

## Table of contents

Preface	5
Table of contents	7
List of abbreviations	15
Chapter1: General introduction	19
Chapter 2: The absence of common trade mark regime in the East African Community	23
A. Introduction	23
B. Institutions responsible for trade mark registration	23
C. Substantive Provisions	24
I. Subject matter of trade-mark protection	24
1. Tanzanian law	25
2. Kenyan and Ugandan laws	25
II. Grounds for trade mark refusal	27
1. Absolute Grounds	27
a) Distinctiveness	27
aa) Under the Tanzania Trade Mark Law	27
bb) Under the Kenyan and Ugandan Trade Mark Laws	28
b) Descriptive and generic marks	29
c) Trade Marks based on a shape of the goods	31
aa) The Tanzanian Law	31
bb) The Kenyan and Ugandan laws	31
d) Other absolute grounds	32
aa) Under the Tanzanian Law	32
bb) Under the Kenyan and Ugandan laws	33
2. Relative grounds	33
a) Prior registered trade mark	33
b) Prior unregistered trade mark	34
c) Business or company name	35
d) Trade mark application filed in the name of agent	35
D. Trade mark opposition and cancellation procedure	35
E. Infringement of a registered trade mark	36

I.	Scope of protection	36
1.	Use of a mark as a trade mark	37
2.	The use of business or company names	38
3.	Trade mark with reputation	38
II.	Limitation to the exclusive rights	39
1.	Use of one's own name	39
2.	Descriptive use of a trade mark	39
3.	Honest concurrent use of trade marks	40
4.	Exhaustion of trade mark rights	40
III.	Duties in relation to a registered trade mark	41
1.	Renewal of registration	41
2.	Obligation to use a registered trade mark	41
F.	International trade mark registration	42
G.	Concluding remarks	43
Chapter 3: The free movement of trade-marked goods in the East African Community		45
A.	Introduction	45
B.	The Principle of free movement of goods	45
I.	Legal basis	45
1.	The EAC Treaty (EACT)	45
2.	The EAC Common Market Protocol (CMP)	46
3.	The EAC Customs Union Protocol (CUP)	46
II.	Trade mark rights in the Common Market	47
1.	The Common Market Protocol	48
2.	The Customs Union Protocol	50
C.	Possible solution to the mischief	51
I.	Principles of trade mark law	51
1.	Trade mark functions	52
a)	Trade mark as a badge of origin	52
b)	Trade mark as a guarantee of quality	53
c)	Trade mark functions and markets compartmentalization	54
aa)	Guarantee of origin	55
bb)	Guarantee of quality	56
2.	The Principle of trade mark exhaustion	57
a)	Forms of trade mark exhaustion	57
b)	National exhaustion	58
c)	International exhaustion	59
d)	Regional Exhaustion	61
3.	Trade Mark Exhaustion in the EAC	62
a)	The general rule	62

aa) The Tanzanian law	62
bb) The Kenyan and Ugandan laws	63
b) Exception to the general rule	64
aa) The Tanzanian law	64
bb) The Kenyan and Ugandan laws	64
c) Conclusion thereof	65
4. Place of sale for the purpose of exhaustion	65
a) The Tanzanian law	65
b) The Kenyan and Ugandan laws	65
II. Relevant principles of international law	67
1. TRIPs Agreement	67
a) Legislative freedom under Article 8 TRIPS	67
b) The chapeau	67
c) The national trade mark exhaustion meets TRIPS' minimum standards	68
d) The debate on Article 6 TRIPS	69
2. The GATT 1994	70
a) The national treatment	71
b) The most favoured nation principle	71
c) Prohibition of quantitative restrictions under Article XI GATT	73
d) The general exception clause under Article XX GATT	74
aa) Provisos under Paragraph (d) of Article XX GATT	75
bb) Provisos under the chapeau	77
D. Concluding remarks	77
Chapter 4: Overview of the European Community trade mark system	79
A. Introductory remarks	79
B. Office responsible for CTM system	80
C. Subject matter of CTM protection	81
I. Substantive requirement – the capability to distinguish	82
II. Formal requirement – the graphical representation	83
III. Essence of the formal requirement	83
IV. Formal and substantive requirements vis-à-vis non-traditional marks	84
1. Smells	85
2. Sounds	87
3. Colours	88
D. Grounds for Trade Mark Refusal	90
I. Absolute Grounds	90
1. Requirements of Article 4 of the CTMR	90
2. Distinctiveness	91

