

person opt to submit his cancellation claim before the registrar, the registrar may (if he so wishes) refer the suit to the High Court irrespective of the stage of the proceedings. This is especially the case if, in the course of the proceedings, the registrar encounters a question of law in respect of which, in his opinion, the court is better placed to provide a proper solution than the registrar would be.<sup>64</sup> Sometimes the registrar may not refer the cancellation suit as aforesaid, but may enter a judgment on the merits of the suit accompanying it with a mandatory, express statement indicating that the judgment is open for an appeal to the High Court.<sup>65</sup> Once trade mark proceedings are properly instituted before the High Court, the national trade mark registrar must be afforded an opportunity to be heard, particularly where the effects of the Court's decision is to change the status of the trade mark registration as had been recorded in the national register.<sup>66</sup> Usually, the status of a trade mark registration may be changed through cancellation.<sup>67</sup>

### ***E. Infringement of a registered trade mark***

The trade mark laws of Tanzania, Kenya and Uganda demonstrate some similarities in the way they address issues pertaining to trade mark infringement such as the scope of trade mark protection and the limitation to the trade-mark-proprietor's exclusive rights.

#### *I. Scope of protection*

Trade mark infringement is categorised as a tort of strict liability. Hence, liability attaches irrespective of whether the defendant intended to infringe the plaintiff's trade mark or not.<sup>68</sup> Thus, where a validity of a trade mark registered in one of the EAC partner states is confirmed, an assumption is cast in favour of the trade

64 Cf. SS. 49 & 55, T., S. 53, K. & S. 63, U.

65 Cf. S. 55, T., S. 53 K. & S. 63 U.

66 Cf. SS. 52, 53 & 54, T., S. 50 K. & S. 61 U.

67 The term "alteration and/or rectification of the register" employed in the national trade mark laws of the EAC Partner States (cf. SS. 36 & 39, T., S. 37, K. & SS. 45, 46 & 61, U.) when referring to circumstances under which the status of a register with respect to trade mark registration may be changed is more general and encompasses the term "cancellation".

68 CCK, 10 May 2001, Case Number: 746/98 *Pharmaceutical Manufacturing Co v Novelty Manufacturing Ltd* [2001] 2 EA 521, 527 para. (c).

mark proprietor that his trade mark registration has extended to him “the exclusive rights to the use of a trade or service mark in relation to any goods including sale importation and offer for sale or importation”.<sup>69</sup> The trade mark proprietor’s exclusive rights are considered to be infringed where a third party not having the authority to use the proprietor’s trade mark, uses in the course of trade or business, a sign which is identical or nearly resembles the trade mark considered to be infringed. Unless the use of an infringing sign is likely to deceive or confuse consumers as to the origin of the goods or services, the court cannot endorse infringement thereto.<sup>70</sup> For that matter, it is imperative for the plaintiff to prove the similarity between the conflicting marks.<sup>71</sup> This may be realised through consumers’ testimony indicating the likelihood of confusion or deception.<sup>72</sup> However, the testifying consumer is not entitled to say that the offending mark so nearly resembles the registered mark as to be likely to deceive or cause confusion. It falls within the court’s competence to answer the question whether the infringing and the registered signs are similar and whether that similarity causes consumer confusion or deception.<sup>73</sup> To discharge this duty, the “court has to wear the shoes of a common man, spread the marks before it and ask itself whether there are resemblances between the two which would make it pick a product which was not intended but the opposite”.<sup>74</sup>

## 1. Use of a mark as a trade mark

A registered trade mark can only be infringed if the infringer uses an infringing sign as a trade mark.<sup>75</sup> No infringement can be imputed to a third party who uses a trade mark in a way that does not cause consumers to associate the third party’s products with the proprietor of that trade mark. This is opposed to a situation in which a third party uses a mark, “upon the goods or in physical relation thereto,

69 S. 31, T. See also SS. 7(1) & 8(1), K. and S. 36, U. See also CAK, 17 October 1997, Case Number: 235/96 *Samaki Industries (Nairobi) Ltd v Samaki Ltd (K) Ltd (2)* [1995-98] 2 EA 366, 373 para. (e).

70 S. 32(1) (a), T. & S. 7(1), K.

71 HCU, 17 February 1964, *Aktiebolaget Jonkoping-Vulcan v East African Match Co. Ltd* [1964] 2 ALR Comm. 176, at p. 183 (lines 30-34).

