

TRADE MARK REGISTRATION IN TANZANIA

Gratian B. Mali
ARDEAN Law Chambers, Dar es Salaam Tanzania
www.ardeanattorneys.co.tz

INTRODUCTION

A **TRADEMARK** is any **visible distinctive sign** used or proposed to be used upon, in connection with or relation to goods or services, for the purpose of distinguishing, in the course of trade or business, the goods or services of a person from those of another (Section 2 of the Trade and Service Marks Act Cap. 326 R.E 2002, “*hereinafter referred to as TSMA*”).

Its origin dates back to ancient times, when craftsmen reproduced their signatures, or “marks” on their artistic or utilitarian products for identification. Over the years these marks evolved into today’s system where the marks are registered and protected by laws. This system besides serving the owner of the trademark or products manufacturers to market their products or services, it on the other hand helps the consumers to identify, choose and finally purchase a product or service because of its quality as it has been displayed by the trade mark owner over the years.

A **visible** sign means any sign which is capable of graphic reproduction, including words, name, brand, devise, heading, label, ticket, signature letter number, relief, stamp, seal, vignette, emblem or any combination thereof (Sect. 2 TSMA)

Trade marks in Tanzania are regulated by:-

- (i) The Trade and Service Marks Act Cap. 326 R. E 2002
- (ii) The Trade and Service Marks Regulations Government Notice No.40 of 2002
- (iii) Zanzibar Industrial Property Act, Act No. of 2008
- (iv) The Zanzibar Industrial Property Regulations of 2015;
- (v) The Merchandize Marks Act Cap.85 R.E 2002; and
- (vi) The Merchandize Marks Regulations Government Notice No. 89 of 2008.

While the Trade and Service Marks Act and its regulations provide for registration and protection of trade marks in Mainland Tanzania, the Zanzibar Industrial Property Act and its regulations provide for registration and protection of trade marks in Tanzania Zanzibar. It is important to note that Tanzania is a United Republic of Tanganyika (Mainland Tanzania) and Zanzibar. Despite of the union of 1964, these two former Republic still maintain different pieces of statute for intellectual property. Thus, registration and protection of a trade mark secured in the mainland does not extend to Zanzibar and the vise versa is true.

IMPORTANCE OF TRADEMARK

A trademark provides protection to the owner of the mark by ensuring **exclusive right** to use it to identify goods or services, or to authorize another to use it in return for payment. It is provided by section 31 of the Trade and Service Mark Act, that: “...*the registration of a trade or service right mark shall, if valid, give or deemed to have given to the registered proprietor the **exclusive right** to the use of a trade or service mark in relation to any goods including sale, importation and offer for sale or importation*”

The essential function of a trademark is to uniquely identify the commercial source or origin of products or services. The use of a trademark in this way is known as ‘trademark use’ and a trademark owner seeks to enforce its rights or interests in a trademark by preventing unauthorized trademark use.

In a larger sense, trademarks promote initiative and enterprise worldwide by rewarding the owners of trademarks with recognition and financial profit. Trademark protection also hinders the effort of unfair competitors, such as counterfeiters, to use similar distinctive signs to market inferior or different products or services. This is also supported by the Merchandize Marks Act Cap.85 R.E 2002. The system enables people with skill and enterprise to produce and market goods and services in the fairest possible conditions, thereby facilitating national and international trade.

REGISTRABILITY REQUIREMENTS

A trademark is eligible for registration if it functions as a trademark and is not generic or descriptive. It is provided by section 16(1) of TSMA that “*A trade or service mark shall be registered if it is distinctive*”. A trade mark is distinctive if it is capable of distinguishing goods or services with which its appropriator is or may be connected in the course of trade or business. Trademarks may be one or a combination of words, letters, and numerals. They may consist of drawings, symbols, three- dimensional signs such as the shape and packaging of goods, audible signs such as music or vocal sounds, or fragrances used as distinguishing features.