3. Descriptiveness	95
4. Generic Signs	100
5. Shape Marks	102
6. Further absolute grounds – Article 7(1) (f) – (k)	105
7. Acquired distinctiveness and public policy	108
II. Relative grounds for refusal	111
E. CTM infringement	112
I. Scope of CTM protection	112
1. Article 9 of the CTMR	112
2. Article 8 of the CTMR	114
II. Likelihood of confusion	118
1. CTM function and likelihood of confusion	118
2. In whose view is the likelihood of confusion determined?	120
3. Thresholds of likelihood of confusion	122
a) Similarity of trademarks	122
aa) Visual similarity	122
bb) Aural or phonetic similarity	124
cc) Conceptual similarity	126
b) Similarity of goods and/or services	128
4. Likelihood of association	131
III. Trademark use as a condition for infringement	131
IV. Protection of a CTM with reputation	133
1. Reputation – what is it?	133
2. Infringing use in relation to a CTM with reputation	135
a) Unfair advantage	135
b) Detriment	136
c) Without due cause	137
V. Limitations to CTM rights	137
1. Honest use of a CTM	137
a) Use of one's own name and address	138
b) Descriptive use of a CTM	139
c) Use of a CTM to indicate intended purpose	139
d) Proviso to Article 12	141
2. Exhaustion of CTM rights	141
VI. Duties in relation to CTM	142
1. Renewal of CTM registration	142
2. Obligation to use a CTM	142
VII. Key principles relating to precedence of CTM rights	145
1. Priority Right	145
2. Seniority right	146
F. CTM Application and Opposition proceedings	146
I. CTM application	147

1. Procedure and contents	148
2. Search procedure	149
II. Opposition against CTM registration	152
1. Objection procedure	153
2. Grounds for opposition	154
3. Entitlement to file a notice of opposition	155
4. Opposition proceedings	156
5. Strategies and defences	157
G. Cancellation of CTM rights	160
I. Revocation	160
1. Non-use	160
2. Improper use of a CTM	161
II. Invalidity	162
1. Absolute grounds for invalidity	163
2. Relative grounds for invalidity	166
III. Effects of CTM revocation and invalidity	166
H. International Registration Procedure under the CTMR	167
I. EC as a designated territory	168
II. CTM registration or application as a basis for international registration	170
 Chapter 5: Interplay between Community trade mark and trademark systems of EU member states	 173
A. Introduction	173
B. Essential aspects of Community trade mark system	174
I. Co-existence of trade marks	174
II. Seniority	176
1. Requirements for seniority	177
a) Status of the earlier national trademark	177
b) Triple identity rule	177
aa) Identity of the marks	178
bb) Same owner	178
cc) Identical goods and/or services	178
2. Examination of seniority claim	179
3. Merits and demerits of seniority right	180
a) Merits	180
b) Demerits	181
III. Trade mark conversion	182
1. Grounds for conversion	182
a) Withdrawal of a Community trade mark application	182
b) Cessation of effects of Community trade mark	183

