

Legal Alert



NOTABLE INTELLECTUAL PROPERTY DECISIONS FROM EAST AFRICA IN 2023

MMAKS Advocates|ALN Uganda reviews some of the Intellectual Property (IP) rulings/judgements from 2023 within East Africa and this list is not in any particular order. Due to increased awareness of IP rights in the region, rights owners have taken precautionary measures against infringement. These measures include the registration of their IP and enforcement through various avenues. Where these rights have been infringed upon, owners have pursued litigation, opposition, and cancellation proceedings among others. As a ripple effect, judicial and quasi-judicial bodies are taking infringement cases and setting precedents for future cases to follow. This article provides a summary of IP infringement cases in East Africa that have served as models for similar lawsuits

- 1. Those who aid and abet, the primary infringement, such as accessorial infringement are equally liable under secondary infringement.***

Garfield Spence (Konshens) vs Airtel (U) Ltd, OnMobile Global Ltd & Others, Civil Suit No. 545 of 2015-Uganda. The case concerned

about a copyright dispute between a Jamaican artist Garfield Spence, (known by the moniker Konshens) and Airtel (U) Ltd a telecommunications company in Uganda, over copyright infringement of the artist's musical works. The High Court in Uganda found Airtel (U) Ltd and OnMobile global jointly liable for unlawfully accessing and using the Plaintiff's musical works/songs as caller tunes to its customers without the plaintiff's consent. Court awarded Konshens general damages of USD.180,000 plus exemplary damages of USD.13,446, as compensation for copyright infringement. Court held that the abettors of the primary infringement are also to be held liable for infringement. Notably, this appears to be the highest award of damages in a copyright dispute in Uganda's jurisprudence. Airtel(U) has since preferred an Appeal against this decision, which at the time of writing is yet to be determined.

- 2. "Unusually reckless people, /consumers in a hurry would likely be deceived.***

Caterpillar (Quingzhou) Limited v Machinery World Limited (Civil Appeal E082 of 2022) [2023] KEHC 2442 -Kenya

This was an appeal based on grounds that the trademark was likely to deceive or cause confusion and amounted to passing off. In dismissing the appeal in favor of the Respondent, the High Court upheld the ruling of the Registrar of Trademarks and held that the Appellant's mark did not deserve protection as a well-known mark because there was no proof of use in Kenya, no proof of sale receipts and records of sale importation of products through distributors. Court observed that the goods traded by both parties were not everyday goods that would be purchased by, "unusually stupid people, fools or idiots, or a moron in a hurry", who would be likely to be confused.

3. The law permits co-existence of a trademark & different enterprises can use similar trademarks without interfering with each other's business.

Abro Industries Inc vs Abri General Traders (Civil Appeal No. 323 of 2021) [2023] TZHC 19740 (7 June 2023) – Tanzania

The appellant argued that the Respondent's mark **ABRI** was phonetically and conceptually identical to its **ABRO** Trademark. Court ruled that *there was no danger of confusion for the Appellant's mark and the Respondent's mark to co-exist in Tanzania*. Court empathized the rule that likelihood of confusion is determined by nature of the commodity, the class of its purchasers, and the mode of purchase and found that the two marks were not similar and could not cause confusion.

4. Phonetic similarity test is not applicable in company registration.

A Plus Funeral Management Limited v A-Class Funeral Services (U) Limited and Another (Civil Suit 355 of 2020) [2023] UGHCCD 186 (30 June 2023) – Uganda.

This was a trademark dispute for passing off. The Plaintiff incorporated its "**A-Plus**" name but never registered a trademark. The Defendant incorporated "**A-Class**" company dealing in similar services. Court held that test of phonetic similarity is not applicable to company registration. In deciding in favour of the Defendant, court held that it was never proved that the mourners at funeral obtained the services of the 1st defendant as a result of the confusion with the plaintiff or as an associate of the plaintiff.

5. Commonly used words cannot be trademarked, and they cannot cause confusion.

Clower SA (PROPRIETARY) Limited Vs Tropicana Product Inc (Civil Appeal No 102 of 2022) [2023] TZHC 21851 (6 October 2023)- Tanzania.

