

## II. Grounds for trade mark refusal

### 1. Absolute Grounds

A detailed discourse on absolute grounds for trademark refusal is covered in chapter 4 *infra*, in the context of the EU Community Trade mark law. The aim of these grounds is to exclude from registration various types of marks such as those which are not distinctive, or those which are descriptive of the goods or services. Others are generic signs, and the type of a shape excluded from registration by a stipulation of the law. A brief discussion on these grounds is offered below in the context of Tanzanian, Kenyan and Ugandan trade mark law.

#### a) Distinctiveness

##### aa) Under the Tanzania Trade Mark Law

Section 16 of the Tanzania Trade and Service Marks Act, apart from providing that “[a] trade or service mark shall be registered if it is distinctive”<sup>28</sup>, also expounds the standards a sign has to attain if it is to be regarded as distinctive. Within the ambit of the Section:

[A] trade or service mark is distinctive if it is capable, in relation to goods or services in respect of which it is registered or proposed to be registered, of distinguishing goods or services with which its proprietor is or may be connected in the course of trade or business from the goods or services in the case of which no such connection subsists, either generally or, where the trade or service mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of registration.<sup>29</sup>

The Section further provides that:

In determining whether a trade or service mark is capable of distinguishing for the purpose of subsection (2), regard shall be to the extent to which:- (a) The trade or service mark is inherently capable of distinguishing as aforesaid; and (b) By reason of the use of the trade or service mark or of any other circumstances, the trade or service mark is in fact capable of distinguishing as aforesaid.<sup>30</sup>

Capability to distinguish, within the ambit of the above quoted provisions, is detached from the sign as such for it is viewed in the light of the relation between the sign, its holder and the products or services. Generally, a trade mark is capable of being registered as long as the owner can demonstrate that his trade

28 S. 16(1), T.

29 S. 16(2), T.

30 S. 16 (3), T.

mark (which of course must be a visible sign)<sup>31</sup>, can distinguish or has already distinguished his goods or services from those of others. Thus, section 16 of the Tanzania Trade and Service Marks Act calls for the assessment of a trademark's capability to distinguish to be done in view of the goods and services.

#### bb) Under the Kenyan and Ugandan Trade Mark Laws

The Trade Mark Acts of Kenya and Uganda determine distinctiveness based on the register of trade marks. Under these laws, an assessment must be made to find out whether a particular mark qualifies to be registered either in part A or part B of the register. The logic behind dividing the register into two parts is to isolate the marks in respect of which an irrefutable, legal presumption of distinctiveness must be cast or those in respect of which there is ample evidence to show that they are distinctive from those which have potentials to distinguish goods and services of one undertaking from those of others.<sup>32</sup> The relevant provisions of the law regard the following categories of marks as registrable in part A of the register:

(a) the name of a company, individual or firm, represented in a special or particular manner; (b) the signature of the applicant for registration or some predecessor in his business; (c) an invented word or invented words; (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname; (e) any other distinctive mark, but a name, a signature or a word or words, other than such as fall within the descriptions in paragraphs (a), (b) and (c), shall not be registrable under this paragraph except upon evidence of its distinctiveness.<sup>33</sup>

In keeping with an operational definition of distinctiveness in relation to a mark registrable in part A of the register, the marks enumerated above are regarded distinctive if they are “adapted in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods which the proprietor of the trade mark is or may be connected in the course of the trade from goods in the case of which no such connexion subsists...”<sup>34</sup>

A trade mark which qualifies for registration in Part A of the register may as well be registered in Part B. As long as a particular mark possesses some potential to distinguish goods or services, it fulfils the requirements for registra-

31 Visibility of a sign is a mandatory, formal requirement for trademark registration under the Tanzania Trade and Service Marks Act (*cf.* S. 2, para. 14, T.).

32 *Cf.* SS. 12 & 13, K. and SS. 9 & 10, U.

33 S. 12(1), K. & S. 9(1), U.

34 S. 12(2), K. & S. 9(2), U.

tion in part B of the register.<sup>35</sup> This particular mark must be capable, “in relation to the goods in respect of which a trade mark is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of the trade from goods in the case of which no such connexion subsists...”<sup>36</sup>

Both laws recognise the legal position that a trade mark may be inherently distinctive or may acquire a secondary meaning in the course of trade and thus becoming distinctive. However, the fact that the pertinent laws divide the trade mark register into two parts connotes that the concept of inherent or acquired distinctiveness is applied differently depending on which part of the register a trade mark concerned is to be registered. This conclusion can be buttressed by the fact that these concepts are only relevant to determine whether a particular mark can serve a trade mark function or not. With this view in mind and insofar as part A of the register is concerned, all the marks mentioned in paragraphs (a) to (d) of Sections 12(1) and 9(1) of K. and U. respectively, are regarded as being inherently adapted to distinguish, whereas the marks that qualify for registration under paragraphs (e) of the above sections their acquired meaning is decisive to finding out whether they are actually adapted to distinguish.

