

**AN ANALYSIS OF THE EFFECTIVENESS OF TRADE MARKS PROTECTION OF
BRAND VALUE OF BUSINESS IN UGANDA.**

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**A RESEARCH REPORT SUBMITTED TO THE FACULTY OF
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DECLARATION

[**Talemwa Rachael** declare that this dissertation is my original work and to the best of my knowledge it has not been presented for a degree or any other academic award in any university or institution of learning.”



28/06/2019

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Date

APPROVAL

confirm that the work put in this dissertation was carried out by the student under my supervision.



Counsel Uwizera Franklin

Supervisor

28th JUNE 2019

Date

DEDICATION

I humbly dedicate this research to my mum Ms. Katusabe Harriet who has been there morally, psychologically and physically since childhood, May the Almighty reward you abundantly mummy and promise to love you unconditionally.

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I am grateful to the Almighty father of heaven and earth for being with me throughout the whole period when pursuing this Bachelors degree in laws.

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TABLE OF STATUTES

The Constitution of the Republic of Uganda 1995 as amended

The Copyright Act Cap 81

The Industrial Property Act 2014

The penal code Act cap 106

The Uganda National Council for Science and Technology Statute No.1 of 1990

The United Kingdom Designs (Protection) Act cap 84

Trademarks Act, 2010

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Uganda Vs Walugembe Joseph CR 284/16.

TABLE OF ACRONYMS

ARIPO	African Regional Intellectual Property Organization
HIV	Human Immune Virus
IPA	Intellectual Property Act
IPR	Intellectual Property Right
MFN	Most Favored Nation
MTEF	Medium-Term Expenditure Framework
SME's	Small and Medium Enterprises
TRIPS	Trade Related Aspects of Intellectual Property Rights
TV	Television
UK	United Kingdom
UNCST	Uganda National Council for Science and Technology
UNECA	United Nations Economic Commission for Africa
UPPC	Uganda Printing and Publishing Corporation
URSB	Uganda Registration Services Bureau
WIPO	World Intellectual Property Organization
WTO	World Trade Organisation

TABLE OF CONTENTS

DECLARATION.....	i
APPROVAL.....	ii
DEDICATION.....	iii
ACKNOWLEDGEMENT.....	iv
TABLE OF STATUTES.....	v
LIST OF CASES.....	vi
TABLE OF ACRONYMS.....	vii
TABLE OF CONTENTS.....	viii
ABSTRACT.....	x
CHAPTER ONE.....	1
INTRODUCTION.....	1
1.0 Introduction.....	1
1.1 Background of the study.....	1
1.2 Problem statement.....	4
1.3 General objective.....	4
1.4 Objectives of the study.....	5
1.5 Research Questions.....	5
1.6 Scope of the Study.....	5
1.6.1 Geographical Scope.....	5
1.6.2 Time Scope.....	5
1.6.3 Content Scope.....	5
1.7 Literature Review.....	6
1.8 Methodology of the study.....	10
1.9 Chapterization.....	10
CHAPTER TWO.....	11
LEGAL FRAMEWORK FOR TRADEMARKS PROTECTION AND BRAND VALUE IN UGANDA.....	11
2.0 Introduction.....	11
2.1 Conceptualization of Trademarks.....	11

2.2 Legal Framework for Trademarks Protection and Brand Value in Uganda.....	14
CHAPTER THREE.....	24
INTERNATIONAL AND REGIONAL FRAMEWORKS FOR TRADEMARKS PROTECTION AND ITS RELATEDNESS TO UGANDA’S TRADEMARK ACT 2010 ..	24
3.0 Introduction.....	24
3.1 International Frameworks for Trademarks Protection and its Relatedness to Uganda’s Trademark Act 2010	24
3.2 Regional Frameworks for Trademarks Protection and its Relatedness to Uganda’s Trademark Act 2010.....	28
3.3 Relationship of the regional and international trademarks with that Uganda	29
3.4 Conclusion	33
CHAPTER FOUR	34
CHALLENGES TO INTELLECTUAL PROPERTY RIGHTS IN UGANDA	34
4.0 Introduction.....	34
4.1 Legal challenges	34
4.2 Conclusion	44
CHAPTER FIVE	45
FINDINGS, CONCLUSIONS AND RECOMMENDATIONS	45
5.0 Introduction.....	45
5.1 Summary of findings	45
5.1.1 Legal Framework for Trademarks Protection and Brand Value in Uganda.....	45
5.1.2 International and Regional Frameworks for Trademarks Protection and its Relatedness to Uganda’s Trademark Act 2010.....	45
5.1.3 Challenges to Intellectual Property Rights in Uganda.....	46
5.2 Conclusions.....	46
5.3 Recommendations.....	47
REFERENCES	49

ABSTRACT

This research was based on an analysis of the effectiveness of trademarks protection of brand value of business in Uganda. It was based on three specific objectives; examination of the legal framework for trademarks protection and brand value in Uganda, to depict the international and regional treaties for trademarks protection and its relatedness to Uganda's trademark Act 2010, to examine the challenges to intellectual property rights in Uganda and to provide for the discussion of findings, conclusions and recommendations on trademarks protection. The study was conducted using a doctrinal research method which helped in description of the issues behind intellectual property rights in Uganda and the globe at large. The study therefore requires studying law as a distinct specialty. The method exposed the researcher to statutory formulations, analysis of legal concepts and fundamental formulations. The study concluded that Uganda is a signatory to several intellectual property treaties relating to trademarks at the international and regional levels and of all these treaties, the TRIPS Agreement stands out as the most comprehensive as it establishes minimum levels of trademarks protection and enforcement expected of member states. The study recommended that the Ugandan law on trademark makes it mandatory for the courts to order disposal of counterfeit goods outside the commercial channels or destruction thereof. In the case of destruction, the law should prescribe the manner of destruction as well as the period within which such destruction should take place. It further proposed that a clear formula for assessing damages is codified to guide the courts in determining the amount of damages to award in infringement cases. In the alternative, the law can provide for statutory damages.

CHAPTER ONE

INTRODUCTION

1.0 Introduction

This chapter provides for the introduction, background to the study, problem statement, purpose and objectives of the study, research questions, significance, scope, literature reviewed by various authors and the methodology which were applied to accomplish the research.

1.1 Background of the study

Globally, the first modern trademark laws emerged in the late 19th century for instance in France the first comprehensive trademark system in the world was passed into law in 1857 with the "Manufacture and Goods Mark Act". In Britain, the Merchandise Marks Act 1862 made it a criminal offence to imitate another's trade mark 'with intent to defraud or to enable another to defraud'. In 1875, the Trade Marks Registration Act was passed which allowed formal registration of trade marks at the UK Patent Office for the first time. Registration was considered to comprise *prima facie* evidence of ownership of a trade mark and registration of marks began on 1 January 1876. The 1875 Act defined a registrable trade mark as 'a device, or mark or name of an individual or firm printed in some particular and distinctive manner or a written signature or copy of a written signature of an individual or firm or a distinctive label or ticket'.¹

In the United States, Congress first attempted to establish a federal trademark regime in 1870. This statute purported to be an exercise of Congress' Copyright Clause powers. However, the Supreme Court struck down the 1870 statute in the Trade-Mark Cases later on in the decade. In 1881, Congress passed a new trademark act, this time pursuant to its Commerce Clause powers. Congress revised the Trademark Act in 1905.² The Lanham Act of 1946 updated the law and has served, with several amendments as the primary federal law on trademarks.³ The Trade Marks

¹L.Bently, "the making of modern trade marks law, the construction of the legal concept of Trade Mark (1860-80)" in Lionel Bently, 2008.

