

A Short Guide to

Trademark Law

in Tanzania and Zanzibar





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CONTENTS

TOPIC	PAGE
Introduction	1
Meaning and selection of trademarks	2
Trademark registration process	6
Licensing and assignment of trademark	10
Duration of registration	11

Introduction

The purpose of this guide is to help you understand the overview of trademark law in Tanzania mainland and Zanzibar. Although Tanzania mainland and Zanzibar are united in many areas such as foreign affairs, local trademark legislation is not a union matter. Each country has its own local trademark legislation. Since foreign affairs is a union matter, international treaties that have been ratified by the United Republic of Tanzania such as Paris Convention apply to Tanzania mainland and Zanzibar. Despite the fact that Tanzania mainland and Zanzibar have different local trademark legislation, most of the issues pointed out in this guide apply to Tanzania mainland and Zanzibar unless indicated otherwise. Currently, both Tanzania mainland and Zanzibar apply International Classification of Goods and Services (Nice Classification - Eighth Edition).

This guide explains the following aspects:

- Meaning and selection of trademarks
- Trademark registration process
- Licensing and assignment of a trademark
- Duration of Registration

This guide summarises the main features of trademark law in Tanzania and Zanzibar. It should not be relied upon as a substitute for obtaining specific advice before determining a course of action. If you would like more information, please contact the following individual who is our partner in charge in intellectual property services:

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Meaning and selection of trademarks

What is a trademark?

A trademark is a sign that distinguishes goods or services of one trader from those of another. According to trademark laws of Tanzania and Zanzibar, a trademark must be a visible sign. A trademark is simply a word, phrase, symbol, or design that appears on the product being sold and which distinguishes itself from other words, phrases, symbols or designs in the marketplace. A service mark is a type of trademark used by the owner or authorized user to provide services instead of goods. A service mark is also represented by a word, phrase or symbol. Another word for trademark is 'brand name'.

Companies work hard to make their trademarks distinctive. A strong trademark may become so embedded in the public's consciousness such that it virtually replaces the real name of the product. The trademark protects the marketing idea. When a company issues a trademark, it wants to make sure that the consumer doesn't confuse its product with some other company's product. The trademark protects the company's image or reputation and helps to create brand loyalty that enables the company to stay in business. Trademarks have become increasingly valuable as the global marketplace has expanded. In situations where markets are flooded by goods and services from all over the world, companies are challenged to work harder to establish and protect their trademarks.

While it is not compulsory to register a trademark, registration provides an easier and more cost efficient way to enforce the rights conferred by a trademark and may prevent other traders from using the mark on the same or related goods or services. Where a trademark is deemed to be well known in Tanzania, it is possible to prevent use of a trademark even in relation to unrelated goods or services. When a registered trademark is infringed, the trademark owner may obtain legal relief to stop the infringement and claim damages or an account of profits. On the other hand, trademark registration provides a defense against trademark infringement proceedings brought by other persons claiming to have rights in the trademarks. Generally, registration of a trademark grants its owner the exclusive right to use, license and assign the trademark. Registration gives also the owner a right to import and offer for sale all goods and services for which it is registered.

The registration of a business or company name conveys limited rights in a name. For this reason, it is worthwhile applying for trademark registration.

Selecting appropriate trademark

Generally, the most effective trademarks are:

- easy to pronounce easy to spell
- easy to remember

- easy to reproduce verbally or in writing
- able to be used worldwide without different or controversial meanings in other languages
- easy to distinguish from trade marks used by competitors.

Which trademarks can be registered?

To be eligible for registration, a trademark must be capable of distinguishing goods or services of one trader from those of another. For this reason, a trademark should not be:

- a sign which other traders are likely to wish to use in conjunction with their similar goods and services. Trade marks which are descriptive of the goods or services, or expressions and acronyms common to the trade generally fall into this category. For example the word 'SOAP' cannot be used as a trademark for soaps.
- a geographical name identical with, or imitate the armorial bearings, flags and other emblems, initials, names or abbreviations or initials of name or official sign or hallmark of any state or organization.
- a reproduction in whole or in part of well-known trade marks, business or company names.
- likely to deceive or cause confusion (eg trade marks which imply a false geographical origin or quality of the goods or services).
- substantially identical with or deceptively similar to a prior trade mark application or registration in relation to the same, similar or closely related goods and services.

