer Baum Lagdameo co-founded the label

Ananas approximately three years ago. A young wife and mother working from home, Jennifer has been successful in promoting her handbags, which retail between \$200 and \$400. Earlier this year, however, she received a telephone call canceling a wholesale order. When she inquired as to the reason for the cancellation, she learned that the buyer had found virtually identical copies of her bags at a lower price. Shortly thereafter, Jennifer discovered a post on an internet message board by a potential customer who had admired one of her bags at a major department store. Before buying the customer looked online and found a cheap, line-for-line copy of the Ananas bag in lower quality materials, which she not only bought but recommended to others, further affecting sales of the original. While Ananas continues to produce handbags at present, this loss of both wholesale and retail sales is a significant blow to a small business.

Copying is rampant in the fashion industry, as knockoff artists remain free to skip the time-consuming and expensive process of developing and marketing new products and simply target creative designers' most successful models. The race to the bottom in terms of price and quality is one that experimental designers cannot win. Nearly every designer or even design student seems to have a story about the prevalence of copying, a situation that makes the difficult odds of success in the fashion industry even longer.

DESIGN PIRACY AND COUNTERFEITING

Not only does the legal copying of fashion designs harm their creators, it also provides manufacturers with a mechanism for

circumventing the current campaign against counterfeit trademarks. If

U.S. Customs stops a shipping container with fake trademarked apparel or accessories at the boarder, it can impound and destroy those items.

If, however, the same items are shipped without labels, they are generally free to enter the country--at which point the distributor can attach counterfeit labels or decorative logos with less chance of detection by law enforcement. There is a lot of counterfeit logos to otherwise legal knockoffs at the point of sale; after the consumer chooses a knockoff item, the seller simply glues on a label corresponding to the copied design. The continued exclusion of fashion designs from copyright protection thus undermines policy with respect to trademarks by perpetuating a loophole in the intellectual property law system.

The fashion industry thrives by rapidly creating new designs. Via this continuous re-definition of what is "in style," the industry sparks demand by consumers for new apparel. This process results in consumption of fashion goods at a level above what would otherwise occur. It also permits many apparel items to be sold at lower prices than would be possible were fashion design protected by the intellectual property laws. To remain healthy, the fashion industry depends on open access to designs and the ability to create new designs that are derivative of them. The industry has thrived despite the lack of design protection; we are very hesitant to interfere with such success.

Fashion designers do have access to some other Intellectual

Property rights both in trademark and patent law. However, trademark law protects the elements of a design that indicate the source of the product but does not provide general protection for designs. In patent law, there is the potential for design patents, but this route of protection often is not practical for designers because of the length of time it takes before the patent issues combined with the typical life span of a fashion design which is only a single season, maybe 3 to 6 months. Further, design patents require a level of novelty

and originality that has generally been held to be higher than that which is achieved by fashion works.

The fashion industry is unique, in that it epitomizes the ultimate paradox of Intellectual Property protection. The arguments I have heard illustrate both sides of the debate. Is a high level of protection necessary to promote innovation, or does the lack of a high level of protection for fashion designs actually spur increased creativity in the fashion industry? Furthermore, in part as a result of the great speed with which fashion trends come and go, new fashions are available in the high end designer stores and in the low end retail outlets, making these fashions available to virtually all individuals regardless of their income level. Will an increased level of protection for designers, be at the detriment of the retailers and the public? Copyright protection to fashion designs and are there other areas which we should also consider extending protection to such as, for example, the furniture and auto part industries. In 2001, the Supreme Court clearly stated that the danger of anticompetitive overprotection is especially high in the case of product design. The Court in *Wal-Mart v. Samara Bros.*, said "It seems to us that design, like color, is not inherently distinctive . . . Consumers should not be deprived of the benefits of competition with regard to utilitarian and aesthetic purposes that product design ordinarily serves by a rule of law that facilitates plausible threats of suit against new entrants." Although that case involved a determination of protectibility under the Trademark Act, the Court's opinion about the role of federal law in protecting product designs is clear and indisputable.

TYPES OF FASHION

1. HAUTE COULTURE

This is a French word for high sewing or high dressmaking. It refers to the creation of exclusive custom-made clothing. It is made to order (custom made) for a specific customer and it is usually made from high-quality,

expensive fabric and sewn with extreme attention to detail and finish often using time-consuming, hand executed techniques.²⁷

It originally referred to Englishman Charles Fredrick Worth's work, produced in Paris in the mid-nineteenth century. In modern France, Haute couture is a "protected name" that can be used only by firms that meet certain well-defined standards. However, the term is also used loosely to describe all high-fashion custom-fitted clothing, whether it is produced in Paris or in other fashion capitals such as Milan, London Rome, New York and Tokyo²⁸

2. PRET-A-PORTER.

Pret-a-porter is the French word for the term "Ready to wear." Ready to wear is the fashion design term for clothing marketed in a finished condition (ready-made), in standard clothing sizes. In the fashion industry, designers produce ready-to-wear clothing intended to be worn without significant alteration, because it is by far the most economical, efficient and profitable way to produce garments. They use standard patterns, factory equipment and faster construction techniques to keep costs low, compared to a custom-sewn version of the same item. Some fashion houses or fashion designers create ready-to-wear lines that are mass-produced and industrially manufactured, while others offer lines that are very exclusive and produced only in limited numbers for limited time usually to specific wholesalers.

Ready-to-wear collections can also be divided into designers/creator collections and confection collections.

a) Confection collections or mass market are the ones we see most commonly in our shops. Stylists design these collections. The brands that produce these

²⁷<https://www.slideshare.net/urmila2008/nature-of-fashion>

²⁸ ibid

collections aim only for a mass public and are in the general not searching for a new point of view on fashion.²⁹

b) designer/creator collections.

Have a high quality a superb finish and a unique cut and design. These collections are the most trendsetting compared to HAUTE Couture and confection. These ready to wear collections often contain concept items that represent a certain philosophy or theory. These items are not created for sales but only to create a fashion trend. The designer's ready-to-wear collection is modeled on international catwalks.³⁰

3. LUXURY FASHION

Luxury fashion constitutes the fashion design that bridges the gap between exclusive, bespoke, custom made garments and mass-produced, readily available clothing. Luxury fashion includes high-quality articles of clothing that are not hand –made but are also not produced in large quantities.³¹ While luxury fashion items are still not as expensive as haute couture items, the prices are high enough to still give consumers a sense of being part of an elite market, with some of the steep prices placing the items outside the buying range of many average consumers. The luxury fashion market continues to grow, and it is expected to continue growing for the foreseeable future. As such there will be a continued need for skilled fashion designers in this market area.³²

4. FAST FASHION.

²⁹ *ibid*

³⁰ *ibid*

³¹ <https://larivierefashion.com/types-of-fashion-design/>

³² *Ibid.*

The majority of apparel brand names that average consumers are familiar with are most likely fast fashion brands. Fast fashion consists of mass-produced clothing with a very rapid turnover rate.

The driving idea behind fast fashion is the desire to put trendy, marketable clothing on the market as cheaply as possible. These fashion designs usually jump from catwalk shows to retail hangers in a lightning-quick process. Some of the most notable fast fashion houses can have pieces developed, produced and in the store within a couple of weeks of the inspiring fashion show. Other companies may take up to six months to replicate these trends. Fast fashion design is less tethered to the idea of seasonal collections of clothing. While luxury and high-end ready-to-wear design houses will often release new clothing on a seasonal basis, fast fashion will frequently buck this trend and release multiple pieces every week.³³

5. ECONOMY FASHION.

At the bottom of the fashion design hierarchy is economy fashion. This level of fashion is below even fast fashion, with the ultimate goal being solely to mass-produce garments in the most efficient manner and ship them to stores.³⁴ The goal of most economy fashion is for the producer to turn a profit, so usually, the cheapest labor and materials used. Economy fashion designs may take general inspiration from seasonal trends but often cannot replicate exact trends due to constraints on budget and time. Economy fashion starts by producing an absolutely massive quantity of clothing, which will then be sold for a relatively low price. Economy fashion is generally the least environmentally friendly type of fashion design. The very low-quality standards result in a short lifespan for garments, and pieces are released on a slower basis, often in the peak of a trend, which makes them out of style much sooner thanks to the rapidly shifting trends governed by fast-fashion.³⁵

³³<https://larivierefashion.com/types-of-fashion-design/>

³⁴ *ibid*

³⁵ *ibid*

CHARACTERISTICS OF FASHION.

1. FASHION IS A GROUP CHOICE. Fashion is not an individual choice but is a group choice. So long as a particular choice remains confined to an individual, it may better be called “style” and no fashion. The style becomes a fashion when adopted by a number.

2.FASHION IS CHANGEABLE: The important characteristic of fashion is its changing nature. If it survives long, it ceases to be a fashion and may become a folkway or mores.

3. THE ELEMENT OF UTILITY MAY OR MAYNOT BE PRESENT IN FASHION. A fashion may be adoptedfor some utilitarian purpose, but it is not essential that every fashion should carry some utility nor can it be said that all fashions are useless.

4. FASHIONS ARE ALL PERVADING: Fashions embrace a large part of human lifeww. They can be seen in numerous fields, from speech to dress. Fashions are found in evry society.

5. UNIFORMITY: Due to the rapid means of transport fashions spread from one corner to the other corner of world.

6.MADDENING TEMPO: sometimes fashions change so quickly that it becomes difficult to be in step with the changing fashions.

FASHION LAW AND FASHION INDUSTRY IN UGANDA.

Uganda’sfashion industry is characterized by struggling ventures, semi-professional small scale production, small –scale production and lack of influstrature, institutions and government support.³⁶Although fashion is one

³⁶<https://www.theeastafrican.co-ke.cdn.ampproject.org/v/s/www.theeastafrican.co.ke/tea/magazine/the-changing-face-of-ugandan-fashion->

of the most active sectors of the creative industry in Uganda, it is still grappling with systemic challenges.³⁷

The copyright and neighbouring rights act 2006 provides for a limited protection of copyright to some fashion designs. Section 5 (1)(f) provides for works of applied art, whether handicraft or produced on industrial scale and works of all types of designing.³⁸

Depending on how a case is presented protection of fashion under the patent system or copyright can be accepted³⁹

In Uganda fashion has always been and will be a reflection of society. It cannot happen in a vacuum. In the 1960's women wore minis, teetered on platform heels, some boldly went braless (the mind boggles) and the huge afros were the in-thing. African states were getting independence from white and in America, the black civil movement was embraced." According to Keturah Kamugasa, a fashion icon, who works with the new vision.

The 1960's

Sanny Kirya first lived in the rural areas, but later tasted the urban life and never turned back. She had a feel of the fashions that dominated the social scene during the 1960s and years later. She says afros were the in-thing. Men too kept their hair long unlike today where they prefer having it short. Others stuck in their hair, a wooden comb as an accessory. According to Joyce

3208384?amp_js_v=a6&_gsa=1&vieww=html&usqp=mq331AQKKAFAQrABI IACAw%3D%3D#aoh=16420537726561&referrer=https%3A%2F%2Fwww.google.com& amp_tf=From%20%251%24s&share=https%3A%2F%2Fwww.theeastafrican.co.ke%2F tea%2Fmagazine%2Fthe-changing-face-of-ugandan-fashion-3208384 accessed on Thursday, 13th January 2022.

³⁷<https://www.theeastafrican.co.ke/tea/magazine/the-state-of-clothing-industry-in-uganda--1383260>

³⁸<https://m.facebook.com/kampalalawmonthly/posts/the-fashion-law-thinking-ugandanby-kampala-law-monthly-magazine-teamphoto-credit/298784240520442/>

³⁹ ibid

Mpanga, women too had style in dressing although most of them went for the British conservative style. She is one of the people who attended the live event at kololo and even went for the garden party. Many women adopted suits, hats and body stockings as their signature wear throughout the early 1960s. They also wore long dresses mimicking the British conservative culture. Even for brides, the fashion was not exceptional, on her wedding in 1965, Mpanga's changing dress had a full length coat, with a hat and gloves. Among the upper class traditional wear remained a reserve for traditional ceremonies. Women elevated their height with the closed platform shoes nicknamed Gabon, which also gave them a chic look. Those shoes have now been replaced with the sharper stilettos, pumps and wedges. Kirya also remembers dresses famously known as twist and tight. They adopted this name because of their style and what they could enable the wearer to do. Much as they were tight from top to waist, they were free following to allow her twirl around when during the twist dance. These dresses with pleats made a great fashion comeback in the 21st century.

Transition in 1970s

Liberations that were occurring around the world in the 1960s and 1970s like the black power movement, feminist movement and birth control movement started impacting on Africa too. According to Fashion expert Keturah Kamugasa, fashion in the 1970s reflected a sense of freedom, courage and liberation. Women had more courage to expose acres of leg and thigh. The 1970s saw the disco era, neon eye shadow, psychedelic colours and prints, polo necks and wide bell bottomed trousers, which were a sign of liberation. Ladies too donned trousers though still held on to their dresses and skirts which they deemed as more feminine and elegant.

“people then had so much respect compared to people now,” rebuts Kirya. She adds that today, the connotations are quite different. “while back in the days, wearing short skirts could have been merely interpreted as ‘riding with the

tide,'today, it is different. The girl may be labeled as a slut for wearing similar clothing.' Kirya explains.

Between 1980s and 1990s

In the late 1980s and 1990s, a woman risked being undressed if she dared go downtown in a mini. In 2000s, however, the perception changed and woman would freely wear mini attire. For the men, bell bottom trousers were the in thing. Everyone made an effort to have a pair of the trousers. At first, they had turn-ups, but later dropped them. Overalls too were both worn by the men and women albeit in different fashion to suit the sexes. Double braced coats first made their arrival and then were partly followed by the coats with back slits. Round hats were a vital accessory for every man unlike today. Most old men likened those hats to respect and therefore wore them all the time.

Liberation.

According to kamugasa, the 1980s were the time for masculine tailoring and huge shoulder pads as women took positions previously jealously guarded by men. Women were now running the corporations. In order to be taken seriously in and out of the boardroom, they dressed like men for work. Come the 1990s and we see women's fashion softening a bit as both men and women came to the realization that women were not mere visitors at the top of social, corporate, political or economic. Uganda has experienced all these changes along with the rest of the world, albeit in her own context. The 1990s ushered in plenty of glamour and lots of freedom. There is no so much fear in revealing clothing or rather exposing their undergarments. Women are more visible in all arenas now and they have disposable income that allows them to shop wherever they want, wear what they want and vote for whom they please. With political representation and women's movement, the woman now had a

voice and can fight for her rights. That could be the reason why she is now free to expose as much flesh as she wants.⁴⁰

OVER VIEW OF FASHION LAW IN UGANDA

The law protects the fashion itself and designs. It is the easiest way business property can be protected using the industrial properties act 2014. The protection designers choose is the patent utility model or industrial design and copyright protection which is limited in a sense.⁴¹ Before anything can have protection, under the patent system, it must be novel, involve an inventive step and have an industrial application. All three characters must exist for a patent to be granted. The authors of the act, having realized the difficulty in satisfying the requirements of the act, set the less rigorous protection of utility models and industrial designs.⁴²

If fashion designers fail to get patent protection, they can apply for a utility model or industrial design or both. For anything to qualify for protection as a utility model, it should be new and have an industrial application. While an industrial design should be new only.⁴³ Ugandan inventions have been communal in ownership, exploitation and use. They have been used for centuries as the culture has existed. This aspect has its own apologists who argue that intellectual property legislation in underdeveloped countries are under-utilized because they failed to take into consideration, the cultural history and nature of intellectual property in such countries such as Uganda.

⁴⁰<https://ugfacts.net/Uganda-fashion/> accessed on 13th/01/2022.

⁴¹<https://m.facebook.com/kampalalawmonthly/posts/the-fashion-law-thinking-ugandanby-kampala-law-monthly-magazine-teamphoto-credit/298784240520442/>

⁴²<https://m.facebook.com/kampalalawmonthly/posts/the-fashion-law-thinking-ugandanby-kampala-law-monthly-magazine-teamphoto-credit/298784240520442/>

⁴³ *ibid*

The imposition of a copy paste legislation, has now fully moved from colonial times, to neo-colonialistic capitalism. This is not good for us. But we cannot negotiate because our soft power money is not deep.⁴⁴

The Act is a capital one. It thrives in environments of high level capitalism, good education and nurturing. Uganda doesnot have that. Our innovative powers are so low. Samson Mugarura, the makerere university student who allegedly invented tear gas actually never made something new. He duplicated the industrial process that was already available and used only one raw material, sugar and some scattered foods around. Infact tear gas is made out of eight raw materials which are, Charcoal, Potassium nitrate, Silicon, Sucrose, Potassium nitrate, silicon, sucrose, potassium chlorate, magnesium carbonate, O-Chlorobenzalmalononitrile, nitrocellulose. Leave kiira-EV car aside. Do we need patents in uganda. Maybe not for the mean time.⁴⁵

For fashion and designs, if Ugandans are innovative enough, the patents system can be used.

In *STAR ATHLETICA V VARSITY BRANDS*⁴⁶ , in October 2016, the supreme court heard an appeal by star Athletica, a cheerleading uniforms company, of a 2015 ruling by the Cincinnati-based 6th U.S. circuit court of Appeals in the law suit filed by varsity brands inc, the dominant U.S maker of cheerleader uniforms, accusing its smaller rival of infringing five of its designs. The case centers on whether the stripes, zigzags and chevrons characteristic of cheerleader uniforms can be copyrighted, as varsity contends, or are so fundamental to the purpose of the garment that they

⁴⁴<https://m.facebook.com/kampalalawmonthly/posts/the-fashion-law-thinking-ugandanby-kampala-law-monthly-magazine-teamphoto-credit/298784240520442/>

⁴⁵ ibid

⁴⁶ Inc, 580 U.S (2017)

should not get such legal protection. Without such adornments, a cheerleader uniform might look like any other dress, star argued.⁴⁷

In *PUMA V FOREVER 21*⁴⁸ forever 21 is offering lookalike versions of footwear from Rihannas Fenty line for Puma, the German sportswear giant slapped the copycat retailer with a design patent, trade dress, and copyright infringement law suit. Puma set forth claims of design patent, trade dress and copyright infringement. In connection with the latter, Puma's counsel applies the test defined in the star *Athletica v varsity brands* decision, citing: "The Fenty copyrights

a) can be perceived as a two -or -three-dimensional works of art separate from the fenty shoes and

b) would qualify as protectable pictorial, graphic or sculptural works either on their own or fixed in some other tangible medium of expression."

In particular, Puma cites the following as the copyright-protected elements of its footwear: The "ridged vertical tooling and grainy texture encompassing the thick rubber outer sole" for the creeper; the "wide plush fur strap extending to the base of the sandal" for the Fur slide; and the "casually knotted fabric bow with pointed endings atop a lined side strap that extends to the base of the sandal" for the bow slide.⁴⁹

*APPLE V SAMSUNG*⁵⁰ in December 2016, the U.S Supreme court ruled that a lower court should revisit a multi-million-dollar damages award handed to Apple Inc. in connection with rival Samsung's copying of the iPhone patent-protected design. The unanimous decision extends a legal

⁴⁷<https://www.thefashionlaw.com/5-lawsuits-that-stand-to-impact-the-fashion-industry/> accessed on January 13, 2022

⁴⁸ Inc.No. CV17-2523 PSG Ex,2017 U.S. Dist.LEXIS 211140 (C.D.Cal.June 29,2017)

⁴⁹<https://www.thefashionlaw.com/5-lawsuits-that-stand-to-impact-the-fashion-industry/> accessed on January 13, 2022

⁵⁰ 786.F.3d 983 (Fed.Cir.2015).

battle that dates back to 2011 and at one point, spanned the globe and engulfed every major maker of smart phones. Samsung appealed to the supreme court, arguing that \$399 million of the \$548 million in damages it had been ordered to pay Apple –in connection with a 2012 jury verdict-for copying the designs of the I phone’s rounded corner front face, bezel and grid of icons, were excessive. The phone-maker also argued that those patent-protected features contributed only marginally to a complex product.⁵¹ Writing for the court, Justice Sonia Sotomayor said Apple might not be entitled to Samsung’s entire profits on 11 fringing smartphones. She told a federal appeals court to consider whether Apple should be able to recoup profits attributable only to particular components as opposed to the designs as a whole. As a result, the Supreme Court’s ruling and the lower courts decision which is still pending stands to have a widespread impact on patent infringement damages awards going forward.⁵²

In *RAJESH MASRANI V TAHILIANI DESIGNS PVT.LTD*⁵³ , In this case, the question arose within the court that does the patterns printed on the fabrics qualifies as artistic work or not and can it be protected under copyright act and design act. It was contended by the respondent that other than the copyright protection granted to the fabric designs which are drawn for production even the patterns printed on the fabric should be protected under the design act. The present case was an appeal as under the previous judgement Rajesh Masrani was prohibited from producing, selling or advertising any kind of similar fabric.

The court stated that any such designs only come under the ambit of copyright protection when not more than 50 such commodities are produced for commercial use. While in the present case only 20 pieces with the specific

⁵¹<https://www.thefashionlaw.com/5-lawsuits-that-stand-to-impact-the-fashion-industry/> accessed on January 13, 2022

⁵² Ibid.

⁵³ On 28th November 2008

design were created due to which justified protection was granted and any similar printing, selling or advertising of a similar pattern was prohibited.⁵⁴

STATE OF THE FASHION INDUSTRY IN UGANDA.

Uganda's clothing industry has been dominated by second hand garments for decades until the government debuted an initiative to help boost local production. Now, the local fashion industry is experiencing a boom, and people don't want to turn back.⁵⁵

In a country where used clothing fuels local fashion markets, ready-made clothing that was manufactured domestically can be hard to find.

Uganda is undergoing a fashion transformation. For decades, the primary options for clothing were used garments imported from Europe or custom-made pieces created by local tailors.

Now, the country has a fresh version of its own garment industry.

Excitement is growing around Uganda-made products because of a government initiative called Buy Uganda Build Uganda (BUBU), launched in 2014 and implemented in 2017. The initiative promotes a series of policies, including one that requires 20% of the government's procurement to be of local products and services. Footwear, pharmaceuticals, plastics, tea and leather products were among the original focus sectors.⁵⁶ Economists recognise the fact that that second-hand clothes play a critical role in creating employment in the retail clothes sector and earning revenue for the

⁵⁴<https://legaldesire.com/landmark-cases-related-to-fashion-industry-in-2020/> accessed on Thursday, January 13, 2022

⁵⁵<https://globalpressjournal.com/africa/uganda/uganda-local-fashion-industry-gets-government-boost/>

⁵⁶<https://globalpressjournal.com/africa/uganda/uganda-local-fashion-industry-gets-government-boost/>

government but with actual figures on employment and government taxes lacking, no one knows the extent.

Figures from the US International Trade Commission show that Uganda imports at least 1,500 tonnes of second-hand clothing annually from the United States alone, while another 2,000 tonnes is imported from the UK, Canada and China.

According to the Uganda Manufacturers Association, the East African Community's annual expenditure on used clothes imports is \$350 million, and is growing at a rate of 60 per cent annually.

According to the Office of the United States Trade Representative, EAC countries are some of the most important markets for US used clothing exports, with direct exports to the EAC countries being at approximately \$24 million in 2016.

USTR adds that the US imports under the African Growth and Opportunity Act (Agoa) from Uganda, Rwanda and Tanzania, was \$43 million in 2016, up from \$33 million in 2015, while exports to the three countries rose from \$257 million in 2015 to \$281 million in 2016. The trade in apparels and used-clothes therefore favours the US.⁵⁷

The country's textile industry, particularly in the form of school uniforms, was identified in other government documents as a key area for investment. The initiative has since been rebranded as Zimba Uganda, but is still widely known as Buy Uganda Build Uganda.

There are now 15 major clothing manufacturers in Uganda, according to information provided to GPJ by Jerome Nuwabasa, the officer in charge of textiles in the Ministry of Trade, Industry and Cooperatives.

⁵⁷<https://www.theeastafrican.co.ke/tea/magazine/the-state-of-clothing-industry-in-uganda--1383260>

It's a welcome shift for many Ugandans, who say they felt patronized by the fact that most of the clothes available at reasonable prices were hand-me-downs from foreign countries.

“The regime should be credited for making an effort to raise the status of many Ugandans, even teachers like us, from wearing used clothes from Europe,” says **Okunde Gloria**, a secondary school teacher.

The Ugandan government has tried to curtail the secondhand clothing market in the past. Along with other members of the East African Community, it agreed in 2015 to work toward banning the import of secondhand clothing in a bid to promote locally-made garments.

Some of those countries, including Uganda, added tariffs to secondhand clothes – a move that startled used clothes sellers. Hadija Nakakande, a spokesperson for Uganda's Ministry of Trade, confirmed that Uganda's tax is currently in effect.

Not everyone is happy about the bans. East African Community member countries are major recipients of secondhand clothing exports from the U.S.-based organization Secondary Materials and Recycled Textiles Association. The organization, also known as SMART, stated that such bans violate the African Growth and Opportunity Act, a U.S. trade act from 2000. That act requires signatory countries to eliminate barriers to U.S. trade, but lobbyists at SMART say bans on secondhand clothing do the opposite.

In 2018, U.S. President Donald Trump announced a suspension of Rwanda's apparel export eligibility duty-free to the U.S. in response to Rwanda's secondhand clothing ban. So far, Uganda hasn't been the target of a similar suspension, and Ugandans are excited about taking back their clothing industry.⁵⁸

⁵⁸ Ibid

Paul Baganizi owns a school uniform factory. He says he started his business with one sewing machine, which he used for tailoring. That was in 2003. Now, he says, his company has more than 200 sewing machines and over 120 workers. The company supplies uniforms to schools throughout the country, as well as in Kenya, Sudan and Rwanda. The BUBU initiative helped his company grow as the entire country got excited about Uganda-made goods, Baganizi says. The rising craze for fashion designed and made by Ugandans has attracted many local people to the industry. **Katende Ivan**, chairman of a group of tailors in Mackay Plaza, a shopping area known for its garment workshops, and **Namatovu Jamira**, who coordinates another section on the same floor, are no exception. They take large wholesale orders for clothing of all types from retailers.⁵⁹

The industry directly rewards good work and efficiency – customers will return items that are not well made, Katende says.

“If one is not very fast or thorough, that will determine how much they should get,” he adds.

Christine Nakaye, a dressmaker, says she feels a duty to serve other Ugandans.⁶⁰

“I could not think of making anything else apart from new bitenge garments,” Nakaye says, using the Kiswahili word that refers to fashion designed in Africa.⁶¹

Edna Namara, GPJ, translated some interviews from Runyankole.⁶²

⁵⁹<https://globalpressjournal.com/africa/uganda/uganda-local-fashion-industry-gets-government-boost/>

⁶⁰ ibid

⁶¹<https://globalpressjournal.com/africa/uganda/uganda-local-fashion-industry-gets-government-boost/>

⁶² ibid

One and a half years ago, 25-year-old Everist Mulindwa dug into his pockets and picked Shs1m, an amount he invested in second hand clothes, also called "Mivumba."⁶³

He had just completed Senior Six and it seemed like the most viable business option for him.

"It was easy to start so I took a million shillings off my savings and went into the business," Mr Mulindwa says.

The trader in second hand dresses and blouses says there has been a change in his life since then because he is assured of retiring home with Shs100,000 in profit every week. However, Mr Mulindwa says the looming ban on second hand clothes threatens his source of income.

He is not alone. Ms Racheal, a lady in her early 20s sells new and used underwear for women in Gazaland, a popular mall in downtown Kampala. The part time student tells me she has been in this business for two years because it is simple to operate and she earns daily.

"Depending on the season, for instance, Christmas time or holidays, I can earn Shs300,000 a day in profit. For young people, this is a trending business because they have seen the outcomes," she says with a faint smile.

But this could change if government endorses its ban on second hand clothes. Mr Mulindwa says this would mean many people like him would suffer, right from the importers to hawkers of these clothes. Racheal would have to devise other means of generating income.⁶⁴

⁶³<https://agoa.info/news/article/15217-uganda-what-ban-of-second-hand-clothes-means-for-businesses.html>

⁶⁴<https://agoa.info/news/article/15217-uganda-what-ban-of-second-hand-clothes-means-for-businesses.html>

What consumers say

For consumers like Ms Agnes Ampaire, the ban is unwelcome because of the currently distressed economy. She says most Ugandans can only afford second hand clothes.

Ms Anicia Atukunda, a loyal customer says she is unable to afford first hand clothes because they are expensive.

"With just Shs10,000, I am able to get myself three blouses to wear to office at Shs3,000 each yet the lowest you can get a new blouse is Shs10,000. I buy skirts at Shs5,000 while one new skirt costs Shs20,000 at least. I cannot afford that with my job that earns me Shs300,000 a month," she explains.

The customer care service agent also says besides affordability, used clothes are durable and unique, qualities that the local textile industry hardly provides.⁶⁵

Behind the ban

A local second hand clothes trader Ms Faridah Asiimwe confirms she has heard about the ban and insists this is a move by government to weed out competition in the textiles sector.

"I think rich people in government are bringing in new clothes and they want the ban so that their businesses run well," she says.

On the contrary, in 2015, East African Community (EAC) Heads of State interested the Council of ministers in promoting the textile and leather industries in the region and stopping the importation of used clothes into the

⁶⁵<https://agoa.info/news/article/15217-uganda-what-ban-of-second-hand-clothes-means-for-businesses.html>

region. This resulted from the need for EAC to partly boost industrialisation in member states.

In Uganda, the decision was informed by Vision 2040 which seeks to promote agro-processing and manufacturing of consumer products, and the 'Buy Uganda Build Uganda' policy which seeks to support the production, supply and consumption of local goods and services.

In 2016, several pleas from the East African Legislative Assembly (EALA) and players in the textiles industry followed for the ban to be effected immediately.

However, Trade Minister Amelia Kyambadde maintained that the trade would remain for a while.

"Uganda has decided to go slow on the ban on used clothes. The ban on secondhand clothes will be a gradual process as Uganda develops her textile and leather industries," Ms Kyambadde was quoted in Daily Monitor last year⁶⁶.

Civil Society weighs in

As local traders cry foul, Civil Society says there has been an exponential growth of second hand clothes in EAC. This growth hurts Uganda's textile industry.

Civil Society now wants government and other East African Countries to phase out the importation of second hand clothes to support budding industries, grow an integrated economy that creates decent jobs and improved welfare.

⁶⁶<https://agoa.info/news/article/15217-uganda-what-ban-of-second-hand-clothes-means-for-businesses.html>

Civil society's plight comes weeks after Uganda's eligibility to trade with the United States was placed under review over its position to ban used clothes.

The review is a result of a petition filed by Secondary Materials and Recycled Textiles (SMART) - a leading exporter of secondhand clothing in the United States, to the US administration in March 2017. SMART is seeking an initiation of a review to determine whether Uganda and other EAC countries are meeting the African Growth Opportunity Act (AGOA) eligibility criteria, with a view of suspending these countries from benefiting from AGOA.

AGOA, an act enacted in 2000 was put in place to assist and encourage economic growth and development in Africa, promote regional integration and facilitate integration of the region into the global economy by offering it better terms of trade. Under the Act, it was envisaged that there would be more investment from the US, improved production, employment and a boost in exports.

According to Southern and Eastern Africa Trade Information and Negotiations Institute (SEATINI), SMART states that the EAC's decision to ban second hand clothes would not only impose significant economic hardships on the United States' used clothing industry but also violate the AGOA agreement which requires beneficiaries to make consistent progress towards establishing a market for the US, thereby eliminating barriers to US trade and investment.⁶⁷

IMPACT ON ECONOMY

Experts admit that second hand clothes play a critical role in creating employment and raising revenue for the country every year. Ms Susan Nanduddu, the executive director of African Centre for Trade and

⁶⁷<https://agoa.info/news/article/15217-uganda-what-ban-of-second-hand-clothes-means-for-businesses.html>

Development (ACTADE), says it is difficult to estimate the number of Ugandans engaged in the trade. She, however, maintains that while the phasing out of second hand clothes will come along with challenges in terms of employment and revenue in the short run, the benefits in the long-term outweigh short-term gains. "The Cotton and Apparel sector alone has the potential to employ 2.5m people. So, if we put our investment in the right places as a country, we shall be in position to gradually shift those who are currently engaged in the business of second hand clothes into a similar business but are indigenous and sustainable," she explains.

Uganda Manufacturers' Association executive director Tito Byenkya says banning second hand clothes is a good aspiration but there is need to tread carefully especially because there are factors to be considered such as local capacity to meet demand, standards, quality and diversity. Like Ms Kyambadde, Mr Byenkya says the ban has to be a phased approach because the country operates within a broader global environment.

"Let it be phased but largely focusing on a combination of legal policy and fiscal intervention to make second hand clothes less desirable and promote the competitiveness of the locally produced clothes," he explained.

On whether the local manufacturers have the capacity to sustainably and comprehensively meet the country's textile needs in terms of quantity and quality, Mr Byenkya says, "There is a market but the question is can the local capacity respond to the demand of the market as it is. I would very confidently say I do not think so but we are getting there."⁶⁸

LOCAL CAPACITY

⁶⁸<https://agoa.info/news/article/15217-uganda-what-ban-of-second-hand-clothes-means-for-businesses.html>

Experts also say not only does the country lack the capacity to produce for the end user but also lacks the capacity to produce the raw materials that sustain the textile factories.

Even with government support, the textile industry is still limping due to failure to turn around production and meet local demand, and for some factories, unsustainable business models.

Last year, Uganda recorded a fall in cotton production following low yields and fewer farmers engaging in cotton growing. According to Uganda Revenue Authority manager public and corporate affairs, Mr Ian Rumanyika, this would be a good move and incentive that supports the local industry but it would have an implication on the tax revenue. "Just like any other tax policy change we have, usually that affects the revenue collection but we find alternatives on how to balance the tax policy changes and have this gap filled," he says.⁶⁹

WHAT PLAYERS WANT

Ms Racheal says if government is to phase out import of second hand clothes, there is need to categorise the types that should be banned since used clothes are grouped as first, second and third class depending on the quality. Mr Byenkya says the textile industry which is part of the BUBU policy has to step up and be supported in relation to capacity and quality.

On the other hand, SEATINI's Faith Lumonya says the US government should not use AGOA as a means to constrain Uganda's range of domestic policies provided for in World Trade Organisation rules but instead help the economy to achieve its development goals.⁷⁰

⁶⁹<https://agoa.info/news/article/15217-uganda-what-ban-of-second-hand-clothes-means-for-businesses.html>

⁷⁰<https://agoa.info/news/article/15217-uganda-what-ban-of-second-hand-clothes-means-for-businesses.html>

UPPING THE GAME

Jose Hendo, a Ugandan-born British eco-sustainable and award-winning fashion designer, says that the fashion industry in Uganda has steadily grown over the past years.⁷¹

“The Kampala Fashion Week has attracted international attention and designers in Uganda have responded by upping their game,” she told *The EastAfrican*.⁷²

“I am happy that Ugandans are aware of what is trending in the international textile and fashion industry. But we need to do more, like Rwanda, to promote the ‘Made in Uganda’ campaign and give room to Ugandan fashion brains to cook up all sorts of designs and styles without relying on what the international industry provides. This, in the end, will help develop the fashion and textile industry in Uganda,” said Ugandan fashion model Fenando Kamugisha.⁷³

COTTON DEVELOPMENT

According to the Cotton Development Organisation (CDO), cotton is Uganda’s third largest export crop after coffee and tea, supporting 250,000 households that cultivate it under rain-fed conditions with minimal use of inputs, such as fertilisers and chemicals.⁷⁴

The CDO further says that with 40 ginneries, the country has an installed seasonal ginning capacity of around one million bales of lint production or

⁷¹<https://www.theeastafrican.co.ke/tea/magazine/the-state-of-clothing-industry-in-uganda--1383260>

⁷² *ibid*

⁷³<https://www.theeastafrican.co.ke/tea/magazine/the-state-of-clothing-industry-in-uganda--1383260>

⁷⁴ *ibid*

200,000 tonnes, which is well above the maximum production achieved in the past two decades.⁷⁵

Because the textile industry in Uganda has lost a lot of ground to competition coming from the Far East countries and to second-hand imports, only 5 per cent of the total cotton production is consumed by two local textile factories.⁷⁶

Nakisanze says that second-hand clothes, however trendy, not only offer unfair competition but also kill creativity in the local clothing and fashion industry, “because Ugandan designers cannot compete with the low prices offered for the second-hand clothes and end up switching to other businesses.”⁷⁷

Kamugisha concurs: “Second-hand clothes may increase our collection of trendy and ready to wear items but they make us lazy. Without them the clothing industry in Uganda would have done much better by creating fresh and multiple affordable designs, but now everyone including fashion designers would rather go for the readily available and cheap second-hand pieces of ‘duplicate’ designs.”⁷⁸

FASHION AND DESIGN

According to Kamugisha, the challenge is that many Ugandans do not value or appreciate the clothing and fashion industry.

“They think working in the fashion design professional is not financially rewarding until one actually makes it to the top. This has not only affected

⁷⁵<https://www.theeastafrican.co.ke/tea/magazine/the-state-of-clothing-industry-in-uganda--1383260>

⁷⁶ *ibid*

⁷⁷<https://www.theeastafrican.co.ke/tea/magazine/the-state-of-clothing-industry-in-uganda--1383260>

⁷⁸<https://www.theeastafrican.co.ke/tea/magazine/the-state-of-clothing-industry-in-uganda--1383260>

the clothing and fashion industry but also stunted creativity in advertising campaigns. However, I am happy that this is changing and now Uganda is appreciating and absorbing all facets of the fashion industry and there are jobs being created and campaigns around fashion happening all the time.”

Like many other clusters of the creative industry in Uganda, data on fashion and design is lacking hindering related national planning, policies, legislation and institutional support.

Nakisanze argues that the government has invested very little in requisite infrastructure and policies to support the textile and fashion industry.

According to Kamugisha, “Ugandans generally love African print fabric because it can be used for outfits for all occasions. Lace and satin are also hot cakes.”

According to Hendo, Africans have always loved fashionable clothes and with globalisation, they also want to wear the latest designs.

Kamugisha concurs and says that Ugandans can afford to pay for the latest fashion. “I consider fashion to be a sense and if you have a sense of style then you can always find ways of dressing up. If it is available, Ugandans will buy it.”⁷⁹

Career development⁸⁰

Of fashion shows and parades in the promotion of fashion, Nakisanze says these are avenues of building designers’ self-esteem and motivation, public awareness and visibility of what is trending.

⁷⁹<https://www.theeastafrican.co.ke/tea/magazine/the-state-of-clothing-industry-in-uganda--1383260>

⁸⁰<https://www.theeastafrican.co.ke/tea/magazine/the-state-of-clothing-industry-in-uganda--1383260>

“Fashion shows are a measure of what’s trending and give a glimpse on how one can gather different pieces to bring out a fashionable look,” Kamugisha says.

