



UGANDA REGISTRATION SERVICES BUREAU

THE TRADEMARKS ACT, 2010

IN THE MATTER OF TRADEMARK APPLICATION NO. UG/T/2004/039465 “B & H” IN CLASS 9 IN THE NAMES B & H FOTO & ELECTRONICS CORP. AND OPPOSITION THERETO BY BENSON & HEDGES (OVERSEAS) LIMITED

BENSON & HEDGES (OVERSEAS) LIMITED:.....:OPPONENT

VERSUS

B & H FOTO & ELECTRONICS CORP:.....: APPLICANT




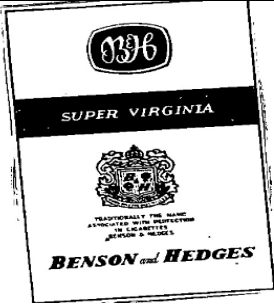

Before: Birungi Denis: Assistant Registrar of Trademarks

Ruling

(a) Background

1. The applicant is a company incorporated and headquartered in New York, United States of America. On 25th June 2004, through its agents MMAKs advocates, the applicant filed application number UG/T/2004/039465 for registration of “B & H” as a trademark in class 9 of the Nice Classification of Goods and Services in respect of Cameras, Photography equipment and accessories, and parts therefor, video cameras, video and audio receivers, speakers and other video and audio equipment and accessories and parts therefor, televisions, monitors, DVD players, DVD recorders, VHS, VCRs, home theatre projectors and other home entertainment, electronics and equipment, accessories and parts therefor, scanners, computers and computer equipment and accessory and parts thereof scopes and binoculars.
2. On 2nd November 2004, the Opponent, through its Advocates, J.B Byamugisha Advocates filed a notice together with grounds of opposition objecting to the registration of the applicant’s mark. The main ground for opposition is that the applicant’s registration and use of the mark would dilute the opponent’s brand because of its acquired reputation in Uganda associated with its goods, which

include cigarettes, cigars, roll your own tobacco, pipe tobacco and tobacco products. The Opponent has registered the following trademarks in respect of the listed tobacco products;

No	Trademark No.	Mark	Goods
1	13205		Tobacco, whether manufactured or unmanufactured.
2	2526	BENSON AND HEDGES	Cigarettes , Cigars and Smoking Tobacco
3	9309	 	Tobacco whether manufactured or unmanufactured.
4	8808		Cigarettes
5	8799		Cigarettes

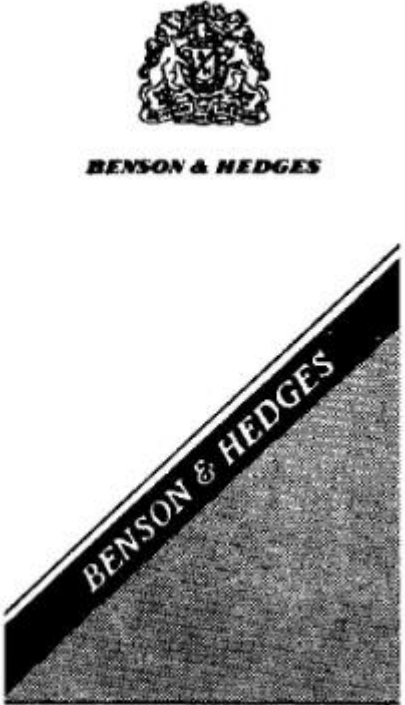
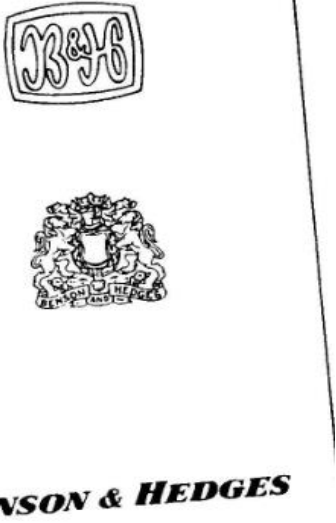
¹ Letters "B & H" are disclaimed

6	11022	BENSON & HEDGES VOGUE	Tobacco whether manufactured or unmanufactured
7	9271		Tobacco whether manufactured or unmanufactured.
8	2967	PARLIAMENT	Cigarettes, cigars and tobacco.
9	B422		Tobacco; smokers' articles; matches
1	16719		Tobacco whether manufactured or unmanufactured.

² The letters B and H are disclaimed




³ The letters B & H are disclaimed

⁴ The trademark expired in 2008 and has never been renewed.