Substantive evidence of use of a trade mark which shows that the sign is in fact capable of distinguishing the goods and services may, in some instances, assist in obtaining registration.

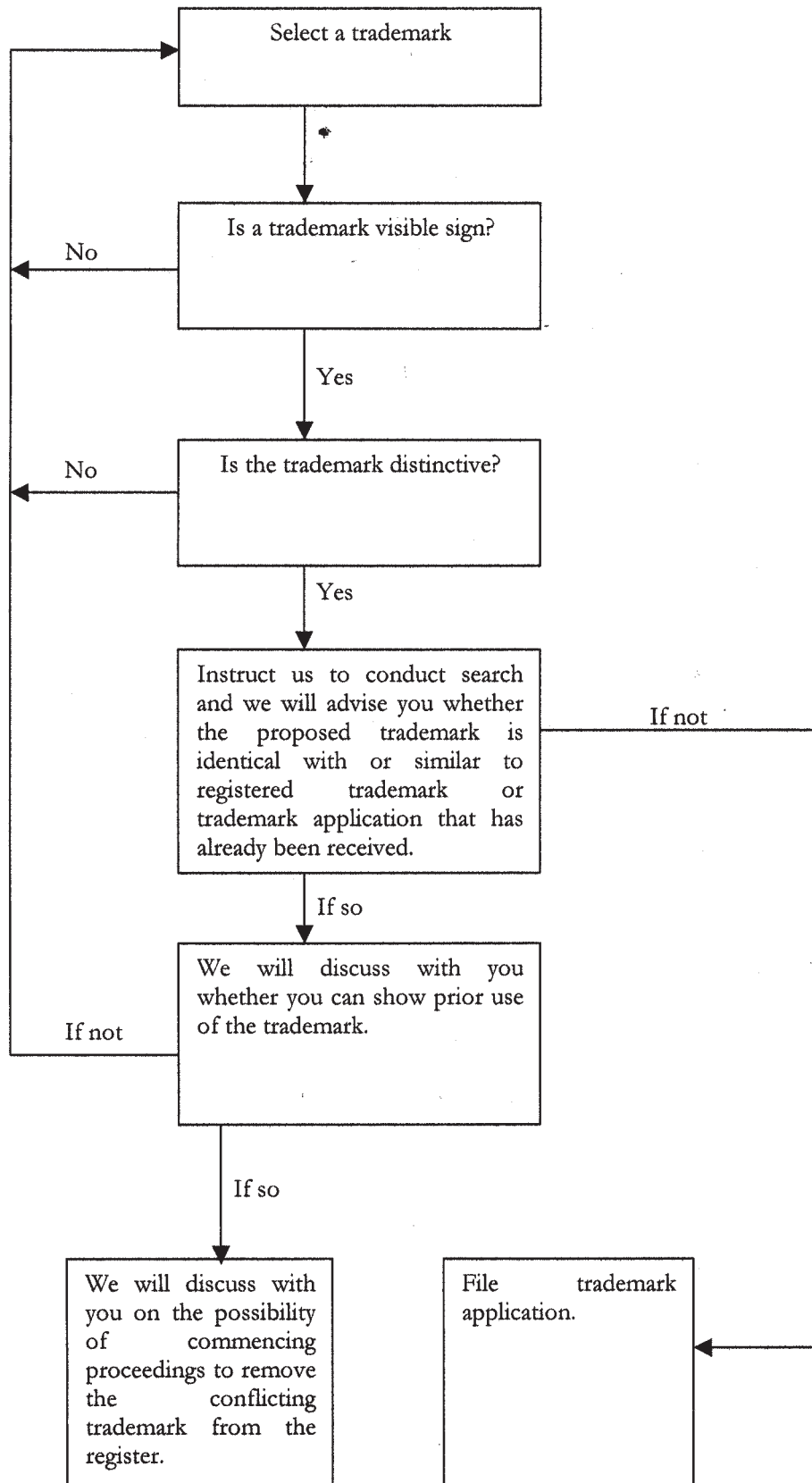
Conducting search

Trademark search is not compulsory in Tanzania and Zanzibar. Trademark search is always conducted with a view to identifying whether or not the proposed trademark is identical with or similar to a registered trademark or trademark application that has already been received. The search is generally confined to single class, except for related goods covered in different classes such as mouth washes, not for medical purposes (Class 3) and mouth washes for medical purposes (Class 5). We will be in a position to advise you precisely whether the search will cover more than one class when

you inform us the proposed specification of goods or services.

