

**The principle of territoriality in trademark protection**  
**Uganda - Coulson Harney Advocates**

**Examination/opposition**  
**Registration**  
**National procedures**

March 31 2016

The High Court case *Nairobi Java House Ltd v Mandela Auto Spares Ltd* (February 9 2016) was an appeal against a May 21 2015 decision of the registrar of trademarks following an opposition filed by the respondent against the appellant. The registrar upheld the opposition and refused registration of the Trademark Application 48062 for JAVA HOUSE & COFFEE in Part B of the Trademark Register under Class 43 of the Nice Classification.

The trademark is depicted below:



The applicant had also applied to register the trademark NAIROBI JAVA HOUSE COFFEE & TEA through Application 48063 in Class 43 of the Nice Classification in respect of coffee, tea and others. This application was also refused. The trademark is depicted below:



The appellant appealed the registrar's decision refusing the applications to the Uganda High Court. The refusal was on the basis that the trademarks were similar to the respondent's CAFÉ JAVAS trademark filed for registration on July 17 2009 under Class 30 of the Nice Classification. The trademark is depicted below:



### Legal context

In arriving at its decision, the Uganda High Court relied on Article 6 of the Paris Convention for the Protection of Industrial Property and Sections 9, 10, 44 and 45 of the Ugandan Trademarks Act 2010. The court also considered the Treaty for the Establishment of the East African Community (as amended on December 14 2006 and August 20 2007).

### Decision

The judge found that there was no confusing similarity between the appellant's marks and the respondent's mark, and set aside the registrar's decision refusing the applications. He issued an order compelling the registrar to allow registration of the appellant's trademarks. .

Of great importance is that the judge considered evidence of prior registration of the marks and acquired

distinctiveness through use in Kenya. At p49 of the judgment, he stated:

*It is my holding that the Registrar did not take into account the prior registration in Kenya of the Appellant yet it was the most material matter for consideration.*

*It is a matter of public interest for the East African Community to consider what to do with marks registered prior in another member state and sought to be registered in yet a different member state of the community...*

At p52, he stated:

*I have considered the fact that Kenya and Uganda are part of the East African Community and operate under the principle of complementarities under Article 7 of the Treaty. The community law is that member states which include Kenya and Uganda shall enact similar laws with regard to the removal of non-tariff and other technical barriers to trade and measures that restrict free movement of goods and services. Sections 44 and 45 of the Trademarks Act 2010 support freedom of movement of goods and services in the East African Community and within the limitations contained in the Sections. In the Treaty for the Establishment of the East African Community (as amended on 14th December, 2006 and 20th August, 2007) article 7 provides that there shall be free movement of goods and persons, labour, services, capital, information and technology ...*

At p53, he stated:

*The decision of the Registrar stifles free movement of services within the East African Community by restriction on the registration of a trademark registered prior in time in Kenya on the ground of registration of a trademark albeit registered later in time to Uganda ...*

Looking at the above excerpts from the judgment, it is clear that the judge placed great importance on prior registration and acquired distinctiveness of the appellant's marks through their use in Kenya.

### **Significance of the decision**

This is a precedent-setting decision that takes a fresh look at the principle of territoriality in trademark protection. It adopts a liberal approach of applying the principle of territoriality in regional economic blocs. It affirms that evidence of use of a mark in one member state of the East Africa Community could be relevant in establishing acquired distinctiveness through use in another member state.

It will be interesting to see whether the courts in other East Africa Community member states find this decision persuasive.

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