

# A discussion on Intellectual Property trends in Uganda

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# Presentation outline

- Overview of the IP Landscape in Uganda
- IP Trends in Uganda
- Recently Ratified International Treaties On Intellectual Property
- Key amendments to Trademark Regulations
- Case Studies
- Opportunities for commercialization of IP Assets in Uganda



# Overview of the IP Landscape in Uganda

Uganda has laws providing protection for the following forms of IP

- Copyright & Neighbouring Rights
  - The Copyright & Neighbouring rights Act, 2006
  - The Copyright & Neighbouring Rights Regulations, 2010
  
- Trademarks
  - The Trademarks Act, 2010,
  - The Trademarks Regulations, 2012 and The Trademarks (Amendment), Regulations 2021
  
- Patents, Utility Models & Industrial Designs
  - The Industrial Property Act 2014
  - The Industrial Property Regulations, 2017
  - Industrial Property (Fees) Regulations, 2017



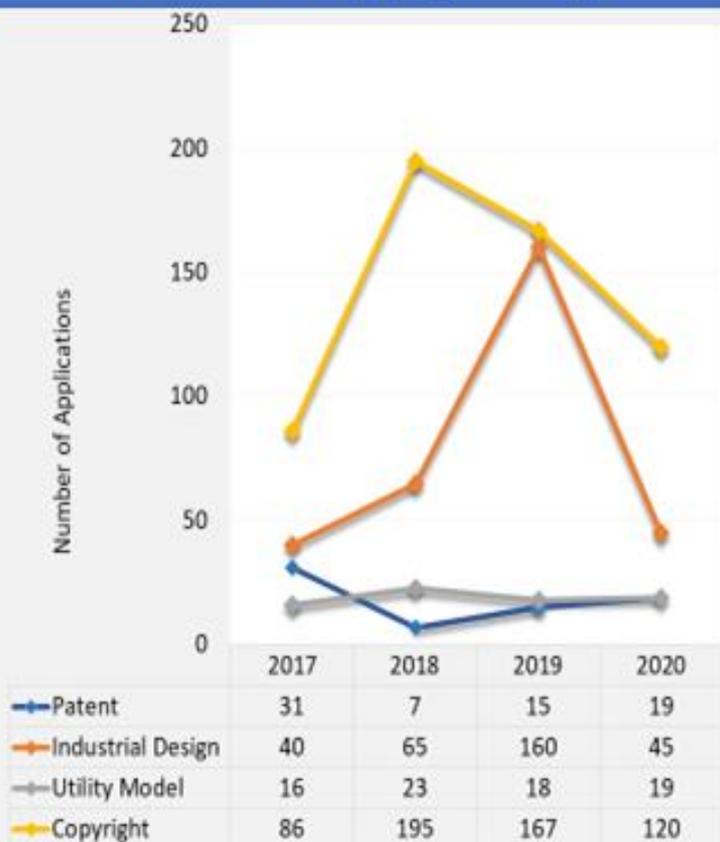
# Overview of the IP Landscape in Uganda

- Geographical Indications (Gi's)
  - The GI Act, 2013 and the GI Indications, Regulations 2018
  
- Trade secrets
  - Trade Secrets Act, 2009

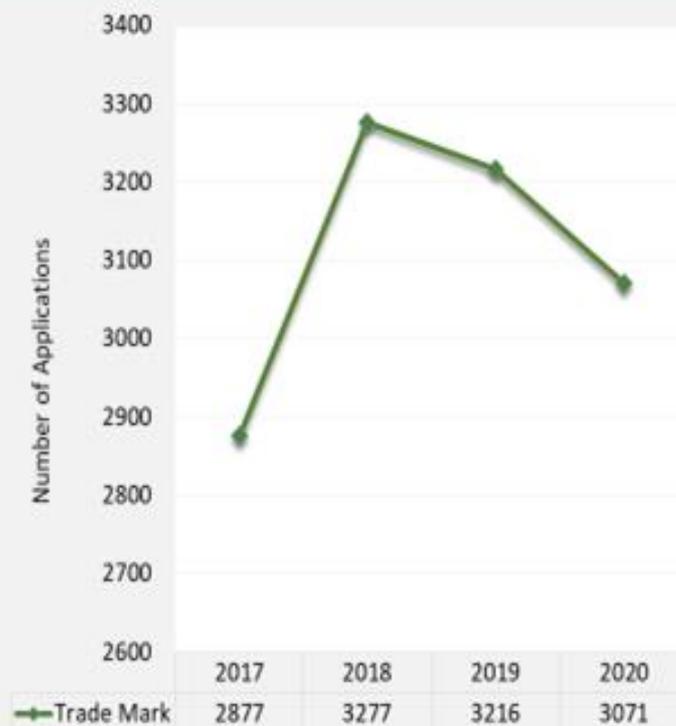


# IP Trends in Uganda

## Trends in Patent, Industrial Design, Utility Model and Copyright Filings



## Trends in Trade Mark Filings



# IP Trends in Uganda

- Leading IP rights protected are Trademarks, followed by Copyright and Patents
- Overall in terms of dispute settlement, more cases are filed for copyright and trademark infringement than other forms of IP.
- URSB is the institution for the registration of IP rights and dispute settlement
- The Commercial Court Division of the High Court handles disputes.
- URSB's enforcement unit handles the criminal aspects of IP infringement.
- Recent amendment to trademark regulations in 2021
- Uganda recently ratified 4 key international intellectual property treaties
- Introduction of electronic filing of trademark searches and applications. (Link on URSB website)



