

# **Intellectual Property Trends in East Africa**

Our Presentation

# Our Presentation – In brief



## Intellectual Property composition

1. Trade mark
2. Patent
3. Copyright
4. Trade secret



## Legal Regime

1. Domestic
2. International



## Regulatory Regime

1. BRELA
2. Fair Competition Commission (FCC)
3. Tanzania Bureau of Standards (TBS)
4. Copyright Society of Tanzania (COSOTA)
5. Tanzania Commission for Science and Technology (COSTECH)



## Registrability of Intellectual Property in Tanzania and the Registration Process

1. Registration requirements
2. Registration timeframe
3. Examination process
4. Validity



## Case Studies

1. Legal remedies for trade mark infringement
2. Recent legal developments

# Types of Intellectual Property (“IP”)

IP is mainly comprised of the following:

Trademarks

**Section 2 of the TMA- Visible sign** used in connection with or in relations to goods/services for purposes of distinguishing in the course of trade/business the goods/services of one person from those of another.

Constitute any logos, words, colours or symbols belonging to a particular enterprise that is used to distinguish goods or services of that enterprise from another and promote brand competition.

Patents

these are legal rights granted to an inventor for an invention or innovation made by him.

Copyrights

mainly concerns works of art, literary works



# Types of Intellectual Property (“IP”)

IP is mainly comprised of the following:

Trade secrets

any piece of confidential corporate information which gives any business a competitive advantage for instance formulars used to prepare products. There are no legislations for trade secrets in Tanzania.



# Legal Regime of IP

The Tanzania Mainland IP Legal Regime is Governed by the Following Fundamental Laws:

- The Constitution of the United Republic of Tanzania of 1977 (as amended) under Article 24 provides for the right to own property and to have legal protection against expropriation of such property without authorization of the law.
- The Trade and Service Marks Act of 1986 as amended by Act No. 5 of 2021 and the Trade and Service Marks Regulations of 2000: which govern the registration and protection of trade and service marks in Tanzania.
- The Patents (Registration) Act Cap 217 R.E 2002 together with the Patents Regulations GN. 190 of 1994 of which provides for registration of patents, governing bodies and protection invention and innovation
- The Copyright and Neighbouring Rights Act, Cap 218 R.E 2002 which makes provisions for protection of copyright and neighbouring rights in literary, artistic works and folklore in the United Republic of Tanzania





# The Legal Regime in Zanzibar

- Tanzania mainland and Zanzibar have separate IP laws and registration systems as such protection of IP rights on one part of the union will not extend to the other part.
- IP Registration in Zanzibar is placed with the Business and Property Registration Agency in accordance with the following laws:
  - the Zanzibar Industrial Property Act of 2008;
  - Patents Decree, Cap 157 (11 of 1930, Cap 9 of 1934, 27 of 1935, S. 5, 11 of 1958) Laws of Zanzibar;
  - Patent Rules (Schedule to Decree No. 11 of 1930) in the Laws of Zanzibar; and
  - Copyright Act No. 14 of 2003.



# International Regime

Tanzania is a party to several international instruments governing protection of IPR. To list but a few;

- i. World Intellectual Property Organization Convention, 1967 (effective for Tanzania as from 30<sup>th</sup> December 1983);
- ii. Berne Convention for Protection of Literary and Artistic Works effective from 1994;
- iii. Paris Convention (International Union) 1883-1967 (effective for Tanzania 16 June 1983);
- iv. Agreement on the Creation of the African Regional Industrial Property Organization of 1979 effective from 1983
- v. Protocol on Patent and Industrial Designs within the Framework of African Region Industrial Property Organization (the Harare Protocol) 1982 effective in Tanzania from 01<sup>st</sup> September 1999;
- vi. Nice Agreement concerning the International Classification of Goods and Services for the purposes of registration of trade marks and service marks.

Tanzania is a member of African Regional Industrial Property Organization (ARIPO) and the World International Property Organization (WIPO)

# Regulatory Regime

## Domestic Regulatory Regime

There are various regulatory authorities that oversee the promotion and protection of IPR in Tanzania, some of which include;

