## Table of contents

7
15
19
23
23
23 24
24
25
25
27
27
27
27
28
29
31
31
31
32
32
33
33
33
34
35
35 35
36
30

	I.	Sco	ope of protection	36
		1.	Use of a mark as a trade mark	37
		2.	The use of business or company names	38
		3.	Trade mark with reputation	38
	II.	Lir	nitation to the exclusive rights	39
		1.	Use of one's own name	39
		2.	Descriptive use of a trade mark	39
		3.	Honest concurrent use of trade marks	40
		4.	Exhaustion of trade mark rights	40
	III.	Du	ities in relation to a registered trade mark	41
		1.	Renewal of registration	41
		2.	Obligation to use a registered trade mark	41
F.	Inte	rnat	ional trade mark registration	42
G.	Cor	ıclu	ding remarks	43
<b>~</b> 1		2		
Ch	apte	r 3:	The free movement of trade-marked goods in the East	4.5
			African Community	45
Α.	Intr	odu	ction	45
			nciple of free movement of goods	45
	I.		gal basis	45
		1.	The EAC Treaty (EACT)	45
		2.	The EAC Common Market Protocol (CMP)	46
			The EAC Customs Union Protocol (CUP)	46
	II.		nde mark rights in the Common Market	47
		1.	<u> </u>	48
		2.	The Customs Union Protocol	50
C.	Pos	sible	e solution to the mischief	51
	I.	Pri	nciples of trade mark law	51
		1.	Trade mark functions	52
			a) Trade mark as a badge of origin	52
			b) Trade mark as a guarantee of quality	53
			c) Trade mark functions and markets compartmentalization	54
			aa) Guarantee of origin	55
			bb) Guarantee of quality	56
		2.	The Principle of trade mark exhaustion	57
			a) Forms of trade mark exhaustion	57
			b) National exhaustion	58
			c) International exhaustion	59
			d) Regional Exhaustion	61
		3.	Trade Mark Exhaustion in the EAC	62
			a) The general rule	62

				aa) The Tanzanian law	62
				bb) The Kenyan and Ugandan laws	63
			b)	Exception to the general rule	64
				aa) The Tanzanian law	64
				bb) The Kenyan and Ugandan laws	64
			c)	Conclusion thereof	65
		4.	Plac	ce of sale for the purpose of exhaustion	65
			a)	The Tanzanian law	65
			b)	The Kenyan and Ugandan laws	65
	II.	Re	levar	nt principles of international law	67
		1.	TRI	IPs Agreement	67
			a)	Legislative freedom under Article 8 TRIPS	67
				The chapeau	67
			c)	The national trade mark exhaustion meets TRIPS'	
				minimum standards	68
				The debate on Article 6 TRIPS	69
		2.	The	e GATT 1994	70
			,	The national treatment	71
				The most favoured nation principle	71
			c)	Prohibition of quantitative restrictions under Article	
				XI GATT	73
			d)	The general exception clause under Article XX GATT	74
				aa) Provisos under Paragraph (d) of Article XX GATT	75
				bb) Provisos under the chapeau	77
D.	Con	clu	ling	remarks	77
Ch	aptei	: 4:	Ove	rview of the European Community trade mark system	79
Α.	Intr	oduo	etory	v remarks	79
				nsible for CTM system	80
				ter of CTM protection	81
	I.			tive requirement – the capability to distinguish	82
	II.			requirement – the graphical representation	83
				e of the formal requirement	83
				and substantive requirements vis-à-vis non-traditional marks	84
			Smo		85
		2.	Sou	ınds	87
		3.	Col	ours	88
D.	Grou	ınds	for	Trade Mark Refusal	90
	I.			te Grounds	90
		1.		quirements of Article 4 of the CTMR	90
		2.		tinctiveness	91
					9
					_

