

## Chapter 2: The Absence of Common Trade Mark Regime in the East African Community

### *A. Introduction*

Are the substantive provisions of the national trade mark legislations of the Partner States of the East African Community (EAC) similar? The positive response to this question would negate a central thesis of this chapter. The chapter takes the view that unless the substantive differences inherent in the national trade mark laws of the EAC Partner States are streamlined and harmonised, a common EAC trade mark regime would be impossible.<sup>4</sup> As a step leading to the foregoing conclusion, the Chapter addresses the subject matter of trade mark registration, and the grounds that the national trade mark offices of the EAC Partner States may invoke to refuse registration of a trade mark. This is followed by an outline of trade mark opposition and cancelation procedure. Issues pertaining to trade mark infringement and the system of international trade mark registration are depicted in the chapter as well. Preliminary considerations are directed to the institutional set up of the national trade mark regimes of the EAC Partner States.

### *B. Institutions responsible for trade mark registration*

Trade and service marks Act of 1986<sup>5</sup> (henceforth T.) governs trade mark administration in Tanzania. Trade mark rights in Kenya and Uganda are respectively created and protected based on the Trade Marks Act (Chapter 506 of the laws of Kenya) of 1957 (henceforth, K.) as amended and the Trademarks Act<sup>6</sup> of Uganda of 2010 (henceforth, U.). These legislations establish an office of

4 The substantive differences depicted in this chapter are only exemplary. It is not the aim of the chapter to go into extensive discussion insofar as the differences are concerned, but just to highlight the key differences that are essential for the attainment of a common EAC trade mark regime.

5 Act No. 12/86 of the Laws of Tanzania.

6 Act No 17 of 2010. This Act, which is published in *the Uganda Gazette No. 53 Volume CIII dated 3rd September 2010*, repeals the Trademarks Act (Chapter 217 of the laws of Uganda) of 1953 (cf. S. 99 of the Act).

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**

#### *I. 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).