Nakisanze’s advice to young Ugandans who wish to take up a career in fashion is: that “originality is key. When you create something new, you attract attention which can translate into monetary gain, and you can therefore compete favourably on the market. New things tend to have an edge over old ones.”⁸¹

There are many opportunities for the young in the fashion industry but it requires dedication, extreme hard work and self-sacrifice to shape a career in one of the most competitive industries in the world. It is best to build on well learned basic skills as a foundation to career in fashion on. One thing that is so important is to respect other people’s intellectual property and not copy, says Hendo.⁸²

“The fashion industry is growing at a very fast rate. This means there is a need and room for sharper people who may want to blossom. Fashion is waiting to embrace every one, only if you are fierce, daring and only if you know what to do,” Kamugisha says.⁸³

Catwalks

Despite being a very small sector of the clothing industry, Uganda’s fashion sector has a number of annual events whose highlight is the Kampala Fashion Week. Others are the Margaret Trowel School of Fine and Industrial Art

⁸¹ ibid

⁸²<https://www.theeastafrican.co.ke/tea/magazine/the-state-of-clothing-industry-in-uganda--1383260>

⁸³<https://www.theeastafrican.co.ke/tea/magazine/the-state-of-clothing-industry-in-uganda--1383260>

show commonly known as MTSIFA Fashion Parade (of the Makerere University), and Abryanz Style and Fashion Awards, among others.⁸⁴

The Abryanz Style and Fashion Awards is an African fashion award ceremony that celebrates and acknowledges fashion industry stakeholders — designers, stylists, hair and makeup artists, media personalities and influencers on the continent and diaspora.

The 2017 edition was held at the Kampala Serena Hotel on December 8 under the theme African Fashion is the Future #FashionTakeover which sought to highlight the entrepreneurial success of the African fashion industry which will in turn translate into the business of fashion.

The 2017 MTSIFA Fashion Parade was held on November 17, under the theme “Beyond Fashion.”

MTSIFA is shaping a new Ugandan fashion subject under the popular culture, famous as a consumerism subject focusing on function and beauty turns into an archive of intellectual discourses transcending traditional borders of design and art.

“It is a students’ experience of object and material (tangible and intangible) through (re)invention, interpretation, and embodiment of meaning into the fashion form. Consequently, fashion asserts as vehicle of self-actualisation and identity,” Nakisanze says. According to MTSIFA, the fashion industry is increasingly becoming an important feature of Uganda’s social and political fabric. Rules and regulations on dress code, especially for civil servants have in the recent past become a national talking point. As a segment of the cultural industry, fashion has moved from the periphery to the centre of the economy.⁸⁵ “Fashion is more than promoting smartness and a positive image of one’s self; it is at the forefront of enabling society get a deeper awareness of

⁸⁴ *ibid*

⁸⁵ *ibid*

itself and its role in contributing to national development and identity,” according to MTSIFA.⁸⁶

UGANDAN FASHION AND DESIGN INDUSTRY AT PRESENT.

More than 10 years ago, Uganda began legislation and policy documentation to initiate growth of the local textile industry. This was part of an initiative aimed at enabling the country to cash in on its high quality cotton as opposed to exporting about 90 per cent as lint (in raw form).⁸⁷

But the government strategy to have professionals as main players in the textile industry and progressively phase out importation of used fabrics from especially Europe, Asia and the United States of America is still limping four years after the idea of bans on such imports was discussed at a regional level.⁸⁸

Though some civil society actors are concerned about the lack of political will to expedite the process of phasing out importation and clearance of second hand clothes, there seems to be no clear policy progress.⁸⁹

The National Textile Policy, 2009 notes that with an East African population of 120 million people, the region has a market potential for 820 million metres of cloth per annum, generating about Shs1.4 trillion (\$415 million).

“We have always had the capacity to produce enough textiles for Ugandans but what was lacking was a clear policy direction. For anyone to produce, there has to be demand for the product. There is nowhere in the world where someone will comfortably invest in a free space. Currently, our policy has been promoting imports. So it is easier for people to import. People are so

⁸⁶ ibid

⁸⁷<https://www.monitor.co.ug/uganda/business/prosper/ugandans--2723612?view=htmlamp>

⁸⁸<https://www.monitor.co.ug/uganda/business/prosper/ugandans--2723612?view=htmlamp>

⁸⁹ ibid

used to imported second hand fabrics,” says Mr Mohammad Muzamil, the head of policy at Uganda Manufacturers Association (UMA).

UMA is an industry-association in Uganda that aims at bringing together Ugandan industrialists and manufacturers to guide the industrial actors in the country towards global competitiveness, on a sustainable basis.

“Uganda has many garment firms that are producing finished garments but are limited in their production lines. We have Graphics Systems, Tailors Association, plus others, over 100 garmenting factories. They procure from the local fabric makers then make the finished garments like shirts,” Mr Muzamil explains.⁹⁰

Tanzania and Uganda, in an East Africa Community dialogue in 2017, insisted that doubling levies on imports of used clothing, from \$0.20 to \$0.40 per kilogramme, was for realignments with the current value. Rwanda increased their tariffs from \$0.2 to \$2.50 per kilogramme before it was eventually partially suspended from African Growth and Opportunity Act (AGOA).⁹¹

The increase in import tariffs was expected to enable a progressive and effective ban on importation of second hand clothes amid continuous threats from AGOA should Uganda or any other East African country impose a ban. AGOA which came into force in 2000, enables preferential trade access of about 6,000 products duty free to selected countries in Sub Saharan Africa till 2025.

The East African Community accounts for nearly 13 per cent of global imports of used clothing worth \$274 million according to a 2017 study by the United States Agency for International Development (USAID). The study

⁹⁰ ibid

⁹¹<https://www.monitor.co.ug/uganda/business/prosper/ugandans--2723612?view=htmlamp>

also found that around 67 per cent of the East African Population purchased a portion of their clothes from used clothing markets.

Uganda in 2017 enacted a policy - Buy Uganda Build Uganda (BUBU), to promote import substitution and have most goods locally produced including textile products.

This was to beef up efforts to enable progressive phasing out of importing second-hand clothes into the country.

“Once we engage the small and medium enterprises and train them, we shall be looking at over \$200 million per annum,” Trade Minister Amelia Kyambadde told the East African Newspaper in 2017.

To date the textile industry is still struggling due to high costs of production and the inability to compete in a free market economy where imported second hand clothes are cheaper for most Ugandans.

According to traders who deal in second hand clothes, imports are still more viable compared to locally manufactured fabrics.

In the face of locally available raw materials like cotton, Uganda should have been in position to invest in the fabric industry better but most of the cotton gets exported instead.

Cotton, a main raw material in quality textiles, is Uganda’s third largest export crop after coffee and tea. It is the main source of income for some 250,000 households.

But according to Uganda Cotton Organisation, only five per cent of the cotton grown locally is used by two main local manufacturers - Fine Spinners Uganda Limited and Southern Range Nyanza Limited.

The percentage changes with season and demand for the product.

“Consumption varies from year-to-year depending on demand from the manufacturers,” says Ms Damlie Lubwama, the production manager, Cotton

Development Organisation.⁹² She adds, “The buffer stock arrangement we have is an incentive by the government to meet the cotton needs of the manufacturers depending on the quantity they require for their textile production.”⁹³

But during the Coronavirus (Covid-19) period, Ms Lubwama notes that the demand for cotton has reduced due to low demand for finished garments and purchasing power of textile and garments consumers.⁹⁴

Whereas Uganda and other East African countries are looking at second hand clothes as a threat to the growth of their local textile industry, a bigger challenge exists in the already-made clothing line of “Made in China.” China’s exports of cheap ready-made clothes to East Africa accounts for \$1.2 billion according to the USAID study.

Mr Bedi says that apart from the bill of utilities, water and electricity, which is a huge hindrance to competitiveness in Uganda’s textile industry, the cost of finance is high “The cost of labour in Uganda is globally competitive but the cost of finance is a big deterrent (to investment) because if you borrow in Uganda shillings at 15 per cent interest, it is not cash competitive. Logistics is also a big cost of business unless one is using locally grown raw materials, then you can sell locally, at the region or across the globe,” he explains.⁹⁵

Logistics costs for importation of in-bound cargo for those who use imported raw materials transported through the port of Mombasa can shoot up the cost of production.

⁹²<https://www.monitor.co.ug/uganda/business/prosper/ugandans--2723612?view=htmlamp>

⁹³<https://www.monitor.co.ug/uganda/business/prosper/ugandans--2723612?view=htmlamp>

⁹⁴ ibid

⁹⁵<https://www.monitor.co.ug/uganda/business/prosper/ugandans--2723612?view=htmlamp>

Cotton is a 26 million tonne business while polyester from China or India could be around 80 million tonnes for one to produce and be competitive. Taking locally grown cotton into the factories to make clothes would be a better alternative to imported second hand clothes.

“We should not think of how one company can increase their cotton consumption from 10 to 12 per cent. The discussion now should be, how we can add value to the 90 per cent cotton that we export raw to the rest of the world? If we have strong import substitution and value addition policies, we should be concentrating on that 90 per cent going out and making sure we add value to it,” says Mr Bedi.⁹⁶

Mr Bedi believes that government incentives, if financed through the Uganda Development Bank, will multiply the country’s investments and boost growth of the textile industry since there is local demand for affordable first hand clothes.⁹⁷

With companies in countries where Ugandan textiles are exported filing for bankruptcies especially in the US, retail shops closing and shifting to online sales, Ugandan textile companies could consider looking inwards as talks about phasing out of second hand clothing lingers in the air.

Last month, Trade Minister, Ms Amalia Kyambadde told Daily Monitor that the country has halted its discussion to ban second hand clothes without details of a strategy to enable the textile industry to take off to sustainability.

“What is the problem with second hand clothes? We told you (the media) that there is no ban,” Ms Kyambadde said.

⁹⁶ ibid

⁹⁷<https://www.monitor.co.ug/uganda/business/prosper/ugandans--2723612?view=htmlamp>

But those in the manufacturing industry say they are working on having Ugandans wear affordable 'Made in Uganda.'

"The heads of state in the East African Community in 2016 decided that they would like to curb the import of second hand clothes. As manufacturers, we decided to take baby steps towards that direction and build local capacity. Fundamentally, we must make new affordable clothing in the region," says Mr Bedi Jaswinder, the director of Fine Spinners Uganda Limited.

LOCAL MANUFACTURERS

According to UMA, Uganda has four main fabric companies that produce from the field to fashion. They are; Fine Spinners Uganda Limited, Southern Range Nyanza Limited, Sunbelt Textiles Company Limited and Sigma Knitting Industry Limited who say they have capacity to meet local garment demands but are constrained.

"Finance is a major cost of doing business because if you have a big project and you cannot fund it, how are you going to grow? We need to create a Textile Fund like India and China did as a means for affordable financing. I borrow cheaper in Kenya than in Uganda. I do not see why because the risks are the same. They are in one community. Debt to GDP ratio is lower in Uganda than Kenya yet the cost of financing is higher than Kenya, why? If you are paying 15 or 20 per cent as interest to the bank, that is your profit. You are not going to keep working for the bank. The interest needs to go down so that you start working for yourself," says Mr Bedi.

Fine Spinners Uganda Limited, a Kenyan Fabric manufacturer that joined the Ugandan market in 2014 prides in using 100 per cent Ugandan cotton from the fields in Kasese and Mbale districts to fashion.⁹⁸

⁹⁸ *ibid*

Not many firms in Uganda have the capacity to produce in a sustainable and traceable cotton and textiles or garments module due to high competition in the free market economy.⁹⁹

“The Value Added Tax is too high which makes the cost of production high and eventually the cost of the finished products. There are discussions underway to have a policy direction to promote local garments and the textile industry,” says Mr Mohammad Muzamil, the head of policy at UMA.¹⁰⁰

RIGHT TO WEAR.

On Wednesday morning around 60 female activists and their supporters, including men, gathered at the Uganda National Theatre in Kampala. In a peaceful protest organised by the End Mini-Skirt Harassment Coalition, the women, many clad in black miniskirts and above-the-knee dresses, carried signs that read “Thou shall not touch my miniskirt”, and “Lokodo hold your libido”. The gathering was spirited, just as the response to the so-called miniskirt ban, which was supposedly signed into law on 6 February under the Anti-Pornography Act, but is now being withdrawn by the cabinet for review, has been tongue-in-cheek. “Uganda should dress its population in nothing but onesies,” wrote the organisers of Kampala’s monthly FashionCorps event on their Facebook page. “These ubiquitous adult baby-gros cover up those naughty breasts, buttocks and thighs and as an unexpected side-benefit they quickly dampen any sexual ardour between wearers, whatever their gender.”¹⁰¹

But the realities of the apparent law are no laughing matter. According to a report by Uganda’s New Vision newspaper, in the eastern part of the country,

⁹⁹ *ibid*

¹⁰⁰ <https://www.monitor.co.ug/uganda/business/prosper/ugandans-2723612?view=htmlamp>

¹⁰¹ <https://www.theguardian.com/fashion/fashion-blog/2014/feb/28/uganda-miniskirt-ban-attacks-women>

seven men were arrested for allegedly targeting women in miniskirts and stripping them naked. The women were said to be on their way to church at the time. According to a report in the Daily Monitor, mobs, including bikers claiming to help police enforce the law, have undressed eight women wearing miniskirts and even two men wearing low-slung trousers, in Eastern Uganda, in the past week.¹⁰²

Elsewhere women describe the level of street harassment as intensifying. "Sexual harassment has been taking place in this country for some time," says Nargis Shirazi, 29, an activist who works for the Woman to Woman Foundation in Kampala. "Now it's like the locals have a reason to stand up and use violence. If we don't do anything about it, it's going to get worse."¹⁰³

The problem, according to Shirazi, is that the law is extremely vague. "The leaders themselves do not understand it," she says. "Lokodo claims that women excite men if they dress like this. The tabloids pounce and there you have your front page: 'Miniskirts banned'. It gives men reason to get violent."¹⁰⁴

The recently signed Anti-Pornography Act 2014, broadly defines pornography as "any representation of the sexual parts of a person for primarily sexual excitement". Simon Lokodo, Uganda's ethics and integrity minister and a former Catholic priest, has vowed that women wearing clothing that stopped above the knee would be arrested in a revival of Idi Amin's 1970s law, which was on the statute books until 2002. On Tuesday, the same day that President Yoweri Museveni signed a separate anti-gay bill into law, police warned the public against invoking the "anti-miniskirt bill" to strip women in public. Explaining that the law was not yet operational and is being reviewed against a set of procedures and guidelines before police can be

¹⁰² *ibid*

¹⁰³ <https://www.theguardian.com/fashion/fashion-blog/2014/feb/28/uganda-miniskirt-ban-attacks-women>

¹⁰⁴ *Ibid*

instructed, the statement concludes: "The law does not criminalise mini dresses."¹⁰⁵

The confusion over the Anti-Pornography Act has been perpetuated by the focus on women's clothes, despite there being no actual mention of miniskirts in the bill. "So many people on the streets are selling porn DVDs, but all that's constantly being mentioned is 'women, women, women'," says Sharon Atim, 25, an activist and a colleague of Shirazi's. "Actually, we are the vulnerable group."¹⁰⁶

So can women wear miniskirts in public? The Ugandan cabinet is currently reviewing the bill in response to public attacks on women. On Monday, after the ceremonial signing of the anti-gay bill, Lokodo made his feelings clear, saying: "Put on a miniskirt but please don't expose your thighs, your buttocks and your genitalia. Finished." But while women continue to suffer as a result of his bill, the problem is far from over.¹⁰⁷

¹⁰⁵<https://www.theguardian.com/fashion/fashion-blog/2014/feb/28/uganda-miniskirt-ban-attacks-women>

¹⁰⁶<https://www.theguardian.com/fashion/fashion-blog/2014/feb/28/uganda-miniskirt-ban-attacks-women>

¹⁰⁷<https://www.theguardian.com/fashion/fashion-blog/2014/feb/28/uganda-miniskirt-ban-attacks-women>

CHAPTER TWO



LAW ON COSMETICS IN UGANDA.

INTRODUCTION

Cosmetics are defined to mean articles, intended to be rubbed, poured, sprinkled or sprayed on, introduced into, or otherwise applied to the human body for cleansing, beautifying, promoting attractiveness or altering the appearance and also means articles intended for use as a compound of any such articles, including but not limited to cold creams, suntan lotions, makeup and body lotions.

It may also be referred to as cosmetology a term that encompasses a broad range of specialty areas, including hairstyling, nail technology and esthetics (dealing with beauty)

BRIEF HISTORY OF COSMETOLOGY.

The Egyptians.

They were the first to cultivate beauty in an extravagant fashion. They used cosmetics for personal beauty in religious ceremonies, to prepare the dead for burial. Infused essential oils from leaves, bark and blossoms of plants to create perfumes as early as 300BC, used minerals, insects and berries to create makeup. Henna used to sustain hair and nails a rich, warm red, credited with creating kohl makeup-originally made from ground galena, sulfur and animal fat-to heavily line the eyes, alleviate eye inflammation and protect eyes from

the glare of the sun. queen Cleopatra was so dedicated to beauty, she erected a perfume factory next to the dead sea around 50BC

The Chinese

Around 1600BC there is evidence that Chinese aristocrats used a tinted mixture to stain nails crimson or ebony.

Nail tinting was tied to social status and commoners caught wearing royal nail color faced a punishment of death.

The greeks

In Greece around 500BC, hairstyling became a highly developed art. Perfumes and cosmetics were used in religious rites. built elaborate baths, developed methods for dressing the hair and caring for skin and nails, applied cosmetics in much the same way we do today.

Romans

Used fragrances and cosmetics, made and used facials, used hair color to indicate their class in society that is the noble women used red tint, the middle class women used blonde tint and poor women used black tint.

The middle ages.

Beauty culture is evidenced in tapestries, sculptures, and other artifacts by towering headdresses, intricate hairstyles, and the use of cosmetics on skin and hair

- Women wore colored makeup on their cheeks and lips but not on their eyes
- around 1000AD, steam distillation (process used to purify liquids) was refined; ushered in the modern era of steam-distilled essential oils that we use today

The Renaissance

- Western civilization made the transition from medieval to modern history
- Shaving of the eyebrows and the hairline to show a greater expanse of forehead was popular and thought to give women a look of greater intelligence
- both men and women took pride in their physical appearance and wore elaborate clothing; cosmetics and fragrances were used but highly colored preparations were discouraged

The Victorian Age

- the years between 1837 and 1901 are known as the Victorian Age (Queen Victoria was Queen of England during this time)
- dress and personal grooming were austere (plain and simple) and restrictive
- women used beauty masks made from honey, eggs, milk, oatmeal, fruits, and vegetables
- Victorian women pinched their cheeks and bit their lips to infuse color rather than using cosmetics.

The Twentieth Century

- The early 20th century signaled the spread of industrialization which brought prosperity; beauty applications began to follow trends set by celebrities and society figures.

1901-1910

Max Factor came to America from Poland and began making and selling makeup; it was very popular with movie stars because it did not crack or cake even under hot lights

1906

Charles Nessler invented a heavily wired machine that supplied electrical current to metal rods around which hair strands were wound

Long hair was wound from scalp to ends in a technique called spiral wrapping; when women cut their hair shorter into the bobbed style, hair was wrapped from ends to scalp in the croquignole (KROH-ken-yohl) technique

Sarah Breedlove devised sophisticated sales and marketing strategies and traveled extensively to give product demonstrations of her scalp conditioning and healing treatment; by the time of her death, she had established herself as a pioneer in the modern African-American hair care and cosmetics industry

1923

Marcel Grateau (Francois Marcel) invented an electric version of the curling iron he invented in 1872 (it had been heated by a gas burner); he also went on to develop a permanent wave machine, barber clippers, a safety razor, and other devices

1920s

Cosmetics industry grew rapidly

Many women's magazines originally deemed cosmetics inappropriate, but by the end of the 1920s, cosmetics advertising provided their biggest revenue source

1930s

1931- pre-heat perm method (hair was wrapped with the croquignole method then preheated clamps were placed over the wound curls)

1932- two chemists created a method that used chemical heat; a small, flexible pad was wound around the hair strand; when pads were moistened with water, a chemical heat was released creating long-lasting curls

1932- Charles Revson of Revlon marketed the first nail polish using formulas borrowed from the automotive paint industry

Fashion, Design and Entertainment in Uganda

1932- Lawrence Gelb introduced the first permanent haircolor product and founded Clairol

1935- Max Factor invented pancake makeup to make actors' skin look natural on film

1938- Arnold Willatt invented the cold wave that used no machines or heat; precursor to modern perm

1940s

1941- scientists developed a permanent wave that used waving lotion; did not use heat so it was also called a cold wave; replaced all predecessors and competitors

1951-2000

1950s-introduction of mascara; improved hair and nail products; boom and then death of weekly salon appointment

1960s- Vidal Sassoon introduced revolutionary geometric cuts

1970s- era of highlighting created by French hairdressers who used foil to weave hair

1980s- went from barely there to heavily made-up cat eyes and heavy eye shadow

1990s- haircolor became gentler

1998- Creative Nail Design introduced the first spa pedicure system

The Twenty-First Century

Gentler, no fade haircolor

Beauty industry entered the age of specialization

Since the late 1980s, the salon industry has evolved to include day spas

SOME OF THE COSMETOLOGY TERMS.

1. allergy; an allergy is an immune disorder where the body has a negative reaction to a substance or object. In cosmetology, it is important to know if someone has an allergy to a product as mild to severe reactions can occur depending on the level of sensitivity.¹⁰⁸

2. bangs; these are layer of hair closer to the fore head that are cut shorter than the rest of the hair. They can be thick or thin, short over the eyebrows or longer down the face.¹⁰⁹

3. blunt cut: a blunt cut is a haircut with no lyares . it is cut straight-across where the weight falls on the bottom of the hair. If your hair is thin, fine or fragile. This haircut will preserve the density and overall integrity of your hair.¹¹⁰

4. Bob; is a haircut with the weight line at the chin or below the ears. A longer bob, or a lob, is a bob with the weight line grazing the collarbone.¹¹¹

5. Balayage

A highlighting technique that involves brushing color onto a client's hair to produce a silky soft sun kissed appearance. Considered to be an advancement to traditionally foiling, Balayage comes out looking more natural and downplays regrowth lines.

6. Body Scrub

¹⁰⁸<https://www.leonstudioone.com/school/cosmetology-school/basic-cosmetology-terms/> accessed on Friday January 14, 2022

¹⁰⁹ ibid

¹¹⁰ ibid

¹¹¹ ibid

Almost like a facial for the body, body scrubs help exfoliate and rehydrate skin. The result is soft and smooth skin. For the scrub, you will need an abrasive substance, such as sea salt or sugar, and mix it with massage or essential oils. Body scrubs are one of more than 350 different treatments covered under our cosmetology liability insurance program.

7. Benefits

By joining our cosmetology insurance program, you will have instant access to hundreds of dollars worth of exclusive member benefit. We've partnered with leading names like Paul Mitchell and Redken to offer you discounts and early access deals on top gear and accessories. Other benefits include a free professional website, access to great business resources, and a subscription for a Creative Age publication of your choice.

8. Body Wraps

Wrapping or covering the body during a treatment intended to create heat and sweating. Usually combined with body scrub, wash, and lotion to help detoxify and beautify skin. Some also profess the weight loss benefits of this treatment.

9. Breathing Zone

Important safety consideration when using chemicals around clients is to maintain at least two feet around the head - called the breathing zone. This helps minimize the chances of chemical inhalation. A client passing out from chemicals and injuring themselves is just one example of the many forms of liability that can present itself and highlights the necessity¹¹²

10. Chemical Wave

¹¹²The Ultimate Cosmetology Glossary of Terms | Basic Cosmetology Terms (elitebeautysociety.com)

Using a slightly diluted form of a perm solution and special wand, stylists are able to help client's hair maintain a wave that's healthier on the hair than a traditional perm.

11. Chemical Peel

Using a chemical solution to make the client's skin blister and peel off. New skin will appear smoother and less wrinkled. This treatment can help hide scars and wrinkles, reduce fine lines, and even help with some forms of acne. However, a client's mishap with a chemical peel could be incredibly costly without the assurance of cosmetologist insurance.

12. Cosmetic Massage

Gentle massage to the face and neck area meant to improve blood flow and circulation to the area. Cosmetic massage is one of more than 350 different treatments covered under our cosmetology liability insurance program.

13. Charms

Allowing clients to add a little extra "bling" to their nails, desired charms can be attached using a top coat, nail glue or resin, or gel polish.

14. Damaged Fingernail

Many different factors can create a damaged fingernail. You will need to analyze and recognize the right course and treatment for repairing split or damaged nails.

15. Dermaplaning

Exfoliant treatment that uses a scalpel to remove hair and dead skin from the skin's surface. The popularity of dermaplaning has risen for its ability to both remove unwanted facial hair and to make skin silky smooth without the use of chemicals.

16. Design, Cut and Style

A cornerstone of cosmetology is the ability to consider your client's hair volume, head shape, and more and still be able to produce a desired style. Haircutting involves using implements like clippers, scissors, or shears to cut and shape head and facial hair. Hair stylists employ a host of instruments like curls, rollers, irons, and dryers, in addition to many freehand techniques, to produce the desired style.

17. Disorders

As a cosmetologist, you will need to analyze and recognize various disorders and diseases of the skin, hair, scalp, and nails. Providing a treatment to someone with a certain disorder could cause great harm and open you and your business up to undue liability.

18. Eyebrow Shaping

Process of using tweezers, trimmers, and small eyebrow razors to tidy up the eyebrows in a style that best suits the client's facial shape. Because of the close proximity to the eyes and face, extreme caution and skill need to be exerted with this service. Cosmetology liability insurance helps you focus on crafting the perfect line rather than the what ifs of a future claim.

19. Eyelash Extensions

Cosmetologists must be skilled in the application of a synthetic or natural material to client's eyes to enhance a desired trait such as fullness or length.

20. Eyelash Tinting

Hair dye meant just for eyelashes. Helps to produce a look that is similar to that of mascara, that is the length, fullness, or right shade, just without the annoying smudges.

21. Extensions

Process of using specialized clips, glue, or a hand sew to attach additional hair to add length, fullness, or a specific style.

22.Exfoliation

Involves removing dead skin cells on the skin's surface using any one of a variety of different means. Special machines, scrubs, or chemicals can all act as exfoliants.

23.Exothermic Wave

Combines different chemicals to create a reaction which gently processes a client's hair without the application of heat. The result is long lasting and conditioned curls.

24. Facials

Skin care regimen for the face which can include a multitude of different treatment options like facial massage, exfoliation, lotions, and many others. It is typically used as a beauty treatment but also has many health benefits and can also be used to treat specific skin conditions.

25.Facilities License

To provide services as a cosmetologist, most state boards require you to do so in a licensed facility. Failure to do so could result in a suspension of your professional license. State regulations can vary so always be cognisant of your stateboard's specific requirements.

26.Finger Waves

A long-popular method for setting hair with fingers and special styling gels or hairspray to produce the wave hairstyle. Hair is pinched between fingers and combed in alternate directions to make a sort of "s" shape.

27. Frosting - special effect used in hair coloring and lighting that involves bleaching individual hair strands to produce an eye-catching blend of dark and light hairs.

28. General Liability Insurance

Commonly called “slip and fall” insurance because it protects you from third party claims for injuries or damages in or around your premises. Our cosmetologist insurance program provides up to \$2 million per claim and a \$3 million individual annual aggregate for general liability claims.

29. Glitter

The art of applying glitter nail polish or material to the nails. Always start with a clean, trimmed, and shaped nail then move on to applying base coats and glitter. This service sounds tame but consider if a client has a terrible allergic reaction to the glitter you use and they have mountains of medical bills as a result which they say you are responsible for. Without cosmetology insurance, you’ll be left paying these expenses out of pocket.

30. Hair Coloring

The process of changing a hair’s color typically with a chemical dye.

31. Hair Removal

Using any one of a number of techniques to remove unwanted hair from specific areas of the body.

32. Identity Protection Plan

Our cosmetology insurance plan includes the best all around coverage option available because we include comprehensive protection measures like \$25,000 worth of identity recovery services through our provided Identity Protection Plan.

33.Immediate Certificate of Insurance

One of the best perks of membership through EBS is the immediate availability of your certificate of insurance upon check out. No matter where you are, as long as you have an internet connection you can have a COI in minutes.

34. Implements and Equipment

One of the pillars for obtaining your cosmetologist license is being able to demonstrate your knowledge of the safe use and maintenance of the implements and equipment's of the trade. This includes wet and dry sanitizing, properly storing and disposing, and maintaining a clean work area.

35.Liability Insurance

Our liability insurance for cosmetologists comes with generous general and professional liability coverage limits to protect professionals providing services. In addition, we include product liability coverage, rental damage coverage, stolen/damaged equipment coverage, and even an identity protection plan all to create the best real-world protection possible for our members.

36.Limits

Coverage limits are the most amount that your insurance policy will pay for a given claim. With our general and professional liability insurance, you will have up to \$2 million for each claim up to a \$3 million individual annual aggregate.

37.Make Up

Application of specific materials in order to alter the appearance of the face or some other portion of the body. For cosmetologists, this involves the skillful application of any one of a number of different products to make clients feel beautiful inside and out.

38. Manicures

This cosmetic beauty treatment for nails and hands involves a number of techniques including trimming, clipping, massaging, and polishing.

39. Microblading

Eye-brow enhancement process involving the use of a tiny handheld device resembling a scalpel that has many tiny needles within it. The needles are used to physically add pigment directly into the skin to give a desired shape and fullness. Micro blading professionals should exercise extreme caution and skill, and always carry professional liability insurance.

40. Microdermabrasion

Procedure used to help skin tone and texture appear more radiant. Helps with damage caused by the sun, wrinkles and fine lines, and other scarring and conditions. A cosmetologist will skillfully employ an instrument with abrasive materials to remove outer skin layers.

41. Nail Extensions

42. Occurrence Form Coverage

Important coverage distinction that says no matter when you file a claim, as long as the event occurred while the policy was active, you are covered. This means even if you file after your policy expires you will still enjoy coverage for an event that happened when the policy was active. We only provide occurrence form coverage with our cosmetologist insurance.

43. Out of Pocket

Without comprehensive cosmetologist insurance, you can be left paying claims for injuries or damages out of your own pocket. Even when claims are frivolous, legal defense fees can be costly and prove financially devastating without the protection of liability insurance.

44. Pedicures

Cosmetic treatment for the feet and toenails. Beautification of the feet and nails is achieved through various techniques and also typically coupled with relaxing massage to ease stress and anxiety

45. Professional Liability

Also called “malpractice” insurance, professional liability insurance provides coverage for claims relating to the services you provide. For example, a client may claim that your micro blading session injured their eyebrow area and their medical bills and expenses are your responsibility.

46. Product Liability

Provides coverage when a client has an adverse allergic reaction to a product used during the course of their session. Our cosmetologist insurance provides up to \$2 million for product liability claims.

47. Rates

For one year of cosmetology insurance coverage, take advantage of our special intro rate and pay just \$159 for a full year of coverage and instant access to exclusive member benefits. You can save further with a two year rate at \$279.95. We also have a cosmetologist student option at only \$25 for a year.

48. Reciprocity

The degree to which one state will recognize the legitimacy of a license issued in another state. State boards can be a little different so this varies greatly but some states will fully accept your out of state license and just require a few forms and fees for a new license. Other states will require additional education or testing in order to issue you a cosmetologist license in their state.

49. Rental Property Damage Coverage

Coverage that provides up to \$100,000 as reimbursement for repairs of damage that occurs to a space you are renting.

50. Skin Sensitivity Test

Beauty products can cause an allergic reaction in many people so it's best to always do a skin sensitivity or "patch" test. This entails placing a small amount of product usually inside the elbow or behind the ear. For best results, allow the client to go home and return 24-48 hours later to analyze any reactions. Having a client have an adverse allergic reaction is an example of a liability that would fall under Product Liability coverage of our comprehensive cosmetologist insurance.

51.State Board

Each state has its own licensing board that dictates the requirements of the profession in order to achieve and maintain licensure. Be sure to be aware of the unique requirements your state board has for cosmetologists.

52.Straightening

Hair styling technique that flattens and straightens hair for a smooth and sleek look. A variety of techniques exists for straightening but it typically involves using a hot iron or chemical relaxers.

53.Stolen/Damaged Equipment Coverage

It sucks when vital equipment like make up is stolen or damaged. That's why we provide our members up to \$1,000 with a \$250 deductible for stolen/damaged equipment.

54.Student Rate

To help foster the next generation of cosmetology pros, we offer all of the same robust coverage limits and member benefits of our professional policies for only \$25 for a full year to students enrolled in an accredited cosmetology program.

55. Thermal Styling

Encompassing many techniques, at its core thermal styling simply means the application of heat to curl hair. Utilizing heated rollers would be an example of a thermal styling technique.

56. Third Party

This is someone other than the person who is insured or the insurance company. For example, general liability insurance provides coverage for third-party claims for injuries or damages.

57. TrustPilot

Independent third party review platform that helps us get verified members' unbiased reviews.

58. Ultrasound Facials

Gentle treatment that is generally considered safe for most skin types and various conditions such as acne and rosacea. Ultrasound waves are used to penetrate the skin without using chemicals or abrasion.

59. Varnish

Also called nail polish, nail varnish is used to decorate and/or protect the nails of the hands and feet.

60. Vitamin C Peel

Utilizing L-ascorbic acid in Vitamin C, cosmetologists use the peel to exfoliate the client's skin and also create a hydrating mask.

61. Waves

Hairstyle usually used with clients with curly hair where their curls are brushed and flattened which creates a ripple-effect.

62. Waxing

Employing a variety of different techniques, waxing usually uses a hot wax and paper to remove unwanted hair from different areas of the body. Waxing presents many claims against cosmetologists as skin can easily be ripped during the process. Without a robust insurance policy, you could be left paying the costs of a claim out of pocket.

63. Weave

Harmful effects of cosmetic products on humans.

1. unwanted dependency on cosmetics. The myth among people that they cannot look beautiful or handsome if they do not use cosmetic. This dependency can lead to many troubles and results into an addiction. The dependency may result in skipping occasions and parties if their cosmetics are not with them and they can't do make up.

2. Hair problems. Hairstyles are very popular and eye catching. But regular use of shampoos, conditioners, hair colors, gels and serums may actually harm your hair badly through thinning of hair, redness in scalp, hair fall or excessive dandruff.

3. headaches. This may be through wearing of makeup for a long time. A lot of care should be taken while removing the makeup.

4. Ageing. That is the moisturizers do some damage to the skin and with prolonged use wrinkles and other signs of ageing may appear.

5. danger to reproductive organs. This may be so if such products are in direct contact and can also lead to infertility.

6. cancer and other chronic diseases for example lipstick contains aluminum which may cause long term anemia and even glucose intolerance due to

chemicals contained in them that include zinc oxide, barium sulphate which are very harmful to the body and may result in many organ failures like the kidney and liver.

7. damage to nails through manicures,pedicures ,nail paints and nail polish if done very regularly. The quality of nailsbecome thin and lose their natural color starting to look pale.

8.harmful for eyes. The eye shadow,mascara and other forms of eye makeup can harm the eyes very badly.

9.skin diseases and reactions. The skin diseases and reactions are due to use of fairness creams and sunscreens.

Prevention.

1. avoid regular use and long time use of cosmetics.

2. do regular exercises for healthy skin and young looks

3. Adopt a healthy lifestyle and eat nutritive for keeping yourself young and beautiful.

4. One should always read ingredient labels which can provide information to whether a particular product is appropriate.

5.if someone is allergic or sensitive to a particular ingredient, one must avoid a related product entirely

6. be cautious when using products without labels.

7. don't share cosmetics with others as eye products may spread bacteria.

8.any adverse reactions should be reported to a doctor for treatment.

9. avoid heavily scented products.

10. avoid moisturizers, ointments and skin creams with petrolatum, hair spray, gel, or shaving cream with UV filters.

CHAPTER THREE



DESIGN LAW IN UGANDA.

INTRODUCTION

Design is defined to mean only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any trade mark. It is a two-dimensional or three-dimensional features of shape, configuration, pattern, ornament or composition of lines or colors applied to any article by any manual, chemical or mechanical (separate or combined) industrial process or means which in the finished article appeal to and are judged solely by the eye.¹¹³

Design is the way to generate promising ideas for how legal services could be improved, and then get them developed in quick and effective ways.¹¹⁴

Design offers a way to rethink and improve people's experiences of law. This means both from the lay person's perspective — who is having to navigate the legal system to deal with a problem or pursue justice. And it also means from the legal professional's perspective — the lawyer, the judge, the court clerical

¹¹³<https://www.lawyersclubindia.com/articles/brief-introduction-of-design-law-8112.asp>

¹¹⁴ Lawbydesign.co

worker, the paralegal, and beyond. Our legal system does not have to be the way that it is. It can be clearer, more efficient, more usable, and friendlier.¹¹⁵

Design is the way to get there. Design is a field built around ‘How’ — that can complement a field of ‘What’ like law. Design is about figuring out smart, usable, practical ways to make change happen — to make more engaging communications, to create breakthrough new products, to deploy more satisfying services, and to set up more effective organizations, policies, and strategies.¹¹⁶

Design offers a clear, human-centered process to envision what these better legal systems could be, and then craft and launch interventions to realize these changes. It offers **intentionality** in the face of a system that has been hacked and patched together haphazardly and without user testing. Design holds the power to crack open the world of law, and make it more accessible, democratic, and usable.¹¹⁷

Design right is a territorial statutory right (enforceable only upon registration of said design) which allows the proprietor to prevent others from producing, importing, selling or distributing products having an identical appearance or a fraudulent or obvious imitation.

Design law is a brunch of industrial property law, which protects the design as the appearance of a product that is new and has an individual character. The product can be either an industrial or handicraft item, including, interalia parts intended to be assembled into a complex item, packaging, get up, graphic symbols and typographic typefaces but excluding computer programmes.

The aim of legal design is to find an innovative way to explain law that makes it more interesting, easy to understand and more accessible. Legal design as the

¹¹⁵ Lawbydesign.co

¹¹⁶ ibid

¹¹⁷ Lawbydesign.co

name suggests involves the application of design thinking, it combines experience in the legal field with an approach that comes from the design profession, using graphical representation, clear and simple language and new technology. The need for legal design stems from a problem that is both extremely old and highly relevant today, how to make laws and regulations easily understandable so people are better able to protect their interests.

Legal design also means making law more user-friendly. The users of the legal system maybe citizens looking for a lawyer or people who need a legal opinion when drafting a contract or they could be lawyers themselves, who want to adopt the best legal solution to offer to their clients. Legal design helps to create empathy with users who as a result feel better placed to understand how to achieve their goals.