When it comes to a mark registrable in part B of the register, potentiality to distinguish can be inherent or can be achieved by actually using a mark.<sup>37</sup>

One cannot criticise the distinction made between the proof of distinctiveness for the purpose of part A or part B of the register without questioning the essence of dividing the register in two parts, and whether, in a modern trade mark protection regimes, this division is still needed.<sup>38</sup> While this question deserves an analysis, it is not the purpose of this chapter to extend a discourse thereto.

## b) Descriptive and generic marks

A trade mark is regarded as descriptive if it is used to describe the characteristics of the goods or services which it markets, rather than performing a distinguishing role. This legal concept is not clearly described under the Tanzanian, Kenyan,

35 S. 13(3), K. & S. 10(4), U.

36 S. 13(1), K. & S. 10(2), U.

37 S. 13(2), K. & S. 10(3), U.

38 For instance, only one trade mark register is maintained under the Tanzanian Trade and Service Marks Act, 1986 (*cf.* SS. 6(1) and 2, para. 6, T.). Prior to the enactment of the above Tanzanian law, the Trade Marks Ordinance (Cap. 394 of the laws of Tanzania) required the trade mark registrar to divide a trade mark register into two parts. However, the 1986 trade mark law has abolished this division (*cf.* S. 62, T.).

and Ugandan laws. As to what may be likened to the principle of descriptiveness, these laws incorporate a provision entitling trade mark proprietors to disclaim certain features of a trade mark which are considered to be non-distinctive or to be common to trade.<sup>39</sup> A monopoly in these features is not allowed on a simple logic that a non-distinctive feature should be left open for every member of the society to use it. Indeed, a feature considered to be common to a particular trade cannot be monopolised since this would deny a large section of the society an access to an essential instrument without which they cannot be able to engage themselves on a particular trade.<sup>40</sup>

The term “generic mark” is used in the context of trade mark law to refer to a trade mark which was once distinctive but in the course of time has turned out to be used as a name of the very goods it used to distinguish. While the concept “generic mark” is not addressed in the Tanzanian law, the Kenyan and Ugandan Acts contain similar concepts under the heading “words used as name or description of an article or substance”.<sup>41</sup> A trade mark, which after registration turns out to serve as the “name or description of an article or substance or of some activity”, cannot automatically be invalidated based on the relevant provisions.<sup>42</sup> In order for the invalidation to be successful, factual evidence must be adduced to show that the use of a trade mark as a name or a description is well-known and established not only in respect of the goods connected with the trade mark proprietor, but also with other identical goods not connected in trade with the proprietor of trade mark. Only a disclaimer, by the proprietor, of exclusive rights to the use of the trade mark in relation to goods in respect of which the mark is considered generic, can salvage the mark from being invalidated and deregistered.<sup>43</sup>

39 S. 18, T., S. 17, K. & S. 19, U.

40 The corollary to this position is the permission under the law pursuant to which a trade mark proprietor’s consent is not required for third parties to use a trade, provided that such use is a *bona fide* description of the character or quality of a third party’s goods (S. 34 (ii), T., S. 11(b), K. & S. 24(b), U.).

41 S. 18, K. & S. 42, U.

42 i.e. S. 18, K. & S. 42, U.

43 Cf. S. 18(2) (b), K. & S. 42(3) (b), U.

## c) Trade Marks based on a shape of the goods

### aa) The Tanzanian Law

The Tanzanian law on trade marks does not signal the possibility of a shape mark being registered and protected. According to Section 19(b) T. “trade or service marks which consist solely of the shape or configuration of the goods, or the containers thereof” are excluded from those signs that may be registered and protected in Tanzania.