Whenever the search fails to reveal a trademark which is identical with or similar to the one being proposed, it does not imply acceptance of the proposed trademark by the Registrar. The major advantage of conducting search is that it reduces the degree of uncertainty. It also reduces monetary loss because charges payable to the Registrar and Attorneys are non-refundable when the registration process is not completed for failure by the Applicant to meet statutory requirements. It is therefore worthwhile to conduct search before filing a trademark application.

Flowchart illustration of the preliminary process



Trademark registration process

Filing a trademark application

An application for the registration of a trademark is filed with Trademark Office. The rights granted after registration dates back to the date of filing of the application.

Filing requirements

To file a trademark application on your behalf, we require the following:

- The Power of Attorney to appoint us as your trademark Agent. There are special forms of Power of Attorney that applies in Tanzania and Zanzibar (these forms are available on our website). The Power of Attorney does not require notarization or legalization;
- Applicant's full name and address;
- Ten (10) prints of the proposed trademark (except for word marks in ordinary type). If applicable, you have to inform us whether the trademark is to be filed in color;
- Priority Document (if applicable) with verified English translation;
- If the proposed trademark is in a language other than English, the Trademark Office normally requires the application to be accompanied with verified English translation;
- Description of the goods and services for which registration is to be registered so that we may assist you to draft suitable specification; and
- Payment of filing fee.

Trademarks are classified according to the goods or services for which you propose to use and register the mark. As pointed out above, both Tanzania and Zanzibar apply International Classification of Goods and Services (Nice Classification - Eighth Edition).

Examination

A Trade Marks Office Examiner will review the application to make sure that the trade mark meets the requirements prescribed by the Trade and Service Marks Act, 1986 (Tanzania) and Trade Marks Decree, Cap 157 (Zanzibar).

The Examiner considers the registrability of the trademark and issues a report. The Registrar may require further information from the applicant to facilitate completion of the examination process. When the examination is completed, the trademark

application may be accepted on certain conditions such as disclaimer of certain word(s), association of the proposed trademark with other marks in the register, etc. The trademark application may be refused entirely if the proposed trademark:

- lacks distinctiveness;
- is a prohibited mark; or
- is identical or similar with the mark already in the register or in a pending application.

When the trademark application is refused or accepted on certain conditions, the trademark Office gives an opportunity to the applicant to overcome the objections raised by the Examiner. Normally, the applicant makes a counter argument by supplying additional evidence and/or making amendment to the application.

Acceptance and opposition period

When the Examiner is satisfied that there are no outstanding objections from the Trademark Office, the trademark will be recommended for acceptance and advertised in the Patents, Trade and Service Marks Journal. When the trademark is advertised in the Patents, Trade and Service Marks Journal, third parties can oppose the registration of the trademark within sixty days (for Tanzania) and ninety days (for Zanzibar) from the date of advertisement. If no opposition is filed (or an opposition is resolved in favor of the applicant), the application proceeds to registration and a certificate of registration is issued upon payment of registration fee. The registration date that is indicated in the certificate of registration is the date on which the application for registration was received.

Benefits of registration and prevention of losing rights

Generally, registration of a trademark gives the registered proprietor the exclusive right to the use of the trademark in relation to goods and services to which it is registered for, including sale and importation of the respective goods and services. There are a number of guidelines you should follow to prevent losing the rights to use your trademark.