Take contracts for example. Since they are usually very long, detailed and difficult to take in, instead of bothering to read them we often go straight to the final signature (a prime example of this is the terms and conditions on websites). This happens because contracts are written by legal experts. Rethinking a contract from the point of view of the actual user (i.e the person who has rights and responsibilities deriving from the contract itself) provides new ideas on how to structure its content).

Using legal design in this context can mean simplifying the language, removing jargon, including tables of contents and adding graphical representation of certain information through diagrams, icons, timelines and images. This helps to engage users, increases the clarity of the information and in general aids understanding.

Essentials of valid designs.

1. novelty
2. no prior publication

3. the design must be applied to a particular article.
4. Visibility on finished products.
5. Registration.¹¹⁸

What do you need to submit to register a design

1. name and surname of the applicant (or the company name, if the applicant is a legal person)
2. address of the applicant
3. citizenship (incase the applicant is a natural person)
4. authorization to represent the applicant before SIPO or EUIPO)
5. Name, surname and address of the designer of the product (incase it is a different person than the applicant)
6. upto seven photos of the product(taken from different viewing angles inorder to display the appearance of the product as clearly as possible, the product must be photographed on a neutral surface (a wall, for example) and other objects must not be around, it is also possible to submit renders or graphic displays of the product

In some cases the applicant must also select subclasses from the Locarno classification for which protection is sought.

Why do we need legal design?¹¹⁹

¹¹⁸<https://www.mylawman.co.in/2021/04/law-notes-designs-act-of-2000-ipr-by.html>

¹¹⁹<https://www.pixartprinting.co.uk/blog/legal-design/>

1. it makes clients happier for instance putting yourself in your customers shoes understanding their needs and offering something understandable and valuable tends to be greatly appreciated by clients. Listening to customers and working together to create accessible , tailor-made solutions increases their trust in your business.¹²⁰

2. it increases understanding of and compliance with the law that is if users are offered a simpler and more interesting legal product such as contract, they will feel more secure regarding their rights and responsibilities and will be able to understand and comply with the agreements they are entering into. At a large scale, this may lead to better levels of compliance with the terms of the contract and fewer disputes. It also potentially allows the creation of a legal system in which citizens play a more active role.¹²¹

3. it promotes innovation and value creation. Many professionals and indeed non-professionals have good ideas and suggestions to make, but often lack the necessary technical skills to express them. Legal design offers a platform for these people, opening the way for opportunities and improvements. This new system could act as a way of developing existing services.¹²²

Legal design is a useful resource. Companies as well are increasingly exploring a human-centered design approach because:¹²³

- a) People are sick of complex legal documents. Human centered design is now standard at all the biggest companies such as Apple, Google and IKEA which provide us with impeccable products and services. People rapidly getting used to simplified commercial relationships

¹²⁰<https://www.pixartprinting.co.uk/blog/legal-design/>

¹²¹ ibid

¹²² ibid

¹²³<https://www.pixartprinting.co.uk/blog/legal-design/>

and we now expect this approach to be extended to all areas where there are relationships governed by laws.¹²⁴

- b) Users are increasingly demanding in what they expect from their lawyers and solicitors, while wanting to pay less. This means that legal experts have to evolve to offer services that meet the specific requirements of clients. Legal design helps to highlight the things that are truly important for customers.
- c) Legislation itself is starting to demand legal design.¹²⁵

What does design law involve?¹²⁶

Design law involves the use of various tools and methods.

- a) Divergent thinking and convergent thinking. This process is developed in two stages: the first (divergent thinking) involves coming up with numerous ideas based on a single concept or piece of information. In any legal design project it is important to take advantage of both stages to grasp the essence of the problems that need to be overcome before resolving them through ideas and solutions.
- b) Empathy and understanding the problem. Users must always be at the centre of design. Empathy is used to put yourself in the shoes of users and understand the problem from their point of view. To achieve the optimal solution, you need an in-depth grasp of the issue,

¹²⁴ ibid

¹²⁵<https://www.pixartprinting.co.uk/blog/legal-design/>

¹²⁶<https://www.pixartprinting.co.uk/blog/legal-design/>

which can be achieved by analyzing every single aspect of the user experience.¹²⁷

- c) A varied team. Having a team made up of people with a diverse range of skills is crucial to ensure the best possible solution is developed. In general, you need highly specialized people in fields like IT, psychology, law and design) as well as professionals who can represent users.¹²⁸
- d) Graphical representation. The way information is presented influences how it is received and assimilated. In design law, the presentation of information is a vital part of both the process and the solution; the process involves outlines, drawings, sketches and case studies while the solution can present diagrams, icons and images (choosing the language that works best for each specific project)¹²⁹
- e) Language. As a general rule, design law seeks to simplify the use of language, avoiding jargon and making the structure of the text easier to navigate.¹³⁰
- f) Technology. As in virtually every field nowadays, technology can improve legal design solutions, making them interactive and accessible through digital platforms. In addition, technology makes innovation easier.¹³¹

Can you copyright clothing designs?

¹²⁷ *ibid*

¹²⁸ <https://www.pixartprinting.co.uk/blog/legal-design/>

¹²⁹ *ibid*

¹³⁰ <https://www.pixartprinting.co.uk/blog/legal-design/>

¹³¹ <https://www.pixartprinting.co.uk/blog/legal-design/>

Yes, sometimes but in most cases, no. As with every legal question, there's always a general rule and then a mountain of exceptions to that rule. The extent that clothing can be copyrighted is one of those questions that lawyers and judges are still testing the limits of even today.

It might be a fashion faux-pas to copy someone's style, but it may be a surprise to learn that making a direct or substantially similar copy of clothing, in many circumstances is legal, because clothing designs are rarely protected by copyright law specifically.

To understand how the rules work, it's good to keep in mind that the general policy of copyright law is to encourage creativity. Because the law exists for the public's benefit, not to make creators rich, it strikes a balance between giving creators enough rights so that they will have an incentive to continue to create, and making those rights limited and temporary enough so that the public can start adding onto the creations and advance culture, technology and society.

The law wants people to be able to freely express themselves as much as possible without fear of a copyright holder saying "you can't express yourself that way, because I'm the only one with that right." That's why the law does not protect facts or any language that serves a utilitarian purpose.

If phrases like "Barack Obama is the 44th president of the United States" or "turn the screw with a Phillips head screwdriver counterclockwise" could be copyrighted, no one could write a political blog or instructions to build furniture without paying huge licensing fees.

This relates to fashion because courts have concluded that clothing is non-copyrightable for the exact same reason that those phrases are non-protectable, because clothing serves a utilitarian purpose. Yes, clothing does look nice, but its primary purpose at least in the law's eyes is that it keeps us warm, keeps our delicate feet from being cut up by rocks and covers us up enough so that we meet public community decency standards.

Courts interpreting the copyright law have concluded that these utilitarian uses outweigh clothing's ornamental features. Keeping in mind that things that are functional and utilitarian can't be copyrighted, it's easy to see why the cuts of dresses often don't meet the requisite levels of originality to deserve copyright protection. Not even something as seemingly original as a Halloween costume is protectable. While it's common sense to assume the main purpose of a Halloween costume is to look scary or sexy (or both at the same time), the law rarely falls directly in line with common sense.

In the eyes of the law, even Halloween costumes serve the same utilitarian purpose that all other clothing does to prevent nakedness.

a) some elements of clothing are fully protectable by copyright laws.

The seemingly simple rule that clothing can't be protected gets more complicated when you learn the major exception to it.

“features that can be identified separately from and are capable of existing independently of, the utilitarian aspects of [clothing]” can be protected by copyright. It might be helpful to clarify this using the language from an important case on the subject, *BRANIR INTERNATIONAL, INC V CASCADE PACIFIC LUMBER CO*: “if design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of work cannot be said to be conceptually separable from the utilitarian elements. Conversely, where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists.”

To clarify this further, when a portion of your clothing, if taken off the clothing, could independently meet the requirements for copyright protection then that portion can be protected by copyright.

For example in *KIESELSTEIN-CORD V ACCESSORIES BY PEARL, INC*, the court needed to determine whether a designer belt buckle could receive copyright protection. The question came down to whether a

designer belt buckle has a visual function that is not tied directly to its utilitarian function of holding a belt together. The court found that generally “sculptured designs cast in precious metals, decorative in nature and used as jewelry,” were separate enough to be protected by copyright even though belts were not generally protected.

Here's a counterexample where a sculpted design was not protected because the court found that it was utilitarian.

In *CAROL BAMHART INC V ECONOMY COVER CORP*, mannequins of the human torso with hollowed backs were denied copyright protection because the court believed that the design of the mannequins was dictated entirely by their utilitarian function as mannequins (which is to display clothes)

b) clothes may be protected by patent or trade mark law.

Clothes and elements of clothing can sometimes be protected by other laws like patent or trade mark law. Keep in mind, though that clothing rarely meets the standards to be patented and in the unlikely context that it is patented, patent law will protect the clothing very narrowly. Utility patents and design patents are also potentially available if a clothing design is “new and non-obvious” and provides some sort of novel function. Generally for normal, standard clothing items (shirts, dresses, hats, socks) design patents will be inapplicable.

Design patents are given when someone “invents a new, original and ornamental design for an article of clothing.”

c. fabric prints may be protected by copyright.

Fabric prints can have copyright protection. While “there is no copyright in the cut of the cloth, or the design of the skirt or jacket as a whole, since these articles are utilitarian,” the print found on the fabric of clothing is copyrightable to the extent it meets the three requirements for protection that

is fixation, expression and originality, since fabric patterns exist separately from the utilitarian nature of the clothing.

If you think about this logically, it makes sense. After all, it does not matter whether a design is printed on a piece of fabric or printed on a canvas and displayed in a museum, as long as it meets the minimum requirements for copyright protection, it can be protected.

Just like any other image though, it's not very difficult, to make a "knockoff" clothing pattern that's different enough to deserve protection and steer clear of claims of copyright infringement. "that's why famous designers see knockoffs of their clothing almost immediately after a runway show." [Mary Bellis]¹³²

If you have T-shirts with original graphics on them that you made or paid to be made, then the law protects you from others copying/distributing/selling that graphic itself without your permission. If you plan on using the design on the shirt commercially, you could consider registering the copyright to take advantage of all of the benefits of registration.

D. Trade mark and patent law relating to clothing

Trademark law protects against people trying to confuse customers into thinking they are buying something that they are not. Trade mark law is not about prohibiting copied designs; it's about prohibiting copied "labels" that mislead consumers into believing a copied design is an original.

Counterfeits and fake labels are absolutely prohibited by law, but it does not provide any protection for the same fashion design when the pirates omit the label. One of the challenges we have is that people will go to a show and just

¹³²<http://inventors.about.com/b/2010/09/14/can-an-article-of-clothing-be-patented.htm>

sketch it and by the end of the day, print it out and ship it out on the internet to another country to make a copy of it.”¹³³

To complicate things a little bit, once a clothing design gets so well known that consumers associate that design only with that single designer that makes it, a design itself can receive trademark protection as well. That protection will prohibit anyone from copying the design directly. It will also allow the trademark holder to seize and destroy counterfeit direct copies of the product that might be brought into the country.

Similar to trademarks, the registration before a competent intellectual property office is required to obtain design protection. The registration of a design has a territorial effect, which means it is limited to the territory in which it is registered.

DESIGN REGISTRATION ABROAD.

Designs can, similar to trade marks be registered abroad in three different ways:

1. community design registration at the European union intellectual property office (EUIPO)

For the applicants, seeking protection of the design on the entire territory of the EU, the best option is to gain protection of the community design, that can be either registered or unregistered. Protection under the unregistered community design can be obtained without any registration through commercial use of the design within the EU and lasts three years from the date when it first became available to the public. The registered community design, on the other hand has to be registered before its commercial use at the European Union Intellectual Property Office (EUIPO) in Alicante, Spain. When registered, it provides protection in all 28 member states of the EU for

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http://nymag.com/daily/fashion/2010/05/fashion_caucus_determined_to_c.html

five years and can be renewed for up to 25 years. The application for the community design can be filed by a Slovenian citizen (or any other citizen of another member state) or a legal person with the place of business in Slovenia (or any other member state) alone or through a representative in trademarks and designs matters. EUIPO first examines whether the application fulfills the formal prerequisites for registration. After that the substantive conditions are examined, namely whether the appearance of the product is able to be protected and its elements are not in conflict with the public order or morality.

NOTE: similar to SIPO, EUIPO does not examine the novelty and the individual character of the product.

If the design meets all necessary requirements, it is registered and published in the register of community designs. Also before EUIPO, holders of earlier rights cannot object the application of a design, however, they can claim the nullity of the design after it has been registered.

2. international design registration at the world intellectual property organization (WIPO).

The second possibility is to apply for an international registration according to the Hague Agreement concerning the International Deposit of industrial Designs (the Hague Act from 1960 and the Geneva Act from 1999) at the world intellectual property organization (WIPO) in Geneva, Switzerland.

With a single application, a design can be protected in over 60 signatory countries of the Hague Agreement. The registration in different countries through this system offers the same degree of protection as the registration of the design in each country respectively. After the registration of the design has been published by WIPO, selected national intellectual property offices examine whether the appearance of the product meets the conditions for registration.

3. national design registration at foreign intellectual property offices.

The third possibility is to register the design directly before foreign intellectual property offices of countries where protection is sought. For this kind of registration, applicants would usually need the help of national representative, with whom IPI cooperates. In most countries, the registration process is similar to the one before SIPO, with the exception that some offices examine also the novelty and the individual character of the product.

However, clothing designs generally only gain trademark protection in the long term, after widespread sale and advertising. This is a very difficult hurdle for clothing designers to surmount, particularly because by the time the design is eligible trademark protection, it may already be out of style.

Design patents are also potentially available if a clothing design is a “new and non-obvious” and provides some sort of novel utility. Generally, standard clothing (like shirts, dresses, hats) will not be eligible for design patents.

The name of the clothing line, if you have one would be most likely to be protected by trade mark laws. However, its necessary to have comprehensive research on the mark done prior to filing to ensure that there is no possibility of infringing upon another party's trademark.¹³⁴

Features of a product that are due to its technical function only, are not protected by industrial design law. Two or three dimensional designs, including typographical characters which are not protectable by patent or utility model law due to the technical nature of these IP rights, can be protected as design patents. A design patent protects the visual impression of a product on the informed user whereas a patent or utility model protects its technical features.

Protection of industrial designs can be secured by application and registration with the Uganda Patent and trademark office with the office for harmonization in the internet market (OHIM) with the world intellectual

¹³⁴https://www.newmediarights.org/business_models/artist/can_you_copyright_clothing_designs

property office (WIPO) or with any national patent office, depending on the country or geographical region for which protection is sought. The responsible office only examines formal requirements of the application, but neither novelty nor individuality of the design. Whether a design meets these requirements will only be determined in a law suits when the opponent questions novelty and individuality of the design.

PIRACY OF DESIGN

Piracy of a design means the application of a design or its imitation to any article belonging to the class of articles in which the design has been registered for the purpose of sale or importation of such articles without the written consent of the registered proprietor.

The person acting in contravention of the above is liable to pay damages for contravention. In addition, damages may be claimed and injunction can be asked from the court.

REMEDIES IN CASE OF REGISTERED DESIGN AGAINST INFRINGEMENT

Only civil remedies are available and no criminal remedies is available against infringement of copyright in the design. Civil Remedies available are:

- Injunction
- Damages or compensation, and
- Delivery up of infringement articles.

DESIGNS CASE LAW

1. RECKITT BENCKISER, design key rule spare parts that are a significant cost compared to the main product are protected by unregistered design rights. In this case, Canon made printers, Green Cartridge made compatible ink Cartridges which fitted the printer Canon sued. Held that unlike

Bharat Glass Tube Limited v. Gopal Glass Works Limited, 2008

In this case the Supreme Court defined the object and purpose of the Act in the following words:

“The object of the act is to protect the Intellectual Property Rights (IPRs) of the original design with the aim to reward the innovator for research and labor applied to evolve a new and original design. The Court further emphasized that the protection given with respect to designs is primarily to advance industries and to keep them in a high level of competitive progress. One interesting feature of industrial design is that, unlike patents, it does not have high social costs as it does not offer someone the status of an absolute monopolist in the relevant market”.

Gopal Glass Works Ltd. v. Assistant Controller of Patents & Designs, 2006

In this case, the court held that under the law presently in force in India, specification, drawings, and demonstration in connection with the registration of a design do not per se constitute publications that prohibit future registration of that design. Had publication of design specifications by a registering authority, particularly a registering authority in a foreign country, in connection with the registration of a design, in itself, amounted to prior publication, it would have hit all future applications in India for registration of designs. It is significant that parliament consciously made publication in a country other than India a ground of cancellation, in addition to publication in India, but expressly restricted the embargo of prior registration to registration in India. Thus registration in a country other than

India had not been made a ground for the cancellation of a registered design.¹³⁵

¹³⁵[https://www.lawcolumn.in/designs-act-2000-summary-and -notes/](https://www.lawcolumn.in/designs-act-2000-summary-and-notes/)

CHAPTER FOUR



ENTERTAINMENT LAW IN UGANDA.

INTRODUCTION

Uganda is richly endowed with creative talents, there is increase reward for creativity in different dimension especially the entertainment industry with the internet being the key driver of this emerging market.

Entertainment is a form of activity that holds the attention and interest of an audience or gives pleasure and delight. It can be an idea or a task, but is more likely to be one of the activities or events that have developed over thousands of years specifically for the purpose of keeping an audience's attention.¹³⁶

The entertainment law is used interchangeably with intellectual property though it forms a tiny segment of the industry.

Entertainment law is defined to mean the field of law dealing with the legal and business issues in the entertainment industry such as film, music and theater and involving the representation of artists and producers, the negotiation of contract and the protection of intellectual property rights.¹³⁷

¹³⁶https://en.m.wikipedia.org/wiki/Entertainment_law

¹³⁷ Blacks law dictionary, (Bryan A Garner, 9th edition, USA: West Publishing Co. 2004) p. 611

Entertainment law, also referred to as media law, is legal services provided to the entertainment industry.¹³⁸

TYPES OF LAW THAT ARE PART OF ENTERTAINMENT LAW

There are many types of law that are all a part of entertainment law.

Contract law in entertainment law

A large part of entertainment law is contract law. Some contracts in the entertainment industry last years while others are for a single event. Contracts in the entertainment industry might involve very large amounts of money. Drafting and negotiating contracts is a key part of entertainment law. Lawyers must work to carefully to negotiate agreements that are favorable to their clients. They must be mindful of issues like enforceability of contract terms and damages in the event of a breach.¹³⁹

The entertainment industry exists in a state of economic uncertainty. Entertainment companies continually form, merge, re-form, and dissolve. Furthermore, consumer tastes in artistic products can change quickly, thrusting certain artists or artistic movements to the heights of popularity and reducing others to obscurity. Because of this instability, the entertainment industry relies on complex contracts, which usually are drafted to protect entertainment companies against economic risk.¹⁴⁰

Non-compete agreements in entertainment law

Non-compete agreements are often a large part of entertainment law. A production company may want to develop a talent and promote them. They may want assurances from the talent that they aren't going to go work for the

¹³⁸https://en.m.wikipedia.org/wiki/Entertainment_law

¹³⁹<https://legalcareerpath.com/what-is-entertainment-law//>

¹⁴⁰<https://www.encyclopedia.com/law/encyclopedias-almanacs-transcripts-and-maps/entertainment-law>

competition for a period of time after their employment ends with the company.¹⁴¹ An agreement that restricts a talent from working for the competition is called a non-compete agreement. Both national on-air talents and local talents may have a non-compete agreement as part of their employment contract. However, non-compete agreements must be reasonable. Both creating a non-compete agreement and challenging its enforceability may be part of entertainment law.¹⁴²

For example, a record company may contract with a musician to provide one album during the first year of the agreement, with an option to extend the contract. After one year, if the record company feels that it would be economically wise to release a second album by the musician, the record company may exercise its option and require the musician to provide the second album. Under option contracts such as this, producers can keep artists on their roster for many years, or as long as the artists remain profitable.¹⁴³

Litigation in entertainment law

Even carefully drafted contracts may result in disagreements in entertainment law. When there are disputes, people and organizations in the entertainment industry turn to litigation. They might use litigation to resolve contract disputes, torts, employment disputes and other types of wrongs or disagreements. Lawyers who practice litigation entertainment law must be skilled in favorable outcomes when entertainment leads to litigation.¹⁴⁴

Labor and employment law in entertainment law.

Entertainment lawyers must be mindful of labor and employment laws that apply to their industry. Whether it's written law or it's a negotiated union contract, entertainment lawyers who employ talent and production staff

¹⁴¹<https://legalcareerpath.com/what-is-entertainment-law/>

¹⁴² *ibid*

¹⁴³<https://www.encyclopedia.com/law/encyclopedias-almanacs-transcripts-and-maps/entertainment-law>

¹⁴⁴ *ibid*

must be sure to follow labor and employment laws. Labor and employment laws that are applicable in the industry may relate to fair hiring practices, maximum allowed hours of work, workers compensation or safety regulations.¹⁴⁵

Compliance law in entertainment law

Entertainment producers have to comply with a number of rules and regulations. The Uganda Communications Commission creates regulations that apply to the entertainment industry. For example, there are restrictions that prevent radio and television companies from owning too much control of any geographic market. In addition, if a radio or television station gives one political candidate time on the air, it must give equal opportunities to other political candidates. Entertainment companies rely on attorneys in order to help them comply with the myriad of regulations that oversee the entertainment and communications industries.

Standards and practices in entertainment law

Another important area of entertainment law is standards and practices. Standards and practices refers to the ethical and legal implications of an entertainment production. Lawyers help entertainment companies identify practices that might subject the company to legal liability. They help the company implement best practices in order to minimize legal liability.¹⁴⁶

For example, a standards and practice attorney may recommend removing obscene content from a broadcast in order to minimize the risk of a fine from the UCC. They might help the corporation address issues that may arise during the production of a game show. In the standards and practices process, attorneys help their clients do business in a way that minimizes legal risk to their clients in the entertainment industry.¹⁴⁷

¹⁴⁵ *ibid*

¹⁴⁶ *ibid*

¹⁴⁷ <https://legalcareerpath.com/what-is-entertainment-law//>

The Fiduciary Duty of Entertainment Attorneys:

Joel v. Grubman

An attorney has a duty to act solely in the client's best interests, to disclose any potential conflict of interest, and to withdraw if a conflict would impair the attorney's ability to represent the client. In 1992 pop singer Billy Joel sued his former attorney Allen J. Grubman and Grubman's law firm for \$90 million, claiming that Grubman had committed fraud and breach of contract. The suit alleged that while representing Joel throughout the 1980s, Grubman had defrauded the singer out of millions of dollars by negotiating secret deals with Joel's manager, Francis Weber, and by allowing Weber to control the law firm's representation, often in direct conflict with Joel's best interests. Joel claimed that if the firm had notified him of Weber's actions, Joel could have prevented millions of dollars in losses to his manager. The singer claimed that the law firm was concerned primarily with enhancing its own reputation by keeping him on its client roster, and did not want to risk losing Joel as a client by angering Weber.

Joel also alleged that Grubman failed to disclose that the law firm represented Joel's label, Sony Music, and that such representation was an inherent conflict of interest that biased Grubman's judgment during contract negotiations.

The law firm claimed that it had done nothing illegal or unethical in its representation of Joel, and stated that it was hired by Joel only to negotiate contracts, not to monitor the business ventures of Joel's manager. Furthermore, the firm claimed that Joel had earned millions of dollars as a result of his recording contract, proof that its advice to him during negotiations with the label were not affected by the firm's relationship with Sony.

The case sent shock waves through the entertainment industry, where it is not uncommon for attorneys to represent both sides of a contract negotiation, or

at least have ongoing client relationships with both sides, and it is also not uncommon for an attorney to respect the decisions of an artist's manager even though the attorney's client is the artist. Joel and Grubman settled the case without disclosing the terms of settlement.

Attorney Misconduct; Conflict of Interest.

Some option contracts can be disastrous for the artist. For example, musicians sometimes sign an option agreement without a provision that they may break the agreement if the record company fails to release their works. Many recording artists have been held in professional limbo by record companies that refuse to release their music and also refuse to allow them to record for another company. This practice, known as shelving, is used by some record companies to prevent economically risky artists from becoming valuable assets to other record companies.

Other entertainment industries use short-term personal service agreements rather than option agreements. For example, film studios often contract with actors, directors, screenwriters, and other creative artists on a one-film basis. Short-term agreements allow studios to avoid paying guaranteed fees to artists whose market might dissipate overnight.

Litigation over personal service agreements is common in the entertainment industry. Often, an artist who is relatively unknown is willing to enter into an agreement that drastically favors the company with which he or she is signing. Once the artist achieves success and sees the profits that the company is making from his or her services, the artist may demand higher fees or royalties, or to be released from the contract. Conflicts such as this often end up in court, where companies often demand that the court order that the artist not perform for anyone else while the contract is in dispute. (This type of order is known as a negative injunction.) Whether the contract will be enforced and the artist required to perform under the agreement is usually determined by whether the contract meets certain legal requirements based on the state laws that govern it.

CONTRACT FOR RIGHTS

Another primary type of contract in the entertainment industry is the contract for rights. This contract often involves a transfer of copyright ownership or a license to use certain creative property (e.g., a song or photo).

Many times, a contract for rights is combined with a personal service agreement. The agreement often will state that any work created by the artist during the term of the agreement is considered a work for hire. The company with whom the artist has contracted often receives automatic ownership of the copyright to a work for hire. For a work for hire to exist, the artist must either be an employee of the company or create the work pursuant to a valid written agreement—and even then, the work must fall within a few specific categories defined by copyright law.

A license is a contract through which the artist or copyright holder grants certain rights to another party and promises not to sue them for certain activities. For instance, a novelist might grant a license to a film studio to create a screenplay based on a novel. A license specifies the fee or royalty to be paid to the artist, the exact scope of use of the copyrighted material, and the time period for which the company may use the material, as well as any other conditions that the parties agree to attach to the license.

UNIQUE ASPECTS OF ENTERTAINMENT INDUSTRY CONTRACTS

Complex Royalty and Payment Provisions Because entertainment companies often risk large losses, the contracts they use often contain clauses that artists may consider to be unnecessarily complex or one-sided. For example, film studios often base payments to talent in part on net profits. The calculations that are necessary to determine net profits, as defined in a typical contract, can be mystifying to those who represent the talent. A screenwriter

or an actor who receives bonuses or royalties on net profits might be paid little or nothing on a film that has earned hundreds of millions of dollars but is still showing a loss according to the net-profits calculation. Net-profits clauses have resulted in several high-profile lawsuits, *Buchwald v. Paramount Pictures Corp.* (13 U.S.P.Q.2d [BNA] 1497 [Cal. Super. Ct. 1990]),

Garrison v. Warner Bros., Inc. (No. CV 95-8328 [C.D. Cal. filed Nov. 17, 1995]), *Batfilm Productions, Inc. v. Warner Bros.* (Nos. B.C. 051653 & B.C. 051654 [Cal. Super. Ct. Mar. 14, 1994]).

Record companies also use complex contractual formulas to determine royalty payments to their artists. Companies typically offer seemingly large royalty percentages to artists. Various clauses in the recording agreements then are used to reduce the royalty percentages, reduce the number of units on which royalties are paid, and delay payment for many months. Although a few small record companies have made some effort to simplify the structure of recording agreements, the major record companies and their smaller affiliates have fought to maintain the more complex, formula-based agreements.

Advances

Many entertainment contracts are structured with advances. Advances are payments made to an artist before any actual income is received by the company that manufactures or delivers the artist's products or services. For example, an author might receive an advance when a manuscript is approved by the publisher. This advance is normally nonrefundable, even if the publisher never earns money from the publication of the author's work. However, the publisher will keep any royalties that would have been payable to the author, until the author's advance and other expenses have been recouped by the publisher.

Contracts with Minors

Contract law requires that specific steps be taken in, or clauses added to, a contract with a minor, to ensure that the contract is valid. Often, companies will require that the minor's parents execute a valid release, under which they guarantee the services of the child and agree to be held liable for damages if the child fails to perform under the terms of the contract.

Contracts with Intermediaries

Successful artists are surrounded by many individuals who are responsible for enhancing and protecting their career. Unknown artists use the services of such intermediaries to help them become known to more powerful figures in the entertainment industry. Intermediaries have various names and functions, but all serve to promote an artist's visibility and success in the industry. For this service, they generally take a percentage of an artist's earnings or a portion of the artist's property rights in the artist's creations.

Agents

Agents are individuals who procure employment and other opportunities for artists. In film production, agents find actors roles or pitch screenwriters' works to studios, producers, and actors. In music production, agents procure live engagements for musicians.

In book publishing, agents attempt to secure publishing agreements for authors. Agents nearly always require an artist to use only their services, while they usually serve many artists. Agents have become powerful figures in the entertainment industry.

Personal Managers Personal managers are individuals who guide various aspects of an artist's career. In the early stages of an artist's career, the manager might act as agent, publicist, contract negotiator, and emotional counselor. As an artist gains in stature and income, the personal manager's primary tasks are to choose and to direct specialists to handle various aspects of the artist's

career. For these services, personal managers often receive 10 to 20 percent of an artist's income from all sources.

Attorneys

Attorneys in the entertainment industry perform many standard legal functions such as conducting litigation, giving business advice, protecting intellectual property, and negotiating contracts. Entertainment attorneys also serve as industry intermediaries, promoting their clients in order to procure contracts for the artists' products and services. For these services, entertainment attorneys are paid either an hourly fee or a percentage of an artist's income.

Entertainment attorneys often face difficult conflicts of interest. For example, an attorney who has represented a record company is often pursued by a recording artist to shop the artist's material to that company. The artist knows that the company will often trust the attorney's opinion of the artist's marketability, which gives the artist a better chance of obtaining a recording contract. The attorney, however, is often privy to confidential information about the record company, or still represents the company in related negotiations. Attorneys and artists have been involved in several high-profile disputes because of such conflicts of interest.¹⁴⁸

CHALLENGES FACING THE ENTERTAINMENT INDUSTRY.

Uganda is renowned for its creative talents. The country is home to a number of musicians, actors and sportsmen whose works are widely enjoyed by

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<https://www.encyclopedia.com/law/encyclopedias-almanacs-transcripts-and-maps/entertainment-law>

diverse audiences. The industry is however confronted by a number of challenges, key of which is widespread piracy of works.

Ugandan procedures constantly bemoan their fate in the hands of pirates, whose activities have jeopardized their returns on investments, thereby undermining the economic rationale for copyright protection and serving as a disincentive to prospective investors in the sector. For example in the Ugandan music industry, the works of a number of Ugandan artistes are prominently displayed on websites all over the internet. These websites can be seen promoting and offering for sale, works of Ugandan musicians. Others however make the works freely available for downloading. It is even doubtful if those that offer these works for sale do so with the consent of the right holder. This development has affected Uganda's foreign earnings in this emerging industry. Even the Ugandan wood industry does not generate that much measurable revenue for Ugandan entertainment and media due to issues of piracy hampering official cinema owners and film vendors.

As the entertainment industry evolves, the industry is faced with the challenge of finances to execute its projects. With the banks having limited knowledge of the workings in the industry, getting loans from them is difficult. Most entertainment companies merely rely on their savings and funds from the wealthy production.

LACK OF transparency : This has been an issue for as long as the industry can be recognized. Issues in complex nature of contracts, advertising, handling and settlement of funds, acquisition and retainment of personnel and content, ambiguity in having on board the clients and producers have always been of concern to the media houses.

COMPLIANCE WITH LAWS/REGULATIONS, it is very difficult for the media industry to comply with all the rules and regulations within the time limit and to act in accordance with all the laws that apply to them. Legal compliance is very important as it prevents the organizations from lawsuits and damages, while detecting violations. But it is not easy to identify them

since the laws are evolving and an organization needs a sound team to put off this challenge.

CHALLENGES WITH RESPECT TO TAXATION: each business has to pay taxes, to the local government, to the state and the centre. The income tax department comes very heavily on the defaulters, from huge amounts of fines to even imprisonment. Taxation is a very slippery path and it is very important to be cautious as to how the media industry grows and grows safely (without having being a target to the tax structure) hence it is very important that this industry has a very sound section to manage taxes.

THREAT TO MEDIA CHANNELS: with people shifting to digitization, it is not only the transmission of news, facts and information that has become faster and easier but so has the attacks such as hacking social media accounts, phishing, frauds, etc. social media accounts are one of the most important assets of the media industry in the current scenarios, and the hackers can easily hack into them and spread false information which may result in hurting the sentiments of lots of people and attract bad names to the media house. Further the attackers may use these handles to post a link that may redirect the users to malicious websites and the users may be duped. There are various instances wherein these attackers pose themselves as employees of these media houses and loot them.

HURT AND LIFE THREATS TO PEOPLE WORKING IN THE INDUSTRY, this mainly happens to reporters that cover sensitive issues and to those who really put in genuine efforts in revealing the truth behind a story. News anchors, journalists, activists on social media are mainly targeted. People who are whistle blowers or who spend their career covering issues such as rape, dowry, honour killing, murder, revealing the identity of a famous celebrity or a VIP or even cases related to them; most likely get threatened of harm to their life or injury to their loved ones. This holds true for people working in journalism, anchor/hosts of radio station, news channel, writers of print media and influencers online.

CONCERN RELATING TO DATA PRIVACY. Regulations have been implemented for businesses to handle personal data and for organizations that transmit user data to such companies, yet data leak has been the headlines quite very often. Big data challenges can pose trouble when it comes to accumulating adequate user data, without which exact scrutiny cannot be carried on. Viewers are being more sensitive than ever, towards their data and are troubled on how their personal data is being used.

Licensing requirements

With each step of success that the organization takes, registration is required for business licenses, from employment registration, taxation, expanding the business, enlarging its scope by having new clients on board, etc.; for all steps, the ownership document is a primary requirement. Investors are also very vigilant on the license issues ahead of entering into this type of business.

Copyright and piracy issues

These challenges have been in the industry for a very long time now and it is very difficult to bring justice even if the laws are all stringent and in place. With the rise of digitisation, more big data problems have emerged such as sharing of account information through which multiple users can view content from the same account, using the password. It then becomes difficult for the production houses to categorise what genre of content is favourable to an adult and to a child. Pinpointing on the demographic details of an account user also becomes extremely difficult. Many people have started using the content available on online platforms for their own use; pirate and spoof this data to make it look like their own new creation and upload it to generate revenue. This is another major issue faced by, in particular, the entertainment industry.

Adaptation challenges

Only a few percentages of players in the media industry are welcoming new technologies to their area of work, while the majority are hesitant and are concerned about the backfire or the trouble these new “uncommon” solutions will cause. This results in dependency on outdated methodologies making it difficult for the players to communicate business between themselves. Use of terms like “big data”, “artificial intelligence”, “automation” etc have increased now more than ever, particularly as reporting tools and yet we are resilient in adapting these technologies for our benefit.

Lack of financial support

Finance is not so-much-of-a-big-issue for well established or even new media houses that are backed by some influential person; but it matters a lot to small organisations, someone like you and me who wants to establish a start-up to give out some real content. Starting a new company may or may not be difficult on an individual basis but one thing is common in each case, that is, building investment and scaling up with the growing business has always been tough for all types of media houses. These costs vary a lot, from human resources costs, to data collection and processing costs, to data storage and protection costs, etc. SaaS and Cloud storage do make it easier to an extent but not everyone is ready to accept it with open minds or do not have enough resources to implement it.

Media Reputation

Reputation is fast-reaching; it is like the fire in the forest. The character of lifetimes crushed down to “reputation” in one action; whether that action was justified or not is something to be looked into but nowadays, media

houses are not considered to be a very favourable place to work at. It has gained a bad reputation; a medium that was earlier supposed to bring out true facts and be a source of inspiration has now merely become a money-making institution and the “voice of the voiceless” gets silenced in no time. Ever wondered why not many people are choosing this profession? Ever wondered why there aren’t enough professionals to fill the void?

Discrimination and lack of efforts

Both these words are a reality in the media industry. Discrimination happens; discrimination of both types-positive wherein females are not put out on field for particular tasks where muscle and high tolerance to pain and pressure is needed and, negative wherein a stereotype is formed that a particular gender is only fit to assist and to do desk-job. But this discrimination is gradually fading away when we as a society are developing a sense of togetherness, that no work is made for a particular class and that anyone who has the require qualification and skills can perform it. That draws my attention to another challenge which is short of initiative. I remember my journalist friend telling me, “I just do my part of the work, our individuality gets work done but we lack team effort; my teammates always have to gossip around until the deadline and then work all night”, she continues, “we are a group, not a team.” When odds are against us, it is the total effort that brings us success. I believe Hellen Keller puts it in the best way when she says, “Alone we can do so little; together we can do so much.”¹⁴⁹

Bullying and harassment at workplace

¹⁴⁹ Quote by Hellen Keller, <https://www.goodreads.com/quotes/9411-alone-we-can-do-so-little-together-we-can-do> (last visited 03rd December, 2021, 05:00 P.M. IST)

The media industry has been collaboratively working to promote a more inclusive workplace but what comes out is that we still need to work on creating a safe, respectful environment. Bullying in the form of intimidation and/or insulting behaviour, abuse or misuse of power, mobbing or intentional/unintentional targeting is very prevalent. Other than bullying, harassment- physical, mental and visual, is always very frequent in the media biz. For instance in America, the Centre for Talent innovation in its “What #Me Too Means for Corporate America” report has found that 34% of women and 13% of men have been victims of sexual harassment, defined as an unwanted sexual advance or obscene remark.¹⁵⁰ The 2020 film “Unpaused” showed how the boss of that news channel is making advances and is offering his female juniors an opportunity to handle big projects in return for sexual favours. This has been a challenge that needs to be tackled for so long but the victims were not ready to open up for understandable reasons. The society is now supportive and the abusers are now being questioned but we still need to fight this evil.

Sector-specific issues

Media is basically of three types; broadcasting, printing and internet media. Let us now look at some concerns faced by these different communication outlets:

Television

The customer’s flavour is changing every day; they are not anymore fully satisfied with conventional broadcasting. They want, rather need, fresh content each time they log in; on their laptops, tablets, mobile phones, social

¹⁵⁰https://www.talentinnovation.org/_private/assets/WhatMeTooMeans_PressRelease.pdf (last visted 03rd December,2021,05:10 P.M. IST)

media TV etc. That being said, customers now do not have the time to sit in front of the LED TV and view content, they rather prefer television-on-the-go. The biggest challenge that affects the Television media industry is digitisation and technological advancements. Technology never remains static, televisions which were very popular once, have not much in style in the present day. The channels now have their own mobile application through which users can watch the shows from any device, anywhere and this does not look good for this traditional medium of communication. OTT platforms have become quite popular amongst the younger generation. When one can simply view fresh, new content on these platforms, why would users wait for the content to be broadcasted on TV?