- i. **Business Registration and Licencing Agency (BRELA)** – BRELA contains the offices of the Registrar of Patents and Registrar of Trade and Service Marks meaning that this is the body that has the mandate to register trademarks and service marks as well as granting of patents in Tanzania. All applications for registration of trade and service marks and granting of patents are made to BRELA.
- ii. **Copyright Society of Tanzania (COSOTA)** – one of its core functions is to promote, protect and defend the interest of copyrights and other related rights applicable to various artistic and literary works and register right holders and their works.
- iii. **Tanzania Commission for Science and Technology (COSTECH)** – this has maintenance of a registry of imported technology and promotion of scientific innovations and inventions in Tanzania
- iv. **Fair Competition Commission (FCC)** – this institution is established with the aim of promoting and protecting effective competition in trade and commerce and protecting consumers from unfair and misleading market conduct which includes infringement of IPR like using misappropriation of trade and service marks
- v. **Tanzania Bureau of Standards (TBS)** – its functions includes *inter alia* undertaking measures for quality control of commodities through product inspection and certification and services and to promote standardization in industry and trade. They bun used of counterfeit products and work together with other regulatory authorities such the Tanzania Medical and Drugs Authority (TMDA)



# Registration Process of IP

## Registration of Trade Marks and Service Marks

The application for registration of trade marks and service marks is made to the Registrar of Trade and Service Marks whose office is placed with BRELA, and since 2018 the process is effected through the BRELA ORS.

### **Requirements for Registration include**

- i. An applicant must be registered as Tanzania Citizen by providing a National ID
- ii. An applicant and every person to be included must provide name, address, an email address, occupation and cell phone number;
- iii. if the applicant's address is outside Tanzania an address for service within Tanzania;
- iv. Provide the trade or business description of the applicant and make a declaration that the applicant or his proposed registered user is using or proposes to use the trade or service mark within Tanzania

### **Attachments**

- i. Image of the proposed trade or service mark – if in a language other than English then it must be accompanied by a verified English translation
- ii. Consolidated Form of the company
- iii. Form No. 1 for application to be filed by Agent (Applicants not residing in Tanzania must appoint a trademark agent residing and practising in Tanzania to assist with the process – this can be through a power of attorney)



# Cont'd:

## Registration of Trade Marks and Service Marks

### Fees

- i. Application fee Tshs 50,000/= (Approx. USD 22)
- ii. Publication fee in the Journal Tshs 15,000/= (Approx. USD 7)
- iii. Registration Plus Maintenance Fee Tshs 65,000/= (Approx USD 30)

### Procedures on how to apply for trade and service marks registration certificate through online system (ORS)

1. Visit BRELA Website at [www.brela.go.tz](http://www.brela.go.tz) or <https://ors.brela.go.tz/ors>
2. Create an Online Registration System (ORS) Account (one must have NIDA number in order to create an account for new users) and if you have an account you can directly login to the system through new e- service for registered users
3. Select new e-service window of ORS
4. Select trade and service marks in order to apply for a trademark registration certificate



# Registration Process

## Procedures continued

5. Select filing of other documents about trade/service marks and proceed
6. Choose filing type F6 fee for registration of a mark TM/SM8 and add trade/service Mark number (e.g. TZ/T/2020/100) then click the search button and proceed
7. Fill in the item labelled Representative Statement by writing the name of the applicant which can either be a natural person or legal entity and proceed
8. Attach form no. TM/SM8 on the attachment option and click the agreement button to proceed
9. Proceed to payment of registration fees of Tshs. 60,000/= and maintenance fees of Tshs 5000 through electronic mode: M-PESA, TIGO PESA, AIRTEL MONEY, NMB or CRDB Account

**NB: BRELA will communicate by sending registration certificate to the Applicant ORS Account on the printout platform**

# Registration cont'd

## Qualities of a Registrable Mark-

- Section 16 TMA
- Distinctiveness
- If registration is registered without limitation of colour (black & white) , it is deemed to be registered for all colours.
- Any non-distinctive character or matters common to trade which are of non-distinctive character not registrable.



# Registration process cont'd

## Examination

- After reception of the application and upon payment of the application fees, examination process is conducted to determine whether or not the application will be accepted or rejected.
- The examination process is done for both domestic applications and for application made in countries that are members of the Paris Convention effective in Tanzania from 1983.
- Purpose of Examination (section 26 of the Act, 1986)
  - i. Conformity with the formalities required in the Act and its Regulations
  - ii. The registrability of the trade and service mark in accordance with the provisions of the law
  - iii. Whether the trade and service mark is required to be associated

# Registration cont'd

## Examination Process cont'd

When the examination process is completed and the applicant is entitled to registration of his trade or service mark then the Registrar will accept the application and advertise it in the Trade and Service Marks Journal.

Advertisement is for a period of sixty (60) days and if there is no opposition or when opposed the matter is decided in the applicants favour then the mark will be registered as the date of the application for registration.

If the application is rejected, the applicant will be notified by the Registrar of the objections through writing and the applicant may submit his representation or request a hearing concerning the objections within the time allowed but if he does not he will be deemed to have withdrawn his application. However, if he makes a representation and complies with the orders of the Registrar and the Registrar accepts he will be granted

Otherwise, any person may oppose the application of registration within the time limit as prescribed in the advertisement on grounds such as resemblance with other registered marks causing deception or confusion and the Registrar will determine the issue accordingly



# Registration cont'd

## Registration Time Frame

- The registration process may take between five to six months to complete considering that there are no objections or factors that could delay the process.