1	16533		Tobacco whether manufacture or unmanufactured, smokers' articles and matches.
1	17609	<p>BENSON & HEDGES</p> 	Cigarettes, tobacco whether raw or manufactured, smokers' requisites, lighters and matches
1	19830	BENSON & HEDGES SUPREMA S.A. ⁶	Cigarettes, tobacco, tobacco products, smokers' requisites, lighters, matches.

⁵ Expired in 2007, has never been renewed.


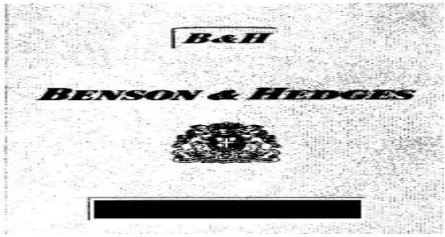
⁶ Trademark expired in 2008, has not been renewed

1	21228		Cigarettes, tobacco products, smokers' articles, lighters, matches.
1	21677		Cigarettes, tobacco, tobacco products, smokers' articles, lighters, matches.
1	21602		Cigarettes, tobacco, tobacco products, smokers' articles, lighters, matches.
1	19139	PARLIAMENT ⁹	Cigarettes Tobacco ,Tobacco products smokers' requites,lighters and matches.

⁷ Expired in 2019, has not been renewed

⁸ Disclaims the letters "B" and "H"

⁹ Expired in 2015

1	25559		Cigarettes, tobacco, tobacco products, smokers' articles, lighters, matches.
1	24602		Cigarettes, tobacco, tobacco products, smokers' articles, lighters, matches.

3. The opponent claims that the sign “B & H” is connected to its tobacco products marketed under the various trademarks listed above and hence is likely to deceive or cause confusion between its goods and those of the applicant. The opponent further contends that the applicant’s filing of the mark is intended to ride on the fame and reputation of its mark. Finally, the opponent contends that the opposed mark is confusingly similar to its marks and is likely to cause confusion in the market.
4. The disposal of this opposition has been long overdue. According to a letter on record, written to the Office by the Applicant’s advocates, dated 22nd February 2022, it is alluded that scheduling for the case took place on 12th September 2006 and parties were directed to file submissions. The submissions were never filed. The advocates consequently prayed for either a ruling based on the evidence and pleadings or a fresh hearing. The office issued a hearing notice setting the matter for fresh scheduling on the 20th May 2024.
5. When this matter came up for scheduling on 20th May, Counsel Brian Kajubi of MMAKs Advocates appeared for the Applicant. The opponent was not represented. Counsel for the Applicant prayed for the hearing to proceed *ex parte* on grounds that service of the hearing notice had been duly effected on the last known address of the opponent’s advocates. An affidavit of service was filed to this effect. Considering that this opposition, having been filed in 2004, has now spent 20 years before it is disposed of, I ruled that the matter would proceed for scheduling *ex parte* but with a direction to Counsel for the Applicant to notify, in

writing, the opponent's advocates of the issues framed and the timelines for filing submissions. The following issues were consequently framed;

(1) Whether the opponent's mark is eligible for protection as well-known mark under the Trademarks Act?

(2) Remedies

6. The parties were given timelines to file written submissions. The opponent was directed to file and serve by 4th June 2024. The applicant was required to file on 10th June 2024. The applicant duly filed its submissions but the opponent did not. In a letter dated 27th May 2024, copied to the Office, the Applicant's advocates wrote to J Byamugisha Advocates and S & L Advocates (both firms appear on record to have represented the opponent) informing them of the timelines to file submissions. The latter firm appear on record as recent advocates of the opponent. However, S & L received the letter in protest, noting that they are no longer instructed in the matter.
7. I proceed to determine this matter considering the statement of grounds, the evidence and the submissions of the applicant. I note that the opponent who filed this opposition in 2004 has not taken steps to prosecute it. This is not only strange but also an abuse of the opposition process. In the procedures and practice of Court contained in the Civil Procedure Rules, where a litigant files a suit but does not take reasonable steps to prosecute, a court may dismiss such a suit for want of prosecution. In the recent amendment to the Civil Procedure (**Civil Procedure (Amendment) Rules, 2019**), suits not prosecuted within 6 months may be deemed to have abated.
8. The Trademarks Act, 2010 and the Trademark Regulations, 2023 do not contain provisions empowering the Registrar to dismiss matters for want of prosecution nor do they provide for abatement of unprosecuted oppositions. However, the Regulations do impose obligations on the parties to take such necessary steps in the prosecution of the opposition such as filing of evidence within stipulated timelines and attendance of hearings. At the closure of evidence, regulation 36 empowers the Registrar to issue a hearing notice. Upon receipt of a hearing notice, regulation 36 (3) requires the recipient to notify the Registrar of its attendance by filing form TM 9 and if it omits to do so, the Registrar may deem the party as not

desiring to be heard and proceed to determine the matter *ex parte*. The Office has not been kept on the filing of TM 9, however, what is expected is that the party so served with the hearing notice should appear for the hearing.