²A. Chasser, "A Historical Perspective: the international Trademark Association and the United States Patent and Trademark Office, (2003).

³W. Roger, Monetary Damages under the Lanham Act; Eighth Circuit Holds actual confusion is not a Prerequisite. 77 (2012).

Act 1938 in the United Kingdom set up the first registration system based on the “intent-to-use” principle. The Act also established an application publishing procedure and expanded the rights of the trademark holder to include the barring of trademark use even in cases where confusion remained unlikely which served as a model for similar legislation elsewhere.⁴

In countries like America, all jurisdictions with a mature trademark registration system provide a mechanism for removal in the event of such *non use* which is usually a period of either three or five years. The intention to use a trademark can be proven by a wide range of acts as shown in the "Woolly Bull" and *Aston v Harlee* cases. In the U.S failure to use a trademark for this period of time will result in abandonment of the mark, whereby any party may use the mark.⁵

In Africa, the Sub-Sahara African countries have also gone a step further by creating a regional institution in intellectual property rights. This is known as the African Regional Intellectual Property Organization (ARIPO).⁶ The history of ARIPO goes back to the early seventies when a regional seminar on patents and copyright for English speaking African countries was held in Nairobi. That seminar recommended that a regional industrial property organization be set up. In 1973, the United Nations Economic Commission for Africa (UNECA) and the World Intellectual Property Organization (WIPO) responded to a request by these English speaking African countries for assistance in pooling their resources together in industrial property matters by establishing a regional organization.

Regional protection of trademarks in African states that are member states to the Banjul Protocol on marks is achieved through registration of trademarks in a member state through Aripo secretariat offices or directly through the intellectual property office of the member state. The African regional intellectual property organization which is an intergovernmental organization for cooperation among African states on matters of intellectual property is entrusted with the registration of marks and the administration of such registered marks on behalf of contracting

⁴World Intellectual Property Organization, Introduction to Intellectual Property; Theory and Practice. Kluwer Law International, (1997) p.23.

⁵ Lech, Mikołaj, "the oldest registered trademarks in the world, Trademark Blog, (2018), accessed on 1st May 2019.

⁶ Membership of ARIPO Botswana, the Gambia, Ghana, Kenya, Lesotho, Malawi, Mozambique, Namibia, Sierra Leone, Somalia, Sudan, Swaziland, Tanzania, Uganda, Zambia and Zimbabwe.

states.⁷ However, the registration of a mark remains valid for a period of 10 years from the filing date and may be renewed for further periods of 10 years. The renewal of the registration must be affected on or before the date of expiration of the original registration or of the last renewal of the registration though a grace period of 6 months is allowed, in either case, on payment of a surcharge.⁸

In Uganda, Trademarks is governed by the Trademarks Act, 2010 which was enacted to align to the country's international obligations more especially under the TRIPS.⁹ The Trademarks Act, 2010 repealed the Trademarks Act Cap 217 which was considered outdated since it was based on the repealed trademark law of Britain.¹⁰ So in addition to the overriding need to meet international obligations, there was need to provide for contemporary developments in trademark law.¹¹ Based on the TRIPS framework, the Trademarks Act, 2010, widened the scope of trademark protection and strengthened the enforcement measures. Of particular significance is the introduction of criminal enforcement provisions in the Trademarks Act, 2010 which were intended to crack the whip against trademark counterfeiters.¹² However, the new law notwithstanding, anecdotal evidence from reports¹³ in Uganda still suggests a high prevalence of counterfeit trademarked goods¹⁴ including consumer items such as electronics, shoe polish, detergents, cosmetics, toothpaste, toilet paper, mineral water and drugs and medicines.¹⁵ In addition to violating the owner's trademark rights, these products often fall short of quality standards and are therefore harmful to human health and life. This raises fundamental questions

⁷I. Ninsiima, How to have a trademark recognized and protected in one or several African states, trademarks in Uganda, 2017, p.6.

⁸Ninsiima Irene, as above.

⁹ ULRC, a Study Report of Intellectual Property Rights: Trademarks and Service marks Law, (Law Commission Publication. No. 15), 2004, p.9.

¹⁰ The Trademarks Act, Chapter 217.

¹¹ULRC (2004), 12.

¹² Ibid at p.6.

¹³ R.K, Ahimbisibwe, "Counterfeiting and Its Impact on Social Economic Development, accessed on 10th April 2019.

¹⁴M. Leesti and T. Pengelly, Technical and Financial Co-operation Needs for Implementation of the WTO TRIPS Agreement in Uganda, Switzerland, 2007, p.12.

¹⁵ EC, "Combating Counterfeiting and Piracy in the Single Market" cited an example of the damaging effects of counterfeiting upon public health and safety is in Uganda where the National Drug Authority discovered expired anti-bacterial drugs labeled as a quinine mixture, p.18.

about the adequacy and effectiveness of the law and the institutions mandated to protect and enforce the law of trademarks in Uganda.¹⁶

1.2 Problem statement

Despite the fact that the Uganda Trademarks Act, 2010 was enacted in response to TRIPS requirements like putting in place a robust Intellectual Property Rights protection system and an enforcement framework to curtail the manufacture, importation and exportation of goods or services bearing infringing trademarks. With the Trademarks Act, 2010 in force, it was anticipated that cases of trademark infringement more so through egregious acts such as counterfeiting which were on the rise, would be curtailed. However, it is not the case for Uganda because her market continues to be flooded with products bearing infringing trademarks and several consumer products have been affected ranging from electronics to shoe polish, toothpaste, toilet paper, mineral water, drugs and medicines.¹⁷ Further, the problem is compounded by Uganda's heavy reliance on imported products mainly from Asian countries such as China,¹⁸ where most of the infringing products are said to originate.¹⁹ When applicable property rights are infringed on, there is insufficient information about the system to use in their defense.²⁰ Therefore the study analyzed the effectiveness of trademarks protection on brand value of businesses in Uganda.

1.3 General objective

To analyze the effectiveness of trademarks protection on brand value of businesses in Uganda.

¹⁶ Ibid.

¹⁷ EC Green Paper "Combating Counterfeiting and Piracy in the Single Market" cited an example of the damaging effects of counterfeiting upon public health and safety is in Uganda where the National Drug Authority discovered expired anti-bacterial drugs labeled as a quinine mixture. Also see: DPP Illicit Trade Prosecution Manual, p.18.

¹⁸ Leesti n14 as seen above at p.18.

¹⁹ The USTR's, Notorious Markets List reported that many sources identify China as the source of counterfeit products sold illicitly in markets around the world, 2014.

²⁰ D. Angualia, trademarks in Uganda, dangers of using unregistered trademarks and benefits of registration, Tuesday 11 October, 2006, p.7.

1.4 Objectives of the study

- i) To examine the legal framework for trademarks protection and brand value in Uganda.
- ii) To depict the international and regional treaties for trademarks protection and its relatedness to Uganda's trademark Act 2010.
- iii) To examine the challenges to intellectual property rights in Uganda.
- iv) To provide for the discussion of findings, conclusions and recommendations on trademarks protection

1.5 Research Questions

- i) What is the legal framework for trademarks protection and brand value in Uganda?
- ii) What are the international and regional treaties for trademarks protection and its relatedness to Uganda's trademark Act 2010?
- iii) What are the challenges to intellectual property rights in Uganda?
- iv) What are the conclusions and recommendations on trademarks protection in Uganda?

