

the goods concerned without requiring a trade-mark proprietor's permission.<sup>88</sup> However, if trade mark rights have not yet been exhausted the proprietor's exclusive rights protected in a certain territory will remain intact. In the circumstances, the trade mark owner will have a right to "stop goods at the borders of the respective territory bearing an identical mark to his own".<sup>89</sup>

The doctrine of trade mark exhaustion, in the context of national trade mark laws of the EAC Partner States, is discussed in detail in section C (I) (2) to (4) of chapter 3. The principle of regional trade mark exhaustion underlying the EU trade mark law is outlined in section C of chapter 6.

### *III. Duties in relation to a registered trade mark*

#### 1. Renewal of registration

Trade mark legislations of EAC partner states require as a condition for continuation of the validity of trade mark after the expiry of the initial registration term of registration that the said registration be renewed. Under both Tanzanian and Ugandan trade mark legislations, trade mark registrations enjoy an initial term of seven years with the possibility of renewal of the registration for further terms, of ten years each, commencing from the date of expiration of the initial registration.<sup>90</sup> Under the Kenyan law, trade marks are initially registered for a term of ten years with a possibility of extension of the registration for further terms of ten years each.<sup>91</sup>

#### 2. Obligation to use a registered trade mark

Trade mark laws of the EAC Partner States devise a mechanism to avoid trade mark system being used as a means of granting a monopoly in words and other signs without those words and signs actually being used in relation to goods or services. For this reason, trade and service marks are protected in Tanzania and

88 Cf. BAINBRIDGE, D., "Intellectual Property" (7th ed.) 827 (Pearson Education Limited, Harlow 2009).

89 PAGENBERG, J., "The Exhaustion Principle and "Silhouette" Case", 30(1) IIC 19, 23 (1999).

90 S. 29 (1) & (2), T. & S. 21, U.

91 S. 23 (1) & (2), K. Before the amendment of the Kenyan Trade Marks Act in 2002, the initial trade mark registration term was 7 years and subsequent terms were 14 years each.

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.<sup>92</sup> The Kenyan trade mark legislation requires a trade mark to be put to genuine use within any five years.<sup>93</sup> 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.<sup>94</sup> 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),<sup>95</sup> whereas protection via an international registration system is conducted pursuant to the procedure and requirements outlined in the Madrid Agreement and the Madrid Protocol.<sup>96</sup>

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.