In determining whether a trade or service mark is capable of distinguishing particular products or services from others, the following must be considered:-

- a) The category to which the trade or service mark is inherent capable of distinguishing as aforesaid
- b) Regard shall be to the extent to which by reason of the use of the trade mark or service mark or of any other circumstances, the trade or service mark is in fact capable of distinguishing. For example, marks which identify or describe a product or service, or which are in common use, or which are used as geographical indicators, must remain available for use to anyone. For this reason, a generic term such as ‘apple’ or descriptive term such as ‘red’ or ‘juicy’ generally could not be registered in relation to apples.

A good example is the case of **Nichols plc v. Registrar of Trade Marks (Case C-404/2004)** of the UK. The applicant applied for the registration in the United Kingdom a trade mark of the surname “ Nichols” for vending machines, food and drink typically dispensed through such machines. The respondent Registrar in judging the capacity of a surname to distinguish goods or services , said that consideration would be given to the commonness of the name, based on a specified number of times that it appeared in an appropriate telephone directory, and to the number of undertakings engaged in the relevant trade. The registrar, having noted that “ Nichols” or phonetically similar names appeared more than the specified number of times in the London telephone directory, refused registration in respect of food and drink, but granted it in respect of vending machines, on the ground that the size of the market in the first case was large, but in the second was more specialized.

Generally, the proposed trade mark must be distinctive so that consumers can **distinguish** it as identifying particular product, from other trademarks identifying other products. It must neither mislead nor deceive customers or violate public order or morality.

Effects of Limitation of Absence of Colour

A trade or service mark is required to be limited in whole or in part to one or more specified colours, and in any such case the fact that it is so limited may be taken into consideration in deciding on the distinctive character of the trade mark. If whenever in any circumstances a trade or a service mark is registered without limitation of colours, it shall be deemed to have registered for all colors (Section 17 of TSMA).

REGISTRATION PROCEDURE

A person processes to use a trade or service mark is required to lodge his application to the Registrar of trademark (section 21 of TSMA, 1986). The application must be made by filling in and filing form TM/SM 2 that must be accompanied by form TM/SM3.

Form TM/SM2 requires the following information to be provided:-

- The name and full address of the applicant;
- The trade or business description of the applicant. Description and nationality of individual, firm or body corporate should be given. If the applicant is a firm (partnership), the names of all partners must be given in full. If the applicant is a body corporate, the kind and country of incorporation should be given.

- Trade or services mark proposed for registration. If the applicant is a foreign entity and the trade mark is already registered in another country, proof of registration must be given.
- A list of goods or services to which the sign would apply (class);
- A declaration that the applicant or his proposed registered user is using or proposes to use the trade mark within Tanzania.

The application form TM/SM2 together with about 8 loose representations of a mark (in form TM/SM3) are submitted to the Registrar for examination.

Where a person applying has applied for protection for any trade or in a country which is party to the **Paris Convention for Protection of Industrial Property, 1983** is entitled to claim the benefits of the earlier application. When he succeeds, his application will be deemed to be of the same date of application in the country provided that application for registration in Tanzania is made within Tanzania is within six months from the date of earlier application (section 22(1)).

The rights applied for cannot be the same as, or similar to, rights already granted to another trademark owner. This may be determined through **search** and **examination** by the Registrar, or by the **opposition of third parties** who claims similar or identical rights. (Section 26 and 27)

Application for Registration must be submitted by appointed Agent of the Applicant together with FORM No. TM/SM1. This is a requirement of Regulation 11 of the Trade and Service Marks Regulations of 2002. Thus, the applicant is required to appoint an Agent who, by virtue of the provisions of Regulation 11(3) must be:

- A person of Tanzania nationality;
- Having a domicile or place of business in Tanzania;
- An advocate of the High Court; or a person approved by the Registrar after successful passing examination conducted by the Registrar; or
- Is a member of the Chartered Institute of Trade and Service Marks Agents.

EXAMINATION

Upon filing of application for registration of a trade mark and payment of the prescribed fee, the Registrar is required to examine the application as to:-

- a) Conformity with the formalities required;
- b) The registability of the trade mark;
- c) Whether the trade and service mark is required to be associated.

Where the Registrar is satisfied with the application of the applicant will accept the same and issue a letter of acceptance to the applicant and proceed to advertise the proposed mark in the Trade and Services Marks Journal (Section 26(2)).