1.6 Scope of the Study

1.6.1 Geographical Scope

The study was conducted from Uganda.

1.6.2 Time Scope

The study was carried out for a period of four months that is to say from February 2019 to June the same year.

1.6.3 Content Scope

Content of this study was based on examination of Trademarks Act 2010 of Uganda and the 1995 constitution of the republic of Uganda which depicts a picture of what should be in the research. However, case laws in regard to trademark protection were considered. The study also considered international and regional instruments in regard to trademarks act of 2010.

..7 Literature Review

Various literatures have been written in regard to trademarks and brand value as seen below;

In his present work on intellectual property law, Narayanan gives an authoritative commentary on the entire gamut of this multifaceted law and explains, inter alia that though there is no copyright in ideas yet the copyright in a work giving expression to the idea in a material form automatically subsists as soon as the work comes into existence, provided it is original. If a design is registered under the designs Act of 1911, it is not eligible for protection under the copyright Act. Beneficial though they are, the changes introduced in the new millennium enormously increased the scope of piracy of intellectual property and against which the present law appears inadequate.²¹

In their exciting new book, the origin of brands, the Rieses take Darwin's revolutionary idea of evolution and apply it to the branding process and what results is a new and strikingly effective strategy for creating innovative products, building a successful brand and in turn achieving business success. Here, the Rieses explain how changing conditions in the marketplace create endless opportunities to build new brands and accumulate riches but these opportunities cannot be found where most people and most companies look. That is in the convergence of existing categories like television and the computer, the cell phone and the internet. Instead opportunity lies in the opposite direction in divergence.²²

Brands have become the single most important asset of many business organizations today and the need to protect them from unauthorized copying, imitation and unfair competition is therefore all the more necessary. Thus trademarks, advertising and brand protection informs the reader of the various legal measures available to protect brands including copyright, trademarks, patents, designs among other and it further offers practical advice on how different aspects of a brand can be protected. Starting with an analysis of a brand in management literature, the book moves on to discuss and analyze brand protection from both marketing and legal perspectives. The book considers each aspect of a brand that is its shape, packaging, marketing, advertising to

²¹ P. Narayanan, Law of trade mark and passing off, eastern law house, Kolkata, 2004, p.2.

²² Al. Ries and Laura, the origin of brands, Harper Collins publisher, 2004, p.13.

provide a comprehensive overview of the subject hence a general overview of brand protection and its valuation issues.²³

Carlos reviewed treaties on intellectual property rights and argued that the TRIPS agreement is the most comprehensive and influential international treaty on intellectual property rights which brings intellectual property rules into the framework of the World Trade Organization, obliging all WTO Member states to meet minimum standards of intellectual property protection and enforcement. This has required massive changes in some national laws particularly in developing countries which provides a detailed legal analysis of the provisions of the TRIPS agreement as well as considering their economic implications in different legal and socioeconomic contexts. This book examines the obligation imposed on WTO members in different field of intellectual property and thoroughly explores the flexibilities that they enjoy in implementing the agreement.²⁴

Greenhalgh & Rogers in their study found a positive correlation between trademarks registration and product innovation, productivity and productivity of firms. Their study was conducted on a sample of firms in UK that have registered trademarks in UK and European Union during 1996-2000 period.²⁵ As dependent variable they use the Tobin's Q, considering that the market value of the firm reflects the expectations of future profitability relative to intangible assets. The study has put in evidence strong differences between firms that have registered a trademark and those that have not. This gap is more prominent in the services firms. The same hypotheses are confirmed by Helmers & Rogers, in their study of survival of small, medium and start-up firms in UK; from their analysis results that firms that use IPR, in particular use trademarks, have major chances of survival.²⁶

²³ D. Ryder Rodney, *Trademark Advertising and brand protection*, Macmillan, 2006, p.13.

²⁴ M. Carlos, *trade related aspects of intellectual property rights; a commentary on the TRIPS Agreement*, Oxford University Press, 2007.

²⁵ C. Greenhalgh, & M. Rogers, *Trade Marks and Performance in UK Firms; evidence of Schumpeterian Competition through Innovation*, (2007), p.12.

²⁶ C. Helmers, & Rogers, M. *Innovation and the Survival of New Firms across British Regions*, department of Economics Discussion Paper Series, British Regions, (2008), p.416.

In Uganda, the literature below was reviewed;

Bakibinga and Mayambala discuss intellectual property law in East Africa primarily focusing on intellectual property rights protection in Uganda. They discuss the various types of intellectual property rights protected in Uganda including, copyrights, designs, patents and trademarks. With regard to trademarks, the book traces the historical origin of Uganda's trademark law to the UK Trademarks Act 1938 which was subsequently repealed by the Uganda Trademarks Act, 1994.²⁷

The authors of the book conduct a detailed analysis of the registrability of trademarks, trademark infringement, defenses and remedies under the Trademarks Act, 2010, as well as the common law action of passing off. The book is a relevant reference material for this study particularly while examining the legal framework for the protection of trademarks in Uganda and the enforcement mechanisms in place. This study however goes further to analyze the law of trademarks in Uganda relative to international treaties to which Uganda is a party, the effectiveness of the law as well as the challenges affecting the effective implementation of the law, aspects which are not addressed in the book.²⁸

Bakibinga also analyses the law governing intellectual Property Rights in Uganda and identifies areas for reform relative to international treaties and the proposals of the Uganda Law Reform Commission. The paper analyses the salient provisions of the Trademarks Act, Cap 217 and concludes that little reform of the trademarks regime is required since most of the provisions are already in tandem with the TRIPS Agreement. However, the paper was written prior to the coming into force of the Trademarks Act, 2010 and analyzed intellectual Property Rights generally without giving detailed attention to trademarks.²⁹

Ongola underscored the importance of enforcement of Intellectual Property Rights observing that rights have no value unless they can be enforced effectively. According to the study enforcement of intellectual property rights is vital for combating counterfeit trade since counterfeiting is in

²⁷D. Bakibinga, and K. Mayambala, *Intellectual Property Law in East Africa*, Law Africa Publishing (K) Ltd Nairobi, Kenya, 2016, p.23.

²⁸D. Bakibinga, and K. Mayambala, *Intellectual Property Law in East Africa*, Law Africa Publishing (K) Ltd Nairobi, Kenya, 2016, p.23.