The appellant's objection was overruled on the ground that the Respondent's trademark **TROPICANA** is distinct and different visually and structurally from the Appellant's well-known mark **TROPIKA**. Court observed that the two marks viewed together were dissimilar. Court took the view that the words "**TROPIC/ TROPICAL**" are commonly used by companies that manufacture beverages in Tanzania and are commonly used internationally in goods related to mixed soft and hard drinks. The un-opposed appeal was dismissed.

6. Without proof of valid registration of a Trademark, one cannot successfully institute an infringement suit.

Godrej Consumer Products Ltd versus Target International (T) Ltd [2023] TZHCCoM D 365-Tanzania.

The case highlights the importance of renewing expired marks and locus to sue for trademark infringement. The Plaintiff failed to renew its Trademark "**HIT**" for mosquito

and insect repelling spray in the Tanzanian market. The said trademark was subsequently expunged from the register for non-use. The defendant continued to use a mark similar to that of the Plaintiff, "HIT". The court held that the Plaintiff had no sufficient close relation to the "HIT" trademark and could not successfully institute an infringement suit seeking protection, in the absence of proof of valid registration after expungement of the said trademark.

7. Intellectual Property Rights claims do not fall under the ambit of the principles for judicial review for court's determination. "COVIDEX" IP ownership rights claim.

Advocates for People & Anor vs National Drug Authority & Jena Herbals (U) Ltd M.A No. 209 of 2021-Uganda.

This was an application for judicial review challenging the decision and actions of the regulator, National Drug Authority to grant Jena permission to produce, sell and distribute COVIDEX drug, on grounds that Jena was not the rightful owner of a Patent in the COVIDEX drug under Section 20 (5) and (7) of the Industrial Property Act, 2014. In dismissing the claim/application, Court held that the claim for ownership of patent rights in Covidex does not fall under the ambit of the principles for judicial review but rather private rights which should have been claimed for by way of the ordinary procedure under the available legal regime.

8. THE TINDERET TEA FARM Case. - The Kenya Industrial Property Institute (KIPI)

This was an application for rectification of the register against the registration of Tinderet Tea as a trademark on grounds that Tinderet tea is a geographical indication originating

from Tinderet Kenya which would prevent the usage of IP rights in the word Tinderet tea farm. The Registrar held that the trademark is distinctive because the proprietor's trademark was on the market for 13 years and thus had acquired sufficient distinctiveness.

9. Protection of Well-Known Marks only applicable to defensive marks.

Trademark opposition: WAVE VS WAVE EXPRESS, Uganda Registration Services Bureau (URSB)

Wave Inc brought opposition proceedings against the registration of Wave Express on grounds similarity leading to a likelihood of confusion, though the opponent's Wave mark was not registered in Uganda, they grounded their plea on the principle of well-known marks. Wave Inc unsuccessfully argued that its mark is a well-known mark that enjoyed protection under S.47 of the Ugandan Trademarks Act. The Assistant Registrar of Trademarks reasoned and held that protection of well-known marks is only applicable to defensive marks/registration and that the same is not available to any well-known mark but rather to "exceptionally well-known" marks under the provisions of Sections 47(2) and 44 of the Ugandan Trademarks Act. The opposition succeeded.

10. Protection of a well-known mark results not from its registration, but its reputation.

Trademark Opposition: POKEMON VS POKEMON, Uganda Registration Services Bureau (URSB)

Keshwala applied for registration of Pokemon trademark which was opposed by Nintendo on grounds that it was confusingly similar to its well-known Pokemon trademark. While relying on Article 6bis of the Paris Convention for the Protection of Industrial Property, the

Registrar found that, the article extends protection to a trademark that is well-known in a member

country even though it is not registered or used in that country, the protection results from reputation and not registration. The opponent's **Pokemon** trademark was considered to be a well-known mark in accordance with Section 44 of the Ugandan Trademarks Act. The opposition succeeded.

In summary, the above article reflects the increasing rate of trademark disputes/precedents compared to other IP rights like copyrights , patents etc. This may be indicative of the presence of several trademark filings and increased IP awareness in the region. It is also positive to see that the relatively growth of IP awareness in the region has led to protective measures which include seeking judicial redress by IP rights holders.

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