The customers have become tech savvy and since now everything is on their fingertips, it is easier for them to decide what electronics are best suited according to their lifestyle, what is pocket friendly and what return do they get out of their investment. This is another challenge for the industry; the customers have realised that television sets are expensive and which are not-so-expensive might need added accessories like speakers and home theatre etc. The other electronics are cheaper and come with newer technologies. The subscription of these OTT platforms and the mobile applications is not very expensive as compared to paying for a TV channel package.

With many more new manufacturers coming out in the TV market, it is necessary to be outstanding from the group to build customer trust and confidence. They are in the pressure to cut their costs and even in the long run, we do not see the companies earning a significant amount of profit. This will result in winding up of many TV manufacturing companies because their selling price would not be much than the manufacturing costs, leading to reduction in the company's profitability.

Radio

The oldest and the cheapest form of entertainment, All India Radio has been going through a turbulent phase and is fighting for its survival. The relief from the government in the form of annual license fee payment is not enough and nor is the FDI which is not more than 49% subject to terms and conditions.¹⁵¹ The smaller organisations would reach a stage whereof their revival is beyond the scope. Another challenge is coming out of the turbulent phase affected by the Covid-19 lockdowns. Even if the business starts operating as usual, there is not much support from the government in respect of advertising and revenue; and hence, the industry will take a long time to put itself back in as their previous position.

Another hit to the radio industry comes through the other sectors of business and their advertising. Apart from the government advertisements, the other players that contribute to its revenue are real estate, MSME, retail, hospitality, etc. These industries too have suffered immensely due to the pandemic and do not help in contributing towards the radio industry. The only way to distribute their content is by branching out and generating revenue for themselves.

Big cities such as Mumbai, Delhi, Ahmedabad and Chennai are recovering from the hit as compared to smaller towns. Banking and finance institutions, the FMCG sector have come forward for advertisement with respect to hygiene, sanitation, etc, bringing in new revenue. The industry is partnering up with OTT music streaming platforms making their original shows, content and podcasts available on apps for a better reach. At the most basic level, radio was used for person-to-person communication, the scenario of which is changing now. Partnering up is at the cost of losing radio's own uniqueness; the business will grow on a compromise driven model rather than a content driven model.

¹⁵¹ Consolidated FDI Policy Circular of 2020, [https://dipp.gov.in/sites/default/files/FDI-PolicyCircular-2020-29 october 2020_0.pdf](https://dipp.gov.in/sites/default/files/FDI-PolicyCircular-2020-29%20october%202020_0.pdf) (last visted 03rd December ,2021,07:00 pm.ist)

The radio is expected to show the true image of the facts; help citizens with clearer social and political awareness. But when the regional and the national government is of two different political parties, that will not be a smooth sail. Even though broadcasting is within the powers of the union government, they cannot work in isolation without the inputs of the state governments. Yes, there is a risk from the new media coming up but radio is still a very respectable medium which has compromised significantly. It is important that with a rigid policy in respect of new recruitments, internal promotions; it meets the requirements of suitability in respect of language and professional standards.

Cinema/Films

Cinema is a combination of visual, dialogue, music and special effects that makes us reflect on our lives and entices deep feelings. There are many petty problems regarding the cinema industry worldwide but here, we will look into how it has mainly affected the industry in India. For the Hollywood movies that wish to come to India for their shoot, one of the major problems is that the industry has too many permissions to take, too many protocols to follow, which results in losing the potential client and they shifting to some other location where this process is much faster.

The industry needs to understand that people see and understand everything. Starring famous celebrities with no proper storyline or concept is not going to bring them money. This is why there is a gradual shift in the audience favouring Ugawood in place of Ugandan cinema. We just do not have good scripts; all we see is a remake of either, old movies or movies from other industries. This being said, another point that we observe is the producers like to play it safe, for themselves and their distributors. Most of the producers bet their money on the same old cliché scripts and are not willing to take risks even on good content, which in my opinion is regretful. Like every other industry in Uganda, even the cinema is affected by the virus of realtive-ity.

With a population of over a billion, we try to accommodate our known ones in a vacancy, even if that person is capable of achieving it for themselves without any help. Nepotism has been the talk of the industry for quite some time now, and it is very difficult for a newcomer to get established and be launched without a caretaker.

Piracy and shifting to OTT platforms has been an issue for quite a few decades and the major reasons that aids to piracy are high ticket prices, release of film in other places of the world before India and poor cyber structure. However, with anti-piracy measures and laws in place to safeguard innovative content, along with the government reducing the GST on film tickets, piracy has been under the radar but it still has a long way to go.

Print Media

Technology upgradation and changes in customer preferences have created some serious challenges for this industry. One of the very serious concerns amongst the masses lately has been that so much paper is consumed by the print and publication industry. As much as half, or atleast near about so; of the trees that are harvested, are cut off to make paper. The bleaching agents that the industry uses, also causes harm to the environment. Inks which are petroleum based, have high amounts of volatile organic compounds that cause further harm to the environment.

Challenges faced

One of the biggest challenges is the digital substitution of the print media. With the introduction of E-Book formats such as Kindle, Noble and Nook, and audio books, a larger audience has substituted the traditional means of newspaper, magazines and books. These digital substitutions are a better option and are affordable, convenient. Another shot that digitalisation has

taken on the print media is that, there were some tasks that very mandatorily be done through the means of printing; but due to the Covid-19 hitting worldwide and us witnessing nationwide lockdown, has made us digital. We create documents and send them online; can create invites, brochures, magazine layouts on our desktops/laptops and share online with people. No need for printing now.

They say that a Pen is mightier than a sword. Journalism, a form of print media is expected to state out true facts, to bring out the political narrative. However, with political pressure and/or the media house owners'/promoters' ties with political links, suppress the actual facts and the whole intention of free press is failed. Various regional print media publications are partially or wholly owned by the political parties. Such control of present or former politicians can directly/indirectly affect the elections. Though the Electoral Commission comes down heavily and watches every activity of the parties participating in elections, a kin or next friend having interest in the media house can influence the readers through advertisements. Political capture in uganda needs to be regulated.

Being strategic. With many competitors emerging in the industry, the business houses need to up their game, engage in formal strategic planning by goal setting and undertaking measures to stay ahead in the competition. Assets, talent, margins, verticals, customer base, their response should be considered at all times. Planning, Pricing and People will help media houses stay ahead in such times of crisis.

Online Education

With schools and colleges closing its operations during the lockdown due to COVID-19, alternatives had to find an alternative. All the institutions shifted to digital classes through Zoom, Cisco Webex, etc. The problem with going digital is since there are so many participants, bandwidth creates issues and there are other technical glitches too. Apart from issues relating to

geographical reach; not everyone has the means, financial or otherwise, to procuring education by this means. Adaptation is also an issue; not everyone, especially the professors, are not very well versed with the technology.

With lack of in-person interaction, there is also a lot of distraction among students. Social media is always a distraction; while students go online to surf the internet to learn things, they tend to go switch to other social media and then it gets difficult to manage time.

There have been instances where the students while hiding their identity, harass the professors online, calling their names and abusing them. On the other side, during proctored examinations, the supervisors have misused the personal information of the students, approached them and have made advances. One such recent instance was that of NMIMS.¹⁵²

Conducting examinations has been a challenge; though the proctor system is in place, there are still a lot of ways that the students have devised to cheat. Assessment and Feedback is affected as compared to the traditional method where the teachers and the students communicated physically.

Advertising

Ad Blockers are the biggest challenge. People want to view content without interruption. This software makes it easier so that many advertisements do not appear on screen. These programmes cost billions to the advertisers.

With the increase in the use of social media, the advertising agencies saw a great potential in their business. However, the key people of the social media platforms realised what they were missing and simply blocked having advertisements on their platform unless paid for such promotion. The

¹⁵² 'Got Your Number From Sources': Students of Mumbai College Accuse Proctors of Harrassment-published on 9th January, 2021 on <https://thewire.in/education/narsee-monjee-mumbai-harrassment-online-exams-mettl>

industry, especially small brands, started spending hugely on advertisement across all platforms digitally or otherwise. This resulted in an increase in the cost of advertisement. Embracing technology and at the same time protecting the privacy of the users will be something that the industry will have to confront with.

Another challenge for the advertisement industry is attention and retention. We do not have the time and patience to look through all the advertisements and appreciate the content. Which is why, it becomes very important for the players in the industry to keep their content catchy, appealing and targeting a specific audience. The only solution to keep its business growing is to study the market, see what content is acknowledged by the majority of the users and accordingly make content. This helps in attracting an audience as well as in its retention.

Another challenge on a positive side is the rapid growth of the digital setting. Advertisements started off with printing and publishing, then now have moved on to the digital space but the truth is that it's not only the internet that the industry now has to focus on; we have smart cars, smart houses, IoT, virtual reality and what not. It is in the industry to figure out what their audience is, find different avenues, optimize, target and accordingly place advertisements. Technology will continue and so will the obstacles.

OTT platforms

Content is the most important factor to these platforms; it's basically the heart of the OTT media. If the platform is unable to provide services that match up with the standards of the public, these service providers are not going to be successful and are going to suffer terribly. For this, the industry needs to understand its audience. Providing content which is niche, is a very good prospect for growth but the problem while having a survey around this question is that either the sector to which they can invest in is very niche and not very popular or is niche and already over-crowded.

Competition and Retention. One of the very important issues is the rise of players in the industry. With rise in Covid-19 and the governments declaring nationwide lockdown with temporary closure of theatres and other sources of entertainment, these OTT platforms have received fame like it never has. However, there were many companies who had projected this to happen and have launched themselves in the market giving rise to competition. Yes, we do think that the ones that are old enough and have their customer's trust will survive nevertheless. But we are living in a society that is savings friendly; we switch to the service provider that provides services for a lesser amount. Further, since we are talking about reality, let us not forget that we all share our user ids and passwords with our friends and relatives so that they can view content for the platform that we have a subscription and the other way around.

OTT platforms do their best, despite the competition, to offer high quality video, favourable content, at reasonable price and uninterrupted content; yet viewer retention poses a great difficulty to these service providers.

Challenges faced

Challenges such as congestion, privacy, security and LAN etc. occur during multicasting on these platforms. They also require a protocol to distribute the content and program guide across various devices. Further, multicasting either requires diverse versions of multicast streams for facilitating DASH protocols or a one-size-fits-all approach based on a single video version. Along with multicasting, functionality also poses a challenge. Viewers no longer want to browse through pages to find content of their interest; they rather want it on their fingertips wherein they could just search or glance through a set and find interesting content. Thus, it is important that the service provider adapts themselves with the preferences of the viewers and makes their content easily discoverable.

Though this is an internal challenge of each company, it is something that hits the industry across frontiers. Managing demand has been challenge ever since people have started using social media; what content goes viral is almost unexpected to predict; it maybe some really important issue to a really dumb meme. But when a video or a part thereof of some video from OTT platform goes viral, the company must have enough measures in place, the bandwidth and servers in place, so that the application does not crash and that it handles so much pressure effectively.

Social Media

Social Media has become a very powerful tool; some use it to spread awareness and educate people, while others just want to create chaos online. This happens due to a lot of misinformation. Sometimes a post has been shared and re-shared so many times that the real source of the information is lost in the process and it's very difficult to establish whether the piece of information is genuine or fake. This becomes a major challenge for the industry to dig deeper, establish the source and label it, much before the information is lost or creates disorder. The second important challenge of this industry is to protect the privacy of the users. Social media is a space where nothing goes unnoticed and everything that an individual reacts to, comments on or posts, has a consequence or an influence on the onlookers. This attracts attention from people, from authorities and even from people with not-so good intentions. It is the duty of the company providing a platform to the users to protect the interests of the user and takes reasonable measures to guard the identity of the user. Further, driven with ideological and financial motives, we are going to witness more fake news and weaponization of social media. The media houses will have to be more media literate now than ever.

These social media houses are recommendation machines. They suggest to you more of what you want to see. This results in more audiences being attracted to them and their business growing enormously. It becomes difficult to adapt to the geographical reach, the scale of growth, while continuing the level of performance and maintaining internal constraints.

The Regulators come down heavily on these media platforms for any harmful content or for missing compliances.

Conclusion

In this article, we have seen an overview of the difficulties/challenges faced by the entertainment , jointly and severally. The underlying trend is that the society is moving towards digital and social transformation. By using the rapidly evolving technology, distribution of information and news has become easier. The implications of technology depend on the general developments in the industry, its impact on each country and its audience responding and adapting to the change. It also depends on the policies framed, regulation made and on its implementation; censorship, intimidation, professionalism, and interpersonal relations.

However, this article mentions all such challenges that we read on in our everyday life and the real, ground issues are beyond the scope of this article. The Ugandan entertainment industry today has a lot of things happening in and around it; be it introduction of FDI, restrictions from the government and impact on the economy, new lifestyle of the users to the advancement of technology. The industry needs to conquer all its setbacks in a determined manner, while producing high quality end products. The media industry has all that it takes to be a tool rather than a weapon; it only needs a little support from the government and an open mind, ears and eyes of the general public to excel in the economy. Challenges are going to evolve every day in an advanced manner but it is on us how we are informed, keep ourselves informed and inform others.

The absence of entertainment lawyers and other professional experts in the industry has not helped matters in improving the industry. It is the responsibility of these lawyers to help their clients who have joined the industry newly to understand what deals and contracts will be beneficial for them. They also make these clients aware of their performing rights. They

help clients with understanding how to hire an agent, manager and accountant. With their awareness of entertainment law, lawyers provide general counsel to clients. They also aid with inputs on merchandising and marketing deals. Entertainment lawyers help their clients with tax issues and real estate deals too, it is pertinent to point out that there is dearth of entertainment lawyers.

Recommendation

There is need for law reforms to accommodate and handle the different areas of the entertainment industry. Beyond law reform however, institutional support to combat the various challenges facing the entertainment industry need to be put in place through training and other forms of capacity building in the industry. The study of intellectual property law alone in our universities is not enough in preparing lawyers to delve into entertainment law and practice. As earlier pointed out, intellectual property law is just an aspect of entertainment law. We recommended that the intellectual property law department should be subsumed under the entertainment law department and its study well systematized.

Conclusion

As technology continues to grow and evolve, the entertainment industry has to find new ways to deliver content to consumers, and simultaneously deal with challenges of media that arise with these new innovations. However, despite all the problems in entertainment industry today, the fact remains that it's still one of the most lucrative businesses in the world, with consumers numbering in billions. And as change is one of the constant things in life, one

can expect entertainment companies to find creative ways to deal with these technical challenges and serve us even better content.¹⁵³

INSIGHT OF THE ENTERTAINMENT INDUSTRY

Copyright law can be confusing. This research provides an introduction to copyright law for musicians and addresses the often misunderstood issue of what exactly copyright law protects.¹⁵⁴

The most important concept in music copyright law is that each single piece of recorded music involves two distinct rights:

- The first right protects the underlying musical composition—that is, the specific arrangement and combination of musical notes, chords, rhythm, harmonies, and song lyrics. The law refers to this first type of copyright as a “musical work.” This interest is also sometimes referred to as the “musical composition” or the “song.”
- The second right protects the actual recording of a musical composition, which copyright law refers to as the “sound recording.” This interest is also sometimes referred to as the “master” or the “recording.”

While an unsigned songwriter who performs and records his or her own original songs owns both the musical work and sound recording copyrights in the song, it is often the case that the two distinct rights are owned by separate individuals or entities. In general, music publishers own or control the musical work copyright, and record companies own or control the sound recording copyright.

¹⁵³[https://hackercombat.com/4-technology-challenges-faced-by-entertainment-industry-in-2020//](https://hackercombat.com/4-technology-challenges-faced-by-entertainment-industry-in-2020/)

¹⁵⁴<https://blog.reverbnation.com/2018/04/25/music-law-101-what-does-copyright-law-protect/>

A music copyright, whether as a musical work or a sound recording, is created immediately upon creation and satisfaction of the following elements:

- It must be an original work of authorship; and
- It must be fixed in any tangible medium of expression, such as written sheet music, a MIDI file, or a digital (or analog) recording.

For example, as soon as an original song is written down as sheet music or recorded as a MIDI or computer sound file, a copyright is created. It is not necessary to publish the song or register a copyright with the Uganda registration services bureau. Registration is required to obtain certain benefits under the Copyright Act.

While copyright protection generally arises immediately when a new song is recorded, the new song must be original. That is, the work must be original in the sense of being the creative product of the author's own efforts. There is no requirement that it be original in the sense of being novel. "Original" means only that the work was independently created and that it possesses at least some minimal degree of creativity. "Originality" doesn't mean a work of extraordinary genius.

While there are no bright-line rules, some courts have held that rhythm and harmony are generally in the public domain and not "original," while melody is often determined to be "original" and protected by copyright. And, courts have held that contributions by producers and engineers to the creation of sound recordings, including the processing of sounds and the balancing, equalization, and integrating of vocal and instrumental into a blended whole, can be protected by copyright. On the other hand, musical style (i.e., the style of reggae), themes, or ideas in the abstract are not protected by copyright.

Often in copyright infringement actions, the defendant will argue that the plaintiff does not have a copyright because the song at issue was not original. For example, in 2007, 50 Cent was sued over his use of the line "Go shawty. It's your birthday" in the song "In Da Club." The plaintiff, a music publisher,

claimed that the lyric was copied from its song “It’s Your Birthday,” which was written by Luther Campbell (aka, Luke Skyywalker). However, the court ruled for 50 Cent, holding that those lyrics were not original because the phrase was a common chant at hip hop events and nightclubs, had appeared in other prior songs, and Luther Campbell admitted that he didn’t create the phrase. So, if a song or lyric is not original, it’s not protected under copyright law.¹⁵⁵

Similarly, words and short phrases are generally not copyrightable. A court held that the phrase “Everyday I’m Hustlin” used in the song “Hustlin” by Rick Ross is “a short expression of the sort that courts have uniformly held uncopyrightable.” As such, the use of the lyrics “Everyday I’m Shufflin” in the hit song “Party Rock Anthem” by LMFAO was not an infringement of the Rick Ross song lyrics. Similarly, in dismissing a lawsuit filed against Taylor Swift, a court recently found that the lyrics “Playas, they gonna play / And haters, they gonna hate” were “too brief, unoriginal, and uncreative to warrant protection under the Copyright Act.”

In sum, music copyright law protects musical works and sound recordings that are original works of authorship and fixed in any tangible medium of expression.¹⁵⁶

Copyright law also directly addresses the unique needs of dance, theater, and other performing arts. A creator of choreography may claim a copyright for that choreography once it has been fixed in a tangible form, such as on a video recording. The choreography then may be used only with the permission of the copyright holder.¹⁵⁷

¹⁵⁵<https://blog.reverbnation.com/2018/04/25/music-law-101-what-does-copyright-law-protect/>

¹⁵⁶ *ibid*

¹⁵⁷<https://www.encyclopedia.com/law/encyclopedias-almanacs-transcripts-and-maps/entertainment-law>

One key aspect of copyright law as applied to the entertainment industry is that of derivative works. A copyright holder initially controls who may create a work based on the artist's original work. For instance, a film studio generally may create a screenplay based on a novel only with the novelist's, or other copyright holder's, written permission. This control is critical to authors and screenwriters, whose works can be adapted to several other media—films and sequels, television series and movies, audiotapes, toys, games, T-shirts, and other products derived from the work. An author can forgo millions of dollars of potential income simply by allowing a publisher to own and control the rights to create and license any such derivative works based on the author's work.

Entertainment company names, band names, performers' pseudonyms, and, more rarely, performers' legal names, can be protected under trademark laws. Like other businesses, entertainment entities have an interest in preventing others from using names that are so similar to theirs as to cause confusion among consumers as to exactly who is delivering certain products or services. Therefore, many entertainment entities register their names with the patent and trademark office and claim the exclusive right to use their names. In most cases, such names will be registered as service marks, rather than as trademarks. For instance, bands who register their band name as a trademark typically will register for performance of entertainment services. Once an entity receives a registration from the Uganda registration services bureau, no other entity may use the name, or a confusingly similar name, to provide services similar to those provided by the registrant.

Use and ownership of trademarks by members of a band or other entertainment company can be a source of great controversy when the entity dissolves. If, prior to dissolution, the owners or members of the entity have not agreed as to who may use the trademark after dissolution, lengthy legal battles can result as different members or factions try to use, and prevent the other members from using, the trademark.

Electronic Copyright

A new format known as MP3 (Motion Picture Experts Group-1 Audio Layer 3), which can compress and store high-quality, digital music in one-tenth of the space in which a CD can store it, has recently caused considerable legal ramifications in the entertainment industry. Access to this digitized music is widespread and growing rapidly. Electronic distribution and the digitization of music has the potential to radically reduce royalties to artists.

Napster

In early 1999, Shawn Fanning, who was only 18 at the time, began to develop an idea as he talked with friends about the difficulties of finding the kind of MP3 files they were interested in. He thought that there should be a way to create a program that combined three key functions into one.

These functions included a search engine, file sharing, (i.e., the ability to trade MP3 files directly, without having to use a centralized server for storage) and an internet Relay Chat (IRC), which was a means to find and chat with other MP3 users while online. Fanning spent several months writing the code that would become the utility later known world-wide as Napster. Napster became a non-profit on-line music-trading program that became especially popular among college students, who typically had access to high-speed Internet connections.¹⁵⁸

In April 2000, the heavy metal rock group Metallica sued Napster for copyright infringement. Several universities were also named in this suit. Metallica claimed that these universities violated Metallica's music copyrights by permitting their students to access Napster and to illegally trade songs using university servers. A number of universities already had banned Napster prior to April 2000 because of concerns about potential copyright infringement and/or because traffic on the Internet was slowing university

¹⁵⁸<https://www.encyclopedia.com/law/encyclopedias-almanacs-transcripts-and-maps/entertainment-law>

servers down. Yale University, which was named in the suit, immediately blocked student access to Napster.¹⁵⁹

Nichols v. Universal Pictures Corp., - 45 F.2d 119 (2d Cir. 1930)

RULE:

Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. As respects infringement of copyrights in plays, the controversy chiefly centers upon the characters and sequence of incident, these being the substance. Otherwise the playwright could prevent the use of his ideas, to which, apart from their expression, his property is never extended.

FACTS:

The plaintiff is the author of a play, "Abie's Irish Rose," which it may be assumed was properly copyrighted under section five, subdivision (d), of the Copyright Act, 17 USCA § 5(d). The defendant produced publicly a motion picture play, "The Cohens and The Kellys," which the plaintiff alleges was taken from it. Plaintiff alleged that the copyright in her play, concerning a marriage between a Jewish man and an Irish woman and the resulting difficulties between both families, was infringed by defendant's movie about the marriage of an Irish man and a Jewish woman, also focusing on differences between their families. The court affirmed the judgment for defendant, finding the two stories were different as to incident and character, and thus there was no infringement. As for plots, the only matter common to the two was a quarrel between a Jewish father and an Irish father, the marriage of their children, the birth of grandchildren, and a reconciliation. The court found such theme was only a part of plaintiff's ideas, and therefore was not copyrightable.

¹⁵⁹<https://www.encyclopedia.com/law/encyclopedias-almanacs-transcripts-and-maps/entertainment-law>

The Court found that the plot of the second play was too different to infringe, because the most detailed pattern, common to both, eliminated so much from each that its content went into the public domain; and for this reason we said, "this mere subsection of a plot was not susceptible of copyright." But the Court does not doubt that two plays may correspond in plot closely enough for infringement. How far that correspondence must go is another matter. Nor does the court need to hold that the same may not be true as to the characters, quite independently of the "plot" proper, though, as far as we know, such a case has never arisen. If *Twelfth Night* were copyrighted, it is quite possible that a second comer might so closely imitate Sir Toby Belch or Malvolio as to infringe, but it would not be enough that for one of his characters he cast a riotous knight who kept wassail to the discomfort of the household, or a vain and foppish steward who became amorous of his mistress. These would be no more than Shakespeare's "ideas" in the play, as little capable of monopoly as Einstein's Doctrine of Relativity, or Darwin's theory of the Origin of Species. It follows that the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly.

SUBSIDIARY RIGHTS : ACQUISITION AND LICENSING

The *grant of rights* clause in a publishing contract is one of the most important clauses because it enumerates the specific rights granted to the publisher by the author. Negotiation of this clause has become even more important in today's world where increasingly more uses are being developed for literary content.¹⁶⁰

The scope of the clause may vary widely, it could be all inclusive -- granting all the exclusive rights and interests in the author's work, or the grant could

¹⁶⁰<https://corporate.findlaw.com/intellectual-property/subsidiary-rights-acquisition-and-licensing.html>

be very narrow -- only including a single specific use of the author's work, or it could be somewhere between these extremes. The critical point is that the publisher only has the right to exploit those rights that are specifically granted to the publisher and any exploitation of rights exceeding the author's grant could be deemed a copyright infringement of the author's work.

Copyright ownership of a literary work consists of a *bundle of rights* which an author, at least theoretically, may assign to the publisher in any manner they choose. Thus, an author may assign all or only a part of his/her rights to one or more publishers while retaining particular rights for himself/herself.

The Copyright Act confers five separate exclusive rights to copyright owners of a literary work. Subject to certain limitations, the copyright owner has the exclusive right to: (1) reproduce the copyrighted work, (2) prepare derivative works based on the copyrighted work, (3) distribute copies of the copyrighted work to the public, (4) perform the copyrighted work publicly, and (5) display the copyrighted work publicly. Any or all of these rights may be subdivided in an almost infinite number of ways by format, language, territory, or term.

When negotiating the grant of rights clause the publisher and author should be very specific in discussing the rights that will be to the publisher. The clause should not use vague terms that could be open to more than one interpretation; for example, what does the term "electronic rights" mean? Before beginning the negotiation process it is advisable that the publisher prioritize the rights into the categories of "must have", "like to have", and "do not really need". Following this the publisher should evaluate how much any particular right will be worth to acquire. The more evaluation done before negotiating the agreement the more likely the publisher will succeed in obtaining its objectives.

PRIMARY AND SUBSIDIARY RIGHTS

Primary rights and secondary or subsidiary rights are the two main categories of rights in a book publishing contract. Although these terms are used frequently they do not have precise definitions; however, traditionally *primary rights* include only those rights the publisher specifically intends to use. For the print publisher these rights normally have included the book publication right for the original hard or soft cover edition and paperback reprint rights, and possibly foreign translation rights, serialization rights, book club rights, and the rights for special editions. On the other hand, *subsidiary rights* are those rights that are, as the name suggests, subsidiary to the right of publishing the literary work in book form. These rights include electronic rights, motion picture and television rights, audio book rights, audiovisual rights, merchandizing rights and dramatic or performance rights. Motion picture, television, audio and merchandising rights are good examples of how valuable subsidiary rights can be today, while electronic rights could be tomorrow's best example.

WHO CONTROLS SUBSIDIARY RIGHTS

Many publishers take the position that they will only enter into a publishing agreement with an author under the condition that they obtain all rights in the work, however this eventuality may not always be possible for a particular literary work. Prioritizing particular rights becomes important in those instances where an author is unwilling to assign all rights or when an author attempts to place specific restrictions on a particular right(s), such as a clause stating "the publisher must exploit electronic rights in the literary work within three years of the publication date of the hard cover edition of the book or such electronic rights revert to the author". Since author and publisher are usually both remunerated from the licensing or sale of subsidiary rights to third parties there are many ways in which each party can achieve their common objectives. There may be instances where an author has better contacts than the publisher for exploiting a particular right. In such event that particular right could be reserved for the author and the author would then be responsible for compensating the publisher from the

successful exploitation of that right. Alternatively, both parties could pursue the licensing of a particular right with the proceeds being divided between the parties. The grant of rights clause should be specifically crafted to accomplish the publishing company's objectives. Flexibility and compromise should be the *modus operandi* for both parties when negotiating the grant of rights clause, rather than a posture implying "take it or leave it".

WHO SHOULD SELL OR LICENSE THE SUBSIDIARY RIGHTS

Subsidiary rights are normally sold or licensed to third parties by the publisher and under certain circumstances by the author. Another possibility, especially when the publishing company has limited personnel resources is for the publisher to hire an agent(s) to handle to the sale or licensing of subsidiary rights. The agent, if successful in exploiting a particular subsidiary right(s) for the publisher, will be compensated by a commission that reduces the compensation to be divided between author and publisher, however, an experienced agent who can initiate and conclude a subsidiary rights deal will bring additional income to the author and publisher that they by themselves could not have achieved.

NEGOTIATING SUBSIDIARY RIGHTS DEALS

The following discussion focuses attention on certain key issues that may be in encountered in negotiating subsidiary rights deals for mass market paperback, book club, foreign and translation, electronic and dramatic rights.

Mass Market Paperback Rights

Whether the work has been successful in its original edition or there is "hot interest" in obtaining mass market paperback rights prior to publication of the original edition, then it goes without saying that the publisher of the original edition should attempt to obtain as large an advance as possible. Some publishers of the original edition will not begin to license mass market paperback rights until sales of the original edition begin to slow down, as they do not want the mass market paperback competing with sales of the original edition. However, a better way of achieving this objective is to make certain that the agreement with the mass market paperback publisher specifically states the publication date and the date on which the mass market paperback publisher may begin shipping the paperback. Another key point that needs to be negotiated is the time period for the mass market paperback rights and whether or not that term is automatically extended if the advance for these rights has not been recouped.

Book Club Rights

Book club royalty advances have decreased as membership in the book clubs has fallen-off. Higher advances are normally forthcoming if the literary work has been chosen as the featured selection for the month. An additional benefit of a book club rights deal occurs when the book club edition manufacturing order is included as part of the original edition print run resulting in a reduced unit manufacturing cost of the original edition. The publisher should attempt to negotiate a non-exclusive book club rights deal because it is possible these rights could be licensed to both general as well as specialty book clubs.

Foreign and Translation Rights

Foreign translation rights or foreign (non-U.S.) English language editions could also be very important to the publisher if a particular title has the potential outside the United States. Historically, the strongest markets have been in the countries that comprised the British Commonwealth, Germany, France, Italy, Spain, Spanish speaking America, and Japan. These rights are

frequently sold at international book fairs and expositions and U.S. based scouts for foreign publishers are playing an increasing role in offering deals even prior to U.S. publication.

Some of the major deal points in negotiating these rights are the following: (1) estimated first printing, (2) royalty advances that cover at least 50% to possibly almost 100% of the estimated first printing on smaller deals, (3) payments to the U.S. publisher should be in U.S. dollars, (4) selling price of the book in the foreign country and the royalty schedule, (5) minimum annual royalty payments, (6) approval of translation, (7) ownership of the copyright in the translation and the U.S. publisher's right to use that translation -- this could be important regarding other media formats based on that translation, (8) control of subsidiary rights, (9) the term, usually five to twelve years is normal, or curtailment to a shorter period if annual royalty payments fall below a certain level, (10) the specific territory - this is very significant when dealing with Spanish language rights, and (11) foreign tax obligations and responsibility for such payments.

Electronic Rights

Many of the same key issues that are involved in the negotiation of electronic rights with the author are present when a publisher attempts to license electronic rights to a third party. The growing importance of electronic rights and electronic publishing makes the negotiation of electronic rights agreements particularly important.

A basic issue involving the licensing of electronic rights to a third party is how that third party intends to adapt or manipulate the original work and in what specific electronic formats the literary work will be used. The publisher of the original edition of the literary work should not, unless the financial reward is so great, grant a license to a third party that is an exclusive license that encompasses all electronic rights. Instead the license should be for specific formats, platforms and types of products, and should have a reversion clause

if the specific rights granted to the licensee are not commercialized within a specific time period. The publisher should try to ensure that the electronic rights that are being licensed are defined with specificity in order that the publisher may carve out multiple electronic niches for which the content may be licensed.

Since technology is changing so rapidly it is not possible to provide a precise definition of electronic rights. As a result of this indefiniteness the publishing contract frequently contains a *future technology clause* that grants the right to exploit a work in "all media now known or hereafter created." The purpose of the future technology clause is to try to ensure that electronic rights include the right to create a derivative work in a technology that may not have been developed or even contemplated at the time the parties signed the contract. Conceivably there may be no limit to the scope of the specific rights known as electronic rights. Thus, a key issue when negotiating the licensing of electronic rights to a third party is whether or not a future technology clause has been included in the publishing agreement and whether it should be included in the licensing agreement.

Another basic issue that must concern the publisher of the original edition of the literary work is when that literary work contains copyrighted materials of third parties for which the author obtained permission to use in the original edition. The crucial inquiry is whether that permission extends to the use or licensing of these third party materials in an electronic publishing project. The answer to this question is important because the publisher can only use or license copyrighted materials that they own or have obtained permission to use, otherwise there exists the potential risk of copyright infringement.

Dramatic Rights

It is rare when dramatic rights - motion picture, television, theatrical - are purchased outright by a production company before negotiating an *option agreement* for the potential future purchase of such rights. Option

agreements normally are for twelve to eighteen months, but frequently have extension clauses for additional time periods. During the option period the producer will attempt to develop a screenplay or other format and locate and obtain financing for the actual production of the dramatic work. Proceeds received by the publisher from an option agreement are usually directly correlated to the success or prospects of the literary work; the option could be as low as \$1,000 or more than \$50,000. The normal practice is for the option price to be considered as an offset against the purchase price. Purchase prices for dramatic works vary widely and frequently are a percentage of the actual production budget along with additional contingency profit participation compensation.

It is estimated that less than 1% of optioned dramatic works actually are purchased and therefore one difficulty encountered by the publisher of the optioned property is the legal expense involved in negotiating and formalizing an option agreement. The expense is incurred because a dramatic rights license usually involves a short form option agreement that is accompanied by a complex, extensively negotiated purchase agreement, containing the details of the dramatic rights license and ancillary rights involving merchandising, novelization, syndication, international distribution, sequels, and use of characters, that automatically becomes effective at the time the option is exercised.

CONCLUSION

The use, sale or licensing of subsidiary rights frequently makes a significant difference in the financial success of a particular literary work or publishing company. Obtaining these rights from the author is extremely important, but once these rights are obtained they must be exploited if both publisher and author are to reap additional financial benefits. Therefore, it is imperative for the publisher to obtain the primary and specific subsidiary rights that they

have the capability to exploit, thus ensuring the maximum revenue from each published work.¹⁶¹

¹⁶¹<https://corporate.findlaw.com/intellectual-property/subsidiary-rights-acquisition-and-licensing.html>

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APPENDIX

ACTS

SUPPLEMENT No. 2 28th February, 2014. ACTS SUPPLEMENT
to The Uganda Gazette No. 12 Volume CVII dated 28th February, 2014.

Printed by UPPC, Entebbe, by Order of the Government.

THE INDUSTRIAL PROPERTY ACT, 2014.

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Act 3 Industrial Property Act 2014

THE INDUSTRIAL PROPERTY ACT, 2014.

An Act to provide for the promotion of inventive and innovative activities, to facilitate the acquisition of technology through the grant and regulation of patents, utility models, industrial designs and technovations and to provide for the designation of a registrar, to provide for the functions of the registrar, and the establishment of a register of industrial property rights and for related matters.

DATE OF ASSENT: 6th January, 2014. *Date of Commencement*: See section

1. BE IT ENACTED by Parliament as follows:

PART I—PRELIMINARY

1. Commencement.

This Act shall come into force on a date that the Minister may, by statutory instrument appoint; and the Minister may appoint different dates for different provisions.

2. Interpretation.

In this Act, unless the context otherwise requires—
“application” means an application under this Act for the grant of— (i) a patent;

(ii) a certificate of utility model;

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(iii) registration of an industrial design; or

(iv) a certificate of technovation;

“ARIPO” means the African Regional Intellectual Property Organisation;

“ARIPO Office” means the Secretariat managing the African Regional Intellectual Property Organisation (ARIPO), formerly known as Industrial Property Organisation, for the English-speaking Africa (ESARIPO) established by the Lusaka Agreement of 9th December 1976 as amended;

“Bureau” means the Uganda Registration Services Bureau established by the Uganda Registration Services Bureau Act;

“compulsory licence” means an authorization given by the competent authority to a person, firm or a private or state-owned or state-controlled entity, to exploit a patent, a utility model, a layout-design or an industrial design in Uganda without the approval of the rights owner;

“concerned Minister” means the Minister to whose ministry the information

in an application relates; “Court” means the High Court of Uganda; “cross-licence” means a licence to enable a person to use his or her own patent together with an earlier patent without which his or her own patent cannot be worked without infringing rights derived from the earlier patent; “currency point” has the meaning given to it in the Schedule; “designated office” means an office designated under section 34; “divisional application” has the meaning given to it by section 23; “elected office” means an office designated under section 34;

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“examiner” means an examiner of patents designated as examiner of patents under the Uganda Registration Services Bureau Act; “exclusive licence” means a licence contract that confers on the licensee and, where it is established expressly in it, on the persons authorised by the licensee, the right to exploit the licensed industrial property right to the exclusion of all other persons, including the rights owner; “foreign application” has the meaning given to it by section 25; “former Office” means the Patents Office existing immediately before the commencement of this Act; “Harere Protocol” means the Harere Protocol on Patents and Industrial Designs within the Framework of the African Regional Intellectual Property Organisation;

“industrial design” has the meaning given to it in section 71; “industrial property rights” mean rights under patents, certificates of utility models and technovation and registration of industrial designs issued under this Act; “innovation” means utility models, technovation models, and industrial designs and any other non-patentable creations or improvements that may be taken as deserving specified intellectual property rights; “international bureau” means the International Bureau of the World Intellectual Property Organisation;

“international classification” means the classification of patent for invention, inventors certificates, utility models and utility certificates known as the international patent classification” as established by the Strasbourg Agreement concerning the international patent classification of March 24th, 1971 as amended on September 28, 1979; 8

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“international classification” as regards industrial designs, means classification in accordance with the Locarno Agreement of October, 1968; “invention” means a new and useful art whether producing a physical effect or not, process, machine, manufacture or composition of matter which is not obvious, or a new and useful improvement of it which is not obvious, capable of being used or applied in trade or industry; and includes an alleged invention;

“inventor” means the person who actually devises the invention as defined in section 8; and includes the legal representative of the inventor;

“licence contract” means a contract or an agreement by which a person grants permission to use his or her industrial property rights, know-how, or other technical information or technical services;

“licensee” means a person licensed under a contract which is registered or taken to be registered under this Act;

“licensor” means a party to a licence contract who grants the permission under a contract registered or taken to be registered under this Act;

“Minister” means the Minister responsible for justice;

“National Council for Science and Technology” means the Council established by section 1 of the Uganda National Council for Science and Technology Act;

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

“patent” means the title granted to protect an invention;

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“Patent Cooperation Treaty” means the Patent Cooperation Treaty signed on June, 1970 the Regulations made under the administrative instructions under that Treaty as revised, amended and modified; “priority date” means the date of the first application that serves as the basis for claiming the right of priority provided for in the Paris Convention; “priority user” has the meaning given to it in section 41; “receiving office” means an office designated under section 34; “register” means the register of industrial property rights under section 5; “registrar” means the officer designated as registrar of industrial property under the Uganda Registration Services Bureau Act and includes the deputies and assistants of that officer; “self-replicable matter” means any matter possessing the genetic material necessary to direct its own replication by way of a host organism or in any other indirect way; “surcharge” means a fee prescribed under this Act in respect of delayed payment; “utility model” means any form, configuration or disposition of element of some appliance, utensil, tool, electrical and electronic circuitry, instrument, handicraft mechanism or other object or any part of it allowing a better or different functioning, use, or manufacture of the subject matter or that gives some utility, advantage, environmental benefit, saving or technical effect not previously available in Uganda; and includes microorganisms or other self-replicable material, products of genetic resources and herbal as well as nutritional formulations which give new effects; “World Trade Organisation” means the World Trade organisation, established in 1995 by the Uruguay Round of multilateral trade negotiations under the auspices of GATT (General Agreement on Tariffs and Trade, based on a 1947 agreement).

