



THE REPUBLIC OF UGANDA

THE TRADEMARKS ACT 2010 AND THE TRADEMARKS REGULATIONS 2012
IN THE MATTER OF TRADEMARK APPLICATION NO. UG/T2022/074413 'WAVE
EXPRESS' INCLASS 36 IN THE NAME OF AGABA ERNEST AND OPPOSITION
THERETO BY WAVE INTELLECTUAL PROPERTY INC.

WAVE INTELLECTUAL PROPERTY INC.:.....OPPONENT

VERSUS

AGABA ERNEST:.....APPLICANT

RULING

BEFORE: BIRUNGI DENIS: ASST. REGISTRAR TRADEMARKS

Representation

*Counsel Mr. Kenneth Muhangyi—for together with Ms. Catherine Akankwatsa for the
opponent. Mr. Kaddu Benjamin, its legal Manager, represented the opponent.*

Counsel Edwin Muhumuza represented the applicant.

A. Background

1. On the 07th February 2022, the applicant applied for the trademark “Wave Express” and the device in class 36 vide trademark application no. UG/T/2022/074413 for Financial services, Real Estate services and Insurance services as indicated below;



2. The said mark was published in the Uganda Registration Services Bureau (URSB) Journal No. URSB.IP.2022.006 on the 11th February 2022. On 7 April 2022, the Opponent filed a notice of opposition objecting to the registration of the mark together with grounds of opposition. The same was transmitted and the respective statutory documents filed. In its statement of grounds, the opponent contends to be

the registered owner of “WAVE” mark, and that though it is not registered in Uganda, the brand “wave” is operated in Uganda by Wave Transfer Ltd under a License and Service Agreement. That Wave Transfer Ltd carries mobile money business in which it uses the “wave” mark and is licensed by Bank of Uganda to operate in Ugandan territory. The opponent claims to have registered its wave mark in 52 countries. The opponent’s wave mark and device is indicated below;



3. It should be noted that the opponent’s mark is not registered in Uganda. It was after the applicant had filed its application on 7 February 2022 that the opponent attempted unsuccessfully to apply for the registration of its mark. According to the record, the opponent applied for the wave mark vide application no. UG/T/2022/074855 “wave and the device” and UG/T/2022/074834 “wave” in class 36 in respect of financial services on 21 March 2022. Both applications were rejected by the examiner vide exam reports dated 14th April 2022 and 31st March 2023 on grounds that the proposed marks were similar to the applicant’s mark pending registration, which is the subject of these proceedings.
4. Dissatisfied with the examiner’s report, the opponent’s advocates responded vide letter dated 03rd May 2022, appealing to the Registrar to reconsider her decision and grant their client’s mark, on grounds among others, that the Wave Brand in Uganda is operated by Wave Transfer Ltd under a license agreement. They argued that Wave Transfer Ltd as a beneficiary under the agreement has carried mobile money transfer business and other financial services business in Uganda using the mark since 2014 and that the opponent is a registered owner of the mark in the United States of America, the European Union and the United Kingdom. The opponent also argued that due to the registration of its mark in the United States of America, the Registrar of trademarks in Uganda is under duty to register the mark pursuant to the Paris Convention for the Protection of Industrial Property of 1883. Finally, the opponent contended that its mark is widely used in Uganda and hence has acquired good will and reputation. The opponent appealed to the Registrar to reconsider her

decision and grant both its applications that were rejected because of prior filing by the applicant.

5. In her response in exam report dated 27 May 2022, the Registrar declined the appeal and maintained her decision. She reasoned that intellectual property is territorial; hence, registration in other states does not justify registration in Uganda. With respect to the arguments based on the Paris Convention, the Registrar stated that article 6 ^{quinquies} B-1 of the Paris Convention allows the Registrar to decline to register a mark, if registration of the same would affect third party rights. The Registrar cited section 25 of the Trademarks Act, 2010 to support this position, and maintained the rejection. She advised the opponent to wait for the outcome of these opposition proceedings.