# Recently Ratified International Treaties On Intellectual Property in Uganda

Treaty	Date of ratification
Beijing Treaty on Audiovisual Performances	28 <sup>th</sup> January 2022
Berne Convention for the Protection of Literary and Artistic Works	28 <sup>th</sup> January 2022
WIPO Copyright Treaty	28 <sup>th</sup> January 2022
WIPO Performances and Phonograms Treaty	28 <sup>th</sup> January 2022



# Trademark (Amendment) Regulations, 2021

This Amendment carries 26 provisions that amend the Trademark Regulations, 2012. Some of these include;

- Mandatory registration of trademark agents.
  - Trademark agents to renew their registration annually.
  - List of trademark agents on URSB website.
- Classification of goods and services
  - Reference shall be made to the current edition of the International Classification of Goods and Services for registration of marks under the Nice Agreement of 15th June, 1957 and to the current edition of the International Classification of Figurative Elements of Marks under the Vienna Agreement of 12th June, 1973.
  - Previously reference was made to the 9<sup>th</sup> edition



# Trademark (Amendment) Regulations, 2021

- Publication in the URSB journal.
  - The intention was to make publications more affordable and easily accessible. This has however been put on hold.
  
- Special form for extension of time to do any act
  - Includes extension to apply to a notice of opposition
  - To respond to an office action such as provision of a POA, responding to a rejection notice or notice of opposition etc.
  
- Trademark Searches
  - Previously requested for by ordinary letter or even word of mouth on presentation of proof of payment of the relevant search fee
  - Introduction of new form for trademark search



## Case Study

### **In the matter of Trademark Application No. 56975 “Delights Automart “ in class 12 by Delights Automart Co. Ltd and In the matter of an opposition of the Registration by Delights Co. Ltd**

The Registrar found that the mark “Delight Automart” that the Applicant had applied to register in Uganda and “Delights” registered in Kenya visually, aurally and conceptually resembled each other. That the registration of “Delight Automart” in Uganda would not amount to a trademark infringement because,

- “Delights” had not been registered in Uganda but rather in Kenya.
- Secondly that the phrase “country of origin” as used in Section 44 (3) and (4) of the Trademarks Act seem to be used interchangeably. However, Article 6 of the Paris Convention for the Protection of Industrial Property suggests that this is the place where the applicant has a real and effective industrial establishment.

Since both companies in Kenya and Uganda were dealers in Japanese cars, the Applicant’s real and the effective industrial establishments were in Uganda and Kenya and not in Japan.

The Opponent failed to show that they had registered the mark in the country from which the goods originated, therefore the first in time to apply prevails “*qui prior est tempore potior est jure*”. The only recourse to the opponent was to apply for cancellation of the mark after its registration.



## Case Study

Applicant's Mark	Respondent's Mark
MOUNTAIN DEW	MORNING DEW

**In the matter of Trademark Registration No. 44668 “Morning Dew” in class 32 in the names of X-tra Industries Ltd and in the matter of an application for cancellation by Pepsico, Inc..**

Pepsico Inc.. the registered proprietors of trademark “Mountain Dew” applied for the cancellation of trademark “morning dew” registration No. 44668 in respect of goods in class 32 that has been registered to X-tra Industries Ltd in respect of mineral water in class 32 since it was confusingly similar to their registered mark.

Much as the marks sound different and in fact mean different things, they ought to be perceived as a whole, since consumers do not proceed to analyze its various details.

The registrar noted that both marks started with letter “M” for the first word and end with the word “Dew”, additionally the goods in issue are similar and intended to be sold and distributed, marketed and consumed in similar ways. There was a likelihood that the use of the Respondent’s mark “Morning Dew” would deceive the public as to the source of the relevant goods, therefore the entry was wrongly made on the register and had to be accordingly expunged.



## Case Study

### Kyaninga Royal Cottages Ltd v Kyaninga Lodge

- The High Court of Uganda, Commercial Division in March 2021 dismissed with costs a Trademarks suit that was instituted by Kyaninga Estates Limited, Trading as Kyaninga Lodge against Kyaninga Royal Cottages Limited over the use of the Trademark “Kyaninga Elegance at its Peak”
- The Court upheld an objection raised by the Defendant that the name “Kyaninga” cannot be protected under the Trademarks Act as it is not distinctive and it is a geographical name of a crater lake and village in Fort Portal City in Kabarole District found in Western Uganda part of Uganda.



# Opportunities for commercialization of IP Assets in Uganda

- Utilisation of IP assets as collateral for financing
  - IP Assets are recognized under the Companies Act, 2012 and the Security Interest in Moveable Property Act, 2019
  - Provide for the registration and enforcement of security in IP
  - IP charges can now be reflected on SIMPRS
  
- Need for increased valuation of IP assets to enable their commercialization in the following areas;
  - Licensing transactions
  - Assignment of a business
  - Mergers and Acquisitions
  - Joint ventures
  - Enables raising of funds



Thank you!



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