		3. Descriptiveness	95
		4. Generic Signs	100
		5. Shape Marks	102
		6. Further absolute grounds – Article 7(1) (f) – (k)	105
		7. Acquired distinctiveness and public policy	108
	II.	Relative grounds for refusal	111
E.	CTN	1 infringement	112
	I.	Scope of CTM protection	112
		1. Article 9 of the CTMR	112
		2. Article 8 of the CTMR	114
	II.	Likelihood of confusion	118
		1. CTM function and likelihood of confusion	118
		2. In whose view is the likelihood of confusion determined?	120
		3. Thresholds of likelihood of confusion	122
		a) Similarity of trademarks	122
		aa) Visual similarity	122
		bb) Aural or phonetic similarity	124
		cc) Conceptual similarity	126
		b) Similarity of goods and/or services	128
		4. Likelihood of association	131
	III.	Trademark use as a condition for infringement	131
		Protection of a CTM with reputation	133
		1. Reputation – what is it?	133
		2. Infringing use in relation to a CTM with reputation	135
		a) Unfair advantage	135
		b) Detriment	136
		c) Without due cause	137
	V.	Limitations to CTM rights	137
		1. Honest use of a CTM	137
		a) Use of one's own name and address	138
		b) Descriptive use of a CTM	139
		c) Use of a CTM to indicate intended purpose	139
		d) Proviso to Article 12	141
		2. Exhaustion of CTM rights	141
	VI.	Duties in relation to CTM	142
		1. Renewal of CTM registration	142
		2. Obligation to use a CTM	142
	VII.	Key principles relating to precedence of CTM rights	145
		1. Priority Right	145
		2. Seniority right	146
F.	CTN	A Application and Opposition proceedings	146
	I.	CTM application	147

		1. Procedure and contents	148
		2. Search procedure	149
	II.	Opposition against CTM registration	152
		1. Objection procedure	153
		2. Grounds for opposition	154
		3. Entitlement to file a notice of opposition	155
		4. Opposition proceedings	156
		5. Strategies and defences	157
G.	Can	cellation of CTM rights	160
	I.	Revocation	160
		1. Non-use	160
		2. Improper use of a CTM	161
	II.	Invalidity	162
		1. Absolute grounds for invalidity	163
		2. Relative grounds for invalidity	166
	III.	Effects of CTM revocation and invalidity	166
Н.	Inte	rnational Registration Procedure under the CTMR	167
	I.	EC as a designated territory	168
	II.	CTM registration or application as a basis for international	
		registration	170
Ch	apte	r 5: Interplay between Community trade mark and trademark	
-	ap v	systems of EU member states	173
		oduction	173
В.		ential aspects of Community trade mark system	174
	I.	Co-existence of trade marks	174
	II.	Seniority	176
		1. Requirements for seniority	177
		a) Status of the earlier national trademark	177
		b) Triple identity rule	177
		aa) Identity of the marks	178
		bb) Same owner	178
		cc) Identical goods and/or services	178
		2. Examination of seniority claim	179
		3. Merits and demerits of seniority right	180
		a) Merits	180
		b) Demerits	181
	III.	Trade mark conversion	182
		1. Grounds for conversion	182
		a) Withdrawal of a Community trade mark application	182
		b) Cessation of effects of Community trade mark	183
			11

			c)	Refusal of registration	183
				Successful cancellation proceedings	184
		2.	Gro	ounds for excluding conversion	184
			a)	Non-use of a Community trade mark	184
			b)	Grounds for refusal available in one Member State	184
C.	Enla	rgei	nent	t of the European Union and Community trade marks	185
	I.	Au	toma	atic extension of Community trade marks	185
		1.	Ab	solute grounds for trademark refusal	185
		2.	Op	position against registration of Community trade marks	186
		3.	Car	ncellation of Community trade marks	186
	II.	Pre	eserv	vation of earlier rights under national law	187
D.	Enf	orce	emen	nt of Community trade mark rights	187
	I.	Ap	plica	ation of Brussels Regulation	188
	II.	Co	- mmı	unity trade mark courts	189
		1.	Jur	isdiction over infringement and invalidity proceedings	190
			a)	Infringement actions	191
				Validity of a Community trade mark	192
		2.	Inte	ernational jurisdiction	192
			a)	Connection of parties and courts	193
			b)	Factors contained in the Brussels Regulation	194
			c)	Place where harmful act takes place	195
		3.	Del	limitation of jurisdiction	195
		4.	Rel	lated, simultaneous and successive actions	196
			a)	Similar Community trade mark claims	196
			b)	Related Community trade mark and national trade	
				mark claims	197
		5)	Jur	isdiction to award temporary reliefs	199
	III.	Αp	plic	able law	200
		1.	Ro	me II Regulation	200
		2.	Co	mmunity Trade Mark Regulation	201
			a)	General applicable law	201
			b)	The law applicable to sanctions	202
			c)	Efficacy of lex loci delicti rule	203
	IV.	Re	cogi	nition and enforcement of Judgments	204
E.	Con	cluc	ling	remarks	206
Ch	apte	r 6:	Free	e movement of branded goods in the European Union	207
A.	Intr	odu	ctior	1	207
В.	Leg	al b	asis	for free movement of branded goods	208
	I.			eaty on the Functioning of the European Union	208
	II. Principles developed by the ECJ				