B. Issues

6. When both parties appeared before me for scheduling on the 16th December 2022, the following issues were agreed for consideration;
 - I. *Whether the applicants mark is confusingly similar to the opponents mark?*
 - II. *Whether the applicant is capable of distinguishing the applicant's services from those of the opponent?*
 - III. *Whether the applicant's mark was filed in good faith?*
 - IV. *Whether the opponent's mark is internationally recognized?*
 - V. *Remedies*
7. Parties were directed to file written submissions as follows; the opponent to file and serve its submissions by 16 January 2023. The applicant to file submissions in reply by 17 February 2023. The opponent to file a rejoinder by 24 February 2023. The ruling was scheduled for 7 April 2023.
8. By 7 April 2023, the opponent had filed its submissions, however, the applicant had not, albeit without any request to file out of time. This prompted the Registrar to summon the parties for mention on 12 April 2023 to inquire into the reasons for non-compliance with timelines. On that day, Counsel Blair Michael Ntambi appeared for the opponent while Counsel Muhumuza Edwin appeared for the applicant. By consent of both Counsel, the following new timelines were set: Counsel for the

applicant to file and serve submission by 17 April 2023, Counsel for the opponent to file a rejoinder by 25 April 2023.

9. Surprisingly, by 25 April 2023, Counsel for the applicant had still not filed submissions. The opponent vide email dated 25 April 2023 brought this to the attention of the Registrar and sought guidance on how to proceed. The applicant's Counsel was copied to this email. In response to the email, the Registrar advised that failure to comply with timelines does not bar him from exercising his quasi-judicial functions to determine the merits of the opposition considering submissions and evidence on record filed within stated timelines.
10. In a strange manner, upon receiving the Registrar's response, Counsel for the applicant, via email on the same day sent his submissions to Counsel for the opponent with the Registrar in copy. At this time, Counsel for the applicant was out of time and Registrar made it known to him that his submissions would not be considered as no request for extension of time had been filed to file out of time.

C. Analysis.

Whether the applicants mark is confusingly similar to the opponents mark?

11. The Trademarks Act, 2010 stipulates the criteria and test for registration of a trademark. Section 4, provides for protectable subject matter that qualifies to be registered as a trademark to include; (1) a sign or combination of signs, capable of distinguishing goods or services of one undertaking from those of other undertakings. (2) where a sign is not inherently capable of distinguishing the relevant goods or services, qualification for registration shall depend on distinctiveness acquired through use. This criterion has two underlying aspects—ability of the mark to distinguish goods or services of one enterprise from that of others, and two, where that ability is absent, then registration depends on the acquired distinctiveness through use.
12. Section 9 of the Trademarks Act, 2010, sets a more elaborate criterion for distinctiveness. It provides, in paragraph (d) that for a mark to be registered in part A, it shall contain a word or words having no direct reference to the character or

quality of the goods or services, and not being according to its ordinary signification, a geographical name or a surname.

13. While section 9 (2) explains the meaning of distinctiveness as follows; “For the purposes of this section, “distinctive” means—

(a) in the case of a trademark relating to goods, adapted in relation to the goods in respect of which the trademark is registered or proposed to be registered, to distinguish goods with which the owner of the trademark is or may be connected, in the course of trade, from goods in the case of which no connection subsists or;

(b) in the case of a trademark relating to services, adapted in relation to services in respect of which the trademark is registered or proposed to be registered, to distinguish services with which the owner of the trademark is or may be connected in the course of trade, from services with the provision of which he or she is not connected, generally or, where the trademark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(3) In determining whether a trademark is adapted to distinguish as goods or services, the registrar or the court may have regard to the extent to which—

(a) the trademark is inherently adapted to distinguish goods or services; and

(b) by reason of the use of the trademark or of any other circumstances, the trademark is in fact adapted to distinguish goods or services.”

14. The procedure for trademark registration provides for publication of the mark before registration to notify the public and give an opportunity to any aggrieved party whose mark maybe infringed on and whose customers may be confused by the registration of the applicant’s mark, and the co-existence of goods or services, bearing that mark alongside those of the aggrieved party. Section 12 creates the right to object to the registration of a mark. The application for opposition or objection must be supported by grounds—which grounds must be those that are sufficient, under the Act, to warrant rejection of a mark.

15. The right or locus to object to registration is given to an “a person”. The question therefore is, who is that person qualified to object under section 12 of the

Trademarks Act? The answer to that question is under section 44 of the Trademarks Act. The person—natural or legal—must satisfy the test set thereunder.

16. Section 44 provides that;

- (1) Subject to subsection (3), the registrar may refuse to register a trademark relating to goods in respect of goods or description of goods if it is proved to his or her satisfaction by the person opposing the application for registration that the mark is identical with or nearly resembles a trademark which is already registered in respect of—
- (a) the same goods;
 - (b) the same description of goods; or
 - (c) services or a description of services which are associated with those goods or goods of that description, in a country or place from which the goods originate.”