PART II—ADMINISTRATION.

3.3 Registrar.

- (1) (1) The Registrar General appointed under the Uganda Registration Services Bureau Act shall be the Registrar of industrial property.
- (2) The registrar shall have a seal of a device approved by the Minister, but until the seal has been obtained a stamp in a form approved by the Minister shall be issued instead of the seal.
- (3) The impression of the seal or stamp shall be judicially noticed and admitted in evidence.
- (4) Any act or thing directed to be done by or to the registrar may be done by or to any officer authorized by the Minister.

4.3 Functions of the registrar.

- (1) The functions of the registrar are—
 - (a) to receive, consider and grant applications for industrial property rights;
 - (b) to receive, and register technology transfer agreements and licences;
 - (c) to provide to the public industrial property information for technological and economic development and maintain links with users and potential users of industrial property information;
 - (d) to promote inventiveness and innovativeness in Uganda; and
 - (e) to perform any other functions for the better carrying out of this Act.
- (2) In the carrying out of his or her functions, the registrar shall liaise with relevant institutions.

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5. Register of industrial property.

- (1) The registrar shall maintain two registers one of which shall contain all industrial property applications received, and the other shall contain all industrial property and other rights granted under this Act, in which shall be

recorded and numbered in the order of grant, and in respect of each patent, where appropriate, its lapse for non-payment of annual fees and all transactions to be recorded by virtue of this Act.

(2) A person may, during working hours, inspect the registers maintained under subsection (1) and may, subject to the payment of the prescribed fee and to any regulations made under this section, obtain extracts from them.

(3) The form of the registers shall be as prescribed by regulations. (4) The register of patents shall be *prima facie* evidence of any matter required or authorised by or under this Act to be entered in the registers.

6. Protection from personal liability.

No matter or thing done by any member, officer, employee or agent of the registrar shall, if the matter or thing is done bona fide for executing the functions of his or her office, render the member, officer, employee or agent or any person acting on his or her directions personally liable for any action, claim or demand.

7. Liability of the registrar for damages.

Section 6 shall not relieve the registrar of the liability to pay compensation or damages to any person for injury to him or her, his or her property or any of his or her interests caused by the performance of the functions conferred on the registry by this Act or by any other written law or by the failure, whether wholly or partially, of any works.

PART III—PATENTABILITY.

8. Meaning of “invention”.

(1) For the purposes of this Part, “invention” means a solution to a specific problem in the field of technology.

(2) Subject to subsection (3), an invention may be, or may relate to, a product or a process.

(3) The following shall not be regarded as inventions and shall be excluded from patent protection—

(a) discoveries, scientific theories and mathematical methods; (b) schemes, rules or methods for doing business, performing purely mental acts or playing games;

(c) diagnostic, therapeutic and surgical methods for the treatment of humans or animals;

(d) mere presentation of information;

(e) plants and animals other than micro-organisms, and essentially biological processes for the production of plants or animals other than non-biological and micro-biological processes; and

(f) pharmaceutical products and test data until 1st January 2016 or such other period as may be granted to Uganda or least developed countries by the Council responsible for administering the Agreement on trade related aspects of intellectual property under the World Trade Organization;

(g) natural substances, whether purified, synthesized or otherwise isolated from nature; except the processes of isolating those natural substances from their original environment; and

(h) the human body and all its elements in whole or in part.

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9.3 Patentable invention.

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

10.3 Novelty.

(1) An invention is new if it is not anticipated by prior art or where a person who is highly skilled in the relevant area could not derive the invention from a combination of prior disclosed art.

(2) For purposes of this Act, prior art consists of everything made available to the public anywhere in the world by means of written disclosure including drawings, published patent applications, and other illustrations or by oral disclosure, use, exhibition or other non-written means, where the disclosure occurred before the date of filing of the application or, if priority is claimed, before the priority date validly claimed in respect of the application.

(3) For the purpose of the evaluation of novelty, an application for the grant of a patent or a utility model certificate in Uganda shall be considered to have been comprised in the prior art as from the filing date of the application, or if priority is claimed, as from the date of its validly claimed priority, to the extent to which its content is available, or is later made available, to the public in accordance with this Act or in accordance with the Patent Cooperation Treaty.

(4) For the purposes of subsection (2), a disclosure of the invention shall not be taken into consideration if it occurred within twelve months before the filing date or, where applicable, the priority date of the application and if it was by reason or in consequence of—
(a) acts committed by the applicant or his or her predecessor in title; or
(b) an evident abuse committed by a third party in relation to the applicant or his or her predecessor in title.

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11.3 Inventive step.

An invention shall be considered as involving an inventive step if, having regard to the prior art relevant to the application claiming the inventions, it would not have been obvious to a person skilled in the art to which the invention relates on the date of the filing of the application or, if priority is claimed on the date validly claimed in respect of the invention.

12.3 Industrial application.

An invention shall be considered industrially applicable if, according to its nature, it can be made or used in any kind of industry, including agriculture, medicine, fishery and other services.

13. Non-patentable inventions.

The following are not patentable—
(a) plant varieties as provided for in the law providing for the protection of plant varieties;
(b) inventions contrary to public order, morality, public health and safety, public policy, principles of humanity and environmental conservation.

14.3 Information prejudicial to security of Uganda or safety of the public.

(1) Where an application for a patent is filed under this Act or under any international convention to which Uganda is a party, and it appears to the registrar that the application contains information of a description notified to the registrar by the concerned Minister as being information the publication of which might be prejudicial to the security of Uganda, the registrar may give directions prohibiting or restricting the publication of that information or its communication to any specified person or persons.

(2) Where it appears to the registrar that any application filed as described in subsection (1) contains information the publication of which might be prejudicial to the interest of the public, the registrar may give directions prohibiting or restricting the publication of that information or its communication to any specified person or persons until the end of a period not exceeding three months from the end of the period prescribed for the purposes of section 29.

(3) Where directions under this section are in force with respect to any application—

(a) if the application is made under this Act, it may be processed to the stage where it is in order for the grant of a patent, but shall not be published and

any information relating to it shall not be communicated and no patent shall be granted in response to the application;

(b) if it is an application for an ARIPO patent, it shall not be sent to the ARIPO office; and

(c) if it is an international application for a patent, a copy of the application shall not be sent to the International Bureau or to any international searching authority appointed under the Patent Cooperation Treaty.

(4) Where the registrar gives instructions under this section in respect of an application, the registrar shall give notice of the application and of the directions to the concerned Minister and the following provisions shall have effect—

(a) the concerned Minister shall, on receipt of the notice, consider whether the publication of the application or the publication or communication of the information in question would be prejudicial to the defence of Uganda or the safety of the public;¹⁶

(b) where the concerned Minister determines that the publication of the application or the publication or communication of the information would be prejudicial to the safety of the public, the Minister shall notify the registrar, and the registrar shall continue his or her directions under subsection (2) until they are revoked under paragraph (e);

(c) where the concerned Minister determines that the publication of the application, or the publication or communication of the information would be prejudicial to the defence of Uganda or the safety of the public, he or she shall, unless a notice under paragraph (d) has previously been given by the Minister responsible for defence or the concerned Minister to the registrar, reconsider that question during the period of nine months from the date of filing the application and at least once in every subsequent period of twelve months;

(d) where on the consideration of an application at any time it appears to the concerned Minister that the publication of the application, or the publication or communication of the information, contained in it would not, or would no longer, be prejudicial to the defence of Uganda or the safety

of the public, he or she shall give notice to the registrar to that effect; and (e) on receipt of a notice under paragraph (d), the registrar shall revoke the directions and may, subject to conditions that the registrar may consider fit, extend the time for doing anything required or authorised to be done by or under this Act in connection with the application, whether or not that time had previously expired.

(5) The concerned Minister may, in determining a question under subsection (4)(c)—17

(a) at any time after, or, with the consent of the applicant, before the expiry of the period prescribed for the purposes of section 29, consider the application and any documents submitted in relation to the application; or (b) where the application contains information relating to the production or use of atomic energy or research into matters connected with the production or use, of atomic energy, authorise the National Council for Science and Technology to study the application and any documents sent to the registrar in connection with the application and report to the registrar as soon as reasonably practicable on the utility or otherwise of the patent applied for.

(6) Where directions have been given under this section in respect of an application for a patent for an invention and the period prescribed in relation to the application expires, and while the directions are still in force, an application is brought for the grant of a patent—

(a) if while the directions are in force, the invention is used by or with the written authorisation of or on the orders of a Government Ministry, department or agency, section 66 shall apply as if—

(i) the use was made under that section;

(ii) the application had been published at the end of that period; and

(iii) a patent had been granted for the invention at the time the application is brought for the grant of a patent taking the terms of the patent to be those of the application as at the time it was brought; and

(b) if it appears to the Minister responsible for defence or the concerned Minister that the applicant for the patent has suffered hardship by reason of the continuation in force of the directions, the Minister may, with the

consent of the Ministry responsible for finance, make such payment by way of compensation to the applicant, as appears to be reasonable having regard to the inventive merit and utility of the invention, the purpose for which it is designed and any other relevant circumstances.

(7) Where the applicant is dissatisfied with the amount of compensation paid to him or her under subsection (6), he or she may appeal to the court.

(8) Where a patent is granted in response to an application in respect of which directions have been given under this section, no renewal fees shall be payable in respect of any period during which those directions remain in force.

(9) A person who fails to comply with a direction under this section commits an offence and is on conviction, liable to a fine not exceeding forty eight currency points or imprisonment not exceeding two years or both.

15.3 Restriction on applications abroad by residents of Uganda.

(1) Subject to this section, a person resident in Uganda shall not without written authority granted by the registrar, file or cause to be filed outside Uganda, an application for a patent, unless—
(a) an application for a patent for the same invention has been filed with the registrar not less than six weeks before the filing of the application outside Uganda; and

(b) no directions have been given under section 14 in relation to the application in Uganda or any such directions given have been revoked.

(2) Subsection (1) does not apply to an application for a patent for an invention in respect of which an application for a patent has first been filed in a country outside Uganda by a person resident outside Uganda.

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(3) A person who files or causes to be filed an application for the grant of a patent in contravention of this section commits an offence and is liable on conviction, to a fine not exceeding forty eight currency points or imprisonment not exceeding two years or both.

(4) In this section—

(a) a reference to an application for a patent includes a reference to an

application for other protection for an invention; and (b) a reference to either kind of application is a reference to an application under this Act, under the law of any country other than Uganda or under any international treaty or convention to which Uganda is a party.

16.3 Patents relating to micro-biological processes or products.

(1) Where an invention concerns a micro-biological process or the product of that process and involves the use of a micro-organism which is not available to the public and which cannot be described in the patent application in such a manner as to enable the invention to be carried out by a person skilled in the art, the invention shall only be regarded as disclosed if— (a) a culture of the micro-organism has been deposited with a depository institution not later than the date of filing of the application; (b) the application as filed gives such relevant information as is available to the applicant on the characteristics of the micro-organism; and (c) the depository institution and the file number of the culture deposit are stated in the application.

(2) The information referred to in subsection (1)(b) may be submitted within sixteen months after the date of filing of the application or, if priority is claimed, after the priority date.

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(3) The deposited culture shall be made available upon request of any person having the right to inspect the files.

(4) Where a deposited micro-organism ceases to be available from the institution with which it was deposited because—

(a) the micro-organism is no longer viable; or

(b) for any other reason the depository institution is unable to supply samples;

and if the micro-organism has not been transferred to another depository institution from which it continues to be available, an interruption in availability shall not be taken to have occurred if a new deposit of the micro-organism originally deposited is made within three months from the date on

which the person who deposited it is notified of the interruption by the depository institution and a copy of the receipt of the deposit issued by the institution is forwarded to the registry within four months from the date of the new deposit stating the number of the application or of the patent.

(5) A new deposit shall be accompanied by a statement signed by the person making the deposit indicating that the newly deposited micro-organism is the same as that originally deposited.

(6) In this section “depository institution” means a place where biological organisms are stored.

PART IV—RIGHT TO INVENTIONS AND NAMING OF INVENTOR.

17.3 Right to a patent.

(1) Subject to this section, the right to a patent belongs to the inventor.

(2) Where two or more persons have jointly made an invention the right to the patent belongs to them jointly.

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

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

(5) Sections 51 to 65 apply, with the necessary modifications, to contracts assigning the right to a patent.

18.3 Unauthorised application based on an invention of another person.

Where an applicant has obtained the essential elements of the invention which is the subject of his or her application from the invention of another person, he or she shall, unless authorised by the person who has the right to

the patent or who owns the patent, assign to that person the application or, where the patent has already been granted, the patent.

19.3 Inventions made in execution of commission or by employee.

(1) Notwithstanding section 18 and in the absence of a contract to the contrary, the right to a patent for an invention made in execution of a commission or of a contract of employment, belongs to the person having commissioned the work or to the employer.

(2) Where the invention referred to in subsection (1) is of exceptional importance the employee has a right to equitable remuneration taking into consideration his or her salary and the benefit derived by the employer from the invention.

(3) Subsection (1) applies where a contract of employment does not require the employee to exercise any inventive activity but when the employee has made the invention by using data or means available to him or her during his or her employment.

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(4) In the circumstances referred to in subsection (3), the employee has a right to equitable remuneration taking into account his or her salary, the importance of the invention and any benefit derived from the invention by the employer.

(5) In the absence of an agreement between the parties, the court shall fix the remuneration.

(6) An invention made without any relation to an employment or contract of service and without the use of the employer's resources, data, means, materials, installations or equipment belongs solely to the employee or the person commissioned.

(7) This section, where relevant, applies directly or indirectly to government department or an agency of government or a similar organisation.

20. Naming of inventor.

- (1) The inventor shall be named as inventor in the patent application and in the patent unless in a special written declaration addressed to the registrar, he or she indicates that he or she wishes not to be named.
- (2) A promise or an undertaking by the inventor made to any person to the effect that he or she will make the declaration referred to in subsection (1) has no legal effect.
- (3) Where two or more persons have made the same invention independently of each other, the person whose application has the earliest filing date or, if priority is claimed, the earliest validly claimed priority date shall have the right to the certificate, as long as the application is not withdrawn, abandoned or rejected.
- (4) In order to establish the right of preference the registrar shall take into account the matter claimed in the applications.
- (5) Where an invention is made in execution of an employment contract the purpose of which is to invent, the right to the patent shall belong, in the absence of contractual provisions to the contrary, to the employer.

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- (6) Where the economic gains extracted by the employer are disproportionately high as compared to the employee's salary and the reasonable expectations of gain that the employer had from his or her employee's inventive output at the time he or she hired him or her, the employee is entitled to an equitable remuneration.
- (7) Where an invention is made by an employee not in execution of an employment contract, and where for making that invention the employee used materials, data know-how of the employer, the right to the patent shall belong, in the absence of contractual provisions to the contrary, to the employer.
- (8) The employee is entitled to a remuneration that is at least equivalent to one third of the net direct and indirect gains obtained by the employer from exploiting the invention.
- (9) Where the employer neglects to file a patent application within one year from the date on which the employee communicates to him or her the

invention, the employee shall have the right to the patent, including the right to assign that right to an interested party and to license or transfer the patent, if granted.

(10) An invention claimed in a patent application filed by the employee within one year after the expiry of the employment contract which falls within the scope of the former employer's main business, shall be presumed to have been made under the expired contract, unless the employer produces evidence to the contrary.

(11) An anticipated promise or undertaking which is made by the inventor to his or her employer to the effect that he or she will waive any remuneration he or she is entitled to under this section shall be without legal effect.

(12) The inventor shall be named as such in the patent, unless in a special written declaration signed by him or her and addressed to the registrar he or she indicates that he or she wishes not to be named.

(13) A promise or an undertaking by the inventor made to a person to the effect that he or she will make such a declaration under subsection (12) has no legal effect.

(14) This section shall apply to all employees whether or not they are employed in the public service.

PART V—APPLICATION, GRANT AND REFUSAL OF GRANT OF PATENT.

21.3 Application for a patent.

(1) An application for a patent shall be filed with the registrar and shall contain—

- (a) a request;
- (b) a description of the invention;
- (c) one or more claims;
- (d) one or more drawings, where necessary;
- (e) an abstract; and
- (f) such other details as shall be prescribed by the regulations made under this Act of Uganda.

(2) Where the applicant's ordinary residence or principal place of business is outside Uganda, the applicant shall be represented by an advocate of the High Court of Uganda.

(3) The request shall state the name and prescribed data concerning, the applicant, the inventor and the agent, if any, and the title of the invention and where the applicant is not the inventor the request shall be accompanied by a statement justifying the applicant's right to the patent.

(4) The appointment of an agent shall be indicated by the designation of the agent in the request or by furnishing a power of attorney signed by the applicant and, where subsection (2) applies, the agent shall be designated in the request.

(5) The description shall—

(a) disclose the invention and all practicable modes, including specification of the best mode, of carrying out the invention known to the inventor at the filing date or, where priority is claimed, at the priority date of the application, in full, clear, concise and exact terms as to enable a person who has ordinary skills in the art to make use of and to evaluate the claimed invention; and

(b) include any drawings and relevant deposits as in the case of micro-organisms and self-replicable material which are essential for the understanding of the invention.

(6) Disclosure of the claimed invention shall be considered sufficiently clear and complete if it provides information which is sufficient to allow that invention to be made and used by a person with who has ordinary skill in the art on the filing date, without undue experimentation.

(7) For the purposes of assessing sufficiency of disclosure, the disclosure contained in the description, claims and drawings, as established on the date in which the sufficiency of disclosure was examined, shall be taken into account.

(8) The description shall contain a clear identification of the origin of genetic or biological resources collected in the territory of Uganda and that were directly or indirectly used in the making of the claimed invention as well as of any element of traditional knowledge associated or not with those resources

and that was directly or indirectly used in the making of the claimed invention without the prior informed consent of its individual or collective creators.

(9) For the purposes of this section, a person shall be taken as having ordinary skill in the art if that person is a citizen of Uganda who has studied and carries out his or her profession in Uganda, and has acquired an average expertise and experience in the technical field of the claimed invention.

(10) The registrar may, before granting the patent, require the description in a foreign patent application to be adapted to the ordinary skill in the art of the citizens of Uganda so as to ensure technology dissemination.

(11) The abstract, which must be concise and precise, shall only serve the purpose of technical information; and shall not be taken into account when interpreting the scope of the protection.

(12) The abstract shall only serve the purpose of providing technical information; and it shall not be taken into account when interpreting the scope of the protection sought.

(13) The applicant may, at any time before the grant of the patent, withdraw the application.

(14) Where the application has been withdrawn without having been opened to public inspection, and—

(a) no priority rights have been claimed by virtue of that application; and

(b) no rights are outstanding in Uganda in connection with the application, a subsequent application may be filed in Uganda in respect of the same invention.

(15) The subsequent application shall be regarded as the first application in Uganda in respect of that invention.

(16) Priority rights shall not be claimed on the withdrawn application after the lodging of the subsequent application.

(17) The details of the requirements with which the application must comply shall be prescribed by regulations made under this Act.

22. Unity of inventions.

- (1) The application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.
- (2) The regulations shall contain rules concerning compliance with the requirements of unity of invention under subsection (1).
- (3) The fact that a patent has been granted on an application that did not comply with the requirements of unity of invention shall not be a ground for the invalidation or revocation of the patent.

23. Amendment and division of application.

- (1) The applicant may amend the application, but the amendment shall not go beyond the substance of the disclosure made by the applicant in the initial application.
- (2) The applicant may divide the initial application into one or more applications, in this Act referred to in this Act as “divisional applications” but each divisional application shall not go beyond the disclosure made in the initial application.
- (3) Each divisional application is entitled to a filing date and where appropriate, the priority date of the initial application.

24. Right of priority.

- (1) The application may contain a declaration claiming the priority, as provided for in the Paris Convention, of one or more earlier national or regional applications filed by the applicant or his or her predecessor in title in or for any State party to that Convention and any Member of the World Trade Organization.
- (2) Where the application is filed in Uganda before the expiration of the periods referred to in subsection (1), the application shall not be invalidated by reason of an act accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, and those acts shall not give rise to any third-party right or any right of personal possession.

(3) The period of priority under subsection (1) is twelve months and shall be counted according to the provisions of article 4 of the Paris Convention.

(4) Where the application contains a declaration under subsection (1), the registrar may request that the applicant furnish, within the prescribed time, a copy of the earlier application certified as correct by the Industrial Property Office with which it was filed.

(5) The registrar shall accept the form and the content of the certification mentioned in subsection (4) as determined by the certifying authority.

(6) Where the registrar finds that the requirements under this section and the regulations relating to those requirements have not been complied with, the declaration shall be considered not to have been made.

25.3 Information concerning corresponding foreign applications and grants.

(1) At the request of the registrar, an applicant shall furnish the registrar with the date and number of any application for a patent or other title of protection filed by the applicant with the office responsible for registration of industrial property of another country or with a regional industrial property office, in this Act referred to as a “foreign application”, relating to the same invention as that claimed in the application filed with the registrar.

(2) The applicant shall, at the request of the registrar, furnish the registrar with the following documents relating to one of the foreign applications within sixty days—

(a) copies of any communication received by the applicant concerning the results of a search or examination carried out in respect of the foreign application;

(b) a copy of the patent or other title of protection granted on the foreign application; and

(c) a copy of any final decision rejecting the foreign application or refusing the grant requested in the foreign application.

(3) The applicant shall, at the request of the registrar, furnish the registrar with a copy of any decision revoking or invalidating the patent or any other title of protection granted to the applicant on the basis of the foreign

application.

(4) The applicant shall, at the request of the registrar, furnish the registrar with copies of any communication received by the applicant concerning the results of any search or examination carried out in respect of any foreign application other than the one referred to in subsection (2).

(5) The documents furnished under this section shall only serve the purpose of facilitating the evaluation of novelty claimed in the application filed with the registrar or in the patent granted on the basis of that application.

(6) The applicant has the right to submit comments on the documents furnished under this section.

(7) The details of the requirements under this section shall be as prescribed by regulations

26.3 Payment of fees.

(1) The application shall be subject to payment of the prescribed fees.

(2) The registrar may waive the whole or part of the fees in such manner and under such circumstances as may be prescribed.

27.3 Withdrawal of application.

The applicant may withdraw the application at any time before the grant of a patent or before the notification of rejection of the application or before the refusal to grant a patent; but the applicant shall, if he or she does so, forfeit the prescribed fees paid by him or her.

28.3 Filing date and examination of application as to form.

(1) The registrar shall accord as the filing date the date of receipt of the application, if, at the time of receipt, the application contains—
(a) an express or implicit indication that the granting of a patent is sought;
(b) indications allowing the identity of the applicant to be established;
(c) a part which, on the face of it, appears to be a description of an invention;
and

(d) one or more claims identifying the characteristic elements of the invention.

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

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

(4) If the applicant complies with the invitation under subsection (3), the registrar shall accord as the filing date the date of receipt of the missing drawings.

(5) The registrar shall accord as the filing date the date of receipt of the application and shall treat any reference to the drawings as non-existent.

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(6) After allocating a filing date, and having the invention classified according to the international classification, the registrar shall examine whether the application complies with the requirements of sections 21 (1) and (2), and the other requirements of this Act and regulations made under it and whether information requested under section 25, has been provided.

(7) Within ninety days after the publication of the notice mentioned in section 29, any interested party may file with the registrar a notice of opposition.

(8) The notice of opposition shall identify the opposed patent application, as well as the grounds that the opponent considers relevant to bar the grant as well as all relevant evidence.

(9) The failure to meet the formal or substantive conditions of patentability in sections 9, 13 and 21 may be alleged by the opponent.

(10) The registrar shall give notice of the opposition in the Gazette.

- (11) The applicant may within sixty days from the publication of the notice of opposition file a counter-statement.
- (12) The registrar may, if he or she considers fit, grant a hearing at which the patent applicant and the opponent may argue and counter-argue their case and submit additional evidence, if available, including oral evidence.
- (13) Subsection (1) shall apply to the inventions mentioned in section 8(2)(f) immediately after the coming into force of this Act.
- (14) The remaining subsections of this section as well as section 32 shall apply to the inventions mentioned in subsection (13) only after January 1, 2016; and the examination of those inventions shall apply the conditions of patentability referred to in subsection (4) as if those conditions were being applied on the date of filing in Uganda, as established under subsection (1), or where priority was claimed, the priority date of the applications.

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29. Publication of application.

- (1) The registrar shall publish the application as soon as possible after the expiration of eighteen months from the filing date or, where priority is claimed, from the date of priority.
- (2) For the purposes of subsection (1), in the case of applications claiming priority, the period of eighteen months shall be construed from the original filing date and in the case of applications with two or more priority claims, the period shall be construed from the earliest priority date.
- (3) The publication of the patent application shall be effected by publishing the particulars set out in the regulations, in the *Gazette* and a newspaper of wide circulation.

30. International type search.

- (1) The registrar may direct that an application which is found in order as to form be the subject of an international-type search.
- (2) When a direction under subsection (1) is made, the registrar shall request the applicant to pay the prescribed fee; and if the applicant does not comply

with the request, the application shall be rejected.

(3) Upon receipt of the report on the international-type search, the registrar may request the applicant to furnish him or her with a copy of any document cited in the report, and if without lawful reason any copy is not furnished within the prescribed time limit, the registrar shall reject the application.

(4) Where it is apparent from the report on the international-type search or from the declaration on the non-establishment of the report, that the subject of the application or of any claim or claims is not an invention, the registrar shall reject the defective application or consider the defective claim or claims to be withdrawn, as the case may be, unless the applicant satisfies the registrar that the subject of the application or claims constitutes an invention.

(5) Where it is apparent from the report on the international-type search or from the declaration on the non-establishment of the report, that—

(a) the description, the claim or, where applicable, the drawings do not comply, in whole or in part, with the prescribed requirements to such an extent that no meaningful search could be carried out;

(b) the application does not comply, in whole or in part, with the requirements of unity of invention prescribed by section 22 and the rules pertaining to it; or

(c) the invention claimed in the application does not fulfill the requirements of novelty,

the registrar shall reject the application unless the applicant either satisfies him or her that the requirements have been fulfilled or amends or divides the application so as to comply with the requirements.

(6) The details of the requirements and the procedures under this section shall be prescribed by regulations.

31.3 Examination as to substance.

(1) The registrar may, by notice in the *Gazette*—

(a) direct that an application for a patent which relates to a specified field or specified technical fields shall be subject to an examination as to substance; or

(b) amend any direction issued under paragraph (a).

(2) Where an application for a patent satisfies the requirements specified in section 28(1) and the subject matter of the application does not fall within a technical field specified under subsection (1), the registrar shall notify the applicant and the applicant shall, within three years from the filing date of the application, submit a request in the prescribed form for the examination of the application under subsection (4).

(3) Where no request is made under subsection (2) within the prescribed period, the application shall be taken to be abandoned.

(4) Where a request is filed under subsection (2), the registrar shall cause an examination of the application to be made as to whether—
(a) the invention in respect of which the application is made is patentable within the meaning of this Act; and
(b) the application complies with the requirements of section 22(5) and (6).

(5) For the purposes of the examination under subsection (4), the registrar may submit the application together with the relevant documents to an examiner or other competent authority for examination as to the patentability of the claimed invention and the examiner or other competent authority shall submit a report of the findings of the examinations to the registrar and the registrar shall submit a copy of it to the applicant.

(6) Except where an application is subject to an international-type search under section 30, the registrar shall cause an examination to be carried out as to whether the application complies with the requirements of unity of invention prescribed under section 22 and the rules pertaining to it.

(7) Where the registrar is of the opinion that the requirements of unity of invention have not been complied with, the registrar shall request the applicant to restrict or divide the application.

(8) Where, taking due account of the conclusions of a report referred to in subsection (6), the registrar is of the opinion that any of the conditions referred to in subsection (2) are not fulfilled, the registrar shall notify the applicant accordingly and request him or her to submit his or her observations and, where applicable, to amend his or her application.

(9) Where, in spite of any observation or amendment submitted by the applicant, the registrar finds that any of the conditions referred to in subsection (2) are not fulfilled, the registrar shall refuse to grant a patent and notify the applicant accordingly.

(10) The details of the requirements and the procedure to be followed under this section shall be prescribed by regulations.

32.3 Grant, registration, publication and post grant opposition of a patent.

(1) Unless an application has been rejected or a patent has been refused under section 31, a patent shall be granted and issued to the applicant in the prescribed form.

(2) A patent granted under subsection (1) shall be registered, and shall, as soon as reasonably practicable, be published by the registrar in the *Gazette*.

(3) The registrar shall, whenever possible, reach a decision on the application not later than two years from the commencement of the examination referred to in section 31.

(4) The registrar shall, upon the request of the owner of the patent, make any change in the text of drawings of the patent in order to limit the extent of the protection conferred by it, where the change would not result in the disclosure contained in the patent going beyond the disclosure contained in the initial application on the basis of which the patent was granted.

(5) In the event a patent is granted, any interested party may petition the registrar to reconsider the grant on the grounds that the patent fails any requirement of this Act.

(6) The petition under this section must be filed within one calendar year of the published grant of the patent and shall specify the grounds thereof.

33.3 Appeals under Part V.

An applicant who is aggrieved by a decision of the registrar may appeal within two months to the court against a decision by which the registrar—

- (a) records a filing date;
- (b) rejects the application;
- (c) treats the application as if it had not been filed;
- (d) considers any of the claims to be withdrawn; or
- (e) refuses to grant a patent.

PART VI—INTERNATIONAL APPLICATIONS.

34. Further functions of the registry.

- (1) The registry shall act as a receiving office where an international application is filed with it by a national or a resident of Uganda.
- (2) The registry shall act as a designated office or an elected office in the case of any international application in which Uganda is designated or elected for a national patent.
- (3) The functions of the registry under this Part shall be performed in accordance with the Patent Cooperation Treaty, the regulations made under it and the administrative instructions issued under the regulations of the Patent Cooperation Treaty and with the provisions of this Act and the regulations made under the Act relating to them.
- (4) In case of conflict, the provisions of the Patent Cooperation Treaty, the regulations and the administrative instructions issued under it shall apply.

35. Unsearched or unexamined international applications.

- (1) Where an international search report is not established or relates to only one or some of the claims of an international application, the registrar shall reject the international application or consider withdrawn the claim or claims which are not covered by the report, as the case may be, except to the extent that the applicant satisfies the registrar that the non-establishment of the report in whole or in part was not justified.
- (2) Where the international search report which relates to one or some of the claims due to the applicant's refusal to pay additional fees, those parts of the international application which consequently have not been searched shall be considered withdrawn unless the applicant divides out from the application

as provided for in section 23(2) the parts concerned or satisfies the registrar that the request to pay the additional fees was not justified.

(3) Where an international preliminary examination report with respect to an international application has been communicated to the registrar, the following provisions shall apply—

(a) where, in the case of lack of compliance with the requirements of unity of invention, the international preliminary examination report indicates that the international preliminary examination was carried out on restricted claims, or was carried out on the main invention only, those parts of the international preliminary examination shall be considered withdrawn unless the applicant divides the application into divisional applications in accordance with as provided for in section 23(2) in parts concerned or satisfies the registrar that the invitation of the international preliminary examining authority was not justified; and

(b) where the international preliminary examination report states, with respect to the entire international application or one or some of its claims only, the opinion that a defect under article 34(4) (a) of the Patent Cooperation Treaty exists under the international application or the claim or claims, as the case may be, the application shall be considered withdrawn unless the applicant satisfies the registrar that the defects do not exist.

(4) The registrar may refuse to grant a patent if it is apparent from an international search report or an international preliminary examination report that the invention which is claimed in an international application does not fulfill the requirements of novelty, inventive step, industrial applicability, or required disclosure unless the applicant either satisfies the registrar that the requirements have been fulfilled or amends the claims in such a way that fulfils the requirements.

36.3 Provisional protection of published international applications.

(1) Relief against infringement may be sought in respect of acts committed before the grant of the patent but after the date of international publication under the Patent Cooperation Treaty, where the international publication is

effected in English.
(2) If the international publication is effected in a language other than English, subsection (1) shall apply where the applicant has transmitted an English translation of the international publication to the infringer and only in respect of acts committed by the latter after he or she had received the transaction.

37.3 Publication of international applications.

An international application which is published under article 21 of the Patent Cooperation Treaty and in which Uganda is designated for a national patent shall be treated as published under section 29.

PART VII—RIGHTS AND OBLIGATIONS OF THE APPLICANT OR THE OWNER OF THE INVENTION.

38.3 Rights of the owner.

- (1) The applicant or the owner of an invention has the right—
- (a) on fulfilling the relevant requirements under this Act, to be granted the patent;
 - (b) to make, use, exercise and sell the invention exclusively, and may preclude any person from exploiting the patented invention without his or her authorization by any of the following acts—
 - (i) where the patent has been granted in respect of a product, making, importing, offering for sale, selling and using the product or stocking the product for the purposes of offering for sale, selling or using the product;
 - (ii) where the patent has been granted in respect of a process or doing any of the acts referred to in paragraph (a) in respect of a product obtained by means of that process.

(2) After the grant of the patent, and within the terms of this section, the owner of the patent has the right to preclude any person from exploiting the patented invention in the manner referred to in subsection (1).

(3) The owner of a patent may assign or transfer by succession the application for patent or the patent.

(4) The applicant or the owner of a patent may conclude licence contracts as provided for in Part X of this Act and be subject to the obligations referred to in section 39.

39.3 Obligations of the owner.

The applicant or the owner of an invention shall have the following obligations—

(a) to disclose the invention in a clear and complete manner, and in particular to indicate best mode for carrying out the invention, in accordance with the requirements, and subject to the sanctions, applicable under this Act;

(b) to give information concerning corresponding foreign applications and grants including denials, revocations, invalidations, suspensions or lapses;

(c) to pay fees to the registrar, as prescribed in this Act and the regulations, subject to the sanctions provided for under this Act;

(d) to work the patented invention in the country within the time limit prescribed;

(e) in connection with licence contracts and contracts assigning patents or patent applications, to refrain from making undesirable provisions referred to in section 55.

40.3 Remedies.

(1) The owner of a patent has the right—

(a) to obtain an injunction to restrain the performance or the likely performance, by any person without his or her authorization, of any of the acts referred to in section 38;

(b) to claim damages from any person who, having knowledge of the patent, performs any of the acts referred to in section

38, without the owner's authorization; (c) to claim compensation from any person who, without his or her authorisation, performs any of the inventions claimed in the published application, as if a patent had been granted for that invention. (2) The right under subsection (1) is only exercisable where the person referred to in that subsection has at the time of the performance of the act— (a) actual knowledge that the invention that he or she is using is the subject matter of a published application; or (b) received written notice that the invention that he or she is using is the subject matter of a published application, and the application is identified in that notice by its serial number.

41. Right of a prior user.

(1) Notwithstanding section 38, a patent has no effect against any person, in this Act referred to as “the prior user” who, in good faith, for the purposes of his or her enterprise or business, before the filing date or, where priority is claimed, the priority date of the application on which the patent is granted, and within the territory where the patent produces its effect, is using the invention or is making effective and serious preparations for that use. (2) A person referred to in subsection (1) has the right, for the purposes of his or her enterprise or business, to continue the use or to use the invention as envisaged in the preparations referred to subsection (1). (3) The right of the prior user may only be transferred or may only devolve together with his or her enterprise or business, or with that part of his or her enterprise or business in which the use or preparations for use is or are made.

42. Scope of protection.

The scope of the protection afforded under this Part to a patent shall be determined by the terms of the claims but where they are inadequate, the description and drawings included in the patent may be used to interpret the claims.

43. Limitation of rights.

- (1) The rights under the patent extend only to acts which are done for industrial or commercial purposes but do not extend to acts which are done for scientific research.
- (2) The rights under the patent do not extend to acts in respect of articles which have been put on the market in Uganda or in any other country or imported into Uganda by the owner of the patent or with his or her consent.
- (3) The rights under the patent do not extend to the use of articles on aircraft, land vehicles or vessels of other countries, which temporarily or accidentally enter the airspace, territory, or waters of Uganda.
- (4) The rights of the patent do not extend to variants or mutants of living forms or replicable living matter that is distinctively different from the original for which patents were obtained where those mutants or variants are deserving of separate patents.

44.3 Exception to exclusive rights.

It is not an infringement of a patent to use the patented invention without the authorization of the patent holder in any of the following circumstances—

- (a) to carry out any acts related to experimental use or research on the patented invention, whether for scientific or commercial purposes;
- (b) to make use of a patented invention for teaching or educational purposes;
- (c) to carry out acts, including testing, using, making or selling a patented invention solely for the purposes reasonably related to the development and submission of information required under any law of Uganda or of another country which regulates the manufacture, construction, use or sale of any product;
- (d) to make use of the patented invention in relation to the preparation for individual cases, in a pharmacy or by a medical doctor, of a medicine in accordance with a medical prescription; and
- (e) to manufacture and export to another country a patented healthcare invention where the export of the invention addresses a health need identified by the other country, where—

- (i) the product is either not patented in the third country; or
- (ii) the government of another country has authorised use of the patent without the consent of the patent owner and the production for export of the invention is intended only for the market of the third country.

45.3 Harere Protocol on patents.

A patent, in respect of which Uganda is a designated state, granted by ARIPO by virtue of the Harere Protocol has the same effect in Uganda as a patent granted under this Act except where the registrar communicates to ARIPO, in respect of the application of the patent, a decision in accordance with the provisions of the Protocol that if a patent is granted by ARIPO, that patent shall have no effect in Uganda.

PART VIII—TERM OF PATENT AND ANNUAL FEES.

46.3 Term of patent.

A patent shall expire at the end of twenty years from the filing date of the application.

