

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.

### 3. Honest concurrent use of trade marks

Under certain special circumstances, the law allows two or more identical or confusingly similar trade marks to co-exist in the trade mark register. The conditions for such co-existence are met if two persons, who are not connected in business, adopt and use an identical trade mark in relation to identical or confusingly similar goods or services. The adoption and the use of the mark must nevertheless be concurrent and in an honest way.<sup>85</sup> The manner, in which trade mark co-existence is possible, in a legal sense, may be depicted by a hypothetical case. Suppose that PATEL adopts and uses a trade mark, say DRYTOUGH, in relation to building-construction materials, but does not apply for registration of his trade mark. Assume further that RODGERS, not knowing the existence and the use of PATEL's unregistered trade mark adopts and uses the trade mark "DRYTOUGH" in relation to the same goods in respect of which PATEL uses the mark. After some time, RODGERS applies for the registration of his trade mark. The trade mark examiners, being unaware of PATEL's earlier adoption and use of the mark, issue RODGERS with a certificate of registration for the DRYTOUGH mark. In the circumstances, PATEL may get his trade mark registered without however invalidating RODGERS' registration. This may, therefore, be seen as a limitation to the principle of exclusivity of trade mark rights described in section E (I) of this chapter.<sup>86</sup>

On a case variation, RODGERS has no right to restrict PATEL from using DRYTOUGH mark even where PATEL does not seek registration of the mark. RODGERS would only succeed in excluding PATEL from using the mark if PATEL is unable to prove that he, or his predecessor in title, has been using a trade mark from the date anterior to the first use or to the registration of the registered trade mark in question.<sup>87</sup>

### 4. Exhaustion of trade mark rights

Exercise of trade mark rights by proprietors is subject to the doctrine of trade mark exhaustion. The tenet of trade mark exhaustion refers to a scenario under which a trade mark proprietor, having exercised some exclusive rights he/she enjoys in relation to his/her trade-marked goods, is taken to have relinquished those rights with the consequences that third parties can thereafter commercialise

85 S. 20(2), T., S. 15(2), K. & S. 27, U.

86 S. 32(4), T., S. 15(2), K. & S. 27, U.

87 Cf. S. 33, T. & S. 10, K.

the goods concerned without requiring a trade-mark proprietor's permission.<sup>88</sup> However, if trade mark rights have not yet been exhausted the proprietor's exclusive rights protected in a certain territory will remain intact. In the circumstances, the trade mark owner will have a right to "stop goods at the borders of the respective territory bearing an identical mark to his own".<sup>89</sup>

The doctrine of trade mark exhaustion, in the context of national trade mark laws of the EAC Partner States, is discussed in detail in section C (I) (2) to (4) of chapter 3. The principle of regional trade mark exhaustion underlying the EU trade mark law is outlined in section C of chapter 6.

### *III. Duties in relation to a registered trade mark*

#### 1. Renewal of registration

Trade mark legislations of EAC partner states require as a condition for continuation of the validity of trade mark after the expiry of the initial registration term of registration that the said registration be renewed. Under both Tanzanian and Ugandan trade mark legislations, trade mark registrations enjoy an initial term of seven years with the possibility of renewal of the registration for further terms, of ten years each, commencing from the date of expiration of the initial registration.<sup>90</sup> Under the Kenyan law, trade marks are initially registered for a term of ten years with a possibility of extension of the registration for further terms of ten years each.<sup>91</sup>

#### 2. Obligation to use a registered trade mark

Trade mark laws of the EAC Partner States devise a mechanism to avoid trade mark system being used as a means of granting a monopoly in words and other signs without those words and signs actually being used in relation to goods or services. For this reason, trade and service marks are protected in Tanzania and

88 Cf. BAINBRIDGE, D., "Intellectual Property" (7th ed.) 827 (Pearson Education Limited, Harlow 2009).

89 PAGENBERG, J., "The Exhaustion Principle and "Silhouette" Case", 30(1) IIC 19, 23 (1999).

90 S. 29 (1) & (2), T. & S. 21, U.

91 S. 23 (1) & (2), K. Before the amendment of the Kenyan Trade Marks Act in 2002, the initial trade mark registration term was 7 years and subsequent terms were 14 years each.