Subsection 2 of section 44, which applies to services, as is the case in these proceedings, provides as follows;

- “Subject to subsection (3), the registrar may refuse to register any trademark relating to services in respect of any services or description of services if it is proved to his or her satisfaction by the person opposing the application for registration that the mark is identical with or nearly resembles a trademark which is already registered in respect of—
- (a) the same services;
 - (b) the same description of services; or
 - (c) goods or a description of goods, which are associated with those services or services of that description, in a country or place from which the services originate.

17. From the above provisions, the criteria to establish locus for successful opposition proceedings is as follows; first, the opponent must prove to the satisfaction of the Registrar that the opposed mark is *identical* with or *nearly resembles* a trademark, which is already registered. Second, that registered trademark whose resemblance is alleged must be in respect of either the same goods or services as those of their mark, same description of services or goods or description of goods associated with those services or services of that description. Third, the already registered mark likely to be infringed by the registration of the applicant’s mark and its associated

services, must be in a country, meaning the country where registration is sought or in the place (which includes a country) from where those services originate.

18. In the instant matter, the opponent's 'wave' mark is not registered in Uganda but according to the opponent's statement of grounds and statutory declaration, it was first registered in the United Kingdom (UK) on 20th September, 2016 under Reg. UK 00915441281 as a trademark in class 09 and 36. It is also registered and operates in the European Union covering 27 countries of the Union as well as in Africa under the African Intellectual Property Organization (OAPI). It is also registered in Canada, Gambia, Ghana, Malawi, Zambia. The opponent's mark is also registered in Tanzania, USA and Zanzibar under the Madrid system of the World Intellectual Property Organization, claiming priority as back as 2016. The opponent adduced evidence on the statement of grounds to prove registration in those countries by way of certified certificates of registration and I find that this fact is sufficiently proved on a balance of probabilities.
19. Counsel for the opponent raised three arguments in support of the opposition. The first argument is that the applicant's Wave Express Mark and the opponent's Wave Mark are identical and nearly resembling or similar so as to lead to a likelihood of confusion on grounds that the two marks are similar visually, phonetically and conceptually. Secondly, Counsel submitted that the opponent's marks is an internationally recognized mark and hence protected by section 44 (2) of the Trademarks Act, 2010. According to him, this section envisaged international registrations and sought to place priority on marks first registered albeit not in Uganda. Third, Counsel submits that Article 6^{bis} of the 1967 Paris Convention for the Protection of Industrial Property requires Uganda—a member country, to afford certain protections to well-known marks such as the opponent's, regardless of whether they are registered in Uganda or not. Counsel prays that the opposition is granted and the applicant's application be rejected. On their part, the applicant in the counterstatement maintain that its mark is not visually, phonetically and conceptually similar due to the existence of a bird with blue and brown colors on the right part of the mark and the fact that it is restricted to real estate services under

class 36 and not financial services offered by the opponent, and prays that the opposition be dismissed with costs.

D. Decision

20. I have read the grounds of opposition, the counterstatement, the evidence filed and the opponent's submissions. I will now proceed to assess whether the opponent meets the criteria set out under the law to succeed with this opposition.

21. First, the opponent must prove satisfactorily that the opposed mark is *identical* with or *nearly resembles* a trademark, which is already registered.

Factors to consider in assessing similarity of trademarks and likelihood of confusion

22. The case of ***Specsavers International Healthcare Ltd v Asda Stores Ltd*** [2012] EWCA Civ 24 adopts, with approval, a useful guide developed by the United Kingdom Trademark Registry to determine identity and likelihood of confusion. I will reproduce it extensively;

- a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

- f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;
- i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.

23. As to similarity and resemblance of the marks, while, visually, the opponent's and the applicant's mark appear different with the opponent's mark containing the word "wave" and a penguin with a raised hand waving, while the applicant's mark contains the word "wave" and a bird flying in the right direction with its wings spread out. However, the two marks are phonetically and aurally similar due to the dominant part of the word "wave" in both marks as well as the "wave/waving" aural/phonetic impression as well as the entire getup of the marks. The dominant wave impression is caused by two elements. On the part of the opponent's mark, the word "wave" and the raised hand of a penguin "waving". On the applicant's mark, the word "wave" and the phonetic impression. The applicant, in its counterstatement argues that their mark is positioned above the word "express" in black font with a bird on the right, colored in brown and blue and that these make it different from the opponent's mark. The applicant contends that the only shared word is "wave" which, they contend, is

insufficient to cause confusion between the two marks. With due respect I disagree with the applicant's view. The overall impression created by the features of both marks, is likely to cause confusion, as I will enumerate below.