c) Refusal of registration	183
d) Successful cancellation proceedings	184
2. Grounds for excluding conversion	184
a) Non-use of a Community trade mark	184
b) Grounds for refusal available in one Member State	184
C. Enlargement of the European Union and Community trade marks	185
I. Automatic extension of Community trade marks	185
1. Absolute grounds for trademark refusal	185
2. Opposition against registration of Community trade marks	186
3. Cancellation of Community trade marks	186
II. Preservation of earlier rights under national law	187
D. Enforcement of Community trade mark rights	187
I. Application of Brussels Regulation	188
II. Community trade mark courts	189
1. Jurisdiction over infringement and invalidity proceedings	190
a) Infringement actions	191
b) Validity of a Community trade mark	192
2. International jurisdiction	192
a) Connection of parties and courts	193
b) Factors contained in the Brussels Regulation	194
c) Place where harmful act takes place	195
3. Delimitation of jurisdiction	195
4. Related, simultaneous and successive actions	196
a) Similar Community trade mark claims	196
b) Related Community trade mark and national trade mark claims	197
5) Jurisdiction to award temporary reliefs	199
III. Applicable law	200
1. Rome II Regulation	200
2. Community Trade Mark Regulation	201
a) General applicable law	201
b) The law applicable to sanctions	202
c) Efficacy of <i>lex loci delicti</i> rule	203
IV. Recognition and enforcement of Judgments	204
E. Concluding remarks	206
 Chapter 6: Free movement of branded goods in the European Union	207
A. Introduction	207
B. Legal basis for free movement of branded goods	208
I. The Treaty on the Functioning of the European Union	208
II. Principles developed by the ECJ	209

1. Existence and exercise of intellectual property	209
a) Grundig	211
b) Parke	212
c) Sirena	213
d) Deutsche Grammophon	214
2. Specific subject-matter of intellectual property	215
3. Essential function of a trade mark	216
<b>C. Exhaustion of trade mark rights</b>	<b>217</b>
I. Delineation and forms of trade mark exhaustion	217
II. Rationale of Community trade mark exhaustion	218
III. Conditions for Community trade mark exhaustion	220
1. Putting goods on the market	221
2. Consent	223
a) Consent is given for specific goods	223
b) Express and implied consent	224
c) Contractual restrictions do not vitiate consent	225
3. Burden of proof in relation to exhaustion	226
IV. Factors vitiating exhaustion	227
1. Repackaging and re-affixing of a trade mark	229
a) Artificial partitioning of the common market	230
b) Condition of goods	231
c) Notice of repackaging	231
d) Identity of a person who repackaged the goods	232
e) Reputation of a trade mark	233
2. Extension of repackaging principles to other case scenarios	234
a) Rebranding	234
b) Removal of a stock code	234
c) Reworked products	236
<b>D. Concluding summary</b>	<b>236</b>
<b>Chapter 7: A model trade mark regime for the East African Community</b>	<b>239</b>
<b>A. Introduction</b>	<b>239</b>
<b>B. Key Principles governing Community trade mark system</b>	<b>240</b>
I. The principle of unitary character	240
II. The principle of Coexistence of trade mark rights	241
III. Interaction between trade mark coexistence and unitary principles	242
<b>C. Principles that should govern the EAC trade mark system</b>	<b>243</b>
I. Modifications to the principle of unitary character	244
1. Abandonment of the unitary principle	245

2. Unitary character not to be defined by the entire scale of the regional bloc	245
3. Justifications for the proposed modifications to the unitary principle	246
a) Free movement of goods	246
b) Competition in trade-marked goods	247
c) Unitary character as a means of expansion of economic activities	248
II. Modifications to the principle of co-existence	249
1. Abolition of the national trade mark	249
2. Coexistence as a transition solution	250
a) Incentives to ensure that the national system fades away	250
b) The Benelux model: Transforming existing national trade marks into EAC trade marks	251
3. The German trade mark model	252
D. The Proposal for the EAC trade mark regime	256
I. Acquisition of trade mark rights and the extent of validity	257
1. Non-examination system at national offices	257
2. Examination system at the EAC trade mark office	258
3. Trade mark use requirement and the consequences thereof	259
a) The use requirement	259
b) Consequences of non-compliance with the use requirement	259
II. Integration of the existing national trade mark rights into the EAC trade mark regime	261
1. National trade mark registrations	261
2. Applications for national trade marks	261
3. Conciliation board	262
Bibliography	265