²⁹DJ. Bakibinga, "Intellectual property rights in Uganda, Reform and Institutional Management Policy Formulation", A paper delivered at the Network of Academies of Sciences in Organization of Islamic Countries (NASIC) International Seminar on Intellectual property and innovation, Value creation in the Knowledge Economy held in Islamabad, Pakistan, 12-14 December, 2016, p.21.

self an infringement of intellectual property rights.³⁰ He cites a number of intellectual property laws which have a bearing on counterfeit trade in Kenya, namely the Trade Mark Act, Copyright Act and Industrial Property Act and the Anti-Counterfeit Act. This study is based on the argument that effective implementation of intellectual property laws particularly the Trademark Act, 2010 will address the problem of trade mark counterfeiting and infringement generally, in Uganda. However, whereas Ongola discussed the efficacy of anti-counterfeit laws of Kenya, this study analyses the legal and institutional framework for protection and enforcement of trademarks in Uganda in light of international obligations.³¹

Kakooza discussed the enforcement of intellectual property rights in Uganda through civil, administrative and criminal means.³² The paper concludes that civil adjudication of intellectual property disputes in Uganda has been a success attributable to the creation of the commercial court comprising of competent judges who have expeditiously heard and determined intellectual property disputes. However, the paper found that criminal enforcement has been poor due to lack of awareness and training of police officers on the importance of fighting counterfeiting. This paper though relevant was written prior to the coming into force of the Trademarks Act, 2010 and could not have analyzed the Act in detail to ascertain its adequacy and effectiveness.³³

Wangwe states that there are three key institutions actively involved in IP-related activities and these are the Registrar General's Office (Ministry of Justice), Uganda National Council for Science and Technology, and the Uganda Law Reform Commission.³⁴ He concludes that there is very little if any co-ordination between these institutions, they are under-staffed and poorly funded and hence generally lack the institutional capacity to execute their mandates. However, there have been a number of institutional and legal reforms since this study was undertaken. Case in point is the repeal of the Trademarks Act Cap 217 which was replaced by the Trademark Act, 2010 and the establishment of the URSB as an independent institution mandated to administer

³⁰ B.S Ongola, *Efficacy of Anti-counterfeiting Laws in Kenya*, LLM Dissertation, University of Nairobi, 2011, p.2.

³¹ Ibid.

³² A. Kakooza, *The Civil, Administrative and Criminal Law Standards in Intellectual Property Enforcement in Uganda; the Good, the Bad and the Hoped-For*, 2010.

³³ Ibid.

³⁴ S. Wangwe et al *Country Case Study for Study 9 Institutional Issues for Developing Countries in IP Policy-Making, Administration and Enforcement-Uganda*, Economic and Social Research Foundation, Dar es Salaam Tanzania, A Report commissioned by the Commission of Intellectual Property Rights-Institutional Capacity In Intellectual Property Policy, Administration And Enforcement, the Case Of Uganda.

intellectual property. This study is different as it is conducted within a framework of these reforms.

1.8 Methodology of the study

A doctrinal research method was used to fully describe issues behind intellectual property rights in Uganda and the globe at large. The study therefore requires studying law as a distinct specialty. The method exposed the researcher to statutory formulations, analysis of legal concepts and fundamental formulations. The researcher adopted a multidisciplinary approach to the study relying and drawing generally from both primary and secondary data on the concept and formulations of development as a political and economic issue in order to generate materials that aid in coming up with reasons to ground and situate the final analysis and conclusions of the researcher. This helped in analysis of the law on trademarks protection on addition to international legal frameworks.

1.9 Chapterization

Chapter one introduced various parts of the study as well as background information, it gave an overview of the methodological approach and the literature reviewed by different authors plus exposing the scope of the study. Chapter two was based on examination of the legal framework for trademarks protection and brand value businesses in Uganda, chapter three depicted the international framework for trademarks protection and its comparison to Uganda's trademark act 2010. Chapter four explored the challenges to intellectual property rights and chapter five provided for the discussion of findings, conclusions and recommendations on trademarks protection and brand value businesses. The study was based on Trademarks Act 2010 of Uganda and the 1995 Constitution of the Republic of Uganda.

CHAPTER TWO

LEGAL FRAMEWORK FOR TRADEMARKS PROTECTION AND BRAND VALUE IN UGANDA

2.0 Introduction

This chapter provides for the legal framework of trademarks and brand value in Uganda. It as well provides for case laws where trademarks have been violated in Uganda. The key institution for administrative enforcement of trademarks is the Uganda Registration Services Bureau (URSB). URSB is a statutory body established by the Uganda Registration Services Bureau Act, Cap 210 whose core mandate is to provide effective and efficient registration services for businesses, personal and corporate insolvency, intellectual property rights such as trademarks, patents, copyrights, utility models and designs and marriages. The Bureau is also responsible for collection of Non-Tax Revenue in respect of these transactions.³⁵

2.1 Conceptualization of Trademarks

A trademark is defined as ‘any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings’.³⁶ As the definition shows, trademarks are not limited to symbols in the strict sense as the law theoretically permits the registration unconventional marks.³⁷ Regardless of whether trademarks are strictly attached to them are extraordinary. Trademarks endow their proprietors with an inherent value which can, with intelligence and due diligence, last infinitely.³⁸

While patents and copyrights can be described as governmental grants which give their inventor the right to exclusively use, make or sell a product for a pre-determined time period, trademarks until very recently were merely perceived as indicators of the commercial origin of goods. Therefore, trademarks were never classified as monopolies.³⁹ Yet, trademark protection entails

³⁵ URSB Annual Report 2013/2014, at page 8.

³⁶ B. Paster, ‘Trademarks-Their Early History’ (1969) pp.551.

³⁷ W. Anson, W. Suchy, H. Ahya Fundamentals of Intellectual Property Valuation: a primer for identifying and determining value (The American Bar Association, 2006).

³⁸ Ibid.

³⁹ K. Borhardt, ‘Are Trademarks an Anti-Trust problem, (1943) 31(3), p.245.

herent monopolistic elements and in fact, it is arguable that the monopolistic elements inherent in trademark protection are extending beyond reasonable limits. This point is connected to the main question underlying this thesis on the desired shape of modern trademark protection.⁴⁰

Words are the most common types of marks.⁴¹ Word marks include coined word marks like fanciful marks such as Mukwano, random word marks which have no connection to the products to which they are attached such as Apple or words that suggest the product function (suggestive marks) such as Kleenex.⁴² Hence business entities that adopt word marks and especially suggestive marks run a risk that these words will become generic hence will eventually fall into public use.⁴³ In this case a trademark will lose its legal protection.⁴⁴ This point reasserts the argument that once reprivatized, the trademark loses its private property characteristics and becomes free to use within the public sphere.⁴⁵

The National Development Plan (2011-2015) highlights the importance of IPR in encouraging innovation in science and technology and urges support to cooperatives in accessing and acquiring IPR.⁴⁶ IP protection and promotion of innovation is also one of the 13 thematic areas of intervention identified by the National Trade Sector Development Plans (2008/9, 2012/3) and the national STIP identified acquisition of IPR by local innovators as a key strategic goal.⁴⁷ There are several policies that address IP under different sectors, namely National Trade Policy (2007), National Industrial Policy (2007), National Science, Technology and Innovation Policy (2009), National Policy on Culture and National Health Policy.

Uganda has passed a number of IP-related laws over years including the Trademarks Act (2010), Trade Secrets Promotion Act (2009) and the Copyright and Neighbouring Act (2006). These laws as well as the Patents Act (1993) are administered by the Ugandan Registration Services

⁴⁰ K. Borchardt as seen above n.40.

⁴¹ S. Levy, D. Rook, Brands, Consumers, Symbols and Research (1999) p.173.

⁴² Ibid.

⁴³ S. Diamond, 'How to Use a Trademark Properly' (1971) 61 TMR 431, pp.431-433.

⁴⁴ Molengraff, this problem has recurrently occurred within the pharmaceutical industry, p.307.

⁴⁵ J. Hughes, 'The Philosophy of Intellectual property' (1988) 77 Geo. J., 287.

⁴⁶ National Planning Authority, Uganda National Development Plan, 2010.