9. According to the record, in a letter dated 15th March 2022, the Office wrote to opponent and its advocates directing them to file written submissions with 30 days. This was not done nor is there any communication by the opponent in response regarding this letter. There is no record of change of advocates on the file. The advocates have always been those indicated above. Where a change in representation is made, a party is under duty to notify the Office in writing so that any communication can be served on the new agents or advocates. Therefore, the fact that the advocates appearing on record no longer have instructions should not hinder or further delay the determination of this opposition as this would be prejudicial to the applicant.
10. A person who objects to the registration of a trademark is expected to prosecute the opposition in a timely manner. The practice of filing oppositions without prosecuting them is not only an abuse of process but it is also unfair to the applicant who pays the requisite fees, undertakes the required processes to file its mark only to be unreasonably delayed. The opposition procedure is not intended to be an obstacle to trademark registration but rather a safeguard to ensure that trademarks that are either similar to existing trademarks and hence likely to cause confusion with the opponent's goods or services, are not registered. To achieve this objective, the opponent must prosecute the opposition to its conclusion or where it is no longer interested, communicate that fact to the Office or withdraw the opposition accordingly.
11. The opponent after filing this opposition in 2004 did not take relevant steps to prosecute it to its conclusion. It is instead the advocates for the applicant who have consistently followed up to have the matter fixed and heard conclusively. The opponent being a foreign entity has an obligation to notify the Office in case of a change of advocates. This was not done. This omission is untenable, as it has delayed the registration of the applicant's mark for 20 years now. It is therefore in the interest of justice that this matter is determined, albeit without the opponent making submissions. I have considered the statement of grounds, the counterstatement, the evidence and the submissions of the applicant.

Determination of the issues.

12. The gist of the opposition, as per the statement of grounds, is that the sign "B &H" is a well-known mark belonging to the opponent's portfolio of trademarks used nationally and internationally for sale and marketing of its tobacco and tobacco related products and that its registration will confuse the customers of the opponent. While the opponent asserts likelihood of confusion, in my view it does not arise in this case. This is because the opponent's tobacco and tobacco related products as listed in paragraph 2 for its various trademarks are not similar or identical or in any way related to the goods in respect of which the applicant seeks to register the disputed mark.
13. The applicant seeks to register its mark in class 9 in respect of cameras, photography equipment and accessories, and parts therefor, video cameras, video and audio receivers, speakers and other video and audio equipment and accessories and parts therefor, televisions, monitors, DVD players, DVD recorders, VHS, VCRs, home theatre projectors and other home entertainment .electronics and equipment, accessories and parts therefor, scanners, computers and computer equipment and accessory and parts thereof scopes and binoculars. These goods are not the same, or similar nor are they of the same description to tobacco and tobacco products in respect of which the opponent's trademarks are registered.
14. Likelihood of confusion arises where there is double similarity; similarity between the trademarks and similarities between the goods or services in question. This was the position of the law at the time of filing this opposition in 2004 and is the position today. The now repealed Trademarks Act, Cap 217, which applied at the time, under section 14, provided as follows;

*14. Prohibition of registration of identical and resembling trademarks.
(1) Subject to subsection (2), no trademark shall be registered in respect of any goods or description of goods that is identical with a trademark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or that so nearly resembles such a trademark as to be likely to deceive or cause confusion.
(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the court or the registrar make it proper so to do, the*

court or the registrar may permit the registration of trademarks that are identical or nearly resemble each other in respect of the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as the court or the registrar, as the case may be, may think it right to impose

15. Section 14 of the repealed Trademarks Act, Cap 217 that applied at the time and indeed section 25 of the current statute prohibit registration of trademarks similar or identical with a trademark that is already on the register. Under that provision, it is not enough that the trademarks are similar. The goods for which the subsequent mark is sought to be registered must be the same or of the same description or must be services or description of services associated with the goods. This nexus between the similarity of the disputed marks and the nature of goods in question is the basis for determination of likelihood of confusion. Consequently, there is no likelihood of confusion where the marks in question are similar but the goods are very different.
16. In this opposition, similarity does not arise. The opponent's main claim is a request for refusal of registration of the applicant's mark on the basis that the mark is a sign recognized in the market, is famous nationally and internationally and hence should be protected as a well-known mark to prevent its brand from being diluted. The issue for determinations is whether the opponent's mark should be protected a well-known mark by refusing the registration of the applicant's marks.
17. The concept of well-known marks is derived from Article 6bis of the Paris Convention, which imposes obligations on the Members of the Paris Union, to which Uganda is, to protect well-known marks or famous marks as are sometimes called. I reproduce the provisions of Article 6bis.

