

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.

person opt to submit his cancellation claim before the registrar, the registrar may (if he so wishes) refer the suit to the High Court irrespective of the stage of the proceedings. This is especially the case if, in the course of the proceedings, the registrar encounters a question of law in respect of which, in his opinion, the court is better placed to provide a proper solution than the registrar would be.<sup>64</sup> Sometimes the registrar may not refer the cancellation suit as aforesaid, but may enter a judgment on the merits of the suit accompanying it with a mandatory, express statement indicating that the judgment is open for an appeal to the High Court.<sup>65</sup> Once trade mark proceedings are properly instituted before the High Court, the national trade mark registrar must be afforded an opportunity to be heard, particularly where the effects of the Court's decision is to change the status of the trade mark registration as had been recorded in the national register.<sup>66</sup> Usually, the status of a trade mark registration may be changed through cancellation.<sup>67</sup>

### ***E. Infringement of a registered trade mark***

The trade mark laws of Tanzania, Kenya and Uganda demonstrate some similarities in the way they address issues pertaining to trade mark infringement such as the scope of trade mark protection and the limitation to the trade-mark-proprietor's exclusive rights.

#### *I. Scope of protection*

Trade mark infringement is categorised as a tort of strict liability. Hence, liability attaches irrespective of whether the defendant intended to infringe the plaintiff's trade mark or not.<sup>68</sup> Thus, where a validity of a trade mark registered in one of the EAC partner states is confirmed, an assumption is cast in favour of the trade

64 Cf. SS. 49 & 55, T., S. 53, K. & S. 63, U.

65 Cf. S. 55, T., S. 53 K. & S. 63 U.

66 Cf. SS. 52, 53 & 54, T., S. 50 K. & S. 61 U.

67 The term "alteration and/or rectification of the register" employed in the national trade mark laws of the EAC Partner States (cf. SS. 36 & 39, T., S. 37, K. & SS. 45, 46 & 61, U.) when referring to circumstances under which the status of a register with respect to trade mark registration may be changed is more general and encompasses the term "cancellation".

68 CCK, 10 May 2001, Case Number: 746/98 *Pharmaceutical Manufacturing Co v Novelty Manufacturing Ltd* [2001] 2 EA 521, 527 para. (c).