⁴⁷ WTO EAC Trade Policy Review-Uganda & Priority Needs for Technical and Financial Cooperation. Communication from Uganda, 2012.

bureau.⁴⁸ As of late 2012, the Industrial Properties Bill was still before Parliament. The Bill provides for the granting and regulation of patents, industrial designs, utility models, and "technovations", and for the designation of a registrar. A Geographical Indications Bill is also before Parliament.⁴⁹

The Ugandan Registration Services Bureau (URSB) is the main administrative agency in the country, covering trademarks, patents, utility models and copyrights. The URSB has benefited from WIPO automation support and began conducting automated searches in 2011.⁵⁰ The National Council for Science and Technology is also involved in patent protection and information, and includes a national IP advisory group made up of officials from the public and private sectors. Uganda did not report any data to WIPO for the period 2008-2011 on applications or registrations for patents, trademarks, and industrial designs. Uganda is party to the Patent Cooperation Treaty. Uganda is an ARIPO member and party to the Harare Protocol on Patents & Industrial Designs but not the Banjul Protocol on Trademarks.⁵¹

Therefore, Patent and trademark holders must bring infringement cases to the Ugandan High Court to obtain damages or other remedies and the Trademarks Act 2009 provides for the appointment of inspectors to assist the police services in IP enforcement, though there is no clear indication of the implementation of this provision.

There has been the development by the Uganda National Council for Science and Technology of a National Science Technology and Innovation Plan 2012/13 to 2017/18 both in the national development plan highlights the importance of IP in the promotion of science and innovation for continued development. The Ugandan National Council for Science and Technology includes IP management as one of its key areas and holds monthly workshops free of charge for individuals and businesses seeking advice on patents, trademarks and other IP related issues.⁵² The Uganda

⁴⁸WTO EAC Trade Policy Review-Uganda, 2012 & Priority Needs for Technical and Financial Cooperation. Communication from Uganda, 2007.

⁴⁹Ibid.

⁵⁰WTO EAC Trade Policy Review-Uganda, 2012 & Priority Needs for Technical and Financial Cooperation. Communication from Uganda, 2007.

⁵¹ Ibid.

⁵² Uganda National Council for Science and Technology, National Science, Technology and Innovation Plan. 2012.

Registration Services Bureau is responsible for IPR including the registration of patents and utility models. The website provides users with clear information on what constitutes an IPR, what can be protected and how. There are also forms available on the website for trademark applications.⁵³

2.2 Legal Framework for Trademarks Protection and Brand Value in Uganda

2.2.1 1995 Constitution of the Republic of Uganda

Article 79(2)⁵⁴ provides that Parliament will make provisions that will have the force of law and it grants a Constitutional mandate to Parliament to make provisions and that these provisions will have a force of law, this means in turn that the enactment of Copyright laws is rooted in the Constitution, it serves no purpose therefore to undermine this parliamentary mandate by amending the Constitution to establish an independent provision overriding the existing parliamentary statutes.⁵⁵

These include the copyright and neighboring rights of 2006, the trademark act of 2010, the industrial properties Act of 2013. These laws provide for copyrights and neighboring rights trademarks, patents and utility models respectively. They have not been inadequate in protecting the IPRs holder.

This was clearly demonstrated in the case of *General Electric Co (of U.S.A) v General Electric Co Ltd*⁵⁶, the dispute related to existence of a mark on the register. At any rate the current proceedings are not challenging the registrations of the word 'Java' in as far as it comprises most of the Opponent's marks on the register.

Article 287⁵⁷ is articulate in providing to the effect that all international conventions to which Uganda is party are to apply to it, this was made clear in *Attorney General v Susan Kigula and 417 ors*⁵⁸ where Justice Egonda Ntende as he then was while recognizing various United nations instruments averred that the input of Article 287 was to indicate that the framers of the

⁵³Uganda Registration Services Bureau.

⁵⁴ The 1995 Ugandan Constitution.

⁵⁵Constitution of the republic of Uganda 1995 as ammended.

⁵⁶ (1972) 1 WLR 729.

⁵⁷Constitution of the republic of Uganda 1995 as amended.

⁵⁸ Constitutional Appeal No.3 of 2006 (2009) UGSC.

Constitution were aware of the applicability of these conventions that Uganda is party to. In that regard, one cannot doubt the applicability of the agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS agreement). Provisions in the TRIPS agreement could also work as substitutes to a Constitutional provision that is to relate to the same rights protected by the same agreement which is particularly so since Uganda is party to the TRIPS agreement.⁵⁹

Trade marks seem to already be provided for in the Constitution, a close scrutiny of *Article 26*⁶⁰ affirms this fact. *Article 26* provides for the protection from deprivation of property through for instance (1) where every person has a right to own property either individually or in association with others. (2) No person shall be compulsorily deprived of property or any interest in or right over property of any description except where the following conditions are satisfied the taking of possession or acquisition is necessary for public use or in the interest of defence, public safety, public order, public morality or public health and the compulsory taking of possession or acquisition of property is made under a law which makes provision for prompt payment of fair and adequate compensation, prior to the taking of possession or acquisition of the property; and (ii) A right of access to a court of law by any person who has an interest or right over the property.⁶¹

In the case of *TECNO Telecom Ltd vs. Kigalo Investments Ltd*⁶² an application was brought under section 45 and 46 of the Trademarks Act 2010 to have the mark TECNO which had been registered in Uganda removed from the register on the ground of proof of the registration of that mark in a country of origin. The Applicant was an attorney of TECNO Telecom Ltd and dealt in phones. The Applicant was an appointed agent in Uganda of the firm registered in Hong Kong. They dealt in a phone called TECNO and registered the name as a trademark. On the question of locus standi the Hon Judge held that the Applicant was an aggrieved party who can bring an action under sections 45 and 46 of the Trademarks Act 2010 because the Applicant demonstrated that it is the registered owner of the trademark TECNO and it manufactures and deals in TECNO phones in Hong Kong, China.

⁵⁹ 1995 constitution as seen above.

⁶⁰ Ibid.

⁶¹ Industrial Property Act, 2014.

⁶² HCMC No. 0017 of 2011.

Although the Ugandan courts have not faced a question of interpretation as to whether intellectual property is in the precincts of property as portrayed in Article 26, these opinions can do much to predict what the likely outcome of the court's decision would be. If Intellectual property is indeed to be included in the definition of property as envisaged by Article 26, a separate provision in the Constitution will be unnecessary, a duplication and unwarranted, more so with the court's ardent interpretation of the said article for example in *Phillip Karugaba v the Attorney General of Uganda*⁶³ court held;

The right to own property encompasses the right to control property, to transfer or sell it and to exclude others, while enjoying protection of due process and fair procedural rules governing compulsorily acquisition. The Constitutional Court in Uganda has recognized that the right to property is the highest right a man can have over anything to which one claims ownership, from lands and tenements, to goods and chattels. The right extends to 'personal' as well as 'intangible property' (like debts) and in no way depends on another man's courtesy.

However, IPRs if put in the Constitution will definitely conflict with **Article 37**⁶⁴ which provides to the effect that everyone has a right to practice and promote a culture, language, tradition in community with others. **Article 37** seems to encompass traditional knowledge as part of culture yet traditional knowledge is as for now a copyrightable area, the only protection it has is the very presence of Article 37, a Constitutional provision on preservation of culture, if this provision is diluted by another rival provision providing for the copyrighting of traditional knowledge, the motive of Article 37 will die off. The treating of traditional knowledge as un-owned has exposed it to numerous exploitations by outsiders many of who use this knowledge as an input for their innovations which are later on privatized through patents, copyrights and plant breeders' rights. Adding insult to injury, the financial and technological benefits of those innovations are rarely shared with indigenous communities.⁶⁵

⁶³ Uganda, Supreme Court, Constitutional Appeal No 1 of 2004.