47.3 Annual fees.

- (1) In order to maintain the application or the patent, an annual fee shall be paid in advance and in the manner prescribed, to the registrar.
- (2) The fee shall be due at the end of the day immediately before each anniversary of the date of filing of the application.
- (3) A grace period of six months shall be granted for the payment of the annual fee upon payment of the prescribed surcharge.
- (4) If an annual fee is not paid in accordance with this section, the application shall be taken to have been withdrawn or the patent shall lapse and the relevant invention shall cease to be protected.
- (5) The registrar shall immediately publish the lapse of any patent under subsection (4).

(6) Within six months from the expiration of the grace period referred to in subsection (3), an interested person may, upon payment of the prescribed fee, request the registrar to restore the application that is taken to have been withdrawn, or a patent that has lapsed, by virtue of subsection (4).

(7) Upon a request under subsection (6), the registrar shall, if satisfied that the failure to pay the annual fee is not intended, subject to the payment of the annual fee, make an order restoring the application or the patent as the case may be.

(8) Where a patent is restored, no proceedings shall be brought in respect of the patent—

(a) in relation to any acts performed after the lapse of the patent and before the date of the order for restoration; or

(b) in relation to any acts performed after the date of the order of restoration in relation to articles imported into or manufactured in Uganda, after the lapse of the patent and before the date of the order for restoration.

PART IX—CHANGE IN THE OWNERSHIP
AND JOINT OWNERSHIP OF
APPLICATION AND PATENT.

48.3 Change in ownership of application.

(1) A contract assigning a patent or application for a patent shall be in writing and shall be signed by the party making the assignment.

(2) A change in the ownership of a patent or an application for a patent shall, upon payment of the prescribed fee, be recorded in the patent register.

(3) Until the change has been recorded, a document evidencing the change in ownership shall not be admitted in any proceedings as evidence of the title of a person to an application or a patent, unless the court otherwise directs.

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49.3 Joint ownership of application and patent.

- (1) In the absence of an agreement to the contrary between the parties, joint owners of a patent or an application for a patent may, separately—
- (a) transfer their shares in the patent or the application for the patent;
 - (b) exploit the protected patent, and preclude any person from exploiting the patent;
- (2) The joint owners may only jointly grant permission to any third person to do any of the acts referred to in section 38.

PART X—CONTRACTUAL LICENCES.

50.3 Rights of licensee.

- (1) In the absence of any provision to the contrary in a licence contract, the licensee is entitled to do any of the acts referred to in section 38 in respect of the invention, without limitation as to time, in Uganda and in any field of use of the invention, utility model or industrial design.
- (2) Subject to subsection (1) the licensee may not grant permission to a third person to do any of the acts referred to in section 38.

51.3 Right of licensor to grant further licences and use of the invention.

- (1) In the absence of any provision to the contrary in the licence contract, the licensor may grant permission to any person to do, or may himself or herself do, any of the acts, which constitute exercising the rights of ownership.
- (2) Where the licence contract provides that the permission granted by the licence contract is exclusive, the licensor may neither grant permission to a third person to do any of the acts referred to in section 38 and covered by the licence contract, nor himself or herself do any of those acts, and the licensee shall be considered an exclusive licensee for the purposes of this Act.

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52.3 Effect of patent not being granted, revoked or being invalidated.

Where, before the expiration of the licence contract any of the following events occurs with respect to any patent or application for a patent referred to in that licence contract—
(a) the application is withdrawn; (b) the application is rejected; or
(c) that patent is revoked or declared invalid,
the court may on the application of the aggrieved party, make any order it considers reasonable under the circumstances for the repayment of the royalties or the return of any consideration paid or given under the licence contract and directly relating to the application or patent.

53.3 Form of licence contracts.

All licence contracts shall be in writing and shall be signed by the parties to the contract.

54.3 Petition for registration.

(1) All licence contracts, including modifications of them, shall be submitted to the registrar for registration in the patent register.

(2) A petition for registration under subsection (1) may be made by any party to the contract, and shall be accompanied by the documents and the prescribed fees.

(3) The registrar shall issue to the applicant a receipt, which shall be proof of the fact of filing the petition and of the date on which it was filed.

(4) Where no receipt is issued within fourteen days from the date of the petition, the petitioner may rely on other evidence to prove the fact and date.

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(5) Where—
(a) section 52 or subsections (2) to (4) and the rules relating to the licence contract, have not been complied with; or
(b) the licence contract cannot be registered under section 55, the Registrar shall refuse to register the licence contract and shall state the reasons for the

refusal.

- (6) Before refusing to register the licence contract, the registrar shall notify the petitioner and allow the parties—
- (a) to submit their observations, if any;
 - (b) to correct any defect in the petition; or
 - (c) to amend any term, or to correct any defect, in the licence contract that has been declared by the registrar to have a defect precluding registration, within forty-five days from the date of the notification.
- (7) A licence contract is void if the registration is refused by the registrar in accordance with this Act.

55.3 Prohibited terms in a licence contract.

- (1) The registrar may refuse to register a licence contract if the registrar is of the opinion that any clause in the licence contract imposes unjustified restrictions on the licensee with the consequence that the contract, taken as a whole, is harmful to the economic interests of Uganda.
- (2) Without prejudice to subsection (1) the following terms in a licence contract shall be taken to have the effect described in that subsection to—
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- (a) require payment of a price, royalty or other consideration which is disproportionate to the value of the technology to which the licence contract relates;
- (b) require the licensee to acquire any materials from the licensor or from sources designated or approved by him or her, unless it is practically impossible to ensure the quality of the products to be produced;
- (c) prohibit the licensee from acquiring, or to restrict his or her acquisition of any materials from any source, unless it is practically impossible to ensure that quality of the products to be produced;
- (d) prohibit the licensee from using, or to restrict his or her use of any materials which are not supplied by the licensor or by sources designated or

approved by him or her, unless it is practically impossible to ensure the quality of the products to be produced;

(e) require the licensee to sell products produced by him or her under the contract exclusively or principally to persons designated by the licensor;

(f) limit the volume of the products produced by the licensee with the help of the technology to which the licence contract relates;

(g) oblige the licensee to employ persons designated by the licensor and not needed for the efficient transfer of the technology to which the contract relates except that where the contract provides for the employment of persons who are needed for the transfer of technology to which the contract relates, the contract shall provide for the training of persons to replace them within a reasonable period;

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(h) impose restrictions on research or technological development carried out by the licensee to absorb or adapt the technology in connection with new products, processes or equipment;

(i) prohibit or restrict the use by the licensee of any technology other than the technology to which the contract relates or not owned by the licensor;

(j) extend the coverage of the contract to technology not required for the use of the technology which is the main subject of the licence contract and to require consideration for that additional technology;

(k) fix prices for the sale or resale of the products produced by the licensee with the help of the technology to which the licence contract relates;

(l) prohibit or restrict the use by the licensee, after the expiration of the contract, of the technology acquired as a result of the licence contract, subject, to any right of the licensor under the patent;

(m) establish the duration of the licence contract for a period which is unreasonably long in relation to the economic function of the licence contract; except that any period which does not exceed the duration of the patent to which the contract relates shall not be regarded as unreasonably long;

(n) restrict the licensee from entering into sales, representation or manufacturing agreements relating to similar or competing technologies, when those restrictions are not needed for protecting the legitimate interests of the licensor; including, in particular, protecting the licensor's individual or intellectual property rights or ensuring that the licensee exercises his or her best efforts in respect of any manufacturing, distribution or promotional obligations;

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(o) prevent the licensee from adapting the technology to local conditions or introducing innovations in it or changing to alternative inputs, or to require the licensee to introduce unnecessary designs or specification changes if the licensee makes adaptations on his or her own responsibility and without using the licensor's name, trade marks or trade names, and except to the extent that the adaptation unsuitably affects those products, to be supplied by the licensor, his or her designates, or his or her other licensees, or to be used as a component or spare part in a product to be supplied to his or her customer;

(p) impose acceptance of additional technology, future inventions and improvements, and goods or services not required by the licensee;

(q) impose restrictions on territories, quantities, prices, customers or markets arising out of patent pool or cross-licensing agreements or other international technology transfer interchange arrangements which unduly limit access to new technological developments or which would result in an abusing domination of an industry or market adverse effects on the licensee, except for those restrictions appropriate and ancillary to cooperative arrangements such as co-operative research arrangements;

(r) impose restrictions which regulate advertising or publicity by the licensee except where restriction of the publicity may be required to prevent injury to the licensor's goodwill or reputation where the advertising or publicity makes reference to the licensor's name, trade marks, trade names or other identifying items;

(s) impose confidentiality after the expiry of the licence agreement or to

impose unreasonably long periods for secrecy following the commissioning of manufacturing facilities using the licensed technology, or to impose measures which limit technological learning and mastery, except those which relate to industrial property rights;
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(t) impose requirements for payments even under conditions of *force majeure*;

(u) impose restrictions which prevent or hinder export by means of territorial or quantitative limitations or prior approval for export or export prices of products or increased rates of payments for exportable products resulting from the technology licensed;

(v) impose quality control methods or standards not needed by the licensee, except to meet the requirement of a guarantee or when the product bears a trade mark, or trade name of the licensor;

(w) allow the licensor to participate permanently in the management of the licensee's business as a condition for obtaining the technology;

(x) restrict the licensee from taking measures that will enhance Ugandan technological capacity and which are not prejudicial to the licensor's industrial property rights;

(y) restrict the use of Ugandan expertise in management and consultancy or in any other positions;

(z) require payment of royalty for patents granted outside Uganda;

(aa) apply different conditions to similar transactions with other trading parties, and that placing the licensee at a competitive disadvantage; and

(ab) make the licence contract subject to acceptance of supplementary obligations which, by their nature or according to commercial usage, have no connection with the subject of the contracts.

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56.3 Registration of the contract and issue of certificate.

(1) Where the registrar finds that the licence contract may be registered, the registrar shall register the contract and issue a certificate of registration to the petitioner.

(2) Where the registrar fails to notify the petitioner—
(a) of a defect in the petition or of terms or defects precluding registration of the licence contract within ninety days after the date of the petition; or
(b) of his or her decision to refuse to register the licence contract within ninety days after the date of notification referred to in paragraph (a), the licence contract shall be presumed to have been registered and the registrar shall issue a certificate of registration to the petitioner.

(3) The registration shall take effect—
(a) if the petition was made within sixty days from the date of conclusion of the contract, on the date of the conclusion of the licence contract, and
(b) in all other cases, on the date of the petition.

(4) When the petition is corrected or the licence contract is amended under section 54(6), the petition shall be taken to have been received on the date when the correction or amendment is made.

(5) The registration and certificate shall state—
(a) the name of the parties to the contract and of the licensee if he or she is not a party;

(b) the date of the petition;

(c) the date of the registration; and

(d) the registration number,
all of which shall be published in the *Gazette*.

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(6) The contents of the licence contract shall be confidential unless both parties to the licence contract agree to permit access to it by third parties and the access shall only be to the extent of the permission granted.

57.3 Appeal.

- (1) A petitioner who is aggrieved by a decision of the registrar to register a licence contract may appeal against the decision of the registrar to the court within two months after the registrar's refusal to register the licence contract.
- (2) The grounds of an appeal under this section shall be limited to the following—
 - (a) that the decision of refusal contains no statement of the reasons for the refusal;
 - (b) that none of the reasons specified in the decision is valid under this Act or that the reason was wrongly applied to the petitioner or to the licence contract; or
 - (c) that the procedure applied by the registrar was irregular and prejudicial to the rights of the petitioner.

58. 3 Compulsory licences for non-working and similar reasons.

- (1) After the expiration of four years from the filing date of an application or three years from the grant of a patent, whichever last expires, a person may apply to the Minister for a licence to exploit the patented invention on the grounds that the market for the patented invention is not being supplied, or is not being supplied on reasonable terms, in Uganda.
- (2) Notwithstanding subsection (1), a non-voluntary licence shall not be granted if the owner of the patent satisfies the Minister that circumstances exist which justify the fact that the market for the patented invention is not being supplied, or is not being supplied on reasonable terms, in Uganda.

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59.3 Compulsory licences based upon interdependence of patents. (1) Where a patented invention cannot be worked without infringing the rights derived from an earlier patent, the owner of the later patent may request the Minister for the grant of a compulsory licence with respect to the earlier patent to the extent necessary for the working of his or her invention, if the invention

constitutes an important technical advance of considerable economic significance in

relation to the invention claimed in the earlier patent.

(2) The owner of the first patent is entitled to a cross-licence on reasonable terms to use the invention claimed in the second patent.

(3) The use authorized in respect of the first patent shall be non-assignable except with the assignment of the second patent.

(4) In this section, “earlier patent” or “first patent” means a patent granted on an earlier application or benefiting from an earlier validly claimed priority date, and “later patent” or “second patent” shall be construed accordingly.

60.3 Preconditions for grant of compulsory licences.

(1) A compulsory licence shall not be granted unless the person requesting the licence—

(a) satisfies the Minister that he or she has requested the owner of the patent for a contract licence but has been unable to obtain the licence contract on reasonable commercial terms and within a reasonable time; and

(b) offers a guarantee satisfactory to the Minister to work the relevant invention sufficiently to remedy the deficiencies or to satisfy the requirements which gave rise to his or her request.

(2) The requirement under subsection (1)(a) shall be waived in the case of a national emergency or other circumstances of extreme urgency or where the application is based on anti-competitive practices; except that the registrar shall notify the owner of the patent as soon as reasonably possible of the waiver.

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61.3 Grant and terms of compulsory licences.

(1) When considering a request for a compulsory licence, the Minister shall decide whether a compulsory licence may be granted and shall, if it decides in

favour of the grant and after taking into account any terms agreed by the parties, proceed to fix the terms which shall be taken to constitute a valid contract between the parties and shall be governed by the provisions on contractual licences.

(2) When fixing the terms under subsection (1), the Minister shall ensure that the compulsory licence—

(a) is limited, in scope and duration, to the purpose for which it was authorized, and in the case of semi-conductor technology, shall only be for public non-commercial use or to remedy a practice determined after a judicial or administrative process to be anti-competitive;

(b) is limited predominantly for the supply of the regional market;

(c) does not entitle the licensee to grant further licences without the consent of the owner of the patent;

(d) is non-exclusive; and

(e) provides for the payment to the owner of the patent of remuneration which is equitable having regard to all the circumstances of the case, including the economic and social value of the licence.

(3) A representative of the registrar and the patent owner shall have the right to appear and be heard at the hearing before the Minister of an application for a compulsory licence.

62.3 Transfer of compulsory licence.

A compulsory licence may be transferred only with that part of the industrial undertaking or its goodwill, in which the relevant invention is used and the transfer shall not be valid until the consent of the Minister is obtained.
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63.3 Cancellation of compulsory licence.

(1) On the application of an interested party, the Minister may cancel a compulsory licence if—

(a) the licensee fails to comply with the terms of the licence; or

(b) the conditions which justify the grant of the licence have ceased to exist and are unlikely to recur; but the legitimate interests of the licensee shall be adequately protected.

(2) On the application of the owner of the patent, the Minister may cancel the compulsory licence if, within two years from the grant of the licence, the licensee has not taken the necessary steps to work the relevant invention sufficiently so as to remedy the deficiencies or to satisfy the requirements which gave rise to his or her application for the licence.

(3) On the application of the owner of the patent or the licensee, the Minister may vary the terms of a compulsory licence if new facts on the owner's part justify the variation and in particular if the patent owner has granted a contractual licence on more favourable terms.

64.3 Registration of grant, cancellation or variation.

Where the Minister grants, cancels or varies the term of a compulsory licence, the Minister shall instruct the registrar to record the grant, cancellation or variation in the register without payment of any fee.

65.3 Licence as of right.

(1) The owner of the patent may request the registrar to make an entry in the register to the effect that a licence under the patent is to be available as of right.

(2) The request shall be notified by the registrar to the licensee under the patent.

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(3) A licensee may, within the prescribed time limit, object to the entry requested under subsection (1) on the ground that the owner of the patent is, by the relevant licence contract, precluded from granting further licences.

(4) Where the registrar receives no objection under subsection (3) or considers all objections made to be unfounded, the registrar shall make the requested entry in the register and shall publish the entry.

(5) Where a patent is the subject of an entry under this section, a person may require the owner of the patent to grant him or her a non-exclusive licence under the patent on terms which, in the absence of an agreement between the parties, shall be fixed by the court.

(6) The amount of the annual fees with respect to a patent, which is the subject of an entry under this section, that falls due after the date of the entry, shall be reduced by half.

(7) The owner of the patent may at any time request the registrar to cancel an entry under this section and the registrar shall cancel the entry after payment by the owner of the balance of all annual fees which would have been payable if no entry had been made and the registrar shall publish the cancellation of any entry under this section.

(8) Section 63(3) shall apply, with the necessary modifications, where the terms of a licence granted under subsection (5) have been fixed by the court.

PART XI—EXPLOITATION OF PATENTED INVENTIONS BY THE GOVERNMENT OR BY THIRD PARTIES AUTHORISED BY THE GOVERNMENT

66.3 Exploitation of patented inventions by the Government or by third parties authorised by the Government.

(1) Subject to this section, where—
(a) the public interest, in particular, national security, nutrition, health, environmental conservation, national emergency or the development of other vital sectors of the national economy requires; or
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(b) the registrar determines that the manner of exploitation of an invention by the owner of the patent or his or her licensee is not competitive, the Minister may, upon application to him or her in the prescribed form and after consultation with the registrar and the owner of the patent, order that

the protected invention shall be exploited by a Government ministry, a department, an agency or other person as the Minister may designate in the order subject to the payment of adequate compensation to the owner of the patent in accordance with this section.

(2) An order under subsection (2) shall remain in force until it is revoked by the Minister in writing, after giving six months prior notice of his or her intention to revoke to the party named or described in the order.

(3) An order made under subsection (2) shall not require the payment of compensation to the owner of the patent or licence holder or any other party interested.

(4) The Minister may, notwithstanding any of the measures set out in this section, by written order authorise the utilisation of any process for the manufacture, sale or supply of any molecule or substance, by any individual, corporation, society or other enterprise named or described in the order without notice to the patent holder or any other noticeable party.

(5) An order under subsection (4) and that order shall remain in force until revoked by the Minister in writing, after giving six months prior notice of intention to revoke to the party named or described in the order.

(6) An application shall not be made under subsection (1) unless the applicant has unsuccessfully sought a licence contract from the owner of the patent.

(7) Subsection (1) shall not apply in a case of national emergency or other extreme urgency and in that case the Minister shall cause the contents of the order to be communicated to the owner of the patent as soon as practicable.

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(8) An order under this section shall be subject to conditions that the Minister considers necessary.

(9) Where an order under this section is made, the Minister shall determine the amount of compensation to be paid to the owner of the patent, and the compensation shall be equitable having regard to all the circumstances of the case and in particular, the economic and social value of the patent.

(10) An order under this section shall not preclude the owner of the patent from concluding a licence contract or from exercising the powers conferred by section 38.

(11) The Minister may, upon the request of the owner of the patent or the Government ministry, a department, an agency or other person designated by the Minister for the purpose of any order under this section and after hearing all interested parties, vary the terms of the order to the extent that changed circumstances justify the variation.

(12) The Minister may, upon the request of the owner of a patent and after hearing all interested parties, revoke an order under this section—

(a) if satisfied that the circumstances necessitating the order have ceased and are unlikely to recur; or

(b) where the Government Ministry, department, agency or other entity or person designated for the purposes of the order is in breach of any condition imposed under subsection (7).

(13) The authorisation of a person in an order under this section shall not be transferable except to a business or enterprise owned or operated by that person.

(14) The exploitation of the invention under an order made under this section shall be primarily for the supply of the regional market.

(15) An order which relates to the exploitation of an invention in the field of semi-conductor technology shall only be made where the court has determined that the manner of exploitation of the patented invention by the owner of the patent or his or her licensee is not competitive and the Minister is satisfied that the issue of the order would remedy that practice.

(16) A person who is aggrieved by a decision of the Minister under this section may appeal to the court.

67.3 Transfer of patent in connection with illegally accessed genetic resources.

- (1) The Minister is entitled to claim proprietary interests in any patent application filed or granted that does not comply with sections 21(6) and 21(7) as regards genetic resources.
- (2) The Minister shall notify the registrar to assign to the ministry, or to any agency or entity designated by the competent authority, a share in the application or in the resulting patent, which shall not be less than twenty percent of the ownership of the claimed invention.
- (3) Where the non compliance with violation with sections 21(6) and 21(7) as regards genetic resources generates strong public concern and is likely to give rise to breach of morality and public order, the competent authority, if vested with the total ownership of the application or the resulting patent, may withdraw the application or abandon the patent, so that the claimed invention falls into the public domain.
- (4) This section shall apply without prejudice to the application of sections 102(9) and 102(10).

PART XII—UTILITY MODELS

68.3 Applicability of provisions relating to patents.

- (1) Subject to this section, Parts III, IV, V, VII, VIII, IX, X, XI, XV and XVI shall apply, with the necessary modifications, to utility model certificates or applications for them, as the case may be.
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- (2) Where the right to a patent conflicts with the right to a utility model certificate in the case referred to in section 17 (3), that provision shall apply as if the word “patent” were replaced by the words “utility model certificate”.
- (3) A certificate of utility model is prima facie evidence that the holder is the registered owner of a utility model with the registrar.

69.3 Special provisions relating to utility model certificates.

- (1) An invention qualifies for a utility model certificate if it is new and industrially applicable.
- (2) Sections 9, 11, 30, 31 and 46 shall not apply in the case of applications for utility model certificates.
- (3) A utility model certificate shall expire at the end of the tenth year after the date of the grant of a utility model and is not renewable.

70.3 Conversion of patent applications to application for utility model certificates, and vice versa.

- (1) At any time before the grant or refusal of a patent an applicant for a patent may, upon payment of the prescribed fee, convert his or her application into an application for a utility model certificate, and the utility model certificate shall be accorded the filing date of the initial application.
 - (2) At any time before the grant or refusal of a utility model certificate, an applicant for a utility model certificate may, upon payment of the prescribed fee, convert his or her application into a patent application, which shall be accorded the filing date of the initial application.
 - (3) An application may not be converted under subsections (1) and (2) more than once.
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PART XIII—INDUSTRIAL DESIGNS

71. Definition of an industrial design.

- (1) For the purposes of this Part, “an industrial design” means that aspect of a useful article which is ornamental or aesthetic that may consist of three dimensional features like a shape or surface of an article or a three dimensional feature such as patterns, line or colours.
- (2) The protection of industrial design under this Act shall not extend to anything in an industrial design which serves solely to obtain a technical

result, and to the extent that it leaves no freedom as regards arbitrary features of appearance.

72. Right to industrial design; naming of creator.

- (1) Subject to this Act and to the provisions of any other written law, the creator of an industrial design or his or her successor in title has the exclusive right to sell or cause to be sold for commercial or industrial purposes the goods in which the design is incorporated.
- (2) Sections 17, 19, and 20 apply with the necessary modifications, to the rights of the creator of an industrial design.

73. Registrable industrial designs.

- (1) An industrial design is registrable if it is new.
 - (2) An industrial design shall be taken to be new if it has not been disclosed to the public, anywhere in the world, by publication in tangible form or, in Uganda, by use or in any other way, prior to the filing date or, where applicable, the priority date of the application for registration.
 - (3) Section 10(3) applies, with the necessary modifications, in respect of priority dates of an industrial design.
 - (4) An industrial design which is contrary to public order or morality shall not be registered.
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74.3 Application and examination

- (1) A person who wishes to register an industrial design shall submit to the registrar—
 - (a) an application in the prescribed form;
 - (b) a power of attorney, where the applicant is represented by an agent;
 - (c) drawings, photographs or other adequate graphic representations of the article embodying the industrial design and an indication of the kind of

products for which the industrial design is to be used; and
(d) the prescribed application fee.

(2) The request may be accompanied by a specimen of the article embodying the industrial design, where the industrial design is two-dimensional.

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

(4) Two or more industrial designs may be the subject of the same classification if they relate to the same class under international classification or to the same set or composition of articles.

(5) The application, at the time of filing, may contain a request that the publication of the industrial design, upon registration, be deferred for a period not exceeding twelve months from the date of filing or if priority is claimed, from the date of priority of the application.

(6) The applicant may at any time withdraw an application lodged under this section.

(7) The registrar shall record as the filing date the date of receipt of the application if at the time of receipt of the application, the prescribed application fee is paid and the application contains the name of the applicant and a graphic representation of the article embodying the industrial design or a specimen of the industrial design.

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(8) Sections 24, 28(2) and (3) apply, with the necessary modifications, in respect of priority dates and the filing of corrections to the application.

(9) The registrar shall, if satisfied that an application meets the requirements of this section and of sections 72 and 73, register the industrial design, publish a reference to the registration, and issue a certificate of registration to the applicant.

(10) Notwithstanding subsection (9), where a request has been made under subsection (5) for deferment of publication, upon registration, of the industrial design, neither the representation of the design nor any file relating

to the application shall be open to public inspection.

(11) The registrar shall publish a mention of the deferment of the publication of the industrial design and information identifying the registered owner.

(12) At the expiry of the period of deferment, the registrar shall publish the registered industrial design.

(13) The institution of legal proceedings on the basis of a registered industrial design during the period of deferment of publication, shall be subject to the condition that the information contained in the register and the file relating to the application have been communicated to the person against whom the action is brought.

(14) Subject to subsection (8), the date of the registration shall be that of the application.

75. Duration and renewal of registration of an industrial design.

(1) Subject to subsection (2), the registration of an industrial design shall expire at the end of the fifth year following the date of the registration.

(2) The registration of a design may be renewed for two further consecutive periods of five years upon payment of the prescribed renewal fee.
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(3) The fee for the renewal of registration of an industrial design shall be paid within twelve months before the expiration of the period of registration but a grace period of six months shall be allowed for the late payment of the renewal fee on payment of the prescribed surcharge.

76. Restoration of registration of industrial designs.

(1) Where the protection granted to an industrial design has not been renewed due to circumstances beyond the control of the owner of the design, the owner or any other person entitled to the industrial design may apply for its restoration on the payment of the prescribed renewal fee, as well as of the surcharge, within a period of one year from the date upon which renewal fee

was due.

(2) An application for restoration of registration for an industrial design, together with documents proving payment of the fees and surcharge referred to in subsection (1) shall be sent to the registrar and shall contain a statement of the grounds on which the owner or the persons making the application considers the restoration justified.

(3) The registrar shall examine the grounds mentioned in the statement referred to in subsection (2) and shall either restore the registration for the design or reject the application if he or she does not consider the grounds valid.

(4) Restoration of registration shall not extend prolongation of the maximum duration of the registration of the industrial design.

(5) Restored designs shall be published by the registrar in the prescribed form.

77. Graphic representations, specimens and related matters.

(1) The application, including any drawings, photographs or other graphic representations and any specimen of the registered industrial design shall be kept by the registrar and after publication of the registration they shall be communicated upon request made in the prescribed manner.

(2) Drawings, photographs or other graphic representations and specimens of industrial designs shall be kept by the registrar for eight years after the expiry of the registration and may be examined by any interested person on payment of the prescribed fee.

(3) After publication, a person may, on payment of a prescribed fee, obtain an official copy of the application, representations or specimens from the registrar.

(4) Subsections (1), (2) and (3) apply to official copies furnished by applicants seeking to avail themselves of the priority of an earlier registration and to the documents enabling certain applicants to claim the priority.

(5) An applicant for registration of an industrial design seeking to avail himself or herself outside Uganda of the priority of his or her registration before registration of the industrial design may obtain an official copy of his or her application.

78.3 Publication of reference to registration of industrial designs.

(1) The registrar shall publish a reference to the registration of all industrial designs, which shall contain, in addition to the prescribed details—
(a) the number of the industrial design; (b) the date of filing of the application;
(c) the mention of any validly claimed priority; and
(d) the drawings, photographs or other graphic representations of the industrial design and an indication whether a specimen has been deposited with the registrar.

79.3 Rights conferred by registration of industrial designs and related matters.

(1) Registration of an industrial design shall confer upon its registered owner the right to preclude third parties from performing any of the following acts in
Uganda—
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(a) reproducing the industrial design in the manufacture of a product;
(b) importing, offering for sale and selling a product reproducing the protected industrial design; or
(c) stocking of that product for the purposes of offering it for sale or selling it.

(2) The rights conferred by the registration of an industrial design shall extend only to acts done for industrial or commercial purposes and shall not extend to acts in respect of a product embodying the protected industrial design after the product has been lawfully imported or sold in Uganda.

(3) The registered owner of an industrial design has, in addition to any other rights, remedies or actions available to him or her, the right to institute court proceedings against any person who infringes the industrial design by performing, without his or her consent, any of the acts referred to in subsection (1) or who performs acts which make it likely for infringement to occur.

(4) An industrial design registered by ARIPO by virtue of the ARIPO Protocol and in respect of which Uganda is a designated State has the same effect in Uganda as an industrial design registered under this Act unless the registrar has communicated to ARIPO, in respect of an application of it, a decision in accordance with the ARIPO Protocol that if a registration is made by ARIPO that registration shall have no effect in Uganda.

80.3 Transfer and assignment of industrial designs, licences.

(1) Rights subsisting in an industrial design may be transferred in whole or in part.

(2) Sections 48, 49, 50, 54 and 56 apply, with the necessary modifications, to this
Part.
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PART XIV—TECHNOVATIONS

81. Definitions.

For the purposes of this Part—
“date of the proposal” means the date on which an employee makes a request in accordance with section 83;
“employee” and “enterprise” mean the employee and the enterprise referred to in the definition of “technovation”, and where several enterprises are owned or operated by one person, all those enterprises shall be considered as one enterprise;
“technovation” means a solution to a specific problem in the field of

technology, proposed by an employee of an enterprise in Uganda for use by that enterprise, and which relates to the activities of the enterprise but which, on the date of the proposal, has not been used or actively considered for use by that enterprise; “technovation certificate” means the document issued by the enterprise in accordance with section 84; “technovator” means an employee to whom the enterprise has issued a technovation certificate

82. Right to technovation certificate.

- (1) Subject to subsection (2), an employee of the enterprise on the date of the proposal is entitled to a technovation certificate provided for in this Part.
 - (2) Where the duties of an employee comprise the making and proposing of technovations, he or she is not entitled to a technovation certificate for any technovation which relates to the field of activities for which he or she is employed, unless the degree of the creative contribution inherent in the technovation exceeds that which is normally required of an employee having those duties.
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- (3) Where employees severally request for a technovation certificate for the same technovation, the employee who is the first to make the request is entitled to the certificate.
- (4) Where a request for a technovation certificate is made jointly by two or more employees, the certificate shall be issued in their joint names.

83. Request.

- (1) A request for a technovation certificate signed by the employee shall be filed in writing with the enterprise.
- (2) The enterprise shall assist the employee in filing the request and shall issue

a receipt to him or her acknowledging that a request has been filed and indicating the date on which it is filed.

84. Issue or refusal of technovation certificate.

(1) Where the requirements of this Part are satisfied, the enterprise shall, within a period of three months from the date of the proposal, issue a technovation certificate to the employee.

(2) The enterprise may refuse to issue the certificate if it is of the opinion that the requirements of this Part have not been satisfied and shall notify the employee of the reasons for the refusal within the period prescribed in subsection (1).

85. Use of technovation

(1) Where the enterprise issues a technovation certificate, it shall, at the same time, notify the technovator, in writing whether or not it intends to use the technovation.

(2) Where the decision to use the technovation depends on testing the technovation in practice, the enterprise shall inform the technovator accordingly and may postpone the notification of its intention to use or not to use the technovation by not more one year from the date of the proposal.

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(3) The technovator shall assist the enterprise, to the best of his or her ability in any testing, development or use of the technovation.

(4) The enterprise shall give adequate opportunity to the technovator to furnish the assistance rendered in subsection (3).

(5) Once the technovation certificate has been issued, the technovator shall not communicate his or her technovation to any person other than the enterprise and shall not use it except in collaboration with the enterprise.

(6) Where the enterprise declares that it does not intend to use the technovation or where the enterprise, having declared its intention to use the

technovation, does not start using it within six months from the issue of the technovation certificate or the expiration of the period referred to in subsection (2), the technovator is exempted from the obligations referred to in subsections (3) and (5). (7) Notwithstanding subsection (6) the technovator has the right to communicate his or her technovation to others only to the extent that the communication does not involve the communication of any know-how or other knowledge that has been acquired as an employee.

86. Remuneration of the technovator.

Where the enterprise uses the technovation or communicates it to a third person, the technovator is entitled to a remuneration, the amount and method of payment of which shall, in the absence of an applicable collective bargaining agreement, be fixed by mutual agreement between the technovator and the enterprise.

87. Derogation by contract.

A contractual provision that is less favourable to employees or technovators than the provisions of this Part is void.

88. Disputes

(1) A dispute which concerns the application of this Part shall be submitted by any interested party to an arbitration board consisting of three members: one member appointed by the complainant, the second member appointed by the party complained against, and a chairperson appointed by the two members.

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(2) The arbitration board shall hear interested parties and deliver its ruling.

(3) Where the parties fail to agree on the appointment of the chairperson, the chairperson shall be appointed by the Chief Magistrate's Court which has

jurisdiction in the area where the enterprise is located on the application of any party.

PART XV—SURRENDER, REVOCATION AND INVALIDATION

89. Surrender.

(1) The owner of a patent, utility model or an industrial design registration certificate may surrender it to the registrar.

(2) The surrender may be limited to one or more claims of the patent or utility model, or, in the case of industrial designs, one kind of product or class of products.

(3) The surrender shall immediately be recorded in the register and published by the registrar.

(4) The surrender shall only be effective after it has been published. (5) If a licence is recorded in the register, surrender shall only be registered upon the submission of a declaration by which the licensee consents to the surrender, unless the licence has expressly waived the right to consent in the licence contract.

90. Revocation or invalidation.

(1) An interested person may, in proceedings instituted by him or her against the owner of a patent, or a registered utility model or industrial design or in proceedings instituted against him or her by the owner, request the court to revoke or invalidate the patent, utility model or industrial design registration.

(2) An interested person may, within twelve months from the date of publication of the grant of a patent, utility model or an industrial design, request the court to revoke or invalidate the patent, utility model or industrial design registration.

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(3) The court shall revoke or invalidate the registration of the patent or the utility model or industrial design on any of the following grounds that—

- (a) the owner of the patent is not entitled under sections 17, 18 or 19 to apply for the grant of a patent;
 - (b) the owner of the patent has infringed the rights of the person filing an application for revocation of the patent or of any persons under or through whom he or she claims;
 - (c) the invention does not relate to an art, whether producing a physical effect or not, process, use, machine, manufacture or composition of matter which is capable of being applied in trade or industry;
 - (d) the invention is obvious in that it involves no inventive step having regard to what was common knowledge in the art at the effective date of the application;
 - (e) the invention, in so far as it is claimed in any claim of the application, is not useful;
 - (f) the patent does not fully describe and ascertain the invention and the manner in which it is to be performed;
 - (g) the patent does not disclose the best method of performing the invention known to the owner of the patent at the time when the specification is lodged at the registry;
 - (h) the time the application for the grant of the patent is filed, the application form or any other documents filed under the application contained a material misrepresentation; or
 - (i) the invention is not new in terms of section 10.
- (4) An application for revocation or invalidation of a patent shall—
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- (a) state the ground on which the applicant intends to rely in his or her application for revocation or invalidation of the patent, and
- (b) be accompanied by—
 - (i) a statement setting out particulars of the facts alleged in support of the grounds; and
 - (ii) proof of service on the owner of the patent of notice of filing of the application under sub-section (1) or (2).

- (5) If the owner of the patent wishes to contest the application for revocation of invalidation he or she shall, within the prescribed time or such further time as the court may allow, lodge with the court a counter statement setting out particulars of the grounds upon which the application is to be contested.
- (6) A copy of any counter-statement under subsection (5) lodged with the court shall be served by the owner of the patent concerned on the person making the application for revocation or invalidation of the patent.
- (7) The particulars required under this section may from time to time, with the leave of the court, be amended.
- (8) No evidence shall be admitted in proof of any ground on which particulars have not been delivered under this section, except by leave of the court.
- (9) After receiving an application under subsection (1) and ascertaining compliance with the provisions of this section which are applicable, the court shall arrange for the matter to be heard in the prescribed manner and may make such order as it deems fit.
- (10) The court shall publish the application for revocation or invalidation of the patent in the *Gazette*.
- (11) An aggrieved party may appeal against the decision of the court.
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- (12) Where subsection (2) applies only to some of the claims or some parts of a claim, or some parts of a registered industrial design only those claims or parts may be revoked or invalidated by the court.
- (13) The court may require the owner of the patent, the utility model or the industrial design registration certificate to submit to it for the purposes of examination, the registration certificate, publications and other documents showing the prior art which has been referred to either in connection with an application for a title to the patent, the utility model or the industrial design filed, for the same or essentially the same invention or design by the owner with any other national or regional industrial property office, or in connection with any proceedings relating to the registration of the patent,

utility model or the industrial design or other title or protection granted upon such application.

(14) The notice of the application referred to in subsection (1) shall be served on any licensee under the patent, the utility model or the industrial design and that person is entitled to join in the proceedings in the absence of any provision to the contrary in the licence contract.

(15) Where, before or during the proceedings, it is alleged or it appears to the court that the right to the patent, the utility model or the industrial design belongs to a person who is not a party to the proceedings, notice of the application referred to in subsection (1) shall be served on that person and that person is entitled to join in the proceedings.

91. Effect of revocation or invalidation

(1) A revoked or an invalidated patent, a utility model or an industrial design or claim or part of a claim of a registered industrial design shall be regarded from the date of the grant of the patent or certificate of registration for the utility model or the industrial design to have ceased to have effect.

(2) Where the decision of the court is no longer subject to appeal, the court shall inform the registrar who shall immediately register it and publish it as soon as possible in the *Gazette*.

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PART XVI—INFRINGEMENT

92.3 Acts constituting infringement.

Subject to sections 44, 49, 59, 60 and 68 any act specified in section 38 or 79 and performed by a person other than the owner of the patent or of the registered utility model or industrial design without the owner's authorisation, in relation to a product or a process falling within the scope of a validly granted patent or certificate of registration shall constitute an infringement.

93.3 Relief.

Upon the request of the owner of the patent or the registered utility model or an industrial design, the court shall grant, any of the following reliefs—
(a) an injunction to prevent infringement where infringement is imminent or to prohibit the continuation of the infringement once infringement has started.

- (b) _____ damages; _____ or
(c) any other remedy provided for in law.

94.3 Declaration of non-infringement.

(1) Subject to subsection (2), any person who shows a legitimate interest may request the court to declare that the performance of any specific act does not infringe the patent or the registered utility model or industrial design and the owner and any licensee under the patent or the registered utility model or industrial design shall have the right to be a defendant in the proceedings.