Even if the list of the signs that are capable of being graphically reproduced provided in section 2 T. is open for other items constituting visible signs to be added; the fact that shapes are not specifically mentioned in the section signifies that shape as such cannot be registered under the Act. This conclusion is collaborated by the provisions of section 19(b) which specifically excludes shape per se from registration. However, one fact remains bare: shapes can be reproduced graphically as required under section 2 TMA; they can also acquire distinctiveness if used in relation to goods or services. Nevertheless, the effect of section 19 (b) TMA in relation to registrations is to make such distinctiveness legally valueless. By having such an effect, Article 19 (b) appears to deviate from the underlying objective of the trademark protection regime, which is to virtually protect a sign as long as such sign is capable of distinguishing goods of one undertaking from those of other. In addition, there is a risk that the provisions of Section 19(b) T. contravene Article 15(1) TRIPS pursuant to which any sign (including figurative elements) that is capable of identifying one’s goods or services may be registrable.<sup>44</sup>

### bb) The Kenyan and Ugandan laws

Both Kenyan and Ugandan laws legitimatise registration of shape marks. A mark as defined under the Kenyan Trade Marks Act includes a distinguishing guise.<sup>45</sup> The distinguish guise in the sense in which it is employed in the Act refers to the shape or configuration of containers of the goods applied in relation to particular

44 Regarding the signs capable of being registered as trade or service marks in Tanzania including shape marks see JACONIAH, J., “The Requirement for Registration and Protection of Non-Traditional Trade Marks in the European Union and in Tanzania”, 40(7) IIC 756 *et seq.* (2009).

45 S. 2(1), para. 7, K.

goods.<sup>46</sup> The Kenyan Industrial Property Office has offered a guidance as to which items may be regarded as distinguishing guises:

A distinguishing guise identifies the unique shape of a product or its package. If for example you manufactured a chocolate moulded to look like a rabbit, you might want to register the rabbit shape as a trade mark a distinguishing guise.<sup>47</sup>

On its part, the Ugandan law allows registration of shape marks subject to general and specific requirements. In keeping with the general conditions, shape marks are only registrable if they can distinguish goods<sup>48</sup> and are capable of being used in relation to those goods in printed or other visual representations.<sup>49</sup> Specific registration requirements concerning registration of shape marks under the Ugandan law are stipulated under Section 23(5), U. The effect of the provisions of this section is to deny certain shapes a legal capability of being registered as trade marks for goods even where such registration may not be refused based on the general registrability requirements. In this regard, the Ugandan law clarifies that the “shape that results from the nature of goods; the shape of the goods that are necessary to obtain a technical result; or the shape that gives substantial value to the goods” cannot be registered as a trade mark relating to goods.<sup>50</sup>

#### d) Other absolute grounds

##### aa) Under the Tanzanian Law

In addition to the category of marks described above, the Tanzanian law excludes from registration as a trade mark other types of marks. For instance, any sign the use of which is likely to contravene the good morals of the society cannot be registered. Similar prohibition extends to deceptive marks or those which are likely to “cause confusion as to the nature, geographical or other origin, manufacturing process, characteristics or suitability for their purpose, of the goods or services concerned”.<sup>51</sup> Section 19(c), T., excludes from registration state emblems, official hallmarks, and emblem of intergovernmental organizations. Thus, Section 19(c), T., aims to make the Tanzanian Trade and Service

46 S. 2(1), para. 5, K.

47 <<http://www.kipi.go.ke/index.php/trademarks>> (status: 30 July 2012).

48 S. 4(1), U.

49 Cf. S. 1(2), U.

50 S. 23(5), U.

51 Cf. S. 19(a), T.

Marks Act compliant with the provisions of Article 6<sup>ter</sup> of the Paris Convention, which require Member States to incorporate similar exclusions in their municipal trade mark laws. On its part, Section 19(d), T., excludes registration of “trade or service marks which constitute reproductions in whole or in part, imitations, translations or transcriptions, liable to create confusion of trade or service marks and business or company names which are well known” in Tanzania and belong to third parties. The provisions of Section 19(d), T., implement Article 6*bis* of the Paris Convention, which requires Member States to protect well-known trade marks.

## bb) Under the Kenyan and Ugandan laws

The Kenyan and Ugandan laws contain an all-embracing formulation capable of capturing almost every type of marks prohibited from registration in Tanzania by virtue of Sec. 19, T. In this regard, Sec. 14, K. makes it unlawful:

[To] register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

Formulation of this provision leaves much to be desired: the use of the phrase “be disentitled to protection in the court of justice” is a puzzle, which every prospective trade mark registrant has to unfold in order to determine whether his trade mark qualifies for registration. A more specific embodiment such as that which is enshrined in Sec. 23(1), U.<sup>52</sup> would be needed in Sec. 14, K. for the precision and predictability of the Kenyan trade mark regime.