72 Cf. CCK, 10 May 2001, Case Number: 746/98 *Pharmaceutical Manufacturing Co v Novelty Manufacturing Ltd* [2001] 2 EA 521, 527 para. (f).

73 HCU, 17 February 1964, *Aktiebolaget Jonkoping-Vulcan v East African Match Co. Ltd* [1964] 2 ALR Comm. 176, at p. 183 (line 34) and at p. 184 (line 26).

74 HCT, *Tanzania Breweries Ltd v Kibo Breweries and Kenya Breweries*, Civil Case No. 34 of 1999 (Dar Es Salaam Registry (unreported)), para. 16.

75 S. 32(1) (a) (i), T. & S. 7(1) (a), K.

or in relation to services, or in an advertising circular or other advertisement issued to the public”, in a way that makes the consuming public believe that the goods or services being marketed or advertised come from the proprietor of a trade mark or any other person authorised by him.<sup>76</sup>

## 2. The use of business or company names

Trade mark infringements may be affirmed, pursuant to Tanzanian law, against a person who uses a business or company name identical or closely resembling a registered trade mark.<sup>77</sup> Viewed critically, this strengthened protection a registered trade mark enjoys may not be justified in every circumstances. It is a well-established, general principle of trade mark law that as long as the proprietor prohibits third parties from using his registered trade mark in relation to identical or confusingly similar goods he will be justified.<sup>78</sup> By analogy, the Tanzanian law should be interpreted to mean that the use of a trade or a company name cannot constitute trade mark infringement, unless such use is in respect of the goods and/or services which are similar or identical to those for which the trade mark is registered. However, insofar as the exception to the above general rule is concerned, the Tanzanian law may be justified if the infringed trade mark is a well-known or famous mark.<sup>79</sup> This position is not different from that under the Kenyan and Ugandan laws.

## 3. Trade mark with reputation

Both Kenyan and Ugandan laws do not enshrine a specific provision for the protection of trade mark with reputation.<sup>80</sup> On its part, the Tanzanian law provides an open-ended pigeon-hole in which any use of a sign resembling a registered trade mark with reputation would be enjoined by the proprietor,

76 S. 32(1) (a) (i), T. & S. 7(1) (b) & (c), K.

77 *Cf.* S. 32(1) (a) (i), T.

78 *Cf.* S. 20(1), T.

79 Well-known and/or famous trade marks may be infringed by the use of similar or identical mark for dissimilar goods or services.

80 However, a general stipulation under the Kenyan law may be invoked to protect marks with reputation: Restriction is imposed against a third party who uses a sign, which is identical to or closely resembling a registered trade mark, in a manner that is likely to cause injury or prejudice to the proprietor of the registered trade mark (*Cf.* S. 7(1) (d), K.).

irrespective of whether the goods or services marketed under the sign and the registered trade mark are same. According to the relevant Section of the law, any use of sign by a third party who has not secured a permission from the owner of the registered trade mark will be enjoined if such use is likely to impair the distinctive character or acquired reputation of a registered trade mark, unless the infringing sign and the registered trade mark are not identical or there is no close resemblance between them.<sup>81</sup>

## *II. Limitation to the exclusive rights*

### 1. Use of one's own name

Trade mark laws of the EAC partner states entitle any person to the use of “his own name, or of the name of the geographical location of his business, or of the name of any of his predecessors in business” in relation to goods or services, even where another person owns a registered trade mark similar to the third party's name.<sup>82</sup> However, such use of the name by the third party cannot be justified unless it is a *bonafide* use.<sup>83</sup>

### 2. Descriptive use of a trade mark

It is lawful for marketers to describe the quality or characteristics of their goods using a trade mark irrespective of whether the trade mark owner has consented to the use. This is however a rebuttable presumption: A person resorting to a descriptive use of the mark must ensure that the use does not influence the public to think that the goods under description come from the proprietor of the trade mark, or that there is any connection whatsoever between the goods under description and the proprietor of the trade mark.<sup>84</sup>

81 Cf. S. 32(2), T.

82 S. 34 (i), T., S. 11 (a), K. & S. 24 (a), U.

83 Cf. S. 34 (i), T., S. 11 (a), K. & S. 24 (a), U. It has been held in this regard that “.....A man is entitled to trade in his own name provided he does what is reasonable necessary to distinguish his business from that of another person of the same name” (CCK, Civil Suit 314 of 2006, *Match Masters Ltd v Rhino Matches Ltd* [2006] eKLR 6.

84 S. 34 (ii), T., S. 11 (b), K. & S. 24(b), U.