“(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.”

(2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.

(3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith."

18. Article 6bis permits either cancellation or refusal to register a mark, at the request of an interested party. For this to happen, the following must be satisfied; (1) the legislation of the Country of the Union in question must *permit* or provide for such a remedy; (2) the mark in question must be confusingly similar to a mark considered a well-known mark or an essential part of it constitutes a reproduction of it, either in the country of registration or the country of use as being the mark of the person entitled to the benefits of the convention; (3) the mark must be intended to be used for identical or similar goods.

19. I should add however, that when it comes to protection of well-known marks, it is immaterial whether the goods or services are similar with those of the alleged infringer. The purpose of protection is to prevent brand dilution and to prohibit the infringer from riding on the established recognition and fame of the trademark owner—an act that would be contrary to honest commercial practice and hence qualify as an act of unfair competition. This aspect was introduced by article 16 (3) of the Agreement on Trade Related Aspects of Intellectual Property (TRIPs), a treaty binding on all members states of the World Trade Organization. It states; *"Article 6bis of the Paris Convention shall apply, mutatis mutandis, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between the goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use."*

20. Guidance on the protection of well-known marks can be obtained from the WIPO Joint Recommendation on well-known marks. Paragraph 2 of article 4 of the provides that if the applicable law of a member state allows third parties to oppose the registration of a mark, a conflict with a well-known mark shall constitute a ground for opposition. Explanatory note 5 to article 2 provides that *"Due to the principle of territoriality, well-known marks are enforced on a national basis. Evidence of successful enforcement of the right to a well-known mark or of the recognition of a given*

mark as being well known, for example, in neighboring countries, may serve as an indicator as to whether a mark is well known in a particular State. Enforcement is intended to be construed broadly, also covering opposition procedures in which the owner of a well-known mark has prevented the registration of a conflicting mark”.

Protection of well-known marks under Ugandan law.

21. The Paris Convention does not define what a well-known mark is, but leaves it to the determination of the competent authorities of the member states in their legal and administrative arrangements. The Ugandan Legislature provided for protection of well-known marks under section 29 of the now repealed Trademarks Act, Cap 217. It provided for defensive registration of so well-known trademarks in all classes the applicant chooses, including those goods or services not connected to the applicant for purposes of protecting the mark from registration by others and hence dilution. It provided as follows;

29. Defensive registration of well-known trademarks.

“(1) Where a trademark consisting of an invented word or invented words has become so well-known as respects any goods in respect of which it is registered and in relation to which it has been used that its use in relation to other goods would be likely to be taken as indicating a connection in the course of trade between those goods and a person entitled to use the trademark in relation to the first-mentioned goods, then, notwithstanding that the proprietor registered in respect of the first-mentioned goods does not use or propose to use the trademark in relation to those other goods and notwithstanding anything in section 28, the trademark may, on the application in the prescribed manner of the proprietor registered in respect of the first-mentioned goods, be registered in his or her name in respect of those other goods as a defensive trademark and, while so registered, shall not be liable to be taken off the register in respect of those goods under section....”

22. In accordance with that provision, the opponent’s claims based on well-known marks must therefore be limited to the confines of section 29 of the Trademarks Act, Cap 217, (now section 47 of the current Act) which is the manner in which municipal law domesticated the treaty provision relating to protection of well-known marks. Accordingly, Uganda did not domesticate article 6bis of the Paris Convention as it is in the treaty. It modified it by limiting protection with respect to defensive registration only.

23. Accordingly, the opponent cannot claim for protection as a well-known mark as a basis for objection to the registration of the applicant's mark where the goods are not similar or related. The only option available to the opponent was to apply for registration of the disputed trademark in all classes, with respect to all goods, upon satisfying the registrar that its trademark is a well-known mark within the meaning of section 29 of the Trademarks Act, Cap 217 (now section 47 of the Trademarks Act, 2010).
24. For the reasons above, this opposition is dismissed with costs.

I so Order.

Given under my hand this 21th day of **June** 2024

Birungi Denis
Ass. Registrar of Trademarks