

Registrar of Trade (and Service) Marks, who is charged with a duty to exercise the powers conferred on him by a respective legislation.<sup>7</sup>

Section 3, T., establishes the Tanzanian Trade and Service Marks Office. The office forms an integral part of the Business Registration and Licensing Agency (BRELA) established, under the Ministry of Industry and Trade, to provide services in relation to business name registration, trade and service marks registration, patents, company registration, and industrial licensing.<sup>8</sup> Thus, BRELA is an administrative support framework that facilitates the administration of four registries.<sup>9</sup> The Kenya industrial property institute (KIPI) is a parastatal organisation established, under the ministry of industrialisation of Kenya, to deal with *inter alia* trade mark registrations.<sup>10</sup> The Ugandan Trade Marks Office is under the control of the office of the Registrar General of the Uganda Registration Services Bureau (URSB)<sup>11</sup> whose mandates are overseen by the Ministry of Justice and Constitutional Affairs.<sup>12</sup>

### **C. Substantive Provisions**

#### *1. Subject matter of trade-mark protection*

Protection of a sign as a trade or service mark under the trade mark legislation of Tanzania, Kenya and Uganda is dependent on the sign concerned being registered.<sup>13</sup> Under some exceptional circumstances, unregistered trade mark

7 Cf. SS. 4, 3 and 2 of T, K and U respectively.

8 More information on BRELA is available at <<http://www.brela-tz.org>> (status: 30 July 2012).

9 These registries are the Registry of Companies (under the Companies Act No. 12 of 2002), business names (under the Business Names Act Cap 213 of the laws of Tanzania), Trade and Service Marks (under the Trade and Service Marks Act No. 12 of 1986) and Patents (under the Patents Act No. 1 of 1987).

10 More information on KIPI is available at <<http://www.kipi.go.ke>> (status: 30 July 2012).

11 URSB is established by the Uganda Registration Services Bureau Act No. 7/1998 (Cap 210 of the laws of Uganda). According to the long title of the Act, URSB Act establishes an agency for miscellaneous registrations and collection and accounting for revenues under various relevant laws and for the enforcement and administration of those laws and provide for other related matters.

12 See relevant information at <<http://www.wipo.int/directory/en/urls.jsp>> (status: 30 July 2012).

13 S. 14(1) T., S. 30 T., S. 5, K. & Sec 34, U. See also M. WEKESA & B. SIHANYA (eds), "Intellectual Property Rights in Kenya" 230 (Konrad Adenauer Stiftung, Berlin and Nairobi 2009).

rights may still be enforced.<sup>14</sup> Registration of a trade mark is *prima facie* evidence that the mark has fulfilled all conditions required of a valid mark.<sup>15</sup> To meet these conditions a sign must be distinctive<sup>16</sup> and must fall within the definition provided for under the respective trade mark legislation.<sup>17</sup>

## 1. Tanzanian law

The Tanzanian trade mark legislation qualifies a sign eligible for trademark protection in the following words:

trade or service mark means any visible sign used or proposed to be used upon, in connection with or in relation to goods or services for the purpose of distinguishing in the course of trade or business the goods or services of a person from those of another.<sup>18</sup>

To get a complete picture of the signs capable of functioning as trademarks under the Tanzanian law, one has to supplement the above definition with the operational definition of the visibility requirement provided for under the respective law. Section 2, T. stipulates that:

“visible sign” means any sign which is capable of graphic reproduction, including a word, name, brand, devise, heading, label, ticket, signature letter number, relief, stamp, seal, vignette, emblem or any combination thereof.<sup>19</sup>

## 2. Kenyan and Ugandan laws

The term “trade mark” is operationally employed in the Kenyan Act to refer to a mark used or intended to be used<sup>20</sup> in relation to goods or services to indicate in the course of trade that a connection exists between the goods or services being marketed under the mark and a person who has a right to use the mark.<sup>21</sup> On its part, the Ugandan Trade Marks Act delineates the term “trademark” to mean “a sign or a mark or combination of signs or marks capable of being represented

14 These circumstances are discussed in section C (II) (2) (b) of this chapter.

15 S. 14(2), T., S. 46, K. & S. 58, U. See also the ruling of the High Court of Tanzania (Commercial Court Division) in *Kibo Match Group Ltd v. Mohamed Enterprises (T) Ltd.*, Civil Case No. 6 of 1999 (Dar Es Salaam Registry (unreported)), para. 17.