⁶⁴ Constitution of the republic of Uganda 1995 as amended.

⁶⁵ Lawrence R. Helfer, Human rights and intellectual property; conflict or coexistence.

In the case of *Arsenal Football Club versus Matthew Reed*⁶⁶, the European court of justice held that the function of trademarks is to guarantee the identity of origin of the Trademarked goods or services to the consumers or end-user by enabling them without any possibility of confusion to distinguish the goods and services from others with another origin. The proprietor of the mark has the rights to ensure that the trademark fulfils its function. The Defendant's Counsel submitted that a trader cannot register trademarks without manufacturer's consent and enjoy protection. The trader cannot guarantee the quality of the goods in respect of which the trademark relates unless he or she has authority of the manufacturer. It is good practice elsewhere and courts have declined to allow licensee or distributors to register trademarks associated with foreign manufacturers. Counsel referred to the report by the Trademark Reporter, Official Journal of the International Association and Review of International Trade Mark jurisprudence.⁶⁷

In *Guangzhou Tiger head Battery Group Co. Ltd vs. Uganda Revenue Authority and In Cargo Freighters Agents Ltd*⁶⁸, the Plaintiff as the registered owner of the "Tiger Head" battery brand in Uganda registered under Part A of the register. The Plaintiff's case inter alia was that In Cargo Freighters Agents imported tiger head batteries not of the Plaintiffs manufacture as if they were of the Plaintiffs manufacture. It was a case of passing off and they sought among other order an order of destruction of the goods and a permanent injunction.

2.2.2 The Industrial Property Act

The Industrial Property Regulations of 2017 that operationalized the Industrial Property Act, 2014 for registration of patents, utility models, technovations and industrial designs. The Industrial Property (Fees) Regulations, 2017 which prescribe fees that are payable pursuant to the Industrial Property Act, 2014.⁶⁹

The Act generally provides for the promotion of inventive and innovative activities by facilitating the acquisition and development of technology through the grant of patents, utility models, industrial designs and technovations through registration with the designated registrar of

⁶⁶ Case C-206/01.

⁶⁷ volume 93 between May and June 2003 pp. 541–542.

⁶⁸ HCCS No. 0333 of 2012.

⁶⁹ Industrial Property Act, 2014.

industrial property rights.⁷⁰ The Act provides for the Registrar General as the Registrar of industrial property.⁷¹ The Registrar is charged with receiving, considering and granting of applications for industrial property rights, and promoting inventiveness and innovations in Uganda inter alia.⁷² The Registrar maintains a register of industrial property for both applications received and industrial property rights granted.⁷³

S.38 of the IPA is to the effect that the owner of a patent has exclusive rights of use over the patented product and no one else is allowed to use it without his authorization.⁷⁴ This protection given by an inventor is certainly an assurance of a monopoly for his innovation which works as an incentive to the inventor. It should be argued that with such a reward of monopoly, the inventor will be motivated in engaging in more research to come up with more inventions and perhaps better inventions. The absence of Industrial Property laws would lead to very absurd tendencies like infringements that could dispirit inventors. In Uganda, the IPA will boost confidence in technological research for institutes like Uganda Industrial Research Institute which aims at promoting and improving the level of technology in Uganda.⁷⁵

Patent laws are a form of contract between the inventor and the grantor, what the patent system does is to guarantee a limited term of protection in return for the inventor's agreement to disclose details of his invention⁷⁶ and, ultimately, to abandon his property right in it. This benefits society by stimulating investment and employment because details of the invention are added to the store of available knowledge. After the expiry of the patent, the knowledge is put to use in the technology world.⁷⁷

⁷⁰ Long Title to the Industrial Property Act, 2014 (herein also IPA 2014).

⁷¹ Section 3 IPA 2014.

⁷² Section 4 IPA 2014.

⁷³ Section 5 IPA 2014.

⁷⁴ Industrial property Act, 2014.

⁷⁵ www.uiri.org Uganda Industrial Research Institute. 24/10/2014.

⁷⁶ S.39 Industrial Properties Act.

⁷⁷ Ibid.

The industrial properties Act has been applied in a variety of circumstances like;

2.2.2.1 The role of Industrial properties Act in trade and commerce

Technological knowledge, ideas, methods and techniques are quickly becoming society's most important economic assets. The growth of knowledge as a tradable asset, which takes many forms in its creation, dissemination and movement across borders, is now an established feature of all economies.⁷⁸ This received recognition by the World Trade Organization in the 1990s through one of its major components; the TRIPS agreement where countries agreed to certain intellectual property rights standards and obligation in any regional or bilateral trade agreements.⁷⁹

The aspect of patent rights as a means of attaining economic ends can be traced through the IPA. This is expressed in **Section 38 of the IPA** precludes any commercial use of the patent by a third party not being the patent holder, such commercial use can be after the patent holder has assigned or licensed the patent under the IPA. This assigning or licensing can only be after the licensee has submitted a consideration for the patent; he or she cannot attain the patent (knowledge) at a free cost except if the patent holder wishes it. A patent is to be looked at as an investment and as a product that is being traded to acquire money.⁸⁰

2.2.2.2 The role of Industrial properties Act in health

In the health sector, Intellectual property can provide stimulation for the development of new drugs and medicine.⁸¹ Researchers will often want to be sure they can recoup their investment costs before they can engage in any serious research. In Uganda, research by the Joint Clinical Research Centre for an HIV vaccine has been partly inspired by the protection to be received from Intellectual Property rights. However, it has been argued that the monopoly granted to a patent holder to recoup his profits results in unmanageable prices on the product, burrs the generic modifications of the said drugs and generally puts the medicine out of reach to those who need it.

⁷⁸M. John, Curtis, Intellectual Property rights and International trade an overview, Centre for intellectual governance Innovation, 2014, p.24.

⁷⁹M. John as seen above.

⁸⁰ Industrial property Act, 2014.

⁸¹ World Health Organization, Trade, foreign policy, diplomacy and health. 2014.

This argument however cannot be maintained amidst the mechanisms that have been put in place to circumvent the monopoly granted. Mechanisms like; voluntary licensing, compulsory licensing, bulk purchasing and corporate donations have been effective measures to relax the patent standard requirements. In addition to that, in a recent study by Attaran,⁸² it has been established that geographic patent coverage does not appear to correlate with antiretroviral treatment access in Africa, areas covered by patent law still access drugs like ARVs, instead, the areas that are not covered by patent law have had little access to drugs, suggesting that patents and patent laws are not a major barrier to treatment access in and of themselves.⁸³

Since the start of Intellectual property law in the early 1760s, Uganda had largely remained without patent law until the inception of the Patents Act of 1993 which is not for any strange reason but one particularly, the law was/is irrelevant to the situation in Uganda. The level of research, innovation and invention was/is still so low to require a fully fledged Act on Intellectual Property rights.

IPRs can also provide a viable incentive to inventors to invest more in exploring new fields which will eventually provide solutions to the world's problems. Intellectual property rights create incentives for individuals and firms to invest in research and development, and to commercialize inventions and other creations by allowing individuals and firms to profit from their creative activities.⁸⁴ It is stated, in this regard, that the grant of a IPRs confers great value on any business that has developed the idea, thus creating incentives for innovation and attracting financial investments.⁸⁵

2.2.3 The Uganda National Council for Science and Technology Statute⁸⁶

This Statute creates the Uganda National Council for Science and Technology (UNCST) which it empowers with the function of protecting intellectual property rights. The Statute also provides for the operation of a National Patent Office by the UNCST.