### Validity

- Term of registration: the registration of a trade or service mark is for a period of seven (7) years from the date of registration but may be renewed from time to time upon application to the Registrar and can be renewed for ten years from the date of expiration of original registration or of the last renewal
- Once a trademark is registered the proprietor is regarded to have exclusive right over the trade/service mark- Section 31 TMA

# Registration of IP cont'd:

## Grant of Patents

### Registration Requirements

First, an applicant for patent rights may be a natural or legal person who shall file such application to the Registrar of Patents in the Patents Office which is with BRELA

Secondly, one would need a 'patent document' which contains the entire contents of a patent description of an invention that form the basis for an application for patent rights.

If the applicant is not a resident or the place of his business is outside the United Republic, he /she needs to be represented by an agent through a power of attorney. If the documents are in a language other than English then a verified English translation

### The Contents of a Patent Document

- i. The title of an invention
- ii. General description of the invention
- iii. The claim(s)
- iv. An abstract
- v. Technical drawings (if any)



# Grant of Patents cont'd

## Grant of Patent cont'd

### How to apply

The application for patent rights is done through filing Form no. P.2 accompanied by a patent document in triplicate and submitted to the Registrar of Patents with BRELA. This prescribed form contains the following:

- i. request for the grant of patent;
- ii. full name and address of the applicant(s) including their nationalities and country principal place of business
- iii. Title of the invention
- iv. Statement that the applicant is the inventor (if not a sworn statement must be provided to justify the applicant's right to file a patent application)
- v. Declaration in case of divisional application
- vi. Claim to priority rights

### Criteria for Patent Grant

There are mainly three criteria for patent grant namely:

- i. Novelty – an invention must be new to be patentable
- ii. Inventive Step – an invention is patentable if it is beyond obvious
- iii. Industrial Applicability – an invention shall be capable of being industrially workable to be patented



## Examination Process

Upon filing the application, the Patent Office will examine whether the minimum requirements for obtaining a filing date have been met and if fees have been paid. The examination will also be conducted to spot the following defects:

- i. The request does not comply with the requirements of the law and rules e.g. unity of invention
- ii. The description, the claims and where applicable the drawings do not comply with the physical requirements prescribed by the regulations
- iii. The application does not contain an abstract
- iv. The applicant has not complied with a request made by the Registrar under the Act
- v. The fees have not been paid

If there are such defects the Registrar will require the applicant to remedy such defects and if the applicant does not comply then it will be rejected.



## Examination process cont'd

After the examination process is completed and publication fees have been paid, the Patent Office will publish a reference to the grant in the Patents Journal.

N.B An application for the grant of patent may be opposed by any person within three months after the date of publication in a form of notice of opposition.

### Registration Time Frames

The patent is usually registered within four months from the date of publication of a reference to the grant. A patent certificate will be issued in a prescribed form. Otherwise the whole process from application to grant may take five to six months.

### Validity

The term of grant of a patent application is twenty (20) years counted from its filing date. After the expiry of 20 years, a patent falls into the public domain upon which anyone who is interested can use it freely.

# Copyrights

## Copyright Registration Requirements

- Copyright protection is available to works of authors who are nationals of or have their habitual residence in Tanzania.
- The registration process is administered by the Copyright Society of Tanzania (COSOTA).
- The application for registration of copyrights requires the following:
  - Two copies of the copyrighted work
  - Two passport size of the applicant along with a copy of passport, birth certificate
  - Copy of agreement or other document evidencing other right holder's contribution to the copyrighted work



# Case Study

## Legal remedies for infringement of IPR

### **A person aggrieved by infringement of IPR may:**

- Sue before courts of law for compensation for all the profits made illegally, or may seek for injunction or compliance order against the infringing party. The aggrieved proprietor may also obtain an order for forfeiture or destruction of the counterfeit goods which form part of the infringement.
- Besides in 2015, the Cyber Crimes Act, No. 14 of 2015 made infringement of one's trade mark a criminal offence punishable by law to the effect that where person is found to have infringed a trade mark on a commercial basis, shall be made liable to pay a fine of not less than TZS 25 million (approx. USD 11,000) or to imprisonment for a term of not less than 5 years or both.

## Recent legal developments

It is imperative at this point to mention that there has not been any significant change in IPR legislations in Tanzania. The applicable laws and regulations as mentioned above have been in existence for several decades now.

The only most recent change is on the system of registration, in which all the trade and service marks as well as patents applications are now made through the BRELA Online Registration System.