(2) A declaration shall not be made under subsection (1)—
(a) if the acts to which the request relates are already the subject of infringement _____ proceedings; _____ or

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(b) if the person making the request is unable to prove that he or she has previously demanded from the owner a written acknowledgement of the lawfulness of the acts referred to and the owner has refused that demand or has failed to reply within a reasonable time.

95.3 Threat of infringement proceedings.

(1) A person who is threatened with infringement proceedings and who can prove that the acts performed or to be performed by him or her do not constitute infringement of the patent or the registered utility model or an industrial design, may request the court to grant an injunction to prohibit the

threat and to award damages for financial loss resulting from the threat.
(2) The mere notification of the existence of the patent or the registered utility model or registered industrial design shall not constitute a threat of infringement.

96.3 Presumption of use of patented process.

For the purposes of proceedings, in respect of the infringement of the rights of the owner of the patent, where the subject matter of the patent is a process for obtaining a product, the burden of establishing that an identical product was not made by the patented process shall be on the alleged infringer, if either of the following conditions is fulfilled—
(a) the product is new; or
(b) a substantial likelihood exists that the identical product was made by the process and the owner of the patent is unable, through reasonable efforts, to determine the process actually used.

97.3 Powers of court on appeal

(1) Where provision is made under this Act for appeal from a decision of the registrar, the appeal shall be made to the court.

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(2) Upon any appeal to the court under this Act, the court may—
(a) confirm, set aside or vary the order or decision in question; or
(b) exercise any of the powers which could have been exercised by the registrar in the proceedings in connection with which the appeal is brought; and
(c) make such orders as to costs as it may consider fit.

98.3 Suspension of release by customs authorities

(1) A rights owner, who has reasonable grounds for suspecting that the importation of pirated goods may take place, may lodge an application in

writing with the court for the suspension of the release into free circulation of those goods.

(2) A rights owner who initiates the procedure under subsection (1) shall be required to provide adequate evidence to satisfy the court that, there is *prima facie* infringement of the patent, utility model or industrial design and supply a sufficiently detailed description of the goods to make them readily recognisable by the customs authorities.

(3) In this section “rights owner” is the owner of a patent, utility model or industrial design.

99.3 Expert witnesses.

The court may, appoint any person with expert knowledge to assist the court in any case where it appears to the court that such knowledge is required for the proper determination of the case.

100. Legal proceedings by licensee.

(1) Any exclusive licensee within the meaning of section 102(2) may request the owner of the patent or the registered utility model or industrial design to institute legal proceedings for a specific relief with respect to any infringement specified by the licensee.

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Act 3 *Industrial Property Act* 2014

(2) The licensee may, if the owner refuses or fails to institute legal proceedings in subsection (1) notify the registrar, and may after three months from the request or refusal, and after giving notice to the owner, institute the proceedings in his or her own name; and the owner may join in the proceedings.

(3) Before the end of the three-month period referred to in subsection (2), the court may, on the request of the licensee, grant an appropriate injunction to prevent infringement or to prohibit its continuation, where the licensee shows that immediate action is necessary to avoid substantial damage.

PART XVII—SPECIAL PROVISIONS ON ENFORCEMENT OF PATENT RIGHTS

101. Special provisions on enforcement of patent rights.

(1) Subject to sections 38, 59, 60, and 68, the performance of any act referred to in section 38(2) in Uganda by a person other than the owner of the patent and without the agreement of the owner shall constitute an infringement of the patent.

(2) On the request of the owner of the patent, or of an exclusive licensee, or of a compulsory licensee, or of a non-exclusive licensee if he or she has requested the owner to institute court proceedings for a specific relief and the owner has refused or failed to do so within ninety days, the court may grant an injunction to prevent infringement or an imminent infringement and, where the infringer acted knowingly or with reasonable grounds to know, the court may award damages and grant any other remedy provided for in this Act.

(3) The remedies provided to owners of patents in Uganda shall be also available, where appropriate, to the owners of foreign patents that have been the subject of a compulsory licence for the purposes of supplying the market in Uganda of pharmaceutical products, under the scheme established by the Decision of the World Trade Organisation General Council of August 30, 2003, in order to prevent or remedy the unauthorized importation as well as the re-exportation or deviation of the products in question.

Act 3 Industrial Property Act 2014

(4) Where a foreign patent referred to in subsection (3) resulted from applications that were filed in the country where the compulsory licence was granted after the coming into force of this Act or that were entitled to claim priority in Uganda on that same date, only those applications that are filed in Uganda in accordance with section 8(7) shall benefit from the remedies provided for in this section as well as in

the general law on enforcement.

(5) The customs authorities shall have the authority to take border measures for the purposes of this section.

(6) Where the customs authorities take action under subsection (5), they shall notify the rights owner of the suspension of release and the rights owner shall have ten days for providing adequate evidence that the retained products prima facie correspond to the claims of the patent in question.

(7) Without prejudice to the subsection (3), the same border measures that are available for the suspension by the customs authorities of the release into free circulation of counterfeit trademark and pirated copyright goods shall also apply to prevent the unauthorized importation or re-exportation of the products that have actually been imported into the territory of Uganda under the scheme referred to in subsection (3).

(8) This section shall not apply to re-exportation of pharmaceutical products to other Members of the Common Market of Eastern and Southern Africa (COMESA).

(9) Provisional measures aimed at preserving relevant evidence shall also be available before the granting of the pending patent application, where the court deems necessary.

(10) The applicant shall initiate proceedings in court within twenty working days or thirty one calendar days, whichever is the longer, from the publication of the grant of the pending registration.

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(11) For the purposes of subsection (9), the courts may refuse to grant provisional or definitive injunctions, without prejudice to the payment of damages, where—

(a) after the expiration of four years from the date of filing of the patent application or three years from the date of the grant of the patent, the plaintiff or a person with his authorization is not, or has not taken serious preparations for, or has no serious intention to start, commercially exploiting the invention in a manner that meets the demands of the market as to quantity, or at any

time if the invention is exploited in a manner that does not meet the demands of the market as to quality;

(b) the injunction causes serious harm to the public interest;

(c) the patented products or the products manufactured by a patented process are sold by the plaintiff or by a third party with the plaintiff's consent at prices that are deemed excessive taking into account the average purchasing power of consumers and the specific nature of the needs the products aim at meeting, and there is no competing product on the market;

(d) the plaintiff has engaged in inequitable conduct, according to section 8(3);

(e) the patent was obtained in contravention of sections 21(6) and 21(7).

(12) At any time after ensuring compliance with sections 21(6) and 21(7) of this Act, the patent holder may initiate proceedings on grounds of infringement, under this section.

(13) A remedy, shall not be available to the patent holder in respect of any acts done by third parties before the patent holder has ensured compliance with sections 21(6) and 21(7).

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Act 3 Industrial Property Act 2014

(14) Where the act of infringement is practised by the government or for the purposes of serving the government the court shall not issue an injunction other than for obtaining evidence in control of the infringer, if necessary, without prejudice to the accounting of damages.

(15) The rights accruing from patents for pharmaceutical processes shall not be enforceable until January 1, 2016, or such other period as may be granted to Uganda or least developed countries by the council responsible for administering the agreement on trade related aspects of intellectual property under the World Trade Organisation if alternative processes for making pharmaceutical products that are not subject to exclusive rights are not available and those patents, if enforced, indirectly give rise to market exclusivity of the pharmaceutical products in question.

- (16) The court may order the infringer to pay damages relating to acts of infringement of patent rights practised—
- (a) after the date on which the patent application was opened for public inspection, in accordance with section 29; or
 - (b) after the date on which the patent applicant gave notice to the alleged infringer of the contents of the application; or
 - (c) after the date on which the alleged infringer acquired knowledge of the contents of the application by any means.
- (17) The request for the court to order the payment of damages under subsection (2) may be filed only after the title of industrial property right in question is granted.
- (18) Subsection (17) shall apply to those applications to which section 8(3)(f) refers only after January 1, 2016 or such other period as may be granted to Uganda or least developed countries by the council responsible for administering the agreement on trade related aspects of intellectual property under the World Trade Organisation.
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Act 3 Industrial Property Act 2014

- (19) For the purposes of civil proceedings in respect of the infringement of rights of the patent owner, if the subject matter of a patent is a process for obtaining a product, the court may order the defendant to prove that the process used to obtain an identical product is different from the patented process.
- (20) Any identical product when produced without the consent of the patent owner shall, in the absence of proof to the contrary, be deemed to have been obtained by the patented process in the following circumstances—
- (a) if the product obtained by the patented process is new; or
 - (b) if there is a substantial likelihood that the identical product was made by the process and the owner of the patent has been unable through reasonable efforts to determine the process actually used.
- (21) In the adduction of proof to the contrary, the legitimate interests of defendants in protecting their manufacturing and business secrets shall be

taken into account by the court, which, among other measures, shall not facilitate those secrets to the plaintiff.

PART XVIII—MISCELLANEOUS

102. Public notices.

Whenever any matter is required to be published under this Act, it shall be published in the *Gazette*, and also as soon as practicable, be published in a newspaper of wide circulation in the relevant area.

103. Regulations.

(1) The Minister may make regulations prescribing anything which under this Act is required or authorized to be prescribed, and generally for the better carrying out of the objects and purposes of this Act.

Act 3 Industrial Property Act 2014

(2) Regulations made under subsection (1) may prescribe in respect of a contravention of any of the regulations a penalty of a fine not exceeding forty eight currency points or imprisonment not exceeding two years of both.

(3) The regulations may also prescribe additional penalties in respect of continuing offences and also a requirement that anything used in the contravention shall be forfeited to the state by the court.

104. Corrections of errors and extension of time.

(1) The registrar may, subject to any provision in the regulations, correct any error of translation or transcription, clerical error or mistake in any application or document filed with the registry or in any recording effected under this Act or under the regulations.

(2) Substantive errors, may only be modified by the court, under due process.

(3) For the purposes of this section substantive errors are those that, if modified, will affect the rights conferred.

(4) Unless otherwise provided in this Act, if the registrar is satisfied that the

circumstances justify it, he or she on receiving a written request, may extend the time for doing any act or taking any proceeding under this Act and the regulations, upon notice to the parties concerned and upon such terms as he or she may direct.

(5) The extension may be granted even where the time for doing the act or taking the proceeding has expired.

105. Exercise of discretionary powers.

The registrar shall give any party to a proceeding before an opportunity of being heard before exercising adversely to that party any discretionary power vested in him or her by this Act or the regulations.

106. Power of Minister to amend Schedule.

The Minister may with the approval of Cabinet by statutory instrument, amend the Schedule.

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107. Exemption from stamp duty.

No duty shall be chargeable under the Stamps Act in respect of any instrument executed by, or on behalf of, or in favour of the registrar which, but for this section, the registrar would be liable to pay.

108. Consequential amendment of Cap. 210.

The Uganda Registration Services Bureau Act is amended in item 11 of the First Schedule, by substituting for the reference to the Patent Act the words “Industrial Property Act, 2009”.

109. Repeal of Cap. 216 and Cap. 218, transitional and savings provisions.

(1) The Patents Act and the United Kingdom Designs Protection Act are repealed.

(2) Where a patent was registered in Uganda under the former patent Act or where it was saved under that Act and the privileges and rights conferred by the registration were effective immediately before the commencement of this Act, then, subject to this section—

- (a) the patent shall be treated in Uganda as if it had been granted under this Act;
- (b) the patent shall expire as regards Uganda when those privileges and rights could have expired if this Act had not been enacted;
- (c) the patent may be revoked or invalidated only where those privileges and rights could be declared as not having been acquired in Uganda if this Act had not been enacted;
- (d) the certificate of registration, or a certified copy of the patent, shall be admissible as prima facie evidence of the date and the fact of registration; and

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(e) an action for infringement of the patent shall lie under this Act only if the alleged infringement occurred on or after the commencement of this Act, and in any other case may be referred to the Industrial Property office and disposed of as if this Act had not been enacted.

(3) So far as is necessary for the purposes of subsection (2), the register of patents under the former Patents Act shall continue to be maintained and shall be taken to be part of the register under this Act.

(4) Section 53 of this Act shall not apply to licence contracts and contracts assigning the right to patent or assigning applications or patents, if the contract is concluded before the commencement of this Act and is submitted for registration to the registrar within sixty days from the commencement of this Act.

(5) Where the registered proprietor of any design registered in the United Kingdom enjoyed privileges and rights in Uganda under the former United Kingdom Designs (Protection) Act immediately before the commencement of this Act, those privileges shall continue until they cease to exist under the United Kingdom Act subject to regulations made by the Minister under

section 104 of this Act.

(6) All the funds, assets and other property, movable and immovable, which immediately before the commencement of this Act, were held by the Government on behalf of the former office shall, by virtue of this section and without further assurance, vest in the Government on behalf of the registrar.

(7) Every public officer having the power or duty to effect or amend any entry in the register relating to property, or to issue or amend any certificate or other document effecting or evidencing title to property, shall, without payment of any fee or other charge and upon request by or on behalf of the registrar do all such things as are by law necessary to give final effect to the transfer of any property mentioned in subsection (6) to the registrar.

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Act 3 Industrial Property Act 2014

(8) All rights, powers, liabilities and duties, whether arising under any written law or otherwise, which immediately before the coming into operation of this Act were vested in, imposed on or enforceable by or against the Government in respect of the former office shall by virtue of this subsection, be transferred to, vested in, imposed on, or be enforceable by or against the registrar.

(9) On and after the commencement of this Act, all action, suits or legal proceedings, by or against the government pending in respect of the former office shall be carried on or prosecuted by or against the registrar and no such suit, action or legal proceedings shall abate or be affected by the coming into operation of this Act.

(10) In this section—“former Patents Act” means as the Patents Act (Cap. 216) repealed by this Act; “former United Kingdom Designs (Protection) Act” means the United Kingdom Designs (Protection) Act (Cap. 218) repealed by this Act.

SCHEDULE

Currency point

One cunency point is cquivalmt to twenty thousand shillings.

2014

Act3 Industrial Property Act 2014

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Stamps Act, Cap. 342.

The National Environment Act, Cap. 153.

Uganda Registration Services Burean Act, Cap. 210.

Uganda National Conncil for Science and Technology Act, Cap. 209.

Long title:

An Act to provide for the promotion of inventive and innovative activities, to facilitate the acquisition of technology through the grant and regulation of patents, utility models, industrial designs and technovations and to provide for the designation of a registrar, to provide for the functions of the registrar, and the establishment of a register of industrial property rights and for related matters.

Isaac Christophher Lubogo

STATUTORY INSTRUMENTS

SUPPLEMENT No. 5 10th February, 2017

STATUTORY INSTRUMENTS SUPPLEMENT

To the Uganda Gazette No. 9, Volume CX, dated 10th February, 2017

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STATUTORY INSTRUMENTS

2017 No. 12.

THE INDUSTRIAL PROPERTY REGULATIONS, 2017.

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STATUTORY INSTRUMENTS

2017 No. 12.

The Industrial Property Regulations, 2017.

(Under section 103 of the Industrial Property, Act, 2014, Act No. 3 of 2014)

IN EXERCISE of the powers conferred upon the Minister responsible for justice by section 103 of the Industrial Property Act, 2014, these Regulations are made this 10th day of March, 2015.

PART I—PRELIMINARY

1. Title.

These Regulations may be cited as the Industrial Property Regulations, 2017.

2. Interpretation.

In these Regulations, unless the context otherwise requires— “Act” means the Industrial Property Act, 2014;

“Bureau” means the Uganda Registration Services Bureau established by the Uganda Registration Services Bureau Act;

“court” means the High Court of Uganda;

“industrial property rights” mean rights under patents, certificates of utility models and technovation and registration of industrial designs issued under this Act;

“Journal” means the Industrial Property Journal; “register” means the register of industrial property.

3. Non application to pharmaceutical products.

(1) These Regulations shall not apply to pharmaceutical products.

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(2) For the avoidance of doubt, the registrar shall not accept an application to register a patent, utility model, industrial design or technovation relating to pharmaceutical products, micro-biological products and processes for producing pharmaceutical products, until 1st January 2016, or such other period as may be granted to Uganda or least developed countries by the council responsible for administering the agreement on trade related aspects of intellectual property under the World Trade Organization.

PART II—REGISTER OF INDUSTRIAL PROPERTY

4. Register of industrial property.

(1) For the purposes of section 5 of the Act, the registrar may, in the register of industrial property applications and the register for industrial property rights, separate applications or grants relating to—

(a) patents;

(b) utility models;

(c) industrial designs; and

(d) technovations.

(2) The register for industrial property applications shall contain— (a) the application number and the filing date of the application;

- (b) the name and address of the applicant; (c) the title of the invention;
- (d) the industrial property right claimed by the applicant;
- (e) the name and address of the inventor unless the inventor has indicated that they wish not to be named in the application under section 20 of the Act;
- (f) where priority is claimed, the priority date and the name of the country in which or for which the earlier application was filed;
- (g) the date of the request for an examination submitted under section 31(2) of the Act;

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- (h) the date of publication of the application; (i) the address for service of the applicant;
- (j) if the applicant dies, a notice of that fact; and
- (k) any other information required under the Act or these Regulations or that the registrar considers appropriate.

(3) The register for industrial property rights granted under the Act shall contain—

- (a) the number of the industrial property right granted;
- (b) the name and address of the owner of the industrial property right;
- (c) the date of the grant of the industrial property right; (d) any conditions attached to the grant;
- (e) the address for service of the owner of the industrial property right;
- (f) any change in ownership of the industrial property right;
- (g) any information relating to lapse of the industrial property right;

(h) information relating to revocation or invalidation of industrial property rights; and

(i) any other information required under the Act or these

Regulations or that the registrar considers appropriate.

(4) A person who wishes to obtain an extract from the industrial property register shall make a request in Form 1.

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PART III—THE INDUSTRIAL PROPERTY JOURNAL

5. The Industrial Property Journal.

(1) The registrar shall publish a journal known as “The Industrial Property Journal”.

(2) The Journal shall contain reports of cases relating to industrial property rights whether in Uganda or elsewhere and any other information relating to industrial property or contained in the register of industrial property that the registrar considers necessary.

(3) The Journal shall be published monthly or at such other time as the registrar may direct.

(4) The registrar may offer the Journal to the public at a fee determined by the Bureau.

PART IV—PATENTS

Application, grant and refusal of patent

6. Application for a patent.

(1) An application for a patent shall be made to the registrar in

Form 2 in the Schedule.

(2) Every application shall be accompanied by the prescribed fee. (3) The description of the invention under section 21(1)(b) of the

Act shall—

(a) specify the technical field to which the invention relates;

(b) indicate the background art which, as far as it is known to the applicant, can be regarded as useful for the understanding, searching and examination of the invention and cite the documents reflecting such art; and

(c) indicate how the invention is industrially applicable.

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7. Claims.

(1) The claim shall set out the technical features that are necessary to define the subject matter of the invention that are part of the prior art.

(2) A technical feature set out in a claim shall not rely on a reference to the description or drawings but a reference to a feature may be included if the intelligibility of the claim may be increased by doing so.

(3) A claim shall not include a drawing but may include chemical or mathematical formulae.

(4) Subject to subregulation (5) an application shall not include more than one claim.

(5) An application may include two or more independent claims if each independent claim relates to a single product or a single process.

(6) Where more than one claim is included in the application, the claims shall be numbered consecutively

(7) An application may include a claim stating the essential technical features of an invention with one or more following claims setting out particular embodiments of the invention.

(8) The following apply to claims described in subregulation (7)— (a) the claims setting out particular embodiments of the invention

shall include a reference to the claim stating the essential technical features of the invention;

(b) the claims setting out particular embodiments of the invention shall state the features that it is desired that those claims protect; and

(c) the claims shall be grouped together to the extent possible and in the most appropriate way.

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(9) Where an application contains more than ten claims, the applicant shall pay for each claim beyond the ten as if it is contained in a separate application.

8. Drawings.

The drawings shall comply with the following—

- (a) the lines of the drawings shall be black, durable, uniformly thick and well-defined;
- (b) the drawings, including their scale and the distinctness of their lines, shall be such that all details can be distinguished without difficulty when the drawings are reproduced photographically at two thirds their actual size;
- (c) where the scale is given on a drawing, it shall be given graphically;
- (d) cross sections shall be indicated by hatching that does not impede the clear reading of the reference signs and reading lines;
- (e) where the drawings show a feature mentioned in the description, that feature shall be denoted in the drawings by a reference sign and that reference sign shall be used throughout the application to denote that feature.

9. Abstract.

- (1) The title shall indicate the title of the invention.
- (2) The abstract shall include a summary of the disclosure included in the description under section 21(5) of the Act.
- (3) The abstract shall not include statements about the merits or value of the invention or about uses that are speculative.
- (4) Where applicable, the abstract shall include the formula that best characterizes the invention.

(5) The abstract shall not include a drawing, but if the application includes drawings—

(a) the applicant shall indicate which drawing the applicant suggests should accompany the publication of the abstract; and

(b) a feature referred to in the abstract shall, if the feature is illustrated in a drawing, be followed, in the abstract, by the reference sign used in the drawing.

(6) Unless it is impractical, the abstract shall not contain more than one hundred and fifty words.

10. General requirements for applications for a patent.

(1) All parts of the application must be prepared so that they are legible when they are photocopied or otherwise reproduced.

(2) Notwithstanding subregulation (1), graphic symbols and characters, and chemical and mathematical formulae may be hand-written but must be dark and indelible.

(3) All terms, signs and symbols used in the application shall be used consistently throughout the application and shall be the terms, signs and symbols generally accepted in the relevant field.

(4) Where anything is expressed in units other than metric units the equivalent in metric units shall also be given.

(5) Every application shall be accompanied by a statement disclosing any foreign applications and their status, if any, relating to the same invention by the applicant.

11. Notice of information prejudicial to security of Uganda.

The notice under section 14(1) of the Act by the registrar to the concerned Minister relating to information which is prejudicial to the security of Uganda or safety of the public contained in an application shall be in Form 3.

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12. Directions prohibiting publication of information prejudicial to security of Uganda.

The direction by the registrar prohibiting or restricting the publication of information which is prejudicial to the security of Uganda or safety of the public contained in an application shall be in Form 4.

13. Request for authority to file application abroad.

(1) A request under section 15(1) of the Act for authority to file an application outside Uganda shall be made to the registrar in Form 5.

(2) The authority of the registrar to file an application outside Uganda shall be in Form 6.

14. Unity of inventions.

(1) For the purposes of section 22 of the Act, a group of inventions forms a single general inventive concept if there exists between or among those inventions a technical relationship that involves one or more of the same or corresponding special technical features.

(2) Where the registrar requests an applicant to restrict or divide the application in order to comply with the unity of invention requirements under section 22 of the Act, the request shall indicate that the applicant may restrict or divide the application within sixty days after the date of the request by the registrar.

(3) For the purposes of this regulation, “special technical features” means those technical features that define a contribution that each of the claimed inventions, considered as a whole, makes over the prior art.

15. Amendment and division of application.

(1) An application to amend an application submitted to the registrar shall be in Form 7.

(2) An application shall not be amended more than twice.

(3) The registrar may reject an amendment if the result of the amendment is that the specification would claim or disclose a matter that extends beyond that disclosed in the complete filed specification.

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(4) Where an application is divided under section 23(2) of the

Act—

- (a) the filing date for each divisional application shall be the filing date of the initial application;
- (b) any declaration of priority in the initial application shall be deemed to be included in each divisional application; and
- (c) the applicant shall pay the application fee and any other fees payable in respect of the additional applications resulting from the division.

16. Declaration claiming priority.

- (1) The declaration claiming priority under section 24 of the Act shall include, in respect of each earlier application—
 - (a) the date and number of the earlier application;
 - (b) the symbol of the international patent classification that was assigned to the earlier application or, if no such symbol has been assigned, a statement of that fact;
 - (c) if the earlier application was a national application, the name of the state in which it was filed; and
 - (d) if the earlier application was a regional or international application, the name of the office in which it was filed and the name of the state for which it was filed.
- (2) Where the number of the earlier application, as required under subregulation (1)(a), is not known at the time of making the declaration, the declaration shall include a statement of that fact and the declaration shall be

amended to include the number within ninety days after the application containing the declaration is made.

(3) A certified copy of the earlier application required by the registrar under section 24(4) of the Act shall be furnished within ninety days after the requirement was made.

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(4) Where it is discovered that the date given to the earlier application was incorrect, the following apply—

(a) the registrar shall invite the applicant to provide the correct date; and

(b) the registrar shall disregard the claim for priority unless the applicant provides the correct date within ninety days after the date of the invitation to provide the correct date and that correct date is within the period of priority provided under the Paris Convention.

17. Waiver of fees.

(1) An application to the registrar to waive fees payable under the Act or regulations made under the Act shall be in Form 8.

(2) The payment of any fees for which a waiver is sought shall be deferred pending the decision by the registrar.

(3) The registrar shall communicate the decision to the applicant within fifteen days.

(4) Any deferred fees that have not been waived by the registrar shall be paid within sixty days after the date of that communication.

18. Withdrawal of application.

(1) A withdrawal of an application under section 27 of the Act shall be in Form 9.

(2) Where there is more than one applicant, the application may only be withdrawn with the consent of all the applicants.

19. Filing date and examination of the form of an application.

(1) An invitation by the registrar to furnish missing drawings or make corrections under section 28 (2) or (3) of the Act shall be made within fourteen days after the invitation is made.

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(2) The registrar shall give the applicant sixty days from the date of the invitation to furnish the missing drawings or correct the application.

(3) Where the registrar determines that the applicant has not complied with an invitation referred to in section 28(2) or (3) of the Act and, treats the application as if it had not been filed under section 28(3) of the Act, the registrar shall, within fourteen days after his determination, inform the applicant of the registrar's decision.

(4) An applicant shall be entitled to only one correction of the application unless the registrar directs otherwise.

20. Filing date.

Where the registrar invites the applicant to furnish missing drawing or file corrections, the filing date of the application shall be the date of receipt of the missing drawings or corrections.

21. Confidentiality of application before publication.

(1) The registrar shall keep information about a patent application confidential until the application is published.

(2) This regulation does not apply to— (a) the application number;

(b) the name of the applicant;

(c) the filing date of the application;

(d) if priority is claimed, the priority date and the name of the state in which or for which the earlier application was filed and the number of the earlier application; and

(e) the title of the invention.

22. Publication of application.

The registrar shall publish the following particulars in respect of each application for a patent—

- (a) the application number;
- (b) the name and address of the applicant;
- (c) the name and address of the inventor unless he or she has indicated that he wishes not to be named in the application under section 20 of the Act;
- (d) the name and address of the agent, if any; (e) the filing date of the application;
- (f) if priority is claimed, the priority date and the name of the state in which or for which the earlier application was filed;
- (g) the symbol of the international patent classification; (h) the title of the invention;
- (i) the abstract;
- (j) if applicable the international non-proprietary name of the product;

23. International type search.

- (1) Within thirty days after receiving a report on an international type search, the registrar shall send a copy of the report to the applicant.
- (2) The time limit, referred to in section 30(3) of the Act, for the applicant to furnish a requested copy of a document, is ninety days after the date of the request.
- (3) Where applicant does not furnish a copy of the document cited in the report, the applicant shall inform the registrar within ninety days from the date of the request to furnish a copy of the document.

(4) Where the registrar rejects an application under section 30(2), (3), (4) or (5) of the Act, the registrar shall, within thirty days after doing so, notify the applicant of the rejection.

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(5) The time limit for appealing a decision by which the registrar rejects an application under section 30(2), (3), (4) or (5) of the Act is ninety days after the date of the notice of the rejection.

24. Examination as to substance.

(1) A request for an application to be examined under section 31(2) of the Act shall be in Form 10.

(2) Where an application is on the existing patent the examination shall take into account the existing patent and consider whether there are substantial improvements between the claim in the application and the patent.

(3) Where the registrar submits the application for examination under section 31(4) of the Act, the registrar shall also submit—

(a) the report of any search, within thirty days after the report is submitted to the registrar;

(b) if priority is claimed, foreign documents relating to the invention;

(c) an explanation as to whether the invention is patentable or not;

and

(d) any other document the registrar considers relevant.

25. Notification of refusal to grant patent.

(1) The notification by the registrar of a refusal to grant a patent shall be made within fifteen days after the decision to refuse the application is made.

(2) The notification shall be in Form 11 in Schedule.

26. Notification of grant of patent.

(1) The notification by the registrar of a grant of a patent shall be made within fifteen days after the decision is made.

(2) The notification shall be in Form 11 in Schedule.

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27. Grant of patent.

(1) Upon notification of the grant of a patent, the applicant shall pay the fees for the grant of a patent.

(2) Upon payment of the fees, the registrar shall issue to the applicant the patent in Form 12 in Schedule.

28. Publication of grant of patent.

Within thirty days after issuing the patent, the registrar shall publish the following particulars in respect of the patent—

- (a) the number of the patent;
- (b) the name and address of the owner of the patent;
- (c) the name and address of the inventor unless he or she has indicated that he wishes not to be named in the application under section 20 of the Act;
- (d) the name and address of the agent, if any; (e) the filing date of the application;
- (f) if priority was claimed and accepted, a statement of the priority, the priority date and the name of the state in which or for which the earlier application was filed;
- (g) the date of the grant of the patent;
- (h) the symbol of the international patent classification; (i) the title of the invention;
- (j) the abstract.

International applications

29. Filing requirements for international or regional application.

All international applications shall be—

- (a) in triplicate;
- (b) in English; and
- (c) accompanied by the prescribed fees for transmitting the application.

30. Entry of international application to national phase.

(1) An international application in which Uganda is designated shall, on request, be treated as an application under the Act if the conditions set out in Article 22 or 39 of the Patent Co-operation Treaty and the applicable rules under that Treaty are satisfied.

(2) A request under subregulation (1) shall be in Form 13.

31. Conversion of refused international application.

(1) An international application in which Uganda is designated shall, on request, be treated as an application under the Act if a refusal, declaration or finding described in Article 25 of the Patent Co-operation Treaty was made and the refusal, declaration or finding was the result of an error or omission on the part of the receiving Office or the International Bureau.

(2) A request under subregulation (1) shall be in Form 14 and shall be accompanied by a statement of the facts upon which the applicant relies.

(3) The date of filing, for the purposes of the treatment of an international application as a national application, shall be the date of filing of the international application under the Patent Co-operation Treaty.

32. Conversion of refused regional application.

(1) A regional application in which Uganda is designated and that has been refused by the Secretariat of ARIPO shall, on request, be treated as an application under the Act if the Secretariat of ARIPO transmits to the registrar—

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(a) a request made by the applicant to the Secretariat of ARIPO that the application be treated, in Uganda, as an application under the Act; and

(b) a copy of the files relating to the application.

(2) A request to have a regional application treated as an application under the Act shall be in Form 15.

(3) The date of filing, for the purposes of the treatment of a regional application as a national application, shall be the date of filing of the regional application under the Harare Protocol.

33. Publication of certain international applications.

(1) The registrar shall publish—

(a) an international application in which Uganda is designated within sixty days after the application enters the national phase; and

(b) a regional application in which Uganda is designated within thirty days after Uganda is notified of being designated in the regional application under the Harare Protocol.

(2) The publication of an application under subregulation (1) shall be in the Gazette.

Rights and obligations of the applicant or the owner of the invention

34. Parallel importation.

The limitation on the rights under a patent in section 43(2) of the Act applies to acts in respect of articles that are imported from a country where the articles were legitimately put on the market.

35. Annual fees.

(1) The annual fees shall be payable after one year from the date of filing of the application for the patent.

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(2) At least one month before a fee is due, the registrar shall send a reminder that the fee is due to the applicant or the owner of the patent.

(3) A fee paid after it is due but within the grace period granted under section 47(2) of the Act shall be paid by submitting it along with the prescribed surcharge.

(4) For an international application, the only annual fees that are payable are those due from the priority date.

36. Lapse of patent for nonpayment of annual fees.

(1) Where, under section 47(3) of the Act, an application is taken to have been withdrawn or patent lapses, the registrar may send a notification to the persons specified in subregulation (2), within thirty days after the application is deemed to have been withdrawn or the patent lapses.

(2) A notification under subregulation (1) shall be sent to the following persons—

- (a) the applicant or owner of the patent; and
- (b) every registered licensee.

37. Restoration of application or patent.

(1) The following shall apply with respect to a request under section 47(6) of the Act to restore an application or patent—

- (a) the request shall be in Form 16 and shall be accompanied by a statutory declaration or affidavit supporting the statements made in the request;
- (b) if after considering the request, the registrar is not satisfied that the failure to pay the annual fee was not intended, the registrar shall notify the person who made the request;

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(c) the person notified under subparagraph (c) may request a hearing with the registrar within sixty days after the date of the notification and, if the person does so, the registrar shall hear the person before finally deciding whether or not the registrar is satisfied, under section 47(6) of the Act, that the failure to pay the annual fee was not intended; and

(d) if the registrar makes an order restoring the application or patent—

(i) subregulation (3) applies with respect to the payment of the annual fee under section 47(6) of the Act; and

(ii) the registrar shall advertise the restoration of the application or patent in the Gazette.

(2) Where an application or patent has lapsed and the time for making a request under section 47(6) of the Act to restore the application or patent has expired without a request being made or a request was made but was denied, the registrar shall, within forty-five days after the time expired or the request was denied, notify the applicant or owner of the lapse and draw their attention to the provisions of section 47(3) of the Act.

Change in ownership

38. Change in ownership of application or patent.

(1) An application to have a change of ownership of a patent recorded in the register shall be in Form 17.

(2) An application to have a change of ownership recorded may be made by the former owner or the new owner.

(3) The application shall be accompanied by the following— (a) the instrument effecting the change in ownership; or

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(b) a certificate issued by the Bureau of the change in ownership. (4) Upon registration of change of ownership the registrar shall—

(a) issue a certificate of the registration of a change in ownership, in Form 18, to the new owner; and

(b) publish, in the Gazette, the following information—

(i) the date of the application to have the change of ownership recorded;

(ii) the name of the former owner; (iii) the name of the new owner; and

(iv) the registration number and date of registration of the change in ownership.

(5) The registrar shall ensure that the instrument described in subregulation (3)(a), and its contents, is kept confidential except to the extent that the new owner agrees otherwise.

(6) If the ownership of an application is changed, the new owner shall be taken to be the applicant.

Contractual licences

39. Petition to register licence contracts.

(1) A petition under section 54(2) shall be in Form 20.

(2) The following are prescribed as documents that shall accompany the petition under section 54(2) of the Act—

(a) the documents constituting the contract; and

(b) any documents relating to the contract that are necessary to understand or interpret the contract.

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40. Registration of contracts.

(1) The certificate of registration under section 56(1) of the Act shall be in Form 21.

(2) In addition to the information required under section 56(5) of the Act, the following shall be set out in the register in relation to a patent—

(a) the addresses of the persons referred to in section 56(5)(a) of the Act;

(b) the date the registration takes effect; (c) the duration of the contract; and

(d) if the contract was submitted for registration by an agent, the name and address of the agent.

(3) The additional information set out in subregulation (2) shall be published along with the information that is required to be published under section 56(5) of the Act.

(4) The information required to be published under section 56(5) of the Act shall be published by the registrar.

(5) The registrar shall not register a contract that does not comply with Part X of the Act or these Regulations.

41. Licences as of right.

(1) A request under section 65(1) of the Act to have an entry made shall be in Form 22.

(2) The request shall be accompanied by an undertaking of the owner to grant licences under section 65 of the Act.

(3) Where the registrar notifies a licensee of the request under section 65(2) of the Act the notification shall state the rights of the licensee to object under section 65(3) of the Act.

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(4) An objection shall be made within forty five days after the date of the registrar's notification to the licensee of the request.

(5) A licensee may object under section 65(3) of the Act by giving a notice of opposition in Form 23 in duplicate to the registrar.

(6) Regulation 48 shall apply, with necessary modifications, with respect to an objection under section 65(3) of the Act.

(7) The publication of an entry under section 65(4) of the Act shall be in the Gazette.

(8) A request under section 65(7) of the Act to cancel an entry shall be in Form 24.

(9) The publication of a cancellation under section 65(7) of the Act shall be in the Gazette.

Exploitation by Government

42. Exploitation by Government.

(1) An application to the Minister for an order under section 66(1) of the Act shall be in Form 25.

(2) A request under section 66(12) of the Act to have an order revoked shall be in writing.

(3) The minister shall before revoking an order under section 66(12) of the Act consult the relevant ministry or department or Agency.

(4) For purposes of section 66 (7) of the Act the Minister shall cause the contents of the order to be communicated to the owner of the patent with two weeks.

PART V—UTILITY MODELS

43. Application of Regulations to utility models.

(1) Subject to subregulation (2), the regulations on patents shall apply, with necessary modifications, to utility model certificate or applications for them, as the case may be.

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(2) Regulations 21, 22, 23(3) and (4) and 24 to 31 do not apply with respect to utility model certificates.

(3) A utility model certificate shall be in Form 26.

PART VI—INDUSTRIAL DESIGNS

44. Register of industrial designs.

(1) The registrar shall record the following in the register of industrial property—

(a) the registration number of the industrial design;

(b) the name and address of the owner of the industrial design; (c) the title of the industrial design;

(d) any disclaimer by the applicant limiting the rights conferred by registration; and

(e) any other information required under the Act or these

Regulations or that the registrar considers appropriate.

(2) A person who wishes to obtain an extract from the register in relation to industrial designs shall make a request in Form 27 for a certified copy.

45. Copyrighted designs not registerable.

An industrial design is not registerable if it is protected under the Copyright and Neighbouring Rights Act, 2006.

46. Application to register industrial design.

(1) This Regulation applies with respect to an application to register an industrial design under section 74 of the Act.

(2) The application under section 74(1)(a) of the Act shall be in Form 28.

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(3) There shall be a separate application for each industrial design. (4) The application shall be accompanied by—

(a) an additional copy of the representations required under section 74(1)(c) of the Act; and

(b) a second specimen in addition to the specimen required under section 74(2) of the Act.

(5) The following apply with respect to the representations required under section 74(1)(c) of the Act—

(a) if the application is for a set of articles the representations shall include representations of each article in the set embodying the industrial design;

(b) figures used in the representations shall be in an upright position, unless the registrar is satisfied that it is impractical to do so;

(c) if more than one figure is used to represent an article, all the figures representing the same article shall, unless it is impractical to do so, appear on the same page and shall be labelled to indicate the view they represent;

(d) if the representations are drawings they shall be in ink;

(e) if the industrial design consists of a repeating surface pattern, the representation shall show all of the pattern that is repeated;

(f) only one side of each page of the representations shall be used;

and

(g) the name of the applicant.

(6) A statement describing the features of the design which it is claimed are new shall be included on—

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(a) the representations required under section 74(1)(c) of the Act;

and

(b) the specimen required under section 74(2) of the Act.

(7) Where the design includes a reproduction of anything registered under the law or any registered emblem, the application shall be accompanied by the consent to the registration of the reproduction of the arms or emblem from such person as appears to the registrar to be entitled to give such consent.