⁸² Amir, Attaran, Do patents for antiretroviral drugs constrain access to treatment in Africa? 24-10 -2014.

⁸³ Amir Attaran as seen above.

⁸⁴ The Constitutional Framework for The Protection Of Intellectual Property Rights In Kenya By Allan Tuli.

⁸⁵ Anthony C.K. Kakooza, embracing e-commerce in Uganda: Prospects and Challenges.

⁸⁶ Statute No.1 of 1990.

2.2.4 The Patents Statute⁸⁷

The Statute provides for the grant, registration, and protection of patents and for other purposes incidental thereto. It also provides for the registration and protection of IP rights in patents and utility models.

At the moment, proposals are being floated to amend or even repeal the Patents Statute to bring it in line with Uganda's international commitments. There is a general feeling that this Statute should be repealed and replaced with the Industrial Property Bill (2001).⁸⁸ This need arises from a multiplicity of developments in IP law on the international scene including a number of treaties and organizations to which Uganda is now a signatory.

2.2.5 The Copyright Act⁸⁹

This law makes provision for copyright of literary, musical and artistic works, cinematograph pictures, gramophone records and broadcasts and other purposes connected therewith.

2.2.6 The Trade Marks Act⁹⁰

Section 3 and 4, This is an Act relating to the registration of Trade Marks which provides for the appointment of a Registrar of Trademarks and the keeping of a register of trademarks.

2.2.7 The United Kingdom Designs (Protection) Act⁹¹

The Act provides for the protection in Uganda of designs registered in the United Kingdom.

2.2.8 The Penal Code Act

In as far as IP rights are concerned, the Penal Code defines trademarks and make it an offence for one to infringe on or forge a registered trademark.⁹²

⁸⁷ The Patents Act, Cap 82, Laws of Uganda.

⁸⁸ Joan Apecu, Technical Assistant, Uganda Law Reform Commission, 9 November 2001, interview report.

⁸⁹ Cap 81, Laws of Uganda.

⁹⁰ Cap 83, Laws of Uganda.

⁹¹ Cap 84, laws of Uganda.

⁹² Cap 106, Laws of Uganda.

.2.9 The TRIPS Agreement

The TRIPS Agreement makes reference to earlier international agreements which provide for member state obligations in protecting intellectual property, member states to the TRIPS Agreement such as Uganda are not allowed to derogate from their obligations under prior binding respective agreements referred to in the TRIPS Agreement.⁹³

As a result of the activities of the Uganda Law Reform Commission and the TRIPS Task Force, there are a number of Bills and draft Bills in the pipeline targeting provisions relating to IP rights administration and enforcement. These are intended to up-date the Ugandan law to bring it in line with the country's international obligations under the TRIPS agreement.

The Ugandan legislations in line with the TRIPS Agreement include the following;

2.2.9.1 The Registrar General's Office

Section 3 of the Patents Statute creates the Office of the Registrar of Patents to supervise the performance of the duties and functions of a Registry of Patents which also provides for the creation of other officers including assistant or deputy registrars as well as examiners.⁹⁴

Section 4 of the Patents Statute creates an office known as the Patents Registry with all functions relating to the procedure for the grant of patents. This office is meant to register license contracts, contracts assigning the right to a patent and to provide patent information services to the public, among other functions. The Registrar of Patents is also empowered under the Statute to maintain a Register of Patents in which shall be recorded all the patents granted.⁹⁵ The Registrar may also issue administrative instructions relating to the procedure for the grant of patents.⁹⁶

Other legal provisions empowering the Office of the Registrar General to handle IP matters are contained in the different laws/statutes pertaining to IPR. As far as the staff component of the Registrar General's Office is concerned, it has a strength of ten professional staff (professional lawyers) and about 10 administrative staff (records' clerks).

⁹³ Article 2 TRIPS Agreement, the proviso makes reference to the Paris Convention for the Protection of Industrial Property, March 20th, 1883 as amended on September 28th, 1979.

⁹⁴ Patents Statute, 1991.

⁹⁵ Section 5 of the Patents Statute, 1991.

⁹⁶ Section 6.

The Uganda National Council for Science and Technology

The Uganda National Council for Science and Technology (UNCST or "the Council") was established by Statute No.1 of 1990 as a body corporate, inter alia to advise Government on and co-ordinate the formulation of an explicit national policy on all fields of Science and Technology (S&T). The UNCST Statute also clearly stipulates that one of the functions of the Council "shall be to protect intellectual property through appropriate patent laws and to operate a national patent office."⁹⁷

In conclusion

IPRs are a key for a robust economic development; they have the power to frog leap any economy from a take off stage to a self reliant and independent economy. They influence industrial development and promote research but they are not so fundamental to be embedded in the Constitution, the present law is sufficient to acknowledge their relevance. Besides, they have been enforced by courts before and certainly, the courts have already taken notice of them through the famous doctrine of precedent.

⁹⁷ Section 3(e) Uganda National Council for Science and Technology Statute.

CHAPTER THREE

INTERNATIONAL AND REGIONAL FRAMEWORKS FOR TRADEMARKS PROTECTION AND ITS RELATEDNESS TO UGANDA'S TRADEMARK ACT 2010

3.0 Introduction

This chapter provides for the International and Regional Frameworks for trademarks protection, it cites references for instance from neighbouring countries like Kenya and how they protect their trademarks and further, citations were made in reference to developed countries like America and Australia.

3.1 International Frameworks for Trademarks Protection and its Relatedness to Uganda's Trademark Act 2010

World Trade Organisation Agreement

The Agreement establishing the World Trade Organisation (WTO)⁹⁸ was concluded at Marrakesh on 15 April, 1994. Uganda signed the WTO Agreement on 15th April 1994 and ratified the same in October 1994. By 31st December 1994, Uganda had fulfilled all the conditions necessary to become a founder member of the WTO.⁹⁹ The WTO was established to provide 'a common institutional framework for the conduct of trade relations among its Members in matters related to the agreements and associated legal instruments therein referred to as "Multilateral Trade Agreements" included in the Annexes to the Agreement'.¹⁰⁰ The Agreements mentioned form an integral part of the WTO Agreement and are binding on all WTO members. This includes the Agreement on Trade Related Aspects of Intellectual Property (TRIPS Agreement).¹⁰¹

⁹⁸ Agreement establishing the World Trade Organisation 1994, Marrakesh, Morocco.

⁹⁹ ULRC, A Study Report of Intellectual Property Rights; Trademarks and Service marks Law, (Law Commission No. 15), 2004.

¹⁰⁰ Ibid at Article 11.

¹⁰¹ Ibid.

World Intellectual Property Organization Convention

The World Intellectual Property Organization Convention is the constituent instrument of the World Intellectual Property Organization (WIPO). The Convention was signed at Stockholm on July 14, 1967 and entered into force on 1st June, 1984. Under the Convention, WIPO has two main objectives first; to promote the protection of intellectual property worldwide and second is to ensure administrative cooperation among the intellectual property Unions established by the treaties that WIPO administers. WIPO is now a specialized agency of the United Nations which administers almost all intellectual property treaties except for the TRIPS Agreement which is administered by the World Trade Organisation.¹⁰⁸

Agreement on Trade Related Aspects of Intellectual Property (TRIPS)

The TRIPS Agreement is undoubtedly the most domesticated international instrument when compared to prior and subsequent international intellectual property treaties. The TRIPS Agreement establishes minimum levels of protection and enforcement of intellectual property rights and leaves room for members to stipulate higher standards provided that they conform to the provisions of the Agreement.¹⁰⁹

The TRIPS Agreement was meant to close the gaps left by the Paris Convention. However, the TRIPS does not seek to derogate from the substantive provisions of the Paris Convention but instead builds on the Convention, by increasing on the level of protection and enforcement afforded to trademarks.¹¹⁰

Article 2(1) of TRIPS covers the relationship between TRIPS and the Paris Convention. It obliges all member states to comply with all the substantive rules of the Paris Convention, with the exception of budget and administrative provisions. The TRIPS Agreement reinforces the principles Paris Convention principles of National Treatment¹¹¹ and Independence of Rights and goes further to introduce the international trade principle of Most Favored Nation (MFN) into the

¹⁰⁸Convention Establishing the World Intellectual Property Organization, 1967 Stockholm, Sweden (As amended on September 28, 1979).