## 2. Relative grounds

### a) Prior registered trade mark

The trade mark laws of all the three EAC partner states under discussion refuse trade mark registration if a third party successfully claims that he is the proprietor of a trade mark and that the applicant has submitted to the trade mark

52 S. 23(1), U. provides that: “The registrar shall not register as a trademark or part of a trademark any matter the use of which would be likely to deceive or would be contrary to law, morality or any scandalous design”.

registrar an application for the registration of an identical or confusingly similar trade mark.<sup>53</sup>

#### b) Prior unregistered trade mark

The law puts it tritely that “no person shall be entitled to institute any proceedings to prevent or to recover damages for the infringement of an unregistered trade or service mark”.<sup>54</sup> Nevertheless, unregistered trade mark rights may be invoked to prohibit registration of another trade mark. Under the Tanzanian law, for instance, unregistered rights may constitute relative grounds for trade mark refusal. Thus, a proprietor of earlier unregistered trade mark, may formally base on his rights to oppose registration of a trade or service mark.<sup>55</sup>

Unregistered trade mark rights are not stipulated under the Kenyan and Ugandan laws as relative grounds for the refusal of trade mark registration, but such rights may be enforced, under the tort of passing off, against any person attempting to use a mark identical or confusingly similar to those rights.<sup>56</sup> One may question, whether a proprietor of unregistered trade mark in Kenya or in Uganda can substantiate his rights to prohibit registration of identical or confusingly similar trade marks. The fact that the law acknowledges a possibility of unregistered rights being enforced would be interpreted to mean that the trade mark registrar is likely to refuse a trade mark registration in respect of which he has a reason to believe that such a trade mark is likely to be challenged immediately after the grant of the registration.

53 S. 20(1), T., S. 15(1), K. & S. 25(2), U.

54 S. 30, T. See also S. 5, K. & S. 34, U.

55 S. 27(2) (a), T.

56 S. 5, K. & S. 35, U. See also S. 30, T., for similar position under the Tanzanian law. The judiciary in the East Africa has offered a legal construction of the tort of passing off: “To succeed in any action alleging passing off (which is an infringement of the legal principle that no man may sell his goods as those of another) a plaintiff must prove three things namely (a) that he has acquired a reputation or good will connected with the goods or services and that such goods or services are known to buyers by some distinctive get up or feature; (b) that the defendant, has whether intentionally or not, made misrepresentation to the public leading them to believe that the defendant’s goods are the plaintiff’s; and (c) that the plaintiff has .....damage because of the erroneous belief engendered by the defendant’s misrepresentation” (*SUPA BRITE Ltd v PAKAD Enterprises* [1970] 2 EA563. The case is also quoted in a ruling of the HCK (Commercial Court of Kenya (CCK) registry), Civil Suit 314 of 2006, *Match Masters Ltd v Rhino Matches Ltd* [2006] eKLR 5).



### c) Business or company name

The Kenyan and Ugandan trade mark laws do not provide an express stipulation to the effect that business or company names are relative grounds for trade mark refusal. However, the Tanzanian law<sup>57</sup>, provides as a relative ground for refusing an application for trade mark registration “where the trade or service mark resembles in such a way as to be likely to deceive or cause confusion, with business or company name already used in Tanzania by a third party”.

### d) Trade mark application filed in the name of agent

A trade mark application may be denied registration, if it is proved that the trade mark concerned is registered abroad and that the person seeking registration is just an agent of the proprietor of the trade mark.<sup>58</sup>

## ***D. Trade mark opposition and cancellation procedure***

The national trade mark laws grant the High Courts<sup>59</sup> of the EAC Partner States with exclusive powers to deal with disputes relating to a decision of the trade mark registrar to register a particular trade mark. In this regard, the law allows interested parties to oppose registration of a particular national trade mark by citing some absolute and/or relative grounds for trade mark refusal.<sup>60</sup> Oppositions are normally dealt with by the registrar manning the national trade mark office. An appeal against the registrar’s decision on the registrability of a particular trade mark may be lodged before the High Court of a respective Partner State.<sup>61</sup> Trade mark cancellation proceedings<sup>62</sup> may be instituted before the registrar in a national trade mark office or before the High Court.<sup>63</sup> Should a

57 i.e. Section 27(2) (b), T.

58 S. 27(2) (c), T.

59 Article 108 of the Constitution of the United Republic of Tanzania of 1977 (as amended) establishes the High Court of Tanzania. Article 60 of the Constitution of Kenya [R.E. 2009] establishes the Kenyan High Court. Article 138 of the Constitution of Uganda [R.E. 2000] establishes the Ugandan High Court.

60 These grounds are outlined in section C (II) of this chapter.

61 Cf. SS. 27(6) & 48, T., S. 31(11), K. & S. 12, U. See also S. 2, T., S. 2, K. & S. 1, U., which define the term “court”, as used in the Acts, to mean the “High Court”.

62 Cancellation proceedings may be realised either through revocation or invalidation proceedings (cf. section G of chapter 4).

63 Cf. S. 36, T., S. 35 K. & SS. 50 & 63 U.