Besides legislations, the Courts in Tanzania have from time to time determined IP matters and established principles worth mentioning as follows:



# The case of JC Decaux / JC Decaux Tanzania Limited vs JP Decaux Tanzania Limited, Commercial Case no. 155 of 2018

We represented the Plaintiff. The main principle in this case was that the protection obtained by registration of a trademark in Tanzania overrides the protection offered by registration of a company under the Companies Act.

- Briefly, JCDecaux Tanzania Limited a subsidiary of a south African company registered its trademark JCDecaux in Tanzania in October 2015 by which time JP Decaux Tanzania Limited (JP Decaux Tanzania), had incorporated in August 2014. Both companies mainly dealt with outdoor advertising.
- Following this event, JCDecaux filed a complaint that JP Decaux infringed the trademark JCDecaux **because the two words were confusingly similar**. JP Decaux **contended that the trade mark JC Decaux was registered after its incorporation as JP Decaux Tanzania Limited by the Business Registration and Licensing Agency (BRELA) and its name is therefore protected under the Companies Act, 2002.**

- Holding in favour of JC Decaux, the Court's considerations included the following:
  - Evidence that JC Decaux is not only known worldwide but that it also bears the family name of its founder Mr Jean Claude Decaux, founded in 1964 and had registered the trade mark JC Decaux in at least twenty eight other countries while the Defendant failed to provide sufficient explanation for using the name JP Decaux;
  - The favourable domain name decisions against JPDecaux.com and JPDecaux.tz;
  - That the similarity of the trade mark, differing by only one letter “**P**” vs “**C**” as well as the activities was not a coincidence;
  - The incorporation of the company name JP Decaux and the fact that it is registered by the Business Registration and Licensing Agency (BRELA) with the result that it is protected under the Company's Act, 2002 does not infer that the registration thereof is acceptable and permitted.



# Double Diamond Holdings Limited Vs. East African Spirits (T) Limited and Gaki Investment Limited, Commercial Case No. 8 Of 2018

The High Court, Commercial Division was called to determine a case where the Plaintiff claimed infringement of its trademark and passing off goods by the Defendant.

- The plaintiffs had registered its trademark consisting of the expression “CHASE THE ACE THE ACE OF DIAMONDS” identifying its product spirits/gin while the defendants’ had registered a trademark is with words “WHITE DIAMOND” and “DIAMOND ROCK” which identify their product spirits/gin with pineapple and coffee flavours.
- In defending its exclusive use of the word “Diamond” the Plaintiff claimed that it was not generic to gin and they had chosen the word based on value and quality of the mineral which is considered the strongest mineral in the earth while also contending that upon registration, all constituents of a trademark that are not generic to the goods in respect of which the trademark is registered are protected.
- The defendants on the other hand urged the Court when comparing those trademarks, to evaluate their elements in its entirety rather than dissecting them as is done in several cases worldwide.
- The court determined that the trademarks are not similar by stating as follows:

- The plaintiff's trademark with the word "Diamond" had other words, signs and symbols, which are different from the defendants' trademark which has only two words either "Diamond Rock" or "White Diamond".
- Besides, the packaging materials of the parties, they do not look similar. The bottles have different signs and colours so that picking only the word "Diamond" to determine similarity would not be proper.
- similarity was a question of overall impression rather than element by element comparison of the two marks, the focus being on the buyer who might be deceived by the similarity.
- Although the Plaintiffs had registered its trademark first, that alone could not stop the registration of the latter unless there was similarity and/or the plaintiff had acted.
- The defendants also enjoyed absolute protection since their trademark is also registered with a certificate to that effect
- The Court also held that there was no any evidence that the scenario was befitting the principles of passing off since the Plaintiff showed no evidence of existence of goodwill in the Tanzania market, where the product was presumed widely used. Likewise, the plaintiff also failed to indicate how long the product has been in the market and how wide and huge the market was or documentary evidence such as annual sales receipts to show the trend of how the business was flourishing in terms of the turnover realized from the moment the trademark was introduced in 2016, compared to the trend after the introduction of the defendants' products in the market in 2017.
- For the commission of the tort of passing off to be proved, the **classical trinity** must be present: (1) goodwill (2) misrepresentation and (3) damages- There must be deceit and fraud under common law.



## IPP Limited v Prince Bagenda & 3 Others, Commercial Case No. 20 of 2009,

- The IPP logo owner successfully contested the validity of the defendants' trademarks even though the IPP logo had not been registered as a trademark.
- The court was of the finding that the owner had used the IPP logo without interference for quite long such that everybody was associating the unregistered trademark with them as the users hence declared owner at common law.

# Thank you

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