24. Let me begin with the definition of the word "wave" to gather the different meanings and possible impressions and how these may be invoked by both marks. The online Cambridge dictionary defines "wave" in different ways. It includes the following, among others meanings; *"to raise your hand and move it from side to side as a way of greeting someone"*, *"a raised line of water that moves across the surface of an area of water especially the sea"*, *" a pattern in which some types of energy, such as sound, light, and heat are spread or carried"*. The devices of the penguin and a flying bird (both birds) in the opponent and the applicant's mark respectively each create a wave impression both visually and aurally when placed side-by side as indicated below;



25. The dominant element of the word "wave" as can be observed when both marks are placed side-by side and the phonetic similarity when pronouncing both marks is likely to confuse an ordinary consumer who does not pay attention to the practical details of brands. Due to the phonetical and aural similarity. If a customer was to enter an agent banking shop and ask to transact through "wave", assuming both the opponent and the applicant services were offered in the same shop, the service provider would be prompted to ask; which "wave"?. While color difference is a key component in trademark examination, the difference in color in the opponent and applicant's mark is negligible. In both marks, there are minor shades of brown color. For the opponent's mark on the beak and claws of the penguin while for the applicant's mark, on the lower part of the bird. The opponent's mark contains a significant part of sky blue color, while the applicant's mark contains minor blue color in the bird's wings. The only brown color on the applicant's mark is found on the lower part of the bird's wings, while the upper part has blue color, which forms a

greater part of the opponent's mark. As such, the color difference in the applicant's mark is negligible to create sufficient distinction.

26. I am mindful of the principle that in order to assess whether or not a trademark has any distinctive character, the overall impression given by it must be considered. Authorities have stated however, that that does not mean, that one may not first examine each of the individual features of the get-up of that mark in turn and that it may be useful, in the course of the overall assessment, to examine each of the components of which the trade mark concerned is composed (**see Case C-286/04 P Eurocermex v OHIM [2005] ECR I-5797, paragraphs 22 and 23**). Accordingly, the analysis of the each component above, and the overall impression created, would lead to the conclusion that there would be a likelihood of confusion between the services of the opponent with those of the applicant as both are falling under class 36 of the Nice Classification of goods and services. The applicant's contention that the word "express" creates a distinction is not tenable. This is because the applicant disclaimed the word "express"—meaning it does not form part of the mark for which he seeks exclusive protection and as such another person is free to use it save for using it in combination with the protected parts of the mark for the same services. As such, am convinced on a balance of probability that applicant's mark, if registered, is likely to cause confusion with services of the opponent. This determination however, in and of itself, is not decisive. The opponent must satisfy, on a balance of probabilities, the other requirements under section 44, to which I address in the following paragraphs.

27. Second, under section 44 (2), the registered trademark whose resemblance is alleged must be in respect of either the same services, same description of services or goods or description of goods associated with those services or services of that description. The applicant seeks to register the mark in class 36 for financial services, real estate services and insurance services. On the other hand, according to evidence adduced by the opponent, its wave mark is registered in other countries in several classes including 36 for among others, financial services. With regard to

financial services, the opponent satisfies this requirement, however, this again is not conclusive to determine the opposition.

28. Third, under section 44 (2), the opposed mark allegedly likely to be infringed by the registration of the applicant's mark must be registered in a country (meaning the country where registration is sought) or in the place (which includes a country) from where those services originate. It is already settled that opponent's mark is not registered in Uganda. The alleged extension to Uganda is by a License agreement with Wave Transfer Ltd, which in my opinion does not suffice. Therefore I will now turn to the second alternative, namely that the opposed mark and its associated services purported to be likely to be infringed by the registration of the applicant's mark, must be registered in a place (country) where the services originate. Under this alternative criterion, the place of origin for the opponent's services is not stated anywhere in the filed documents; however, its mark was first registered in the United Kingdom. For purposes of these proceedings, I will take the United Kingdom as the place where services originate. Nevertheless, application for registration of the applicant's mark cannot be refused unless the other criteria under subsection 3 and 4 of that section, is satisfied. I now turn to subsection 3.