(8) The following apply if the design includes the name or portrait of a person —

(a) if the person is living, the application shall be accompanied by the consent of the person to the registration; or

(b) if the person is dead, the registrar may require the application to be accompanied by the consent of such person as the registrar considers appropriate.

(9) Regulations 15 and 17, (2) and (3) apply, with necessary modifications, with respect to the application under sections 74(7), 23,

24 and 28(2) and (3) of the Act.

47. Publication of application.

The registrar shall publish a notice of an application to register an industrial design in the Gazette.

48. Procedure if opposition to application.

(1) Within ninety days after the notice of the application is published a person may oppose the application by giving a notice of opposition in Form 29 in duplicate to the registrar.

(2) The notice of opposition shall set out the grounds for opposing the application.

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(3) The registrar shall give one copy of the notice of opposition to the applicant.

(4) Within thirty days after receiving the notice of opposition, the applicant shall give a counter-statement in Form 30 in duplicate to the registrar.

(5) The counter-statement shall set out the grounds the applicant relies upon to support the application and shall set out any facts alleged in the notice of opposition that the applicant admits.

(6) The registrar shall give one copy of the counter-statement to the person opposing the application.

(7) Within fifteen days after receiving the counter-statement, the person opposing the application shall give to the registrar and to the applicant a statutory declaration or affidavit supporting the opposition to the application.

(8) Within fifteen days after receiving the statutory declaration or affidavit of the person opposing the application, the applicant shall give to the registrar and to the person opposing the application a statutory declaration or affidavit supporting the application.

(9) If the applicant fails to provide a counter-statement under subregulation (4) or a statutory declaration or affidavit under subregulation (8), the application shall be taken to have been withdrawn.

(10) Where the person opposing the application fails to provide a statutory declaration or affidavit under subregulation (7), the opposition to the application shall be taken to have been withdrawn.

(11) After all documents have been provided the registrar shall conduct a hearing of the matter.

(12) The registrar shall give at least 14 days' notice of the hearing to each party.

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(13) A party may be heard at the hearing only if the party provides the registrar with a notice in Form 31 at least seven days before the date of the hearing.

(14) At the hearing no evidence other than the evidence provided by statutory declaration or affidavit may be introduced without the leave of the registrar.

(15) The registrar shall give each party a written notice of the decision together with written reasons within thirty days from the date of hearing.

(16) If there is more than one person opposing the application, the registrar may provide for the objections to be dealt with at the same hearing.

49. Procedure where registrar rejects application and where there is no opposition to application.

(1) Where the registrar proposes to reject the application, the registrar shall send a written notice to the applicant explaining the reasons for proposing to refuse to register the industrial design and inviting the applicant to do one of the following within sixty days after the date of the invitation—

(a) submit written submissions; or

(b) request a hearing.

(2) Where the registrar has sent a notice under subregulation (2), the registrar shall not make his or her decision as to whether or not to register the industrial design until—

(a) if the applicant requests a hearing, after holding the hearing; (b) if the applicant submits observations, after considering the

observations; or

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(c) if the applicant does not request a hearing or submit observations, after the expiry of the sixty day period referred to in subregulation (1).

- (3) The registrar shall notify the applicant in writing of his or her decision.
- (4) Where the registrar decides to refuse to register the industrial design, the applicant may, within thirty days after the date of the notification of the decision, request that the registrar provide written reasons for his or her decision.
- (5) A request under subregulation (4) shall be in Form 32.
- (6) The registrar shall comply with a request under subregulation
 - (5) within forty-five days after the request is made.
- (7) The applicant may appeal the registrar's decision to court within ninety days after—
 - (a) the date of the notification of the decision; or
 - (b) if written reasons are requested, the date of the reasons.

50. Registration of industrial design.

- (1) Before an industrial design is registered under section 74(9) of the Act, the applicant shall pay the registration fee.
- (2) A certificate of registration issued under section 74(9) of the Act shall be in Form 33.

51. Duration and renewal of registration.

An application for a renewal under section 75(2) of the Act shall be in

Form 34.

52. Restoration of lapsed right.

(1) An application for restoration of the protection granted to an industrial design under section 76(1) of the Act shall be in Form 35.

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(2) The application shall be accompanied by a statutory declaration or affidavit supporting the application and by an application for renewal in Form 34.

(3) Before rejecting an application, the registrar shall send a written notice to the applicant explaining the reasons for proposing to reject the application and inviting the applicant to request a hearing within sixty days after the date of the invitation.

(4) Where the registrar sends a notice under subregulation (3), the registrar shall not make his decision as to whether to restore the design or reject the application until—

(a) if the applicant requests a hearing, after holding the hearing; or

(b) if the applicant does not request a hearing, after the expiry of the sixty day period referred to in subregulation (3).

(5) The registrar shall notify the applicant in writing of his decision and, if the registrar decides to reject the application, the notification shall include written reasons for his decision.

(6) Publication of a restored design under section 76(5) of the Act shall be in the Gazette.

53. Request to examine representations.

A request to examine representations or specimens under section 77(2) of the Act shall be in Form 36.

54. Publication relating to registration.

The publication under section 78 of the Act relating to a registration shall be in the Gazette.

55. Application of regulations under section 80(2) of the Act. Regulations 34, 35 and 38 apply, with necessary modifications, with respect to the application, under sections 80(2), 48, 49 and 56 of the Act.

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PART VII—REGISTRATION OF TECHNOVATION
CERTIFICATES

56. Form of certificate of technovation.

A technovation certificate shall be in Form 37.

57. Register of technovation certificates.

(1) The registrar shall record the following in the register of industrial property—

(a) the registration number of the technovation certificate; (b) the name and address of the technovator;

(c) the date of the request for registration;

(d) the name and address of the enterprise that issued the technovation certificate;

(e) the title of the technovation;

(f) the technical field to which the technovation relates; and

(g) any other information that the registrar considers appropriate.

(2) The registrar shall ensure that the information on technovation certificates in the register of industrial property is kept confidential.

58. Application for registration.

(1) A technovator may apply to the registrar to have his technovation certificate registered.

(2) An application under paragraph (1) shall be in Form 38.

(3) The application shall be accompanied by a certified copy of the technovation certificate.

59. Certificate of registration.

Upon registration of a technovation certificate the registrar shall issue a certificate of registration.

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PART VIII—SURRENDER

60. Surrender.

(1) This Regulation applies with respect to the surrender of a patent, utility model or industrial design registration certificate under section 89 of the Act.

(2) Surrender shall be by way of a notice in Form 39.

(3) The publication of surrender under section 89(3) of the Act shall be in the Gazette.

PART IX—AGENTS

61. Representation by agent.

(1) A person may be represented by an agent in respect of a matter if an appointment of the agent in respect of the matter has been filed with the registrar.

(2) Unless the registrar otherwise directs, if a person is represented by an agent—

(a) the agent may attend upon the registrar in place of the person;

and

(b) the agent may sign any document under this Act on behalf of the person.

PART X—MISCELLANEOUS PROVISIONS

62. Copies of documents.

A person who wishes to obtain a copy of a document kept by the registrar shall make a request in Form 27 for a certified copy or in Form

40 for an uncertified copy.

63. Copy of lost or destroyed certificate.

(1) The registrar may issue a copy of one of the following certificates if the certificate is lost or destroyed—

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(a) a certificate of grant of a patent;

(b) a certificate of registration of a change in ownership; (c) a certificate of registration of a licence;

(d) a utility model certificate;

(e) a certificate of registration of an industrial design; or

(f) a certificate of registration of a technovation certificate.

(2) A request for a copy of a lost or destroyed certificate shall be in Form 41.

(3) A request for a copy of a lost or destroyed certificate shall be accompanied by a statutory declaration or affidavit supporting the assertion that the certificate has been lost or destroyed.

64. Request for a search.

A request to have a search done for an industrial property right shall be in Form 42 and shall be accompanied by the prescribed fee.

65. Request to amend a name, etc. in a register.

A request to amend a name, address or other contact information in a register shall be in Form 43.

66. Caution or notice in a register.

A request to have a caution or notice included in or removed from a register shall be in Form 44.

67. Rules for giving notices, etc.

(1) A notice or other document that is to be given or sent to, or served on, a person may be given, sent or served —

(a) by mailing or delivering the notice or document to the address of service provided by the person;

(b) by giving the notice or document personally to the person or by mailing or delivering the notice or document to the person's residence or place of business or employment; or

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(c) by giving the notice or document personally to the person's agent or by mailing or delivering the notice or document to the agent's place of business.

(2) A notice or document that is mailed shall be deemed to have been given, sent or served on the day the notice or document would be delivered in the ordinary course of post.

68. Opportunity to be heard.

Before exercising a power or making a decision the registrar may give a person who would be adversely affected an opportunity to be heard.

69. Hearings, particular provisions.

The following apply with respect to a hearing before the registrar—

- (a) at the hearing the registrar may allow oral evidence and shall allow the cross examination of a person on his statutory declaration or affidavit;
- (b) the registrar may, on such terms as he or she may specify, allow a document to be amended or a procedural irregularity to be rectified;
- (c) the registrar may, on such terms as he or she may specify, dispense with or modify any requirement to do anything, including a requirement to provide a document;
- (d) the registrar may require a party to pay all or part of the costs of another party and determine how the costs are to be determined and how they are to be paid; and
- (e) the registrar may require a party to give security for costs that the party may be required to pay under paragraph (d).

70. Extensions of time.

(1) The registrar may extend the time for doing an act or taking a proceeding, other than a time expressly provided in the Act, on such conditions as he may specify.

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(2) An application for extension of time shall be made to the registrar in Form 45 in Schedule.

71. Documents in English or translated.

(1) Documents provided to the registrar shall be in English.

(2) If a copy of a document that is not in English is required to be provided to the registrar the following apply—

(a) an English translation of the document shall be provided along with the copy of the document;

(b) the translation shall be certified to be an accurate translation; (c) if more than one copy of the document is required, one copy of the translation shall be provided for every copy of the document required; and

(d) the copy of the document shall be deemed not to have been provided until the required translation and copies are provided.

72. Revocation of SI 216 – 1.

The Patents Regulations, SI 216 - 1 are repealed.

CHAPTER 216

THE PATENTS ACT.

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CHAPTER 216

THE PATENTS ACT.

Commencement: 15 October, 1993.

An Act to provide for the grant, registration and protection of patents and for other purposes incidental thereto.

PART I—INTERPRETATION.

1. Interpretation.

In this Act, unless the context otherwise requires—

- (a) “ARIPO Office” means the secretariat managing the African Regional Industrial Property Organisation (ARIPO), formerly known as the Industrial Property Organisation, for Englishspeaking Africa (ESARIPO) established by the Lusaka Agreement of December 9th, 1976, as amended;
- (b) “ARIPO Protocol” means the Protocol on Patents and Industrial Designs within the Framework of the African Regional Industrial Property Organisation (ARIPO), concluded on December 10th, 1982, at Harare;
- (c) “foreign application” means an application for a patent which has been filed in a national patent office of a country other than Uganda, or in a regional industrial property office acting on behalf of that country;
- (d) “Minister” means the Minister responsible for the supervision of the patents registry;
- (e) “Paris Convention” means the Paris Convention for the Protection of Industrial Property signed on 3rd March, 1883, as last revised;
- (f) “register” means the register of patents maintained under section

4;

(g) “registrar” means the registrar of patents appointed under section

2;

(h) “registry” means the patents registry referred to in section 3.

PART II—THE PATENTS REGISTRY.

2. Officers.

The Minister may appoint—

(a) the registrar of patents who shall supervise the performance of the duties and functions of a registry under this Act;

(b) assistant or deputy registrars who shall, subject to the direction of the registrar, have all the powers conferred by this Act on the registrar; and

(c) examiners or other officers as may be necessary for carrying out the provisions of this Act.

3. Patents registry.

There shall be an office known as the patents registry with all functions relating to the procedure for the grant of patents and, in addition, shall—

(a) register licence contracts, contracts assigning the right to a patent and contracts assigning patents, and patent applications;

(b) provide patent information services to the public and maintain

links with users and potential users of patent information;

(c) act as the industrial property office of Uganda for the purposes of applications filed under the ARIPO Protocol; and

(d) perform any other functions that the Minister may by regulations prescribe.

4. Register of patents.

(1) The registrar shall maintain a register of patents in which shall be recorded all patents granted, numbered in the order of grant, and, in respect of each patent, where appropriate, its lapse for nonpayment of annual fees, and all transactions to be recorded by virtue of this Act or regulations made under it.

(2) The Minister may make regulations prescribing the form of register to be maintained under this section.

(3) The register shall be prima facie evidence of all matters contained in it as required by law, and any person, upon payment of the prescribed fee, may search the register or obtain extracts from it.

(4) Notwithstanding the repeal of the Patents Act, Cap. 82 of the 1964 Revision, a register kept in pursuance of that Act shall be deemed to be part of the register kept in pursuance of this Act.

5. Administrative instructions.

The registrar may, in conformity with the provisions of this Act, issue administrative instructions relating to the procedure for the grant of patents and the administration of granted patents as well as other functions of the registry.

6. Restrictions concerning patent officials.

(1) A registrar, assistant or deputy registrar of patents or any other official of the registry shall not file an application for a patent, or be granted a patent or hold any rights relating to a patent.

(2) With respect to information which has come to his or her knowledge in the course of his or her duties, an official of the patents registry shall not, even after the termination of his or her employment, make use of, communicate or divulge to any person, otherwise than in the performance of his or her duties under this Act, the contents of any document, communication or information which by its nature is a professional secret.

(3) A person who contravenes subsection (2) commits an offence and is liable on conviction to imprisonment for a term not exceeding seven years.

PART III—PATENTABILITY.

7. Definition of invention.

(1) For the purposes of this Act, “invention” means a solution to a specific technological problem and may be or may relate to a product or

process.

(2) The following shall not be regarded as inventions within the meaning of subsection (1)—

(a) discoveries and scientific and mathematical theories;

(b) plant or animal varieties or essentially biological processes for the production of plants or animals, other than biological processes and the products of those processes;

(c) schemes, rules or methods for doing business, performing purely mental acts or playing games;

(d) methods for treatment of the human or animal body by surgery or therapy as well as diagnostic methods, but the restriction under this paragraph shall not apply to products for use in any of these methods; and

(e) mere presentation of information.

8. Patentable invention.

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

9. Novelty.

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

(2) Everything made available to the public anywhere in the world

by means of written disclosure, including drawings and other illustrations, or by oral disclosure, use, exhibition or other nonwritten means shall be considered prior art if the making available is one which has occurred before the date of filing of the application or, if priority is claimed, before the priority date validly claimed in respect of it.

(3) The disclosure to the public of the invention shall not be taken into consideration if it occurred within twelve months preceding the date on which the application was filed and if it was by reason or in consequence of—

(a) acts committed by the applicant or his or her predecessor in title;

or

(b) an abuse committed in relation to the applicant or his or her predecessor in title.

10. Inventive step.

An invention is considered as involving an inventive step if, having regard to the prior art within the meaning of section 9, it would not have been obvious to a person skilled in the art, on the date of the filing of the application or, if priority is claimed, on the priority date validly claimed in respect of it.

11. Industrial application.

An invention is considered industrially applicable if, according to its nature, it can technologically be made or used in any kind of industry.

12. Temporary exclusion from patentability.

The Minister may, in the public interest, by statutory instrument, exclude from patentability, inventions concerning certain kinds of products or processes for the manufacture of those products, for a period not exceeding two years.

PART IV—APPLICATION, GRANT, REFUSAL OF GRANT.

13. Application.

(1) An application for the grant of a patent shall be made to the registrar, but where the applicant ordinarily resides or has his or her place of business outside Uganda, he or she shall be represented by an agent admitted to practise before the patents registry.

(2) The application shall be accompanied by the following—

(a) a description disclosing the invention in a manner sufficiently clear and complete for the invention to be evaluated and to be carried out by a person skilled in the art and shall, in particular, indicate the best mode known to the applicant for carrying out the invention;

(b) a clear and concise claim or claims defining the matter for which

protection is sought and fully supported by the description;

(c) any drawing which may be essential for understanding the invention;

(d) an abstract serving the purpose of technical information but which shall not be taken into account for the purpose of interpreting the scope of the protection sought; and

(e) the prescribed fee.

(3) The application shall state the name of any other prescribed data concerning the applicant, the inventor and the agent, if any, and the title of the invention.

(4) Where the applicant is not the inventor, the application shall be accompanied by a statement justifying the applicant's right to the patent.

(5) The appointment of an agent under subsection (1) shall be indicated by designation of the agent in the application or by furnishing of a power of attorney signed by the applicant.

14. Unity of invention.

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

15. Amendment and division of application.

(1) The applicant may amend the application, but the amendment

shall not go beyond the disclosure in the initial application.

(2) The applicant may divide the application into two or more applications (“divisional application”), but each such divisional application shall not go beyond the disclosure in the initial application.

(3) Each divisional application shall be entitled to a filing date and, where appropriate, the priority date of the initial application.

16. Right of priority.

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

(2) Where priority is claimed in accordance with subsection (1), the applicant shall accompany the declaration with a copy of the earlier application, certified as correct by the office with which it was filed.

(3) The effect of the declaration made under subsection (1) shall be as provided in the Paris Convention.

(4) Where the requirements under this section and any regulations relating to them have not been complied with, the declaration referred to in subsection (1) shall be disregarded.

17. Information on corresponding foreign applications and grants.

(1) The registrar may, within one year after the date of filing the application, request the applicant to furnish him or her with details of any foreign application for a patent or another title of protection filed by the applicant with a national industrial property office of another country, or with

a regional industrial property office, relating to the same invention as that claimed in the application filed with the registrar.

(2) The applicant shall, at the request of the registrar, furnish him or her with the following particulars concerning any of the foreign applications referred to in subsection (1)—

(a) copies of any communication received by the applicant concerning the results of any search or examination carried out in respect of the foreign application;

(b) a copy, if any, of the patent or other title of protection granted on the foreign application;

(c) a copy, if any, of the final decision rejecting the foreign application or refusing the grant requested; and

(d) a copy, if any, of a decision invalidating the patent or other title of protection granted to the applicant on the basis of the foreign application.

(3) The particulars furnished under this section shall merely serve the

purpose of facilitating the evaluation of novelty and inventive step with respect to the invention claimed in the application filed with the registrar or in the patent granted on the basis of that application.

18. Withdrawal of application.

The applicant may, at any time before the grant of a patent or the notification of rejection of the application or of refusal to grant a patent, withdraw the application, but he or she shall, if he or she does so, forfeit the filing fee.

19. Filing date and formal examination.

(1) The registrar shall accord as the filing date the date of receipt of the application, where at the time of receipt, the application contains—

(a) an express or implicit indication that the granting of a patent is sought;

(b) information establishing the identity of the applicant; and

(c) a part which, on the face of it, appears to be a description of an invention.

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

(3) Where the application refers to drawings which in fact are not included in the application, the registrar shall invite the applicant to furnish the missing drawings; and if the applicant complies with the invitation, the registrar shall accord as the filing date the date of receipt of the missing drawings; otherwise the registrar shall accord as the filing date the date of receipt of the application and shall treat any reference to the missing drawings as nonexistent.

(4) After according a filing date, the registrar shall examine whether the application complies with the requirements of section 13 and the regulations pertaining to them and those requirements of this Act and the regulations which are designated as formal requirements for the purposes of this Act.

20. Search and substantive examination.

(1) The Minister may, by statutory instrument—

(a) direct that applications for patents relating to a specified technical field or fields or that all applications relating to any technical field shall be the subject of an examination as to substance; or

(b) add further technical fields to those covered by a direction under paragraph (a) of this subsection or remove any technical field from the scope of the direction.

(2) If, in the registrar's opinion, the subject matter of an invention for which a patent is sought falls within a technical field covered by the terms of a direction made under subsection (1), he or she shall cause an examination to be carried out as to patentability under Part III of this Act.

(3) For the purposes of the examination under subsection (2), the registrar may transmit the application, with all accompanying documents, to the ARIPO Office or some other examining authority designated in the statutory instrument for a preliminary examination as to the patentability of the invention claimed, and the examining authority shall furnish a report on the conclusions of its examination and shall transmit it to the registrar and to the applicant.

(4) Where, taking due account of the conclusions of any report referred to in subsection (3), the registrar is of the opinion that any of the conditions as to patentability have not been fulfilled, he or she shall notify the applicant accordingly and invite him or her to amend his or her application.

(5) Where the applicant fails to amend his or her application, within the specified period of time, to the satisfaction of the registrar, the latter shall refuse the grant of a patent and notify the applicant accordingly.

21. Grant, registration and publication of patent.

(1) Unless the application has been rejected or refused under section 20, a patent shall be granted and issued to the applicant in the specified form.

(2) A patent granted under subsection (1) shall be recorded in the register, and the prescribed particulars of the patent shall be promptly published by the registrar in the Gazette.

(3) The registrar shall, whenever possible, reach a final decision on the application not later than two years after the commencement of the examination referred to in section 20.

(4) The registrar shall, upon request of the owner of the patent, make changes in the text or drawings of the patent in order to limit the extent of the protection conferred by it, where the change would not result in the disclosure contained in the patent going beyond the disclosure contained in the initial application on the basis of which the patent was granted.

22. Appeals.

An applicant may appeal to the High Court against a decision by the registrar—

- (a) according a filing date to an application;
- (b) rejecting an application; or
- (c) treating an application as if it had not been filed.

23. ARIPO patents.

A patent granted to an applicant by the ARIPO Office in accordance with the

ARIPO Protocol and in respect of which Uganda is a designated State shall, with the necessary modifications, have the same effect and enjoy the same protection in Uganda as a patent granted under this Act; but a patent so granted shall not have legal effect or protection in Uganda where the registrar has made a written communication to the ARIPO Office, in accordance with the ARIPO Protocol, that the patent shall have no effect in Uganda.

PART V—RIGHTS AND OBLIGATIONS.

24. Obligations of owner.

The owner of a patent shall have the following obligations—

- (a) to disclose the invention in a clear and complete manner and, in particular, to indicate the best mode for carrying out the invention in accordance with the requirements and subject to the sanctions applicable under this Act;
- (b) to work the patented invention in the country within the time limit prescribed; and
- (c) to pay the prescribed fees to the registry.

25. Rights of owner.

- (1) The owner of a patent has an exclusive right to make, use, exercise and vend the invention, and may preclude any person from

exploiting the patented invention without his or her authorisation, by any of the following acts—

(a) when the patent has been granted in respect of a product—

(i) making, importing, offering for sale, selling and using the product;

(ii) stocking the product for the purposes of offering for sale, selling or using the product;

(b) when the patent has been granted in respect of a process—

(i) using the process;

(ii) doing any of the acts referred to in paragraph (a) of this subsection in respect of a product obtained directly by means of the process.

(2) After the grant of the patent, and within the limits defined in section 27, the owner of the patent has a right to preclude any person from exploiting the patented invention in the manner referred to in subsection (1).

(3) The owner of a patent may assign or transfer by succession the application for a patent or the patent.

26. Infringement.

(1) Subject to sections 27, 28 and 37, where a person other than the owner of a patent or a licensee does any of the acts specified in section 25(1)

in respect of the patented invention, that act shall constitute infringement of the patent.

(2) If the owner of a patent or the licensee is of the opinion that his or her patent has been or is about to be infringed, he or she may institute infringement proceedings in the High Court for the following relief—

(a) damages;

(b) an injunction to prevent infringement or continuing infringement of the patent; and

(c) any other civil remedy.

(3) Where a defendant to infringement proceedings can prove that the acts done by him or her do not constitute an infringement, he or she may pray the court for a declaration that the patent in question has not been infringed.

(4) If a patent relates to a process for the manufacture of a product showing novel features, the product shall, in the absence of proof to the contrary, be presumed to have been manufactured by that process.

27. Scope of protection.

The scope of protection under the patent shall be determined by the terms of the claims, but where these are inadequate, the drawings and the description included in the patent may be used to interpret the claims.

28. Limitation.

The rights of an owner of a patent shall extend only to the use of the patented invention for industrial or commercial purposes, but those rights shall not be deemed to be infringed by the following—

- (a) acts done in pursuance of scientific research;
- (b) acts in respect of articles which have been put on the market in Uganda by the owner of the patent or with his or her express consent;
- (c) the use of the patented article on foreign aircrafts, land vehicles or vessels of other countries which temporarily or accidentally enter the airspace, territory or waters of Uganda;
- (d) acts performed by any person who in good faith, before the filing or, where priority is claimed, before the priority date of the application on which the patent is granted and in Uganda, was using the invention or was making effective and serious preparations for such use, to the extent that those acts do not differ in nature or purpose from the actual or envisaged prior use and provided that the right of the prior user referred to in this section may be transferred or devolve only together with the enterprise or business, or with that part of the enterprise or business, in which the use or preparations for use have been

made.

29. Exploitation by the Government or persons authorised by the Government.

(1) Where the Minister is of the opinion that it is in the vital public interest to do so, he or she, in consultation with the registrar, and without the authority of the owner of a patent, may direct that a patented invention be exploited by a Government agent or other person designated by the Minister, on the following conditions—

(a) that the owner of the patent and any licensee has been given an opportunity to be heard before the direction is made; and

(b) that the Government provides for the payment of adequate remuneration, as fixed by the registrar, to the owner of the patent for the use of his or her invention.

(2) The owner of any patent affected by any direction of the Minister under this section may appeal to the High Court—

(a) against the direction of the Minister;

(b) against a decision of the registrar fixing the amount of remuneration under subsection (1),

but an appeal shall not suspend the effect of the direction of the Minister under subsection (1).

(3) For the purposes of this section, “vital public interest” includes matters of paramount importance pertaining to national security, public health, public order and morality and the national economy.

(4) For the purposes of forming an opinion under subsection (1), the Minister may consult with such technical experts in the particular field of the patented invention as may be necessary.

30. Compulsory licences.

(1) At any time after four years from the filing date of an application or three years from the grant of a patent, whichever period last expires, any person may, in proceedings instituted by him or her against the owner of the patent or in proceedings instituted against him or her by the owner request the court for the grant of a compulsory licence on any of the following grounds—

(a) that the patented invention, being capable of being worked in Uganda, has not been so worked;

(b) that the existing degree of working of the patented invention in Uganda does not meet on reasonable terms the demand for the patented product on the domestic market or for the purposes of exploitation;

(c) that the working of the patented invention in Uganda is being

hindered or prevented by the importation of the patented product;
and

(d) that, by reason of the refusal of the owner of the patent to grant licences on reasonable terms, the establishment or development of industrial or commercial activities in Uganda, or the possibilities of exportation from Uganda, are unfairly and substantially prejudiced.

(2) A compulsory licence under this section shall be on such terms as to payment of remuneration by the licensee to the owner of the patent and otherwise as the court may consider just.

(3) Where the patented invention is a process, “patented product” in subsection (1) means a product obtained directly by means of the process.

31. Term of patent.

(1) Subject to subsection (2), a patent shall expire at the end of the fifteenth year after the date of the grant of the application.

(2) Where the owner of a patent makes a request to the registrar for extension of a patent and—

(a) accompanies the request with the prescribed fee; and

(b) satisfies the registrar that—

(i) the invention which is the subject of the patent is being

worked in Uganda at the date of the request; or

(ii) there is a legitimate reason for failing to so work the

invention,

the registrar may grant the extension for a further period of five years; but the request under this subsection shall be made not less than one month before the expiration of the patent.

(3) For the purposes of this section, a patented invention is worked if the patented product is effectively used in Uganda on a scale which is reasonable in the circumstances, but importation does not constitute working.

32. Annual maintenance fees.

(1) In order to maintain the application or the patent, an annual fee shall be paid in advance to the registrar starting with the first anniversary of the date of the filing of the application.

(2) The amount of the annual fee shall be fixed by the regulations so that it increases with the number of years.

(3) A period of grace of six months shall be granted for the payment of the annual fee upon payment of a surcharge whose amount shall be fixed by regulations.

(4) If an annual fee is not paid in accordance with this section, the application shall be deemed to have been withdrawn or the patent shall lapse,

and the lapse of the patent shall promptly be published by the registrar.

(5) Within twelve months from the expiration of the period of grace referred to in subsection (3), any interested person may, upon payment of the fee prescribed in the regulations, request the registrar to restore an application that is deemed to have been withdrawn, or a patent that has lapsed, by virtue of subsection (4).

(6) If the registrar is satisfied that the failure to pay the annual fee concerned was unintentional and all annual fees due have been paid, he or she shall make an order restoring the application or the patent, as the case may be.

(7) Any interested person may appeal to the court against the decision of the registrar granting or refusing to grant a request for restoration.

(8) Where a patent is restored under subsection (6), no proceedings may be brought by virtue of the patent—

(a) with respect to any acts performed after the lapse of the patent and before the date of the order for restoration;

(b) with respect to any acts performed after the date of the order for restoration in relation to articles imported into Uganda, or manufactured in it, after the lapse of the patent and before the date of the order for restoration.

33. Change in ownership.

(1) A contract assigning an application or a patent shall be in writing and shall be signed by the parties to the contract.

(2) Any change in ownership of an application or a patent shall be recorded in the register in accordance with the regulations governing the register, and on payment of the prescribed fee.

(3) Until a change in ownership has been recorded in accordance with this section, any document tending to establish the fact of the change in ownership shall not be admissible as evidence of title of any person to an application or patent.

34. Joint ownership.

In the absence of any agreement to the contrary between the parties, joint owners of an application or a patent may—

(a) separately transfer their shares in the application or the patent;

(b) separately exploit the patented invention and preclude any person not being a joint owner from exploiting the patented invention;

or

(c) jointly grant permission to any third person to do any of the acts referred to in section 25.

PART VI—SURRENDER, INVALIDATION AND REVOCATION OF PATENTS.

35. Surrender of patent.

- (1) The owner of a patent may surrender some or all of the claims in respect of a patent.
- (2) The surrender shall be recorded in the register but shall become effective on publication by the registrar in the Gazette.
- (3) Where a licence has been recorded in the register in respect of a patent, the surrender shall be accompanied by a declaration by the licensee consenting to the surrender, unless the licensee has expressly waived his or her right in the licence contract.

36. Invalidation and revocation.

- (1) The court may, at the request of a party to proceedings under this Act, invalidate and revoke a patent on any of the following grounds—
 - (a) that the invention claimed is not patentable within the meaning of sections 7 to 11;
 - (b) that the invention claimed is excluded from patentability under section 12;
 - (c) that the description and claims accompanying the application for grant of a patent did not comply with the requirements of section 13(2); or
 - (d) that the person to whom the patent was granted had no right to it

and the patent has since the grant not been assigned to the person who has the right to it.

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

PART VII—CONTRACTUAL LICENCES.

37. Licence contracts.

(1) The owner of a patent may, by written contract, grant permission to another person or persons to do any of the acts specified in section 25 in respect of an invention for which the patent was granted or an application is pending.

(2) A licence contract shall be in writing, signed by the parties to the contract, and shall be submitted by them, by petition, to the registrar for registration in the register.

(3) For the purposes of this Part of the Act, “licensor” means the party to the licence contract who grants the permission; and “licensee” means the person to whom the permission is granted.

38. Rights of licensee.

In the absence of provisions in the licence contract to the contrary, the licensee shall be entitled to do, in respect of the invention, any of the acts specified in section 25, but he or she may not grant permission to a third

party to do any of those acts in respect of the patented invention.

39. Prohibited terms in licence contracts.

(1) The registrar shall examine the contract to ascertain whether it contains terms which impose unjustified restrictions on the licensee and whether, as a consequence, the contract taken as a whole, is harmful to the economic interests of Uganda, and he or she may refuse to register the licence contract if after taking into consideration, in such examination, in particular, any term contained in the contract he or she is satisfied that the effect of that term would be—

(a) to permit or require the importation of technology from abroad when substantially similar or equivalent technology may be obtained on the same or more favourable conditions without importation from abroad;

(b) to require payment of a price, royalty or other consideration which is disproportionate to the value of the technology to which the contract relates;

(c) to require the licensee to acquire any materials from the licensor or from the sources designated or approved by him or her, unless it is otherwise impossible, for all practical purposes, to ensure the quality of the products to be produced;

- (d) to prohibit the licensee from acquiring, or to restrict his or her acquisition of, any materials from any source, unless it is otherwise impossible, for all practical purposes, to ensure the quality of the products to be produced;
- (e) to prohibit the licensee from using, or to restrict his or her use of, any materials which are not supplied by the licensor or by sources designated or approved by him or her, unless it is otherwise impossible, for all practical purposes, to ensure the quality of the products to be produced;
- (f) to require the licensee to sell products produced by him or her under the contract exclusively or principally to persons designated by the licensor;
- (g) to require the licensee to make available to the licensor without appropriate consideration any improvements made by the licensee with respect to the technology to which the contract relates;
- (h) to limit the volume of the products produced by the licensee with the help of the technology to which the contract relates;
- (i) to prohibit or restrict the export of the products produced by the licensee;

- (j) to require the licensee to employ on a permanent basis persons designated by the licensor;
- (k) to impose restrictions on research or technological development carried out by the licensee;
- (l) to prohibit or restrict the use by the licensee of any technology other than the technology to which the contract relates;
- (m) to extend the coverage of the contract to technology not required for the use of the main subject of the contract and to require consideration for such additional technology;
- (n) to fix prices for the sale or resale of the products produced by the licensee with the help of the technology to which the contract relates;
- (o) to exempt the licensor from any liability consequent upon any defect inherent in the technology to which the contract relates or to restrict the liability;
- (p) to prohibit or restrict the use by the licensee, after the expiration of the contract, of technology acquired as a result of the contract, subject, however, to any right of the licensor under the patent;
- (q) to require that disputes arising from the interpretation or performance of the contract be governed by a law other than the

laws applicable in Uganda or that those disputes be brought before courts outside the territory of Uganda;

(r) to establish the duration of the contract for a period which is unreasonably long in relation to the economic function of the contract, so however that any period which does not exceed the duration of the patent to which the contract relates shall not be regarded as unreasonably long.

(2) Where the registrar is of the opinion that the contract contains one or more terms which impose unjustified restrictions on the licensee and that, as a consequence, the contract, taken as a whole, is harmful to the economic interests of Uganda, he or she shall notify the petitioners accordingly and invite them to modify the contract so that it does not contain any such term.

40. Registration and certificates.

(1) If the registrar finds the licence contract in order, he or she shall register the contract and issue a certificate of registration to the petitioners.

(2) The certificate of registration shall state—

(a) the names of the parties to the contract;

(b) the date of the petition;

(c) the date of registration; and

(d) the registration number.

(3) All the particulars specified in subsection (2)(a), (b) and (c) shall be published by the registrar in the Gazette.

PART VIII—UTILITY CERTIFICATES.

41. Utility certificate.

(1) The registrar may grant a utility certificate in respect of an invention under this Part.

(2) Except as otherwise expressly specified in this Act, Parts I to VII and Part IX of this Act shall apply with necessary modifications to utility certificates and applications for them.

42. Special provisions relating to utility certificates.

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

(2) It is immaterial that the invention does not involve an inventive step within the meaning of section 10.

(3) The provisions in respect of patents relating to examinations as to substance under section 20 shall not apply to applications for utility certificates.

(4) Utility certificates shall be registered in a separate part of the register.

43. Duration and expiry of utility certificates.

A utility certificate shall expire, without any possibility of renewal, at the end of the seventh year after the date of grant of the application; but the court may, before the utility certificate expires, and in proceedings under section 36, invalidate and revoke a utility certificate on any of the grounds under that section.

44. Conversion of patent application to application for a utility certificate or vice versa.

(1) At any time before the grant of a patent or the notification of rejection of the application or of refusal to grant a patent, an applicant for a patent may, upon payment of the prescribed fee, convert his or her application into an application for a utility certificate, which shall be accorded the filing date of the initial application.

(2) At any time before the grant of a utility certificate or of the notification of rejection of the application, an applicant for a utility certificate may, upon payment of the prescribed fee, convert his or her application into a patent application, which shall be accorded the filing date of the initial application.

(3) An application may not be converted under subsections (1) and (2) more than once.

(4) The Minister may make regulations prescribing the procedure and

requirements for conversion of an application under this section.

PART IX—GENERAL PROVISIONS.

45. Jurisdiction.

(1) The High Court is vested with jurisdiction to decide disputes relating to the application of this Act and matters which under the Act are to be referred to the court.

(2) The court hearing the proceedings under this Act may sit with and be advised by two assessors having expert knowledge of the matters of a technological or economic nature.

46. Regulations.

The Minister may, by statutory instrument, make regulations prescribing anything which under this Act is to be prescribed by the regulations and generally, for better carrying out the objects and purposes of this Act, or to give force or effect to its provisions or for its better administration.

47. Transitional and savings provisions.

A patent registered in Uganda under the Patents Act, Cap. 82, 1964 Revision, which was in force immediately before the commencement of this Act, shall continue in force and confer the same rights and privileges as if granted and registered under this Act, until its natural life in law expires; and the remainder of its natural life shall continue to run as if this Act had not been

enacted.

History: Statute 10/1991; S.I. 70/1993.

Cross References

Lusaka Agreement of 9 December, 1976.

Paris Convention for the Protection of Industrial Property.

Patents Act, 1964 Revision, Cap. 82.

Protocol on Patents and Industrial Designs within the Framework of the African Regional Industrial Property Organisation.



ISAAC CHRISTOPHER LUBOGO

ABOUT THE BOOK

This book is to address the law on fashion, design and entertainment law in Uganda. It's the first comprehensive book that provides information on fashion both on an international and regional level, background and history of the fashion industry. Challenges facing the fashion industry in Uganda.

The book provides the legal and ethical environment in which local and international contemporary fashion design oriented and other businesses operate. Its to equip readers with knowledge on the basic business ethics and legal principles pertinent to both international and national business environments in which they live and operate .it puts emphasis on how these ethical and legal principles apply in corporate decision-making as well as the importance of social corporate responsibility for today's fashion design business.

The book provides readers with knowledge on statutes and legal procedures governing fashion businesses, describing the legal frame work pertinent to international fashion business and the legal and ethical decision making principles and processes in specific fashion business contexts.

The concept of design overlooking how designers can use the law to their advantage through contracts, creation of designs and as to why a person should be vigilant about protecting it, the registrable designs and its benefits and the other different concepts therein that is the principles and elements of design.

The concept of entertainment law which is a specialized part of the law in Uganda that deal with facilitating the creation and dissemination of art. Under this concept, the book is to provide its over view by providing the foundations of entertainment law and concepts that make up the law on entertainment extending to fashion law, hospitality, events management among others. Highlighting how the entertainment industry contributes to Uganda's Gross Domestic Product and the challenges facing the entertainment industry in Uganda, and the recommendations.

Also the concept of intellectual property issues in entertainment law, looking at the copyright and neighboring rights act 2006 providing for copyrightable works and how they are protected under the act and case law