OPPOSITION OF THIRD PARTIES (SECTION 27)

Any person may, within sixty (60) days from the date of advertisement of an application give notice to the Registrar of opposition to the registration of a trade or service mark. The opposition party must state the grounds for his opposition that the application does not satisfy the requirements of the law. Among the grounds which may be raised are:-

- a) That, the trade mark cannot be validly registered in respect of any goods or services because it is identical with a trade or services mark belonging to him or different proprietor and already on the register in respect of the same goods or services or closely related goods or services; or
- b) That, the mark or service cannot be validly registered in respect of any goods or services because it nearly resembles such a trade or service mark of different proprietor as to be likely to deceive or cause confusion as to the nature, geographical or origin; or
- c) That, the trade or service mark cannot be registered in respect of any goods or service because the use of it is contrary to the law or morality.

The notice of opposition must be made in writing with a statement of the grounds for the opposition in form TM/SM 34. The Registrar is required to send a copy of that notice to the applicant who will within the prescribed time send to the Registrar a counter settlement of the grounds on which he relies for his application. If the applicant sends such counter statement as aforesaid, the Registrar will furnish a copy thereof to a person giving notice of opposition. Thereafter, the registrar shall hear the parties if so required and make decision thereof. A party dissatisfied by the decision of the Registrar may appeal to the High Court.

Where the application for registration of a trade or service mark has been accepted, the Registrar shall register the trade and service mark. The registration shall be effective as from the date on which the application for registration was received and shall remain valid for a period of 7 years (Section 29) and may be renewed from time to time for a term of 10 years.

EFFECT OF REGISTRATION

One of the effects of registration is to disentitle any person to institute any proceedings to prevent or to recover damages for infringement of unregistered trade mark. However this restriction is not available for action against any person for passing off goods or service of another person or the remedied in respect thereof (Section 30)

Upon registration, the registered proprietor acquires exclusive right to the use of the trade or service mark in relation to any goods including sale, importation and offer for sale or importation.

TRADE MARK INFRINGEMENT

Registering a trade mark provides the proprietor with certain exclusive rights. The infringement of these rights entitles him a right to action against the infringer. Pursuant to section 32(1) of the Trade and Service Marks Act, 1986 the proprietor's exclusive rights are deemed to be infringed by any person who is not the proprietor of trade mark or registered user thereof uses a sign either:-

- Identical with or so nearly resembling it as to be likely to deceive or cause confusion, in the cause of trade or business, in relation to any good in respect of which it is registered; or
- Identical with or nearly resembling it in the course of trade or business in any manner likely to impair the distinctive character or acquired reputation of the trade mark.

The elements for a successful infringement claim have been well established under both statutes and case law. In a nutshell, a plaintiff in a trade mark case has the burden of proving that the defendant's use of a mark has created likelihood-of-confusion about the origin of the defendant's goods or services. To do this, the plaintiff should first show that the defendant is using a confusingly similar trademark in such a way that it creates a likelihood of confusion, mistake and/or deception with the consuming public. The confusion created can be that the defendant's products are the same as that of the plaintiff, or the defendant is somehow associated, affiliated, approved or sponsored by plaintiff.

Seven factors for likelihood of confusion

To analyze whether a particular situation has developed the requisite "likelihood of confusion," courts have generally looked at the following factors:-

1. The similarity in the overall impression created by the two marks (including the marks' look, phonetic similarities, and underlying meanings);
2. The similarity of goods and services involved (including an examination of the marketing channels for the goods);
3. Any evidence of actual confusion by consumers;
4. The intent of the defendant in adopting its mark;
5. The physical proximity of the goods in the retail marketplace;

6. The degree of care likely to be exercised by the consumer; and
7. The likelihood of expansion of the products lines.

CONCLUSION

It is important to take necessary steps to have a trade mark registered. After, registration is also important to ensure that a trade mark has to be renewed after seven years. Any renewal thereafter lasts for ten years and then renewed consecutively. Where the owner of the mark decides to assign it to someone else, this matter has to be communicated to the Registrar for registration and endorsement. Any change of name or address must be communicated to the Registrar. The same case applies to Mergers, Registered users (also known as licensing) and any other change in particulars registered.