		1.	Existence and exercise of intellectual property	209		
			a) Grundig	211		
			b) Parke	212		
			c) Sirena	213		
			d) Deutsche Grammophon	214		
		2.		215		
		3.	Essential function of a trade mark	216		
C.	Exh	aust	tion of trade mark rights	217		
	I.	De	lineation and forms of trade mark exhaustion	217		
	II.	Ra	tionale of Community trade mark exhaustion	218		
	III.		onditions for Community trade mark exhaustion	220		
			Putting goods on the market	221		
		2.		223		
			a) Consent is given for specific goods	223		
			b) Express and implied consent	224		
			c) Contractual restrictions do not vitiate consent	225		
		3.	Burden of proof in relation to exhaustion	226		
	IV.		actors vitiating exhaustion	227		
		1.	Repackaging and re-affixing of a trade mark	229		
			a) Artificial partitioning of the common market	230		
			b) Condition of goods	231		
			c) Notice of repackaging	231		
			d) Identity of a person who repackaged the goods	232		
			e) Reputation of a trade mark	233		
		2.	Extension of repackaging principles to other case scenarios	234		
			a) Rebranding	234		
			b) Removal of a stock code	234		
			c) Reworked products	236		
D.	Con	clu	ding summary	236		
Ch	apteı	7:	A model trade mark regime for the East African Community	239		
Δ	Intra	odu	ction	239		
	Key Principles governing Community trade mark system					
٥.	I.		e principle of unitary character	240 240		
	II.		e principle of Coexistence of trade mark rights	241		
			teraction between trade mark coexistence and unitary			
			inciples	242		
C.	Prin		les that should govern the EAC trade mark system	243		
٠.	I.		odifications to the principle of unitary character	244		
			Abandonment of the unitary principle	245		
			* ' * '' <b>/ F</b>			

		2.	Unitary character not to be defined by the entire scale	
			of the regional bloc	245
		3.	Justifications for the proposed modifications to the	
			unitary principle	246
			a) Free movement of goods	246
			b) Competition in trade-marked goods	247
			c) Unitary character as a means of expansion of economic	
			activities	248
	II.	Mo	odifications to the principle of co-existence	249
		1.	Abolition of the national trade mark	249
		2.	Coexistence as a transition solution	250
			a) Incentives to ensure that the national system fades away	250
			b) The Benelux model: Transforming existing national	
			trade marks into EAC trade marks	251
		3.	The German trade mark model	252
D.	The	Pro	oposal for the EAC trade mark regime	256
	I.	Ac	quisition of trade mark rights and the extent of validity	257
		1.	Non-examination system at national offices	257
		2.	Examination system at the EAC trade mark office	258
		3.	Trade mark use requirement and the consequences thereof	259
			a) The use requirement	259
			b) Consequences of non-compliance with the use	
			requirement	259
	II.	Int	egration of the existing national trade mark rights into the	
		EA	AC trade mark regime	261
		1.	National trade mark registrations	261
		2.	Applications for national trade marks	261
		3.	Conciliation board	262
Bil	bliog	rapl	hy	265