

in Uganda subject to the condition that such marks be put to genuine use within the maximum period of three years from the date of registration of the marks and from the date of renewal of the registration of the marks concerned.⁹² The Kenyan trade mark legislation requires a trade mark to be put to genuine use within any five years.⁹³ Any trade mark which is not put to genuine use in accordance with the foregoing conditions is likely to be deregistered upon a request of a third party.

F. International trade mark registration

Legal protection of trade marks in the EAC Partner States does not accrue automatically. A formal trade mark protection is dependent upon a mark concerned being registered as a national trade mark in an individual Partner State.⁹⁴ There are different ways through which such registration may be secured. The trade mark proprietor has to decide whether he wants his trade mark application to be governed solely by the national law or by both national law and the law governing international or regional registration of trade marks. Protection, in the EAC, of a trade mark via regional trade mark registration scheme is available under the regime established and managed by the African Regional Intellectual Property Organization (ARIPO),⁹⁵ whereas protection via an international registration system is conducted pursuant to the procedure and requirements outlined in the Madrid Agreement and the Madrid Protocol.⁹⁶

92 S. 35(1), T. & 46, U.

93 S. 29(1), K.

94 However, unregistered trade mark rights may, exceptionally, be enforced (*cf.* Section C (II) (2) (b) of this chapter).

95 *Cf.* the Lusaka Agreement on the creation of an Industrial Property Organization for English-Speaking Africa of December 1976, as amended by the administrative council of ARIPO on December 10, 1982, December 12, 1986 and November 27, 1996, and as amended by the Council of Ministers on August 13, 2004. The Lusaka Agreements empowers ARIPO to enact some Protocols that are necessary to define the functions and powers of ARIPO in specific fields of intellectual property rights. Thus, ARIPO's competence in relation to issues pertaining to trade mark registration are defined by the Banjul Protocol on Marks adopted by the Administrative Council at Banjul, The Gambia on November 19, 1993 and amended on November 28, 1997, May 26, 1998, and November 26, 1999 and as amended by the Council of Ministers on August 13, 2004.

96 The system is governed by two international treaties, namely, the Madrid Agreement Concerning the International Registration of Marks "adopted in Madrid in April, 1891 and the Protocol Relating to the Madrid Agreement adopted in Madrid on 27 June 1989 and came into force on 1 April 1996.

Tanzania and Uganda ratified the Banjul Protocol on Marks and hence are fully bound by it. Kenya has not yet ratified the Protocol but enshrined a provision in the Trade Mark Act implementing the Protocol. According to the implementing provision, the normative order enshrined in the Kenyan Act is superior to the stipulations in the Banjul Protocol.⁹⁷

Kenya has ratified both the Madrid Agreement and the Protocol thereto (hence fully bound by them),⁹⁸ while Tanzania and Uganda have not. Whereas applicants for international trade mark registrations may only designate Kenya, such designation may have impact on the internal market in case a regional trade mark regime is established in the EAC.

G. Concluding remarks

The discussion in the Chapter has brought to light a number of discrepancies and/or some weaknesses inherent in the national trade mark laws of the EAC Partner States. In connection with the absolute grounds for trade mark refusal, the concept of distinctiveness under the Kenyan and Ugandan laws is addressed differently from the stipulation under the Tanzanian law, the root cause being the partition of the Kenyan and Ugandan trade mark register into two parts (i.e., part A and part B). While a generic trade mark cannot be legally registered under the Kenyan and Ugandan laws, the Tanzanian trade mark legislation does not contain any stipulation in this respect. Regarding the relative grounds for trade mark refusal, unregistered rights may be invoked to oppose registration of a trade mark in Tanzania and in Uganda, but such rights cannot constitute a ground for refusing or opposing a trade mark application in Kenya, notwithstanding the fact that infringement of such rights may be redressed under the tort of passing off.

Some other notable substantive differences are the terms of trade mark registration and the renewal of the registration. Important as well is the difference in the time limit with respect to putting a registered trade mark to genuine use.

Finally, the chapter has revealed that the differences exist with respect to systems of international trade mark registrations with effect in the EAC Partner States.

As a condition for attaining a common EAC trade mark regime, the differences and weaknesses of the national trademark systems of the EAC Partner States identified in this chapter must be addressed.

97 See S. 40D (3), K.

98 See S. 40B, K.