¹⁰⁹Ibid at Article 1.

¹¹⁰T. Cottier, "The Prospects for Intellectual Property in GATT", 28 Common Market Law Review 383, 1999, pp.392-93.

¹¹¹TRIPS Agreement, Article 3.

intellectual property rights arena.¹¹² The MFN principle demands that in relation to intellectual property rights protection any advantage, favour, privilege or immunity granted by a member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other Members.¹¹³

The TRIPS Agreement particularly the provisions for trademark rights enforcement arose from the need for a multilateral framework of principles, rules and disciplines dealing with international trade in counterfeit goods. Trademark protection is dealt with under Section 2 of Part II of the TRIPs Agreement while enforcement provisions are provided for under Part III. The TRIPS Agreement tried to harmonize and improve the level of trademark protection and enforcement. For instance it provided a harmonized definition of a trade mark and specified the minimum term of protection and minimum standards of enforcement of intellectual property rights expected of member states.¹¹⁴

Banjul Protocol on Marks

In line with the objectives of ARIPO, the Banjul Protocol on Marks¹¹⁵ was adopted by ARIPO member states and came into force on 13th November, 2004. The protocol regulates the application procedure for registration of trademarks in ARIPO member states. An application for registration of a trademark can be filed to the ARIPO office or to the Industrial Property Office of a member state (and later transmitted to ARIPO within one month from the date of receipt).¹¹⁶ The protocol provides for centralized trademark registration where by a trademark registered by ARIPO has the same effect in the ARIPO member states as if the trade mark was filed and registered under the national law of each state designated in the Application for Registration.¹¹⁷

It is worthy to note that Uganda has not yet domesticated the provisions of the Banjul Protocol. Nevertheless, in the case of *Anglo Fabrics (Bolton) Ltd and Another v African Queen Ltd* and

¹¹² TRIPS Agreement, Article 3.

¹¹³ TRIPS Agreement, Article 4.

¹¹⁴ Ibid.

¹¹⁵ African Regional Intellectual Property Organization (ARIPO) Banjul Protocol on Marks Amended by the Council of Ministers on August 13, 2004.

¹¹⁶ Ibid at Section 2.

¹¹⁷ Section 3 of the Banjul Protocol requires that an application for the registration of a mark to designate the contracting States in which registration is being requested.

Another¹¹⁸ the High Court of Uganda inferred that it would recognize trademarks registered under international protocols like the Banjul Protocol to which Uganda is a member state, as long as Uganda was a designated country for purposes of registration.¹¹⁹

3.2 Regional Frameworks for Trademarks Protection and its Relatedness to Uganda's Trademark Act 2010

East Africa Cooperation Treaty¹²⁰, Uganda signed the East African Co-operation Agreement of 30th November, 1993¹²¹ which was later upgraded into a treaty which Uganda ratified on 27th April, 2000. The provisions of the treaty were subsequently domesticated into the East African Community Act, 2002. The Treaty implores members to create an enabling environment in order to attract investments while taking cognizance of the developments in the world economy as contained in the WTO Agreement.¹²²

Member states are required to uphold the principle of complementarity and to allow free movement of goods and persons, labour, services, capital information and technology.¹²³ They are further obliged to remove all the existing non-tariff barriers on the importation into their territory of goods originating from the other Partner States¹²⁴ and to refrain from enacting legislation or applying administrative measures which directly or indirectly discriminate against the same or like products of other Partner States.¹²⁵

The EAC Treaty principles were upheld in the case of *Nairobi Java House Limited v Mandela Auto Spares*¹²⁶ where court found that the refusal by the registrar to allow the registration of the trademark "Nairobi Java House Coffee & Tea" which had been earlier registered in Kenya by Nairobi Java House Limited in respect of Coffee, tea, foodstuffs and bakery products, stifled the

¹¹⁸ HCCS-0632-2006.

¹¹⁹ Ibid.

¹²⁰ Treaty for the Establishment of the East African Community, 1999 (As Amended on 14th December, 2006 and 20th August, 2007).

¹²¹ A.C, Kakooza, the Civil, Administrative and Criminal Law Standards in Intellectual Property Enforcement in Uganda: The Good, the Bad and the Hoped-For, 2010, at P.12.

¹²² Recital 11 of the Treaty for the Establishment of the East African Community (As Amended on 14th December, 2006 and 20th August, 2007).

¹²³ Ibid, Article 7.

¹²⁴ Ibid, Article 75 (5).

¹²⁵ Ibid, Article 75(6).

¹²⁶ Civil Appeal No 13 of 2015.

free movement of services within the East African Community and amounted to a violation of the guaranteed freedoms under the EAC Treaty.

Agreement on the Creation of the African Regional Intellectual Property Organization

The Agreement which established the African Regional Intellectual Property Organization (ARIPO) was concluded on December 9, 1976, at Lusaka, Zambia and came into force on 13th November, 2004.¹²⁷ Uganda is a founder member of ARIPO and became a State Party on 8th August, 1978. Some of the objectives of ARIPO are ‘to promote the harmonization and development of the intellectual property laws and matters related thereto, appropriate to the needs of its member and of the region as a whole’ and ‘to foster the establishment of a close relationship between its members in matters relating to intellectual property’.¹²⁸

Nairobi Treaty on the Protection of the Olympic Symbol

Uganda is a signatory to the Nairobi Treaty¹⁸ since 21st October, 1983; the Treaty regulates the use of the Olympic symbol. State parties to the treaty are under obligation to protect the Olympic symbol against use for commercial purposes without the authorization of the International Olympic Committee.¹²⁹

3.3 Relationship of the regional and international trademarks with that Uganda

Section 1 of the Trademarks Act, 2010 defines a trademark as a sign or mark or combination of signs or marks capable of being represented graphically and capable of distinguishing goods or services of one undertaking from those of another undertaking. A sign is defined as any word, symbol, slogan, logo, sound, smell, colour, brand label, name, signature, letter, numeral or any combination of them. It is worthy to note that sound, smell and colour trademarks were not protected in the repealed Trademarks Act, Cap 217. These are known as non-traditional trademarks¹³⁰ relative to the traditional trademarks such as symbols, logos, words among others.

¹²⁷ ARIPO agreement signed on December 10, 1982, December 12, 1986 and November 27, 1996, and amended by the Council of Ministers on August 13, 2004.

¹²⁸ Ibid Article III.

¹²⁹ Nairobi Treaty on the Protection of the Olympic Symbol, 1981, accessed on 21st May, 2019.

¹³⁰ T. Cottier, “The Prospects for Intellectual Property in GATT”, 28 Common Market Law Review 383, 1999. pp.392-93.