29. Subsection 3 of Section 44 provides that; "application to register shall not be refused under this section where—

- a) the applicant proves that he or she or his or her predecessors in business have in Uganda, in relation to the goods or services, continuously used the trademark for the registration of which he or she has made application from a date before the date of the registration of the other mark in the country or place of origin; or
- b) the person objecting does not give an undertaking to the satisfaction of the registrar that he or she will, within three months from the giving of the notice of objection, apply for registration in Uganda of the trademark registered in the country or place of origin and will take all necessary steps to complete the registration.

30. I note that under paragraph 38 of statement of grounds, the opponent undertakes to register its mark within 3 months and indeed has already filed applications for registration of the marks, which have been rejected pending the determination of this dispute. The opponent therefore satisfies the requirements of section 44 (3) (b). On the other hand, the applicant has not adduced any evidence to prove that they or their predecessors in business in Uganda have previously used the mark and that they applied prior to the opponent's registration in the country of origin. Indeed as per the record, their application for the disputed mark, the subject of these proceedings, was filed in 2022, while that of the opponent was registered in the United Kingdom in 2016.
31. By their admission in the counterstatement, the applicant only indicated in para 2.1 that it is desirous of engaging in one of the services in class 36, which include insurance services, real estate and insurance services. Nowhere do they state and adduce evidence to show that they have previously used the mark in the same business or applied to register the same before 2016. As such, they have not fulfilled the requirement under section 44 (3) (a).
32. While the opponent ticks the box on all the requirements under 44 (2) and (3), there is an overall requirement under section 44 (4) which provides that: "*The protection given under this section in respect of a trade mark in relation to goods and services originating from a country other than Uganda shall only be accorded if the country of origin of the goods and services accords to goods and services originating from Uganda the same treatment.*"
33. The requirement of section 44 (4) is premised on the principle of national treatment that underpin most bilateral and multilateral trade agreements between and among states. Simply put, it is the idea that if a state provides certain rights and privileges to its citizens, it should also provide the same rights and privileges to foreigners as a matter of reciprocal arrangement between states. In brief, it is the principle of giving others the same treatment as one's own nationals, usually based on treaty obligations.

34. The protections under section 44 are only available if the country of origin of the services accords similar protections as those under section 44 to goods and services originating from Uganda. According to the record and Counsel's submissions, the opponent's mark was first registered in the United Kingdom on 20th September, 2016 under Reg. UK 00915441281 in class 09 and 36. The opponent is a United States Incorporated company. The documents filed however do not show the origin of the services. According to the certificate of incorporation attached to the statement of grounds, the opponent was incorporated in the state of Delaware in the year 2021, while its mark was first registered in the United Kingdom in the year 2016. As earlier stated, for purposes of these proceedings, we shall consider the United Kingdom as the country of origin of the services. Therefore, for the provisions of section 44 to protect the applicant, the United Kingdom must, in its legal provisions, accord Uganda the same protections as those under section 44.

35. Counsel for the opponent has submitted vehemently on how the applicant's application would fail under the test in section 44 (2) and (3) and how they satisfy the same test but has made no submission as to the applicability of section 44 (4) to this proceedings, save for elaborate submissions and pleadings that the opponent's mark is a well-known mark, eligible for protection under the Paris Convention, thereby by invoking the universality principle.

36. While Counsel for the opponent claims protections under the Paris Convention, it is a general principle of law that intellectual property law protection is territorial. The territorial principle stipulates that intellectual property rights do not extend beyond the territory of the sovereign state, which granted the rights in the first place. The exception to this principle is the universality principle, which Counsel for the opponent invokes by citing provisions of the Paris Convention on protection of well known marks as one of the grounds for the opponent's objection. Before I address Counsel's arguments on well-known marks as protected under the Paris Convention, I note that Uganda is a dualist country, hence recognition of

international law is subject to domestication and manner in which a treaty in question is domesticated by Parliament.

Applicability of the Paris Convention on the protection of Industrial Property.