16 S. 16 T., S. 12(2), K. & S. 11(2), SS. 9 & 10 U.

17 S. 2, para. 14, T., S. 2(1), para. 26 (a) & (b), K., & S. 1(1), para 15, U.

18 S. 2, para. 14, T.

19 S. 2, para. 18, T.

20 A trade mark is presumed to be used in legal context if it is used in a printed form or any other visual representations (*cf.* S. 2(2)(a), K.).

21 S. 2(1), para. 26 (a) & (b), K.

graphically and capable of distinguishing goods or services of one undertaking from those of another undertaking”.<sup>22</sup>

As regards signs which a trade mark may consist of, both Kenyan and Ugandan laws do not seem to put a limit to eligible signs, and for that matter they are not at variance with the position under the Tanzanian law. Essentially a “device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination of them” may constitute a trade mark registrable in Kenya or in Uganda.<sup>23</sup> The relevant provision of the Kenyan Act adds to the foregoing list “a distinguishing guise and slogan”<sup>24</sup> – the distinguishing guise in relation to goods being defined to mean a shape or a configuration of containers of the goods.<sup>25</sup> Moreover, the Kenyan Law makes an important specification: where eligible signs are combined, they will still qualify for registration irrespective of whether such combination is rendered in two or three dimension.<sup>26</sup>

The foregoing delineation of the subject matter of trade mark protection under the trade mark laws of Tanzania, Kenya and Uganda complies with the legal standards set out under the Agreement on Trade-Related Aspects of Intellectual property Rights (henceforth, TRIPS).<sup>27</sup> Article 15(1) TRIPs, which describes protectable subject matter of trade marks, indicates that Contracting Parties are obliged to register as a trade mark “any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings”.

22 S. 1(1), para 15, U. By referring to concepts such as “graphical representation” and capability to distinguish, the trade mark definition contained in the Ugandan trade mark law is similar to the one enshrined in the relevant laws governing trade mark matters in the European Union (*cf.* Chapter 4 *supra*, which offers an overview of the system of trade mark governance in the EU).

23 S. 2(1), para. 12, K. & S. 1(1), para 13.

24 S. 2(1), para. 12, K.

25 S. 2(1), para. 7, K.

26 S. 2(1), para. 12, K.

27 Tanzania, Kenya and Uganda are signatories to the Agreement Establishing the World Trade Organization (WTO) adopted at Marrakesh on April 15, 1994 in which the Agreement on TRIPs forms a part (*cf.* KIEFF, F. S. & NACK, R., “International, United States and European Intellectual Property: Selected Source Material 2007-2008” 34 (Aspen Publishers, New York 2006).

## II. Grounds for trade mark refusal

### 1. Absolute Grounds

A detailed discourse on absolute grounds for trademark refusal is covered in chapter 4 *infra*, in the context of the EU Community Trade mark law. The aim of these grounds is to exclude from registration various types of marks such as those which are not distinctive, or those which are descriptive of the goods or services. Others are generic signs, and the type of a shape excluded from registration by a stipulation of the law. A brief discussion on these grounds is offered below in the context of Tanzanian, Kenyan and Ugandan trade mark law.

#### a) Distinctiveness

##### aa) Under the Tanzania Trade Mark Law

Section 16 of the Tanzania Trade and Service Marks Act, apart from providing that “[a] trade or service mark shall be registered if it is distinctive”<sup>28</sup>, also expounds the standards a sign has to attain if it is to be regarded as distinctive. Within the ambit of the Section:

[A] trade or service mark is distinctive if it is capable, in relation to goods or services in respect of which it is registered or proposed to be registered, of distinguishing goods or services with which its proprietor is or may be connected in the course of trade or business from the goods or services in the case of which no such connection subsists, either generally or, where the trade or service mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of registration.<sup>29</sup>

The Section further provides that:

In determining whether a trade or service mark is capable of distinguishing for the purpose of subsection (2), regard shall be to the extent to which:- (a) The trade or service mark is inherently capable of distinguishing as aforesaid; and (b) By reason of the use of the trade or service mark or of any other circumstances, the trade or service mark is in fact capable of distinguishing as aforesaid.<sup>30</sup>

Capability to distinguish, within the ambit of the above quoted provisions, is detached from the sign as such for it is viewed in the light of the relation between the sign, its holder and the products or services. Generally, a trade mark is capable of being registered as long as the owner can demonstrate that his trade

28 S. 16(1), T.

29 S. 16(2), T.

30 S. 16 (3), T.