37. The Paris Convention on the Protection of Industrial Property (the Paris Conventions), to which Uganda is a member, provides as follows;

Article 6^{bis}: “*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.*” It should be noted that article 16 (2) of the Agreement on Trade Related Aspects of Intellectual Property (TIPs) extends this provision to services. It provides: “*Article 6^{bis} of the Paris Convention (1967) shall apply, mutatis mutandis, to services. In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark.*”

38. Article 6^{bis} is the basis for the universality principle, an exception to the territoriality principle. The article 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; (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. I have already held that the two marks are confusingly similar and are used or applied to be used for identical or similar goods under class 36. I will now

proceed to determine whether the opponent is entitled to protection as a well-known mark within the meaning of the Paris Convention as domesticated by the Ugandan Trademarks Act, 2010.

Determination of a well-known mark.

39. The World Intellectual Property Organization (WIPO) Handbook page 151 and 152, provide useful guidance on the concept of well-known marks and how they should be protected by member states of the Paris Convention. It states in para 5.82 “*The Convention deals with well-known trademarks in Article 6bis. This Article obliges a member country to refuse or cancel the registration and to prohibit the use of a trademark that is liable to create confusion with another trademark already well known in that member country. The effect of this Article is to extend protection to a trademark that is well-known in a member country even though it is not registered or used in that country*”. *The protection of the well-known trademark results not from its registration, which prevents the registration or use of a conflicting trademark, but from the mere fact of its reputation.*
40. Para 5.84 of the WIPO Handbook further provides that: “*The trademark that is protected by Article 6^{bis} must be a “well-known” trademark, as determined in a member country by its competent administrative or judicial authorities. A trademark may not have been used in a country, in the sense that goods bearing that trademark have not been sold there; yet that trademark may be well-known in the country because of publicity there or the repercussions in that country of advertising in other countries*”. While para 5.85 adds that: “*The protection of a well-known trademark under Article 6^{bis} exists only where the conflicting trademark has been filed, registered or used for identical or similar goods, as determined by the administrative or judicial authorities of the country in which protection is claimed.*”
41. Further guidance on the protection of well-known marks can be obtained from the WIPO Joint recommendation on well-known marks. For instance, paragraph 2 of article 4 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”.

Treatment of well-known marks under Ugandan law.

42. 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 47 of the Trademarks Act. Section 47 provides for defensive registration of *exceptionally 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 dilution. Consequently, section 47 (2) of the Trademarks Act, 2010 of Uganda provides factors to consider in determining whether a mark is well known for purposes of defensive registration. It provides: “*In determining whether a trademark relating to goods or services is exceptionally well-known and whether its use in relation to other goods or to services or both, would be likely to detract from its distinctive character in respect of goods or services for which it is registered, the registrar shall have regard to all related circumstances, including—*

- a) *the length of time the trademark has been in use;*
- b) *the extent to which it has become well known in relation to the goods or services in respect of which it is registered;*
- c) *the nature of those goods or services; and*
- d) *whether the notoriety of the mark is limited because of its use on goods or services that do not have wide distribution.*

43. It should be noted that the protection of well-known marks under the convention were domesticated under section 47 of the Trademarks Act with respect to defensive registration only, and protection is granted not to *well-known* marks but *exceptionally well-known* marks. The use of the words “*exceptionally*” in the Ugandan Trademark

Act, sets even a higher standard beyond what the Paris Convention provides. The Oxford Online dictionary defines “exceptionally” to mean “to a greater degree than normal”. Therefore, the opponent can only claim that its mark is well-known to the required degree set, and only when applying for defensive registration under section 47 and not as basis for opposition as it seeks to in these proceedings. Had the legislature intended the protection for well-known marks to apply to other aspects such as refusal of registration (section 44) and cancellation (section 45), it would have expressly stated so in its legal arrangements. The opponent’s claims based on well-known marks must, therefore, be interpreted within the confines of the manner in which municipal law domesticated treaty provision in question, and in this case, article 6^{bis} of the Paris Convention. The literal reading of section 47 reveals that Uganda did not domesticate article 6^{bis} of the Paris Convention as it is in the treaty. It modified by limiting it to registration and by setting a higher standard. Accordingly, the opponent cannot claim for protection as a well-known marks in these proceedings.

Protections of marks registered in the country of origin.

44. Section 44 of the Trademarks Act, protects marks which are registered in the country of origin and allows owners of such marks to object registration of similar marks, for as long as they meet the full criteria set out in section 44. As earlier analyzed, the opponent meets much of the criteria under section 44. This includes the opposed mark being similar with that of the opponent, the mark being sought to be registered being in the same class and for similar goods or services, and that the opponent has given an undertaking to register its mark within three months from the notice of objection and lastly, that the country from which the goods or services of the opponent originate grants Uganda similar protections. I now turn to this last requirement of reciprocal treatment.

45. From the earlier analysis, the opponent’s services originate from the United Kingdom, which is a state party to the Paris Convention. Counsel for the applicant did not adduce any evidence to prove that the United Kingdom provides Uganda similar protections under section 44 of the Trademarks Act, 2010. While, I am

mindful of the law of evidence regarding interpretation of foreign law, I have labored to peruse the UK Trademarks Act 1994 (as amended) to ascertain whether the United Kingdom accords Uganda similar protections as those accorded under section 44 of the Uganda Trademarks Act. Section 56 of the Trademarks Act 1994 of the United Kingdom (as amended) provides;

“Protection of well-known trademarks: Article 6bis.

(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention [or the WTO agreement] as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who—

(a) is a national of [the United Kingdom or] a Convention country, or

(b) is domiciled in, or has a real and effective industrial or commercial establishment in, [the United Kingdom or] a Convention country, whether or not that person carries on business, or has any goodwill, in the United Kingdom.

References to the proprietor of such a mark shall be construed accordingly.

(2)The proprietor of a trade mark which is entitled to protection under the Paris Convention [or the WTO agreement] as a well known trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark which, or the essential part of which, is identical or similar to [the well-known trade mark—

(a) in relation to identical or similar goods or services, where the use is likely to cause confusion, or

(b) where the well-known trade mark has a reputation in the United Kingdom and the use of the other trade mark—

(i) is without due cause, and

(ii) takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the well-known trade mark.]”

46. It should be noted that when section 44 (4) requires the country of origin to grant Uganda the same treatment, it does not imply that provisions of the law giving such treatment in the country of origin should expressly mention Uganda—akin to a

bilateral arrangement between two countries. It is sufficient for countries to rely on a multilateral arrangements that would lead to the same effect and indeed the Paris Convention provides such a framework. As already discussed, countries are free to provide for the applicability of these arrangements in their national legislation. Both the United Kingdom and Uganda have done so in their respective Trademarks Act. For the United Kingdom, section 56 of its trademarks Act, while for Uganda it has done so in sections 44, 45 and 47 of the Trademarks Act, 2010.

47. The High Court of Uganda has recognized Uganda's domestication of the principle of reciprocal protection among member states to the Paris Convention in the case of **Nairobi Java House Ltd v Mandela Auto Spares Ltd Civil Appeal No 13 Of 2015** where Justice Christopher Madrama (as he then was) stated that: *“The Ugandan Trademarks Act 2010 has domesticated some of the principles of the **Paris Convention for the Protection of Industrial Property** under sections 44 and 45 thereof. Section 44 (1) gives the registrar power to refuse a trademark where it resembles or is identical with a foreign registered trademark registered prior in time. Section 44 (2) gives the Registrar discretionary powers to refuse to register a foreign registered trademark on the ground that the mark is identical with or nearly resembles a trademark which is already registered in respect of the same services, the same description of services; or goods or a description of goods or services which are associated with those services or services with that description in a country or place from which the services originate. However section 44 (3) provides that the Registrar shall not refuse the application for registration in Uganda if the Applicant proves prior use continuously of the mark before the registration of the foreign trademark in the country of origin. The general principle that emerges from sections 44 and 45 of the Trademarks Act 2010 of Uganda is that the mark registered first in time takes priority to a later trademark in case of resemblances.”*
48. While both countries do not provide for articles 6^{bis} protections in the same way, they are hinged on the same multilateral framework as noted in the dictum of Madram J above. Consequently, from the reading of section 56 of the UK Trademarks Act, it is clear that Uganda being a member of the Paris Convention, goods and services originating from its territory would benefit from the protections

granted under section 56 of the UK Trademarks Act pursuant to article 6^{bis} protections. Similarly, even if the United States (a convention country)—the country of incorporation of the applicant had been used as the country of origin, similar protections exist under § 44 (15 U.S.C. § 1126) of the United States Trademarks Act, 1946 that governs international conventions. As such the opponent meet the requirements of section 44 (4) and the opposition accordingly succeeds. Each party shall bear its own costs.

I so order.

Given under my hand, this 07th day of June 2023

Birungi Denis
Ass. Registrar of Trademark