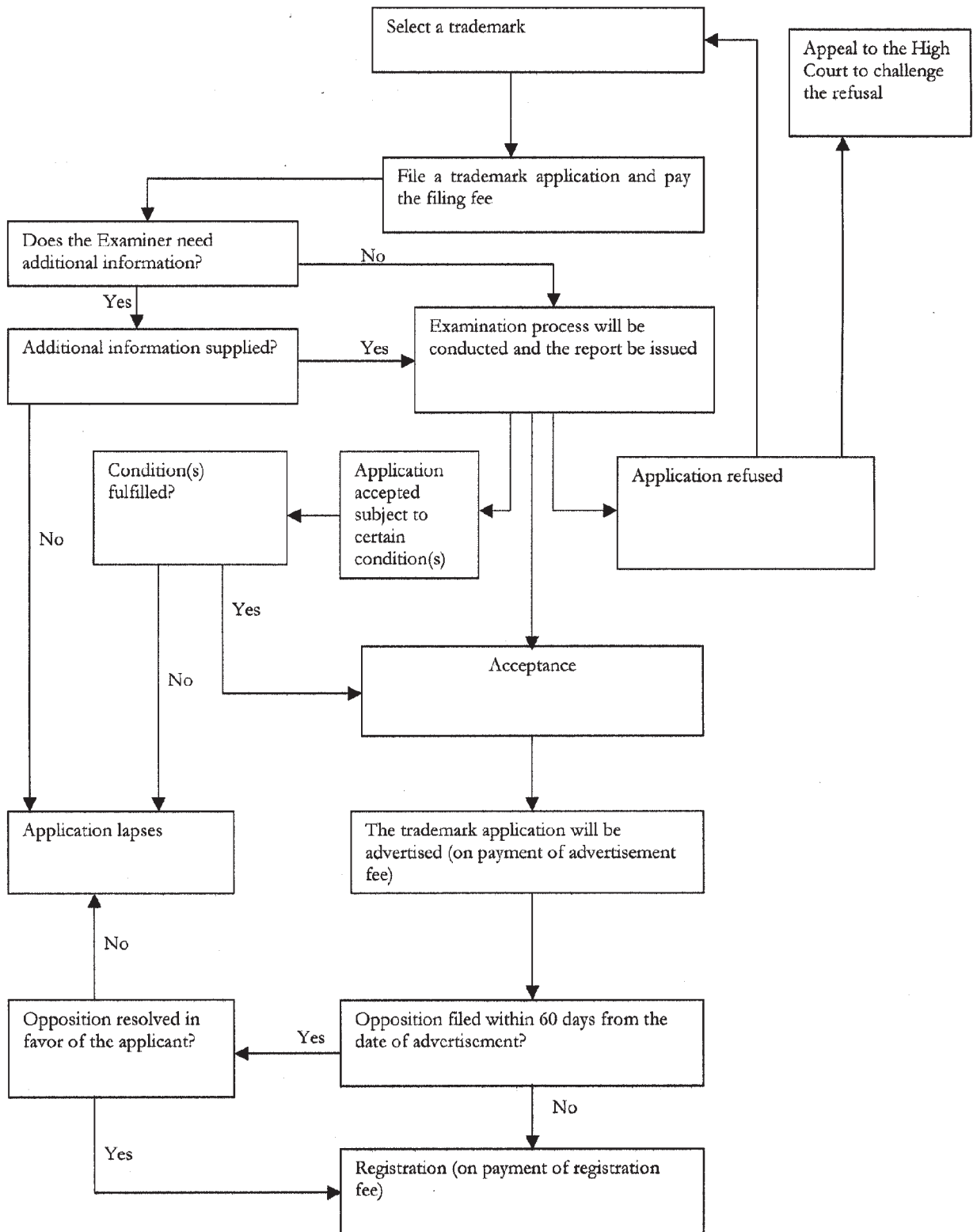
- You have to use your trademark in relation to goods and services that it was registered for.
- Do not make additions or alterations that affect substantially the identity of the trademark. If your trademark is registered in a stylized form, make sure that you use it in that form. Do not copy or imitate in any way the names, trademarks, or logos of another business or company.

Maintaining your trade mark registration

A trademark may be removed from the register if it has not been used on the registered goods and services for a continuous period of three years. However, a removal action

may only be filed after five years from the date of filing of the trademark. A trademark can also be cancelled if it becomes generic, i.e., it is generally recognized as the name of the goods or services. Examples of trademarks that have become generic include computer, internet and escalator.

Flowchart illustration of trademark registration process in Tanzania



Licensing and assignment of a trademark

Licensing

Whenever a trademark owner allows someone else to use the owner's trademark, the owner and the user should enter into a written license agreement. It is generally recommended that the trademark license agreement should contain quality control provisions that govern the quality of goods or services to which the trademark may be applied. Failure to include and enforce adequate quality control provisions in licensing agreement may lead to the trademark being removed from the Trade Marks Register on the basis that its use is deceptive.

Assignment

A registered trademark is a personal property and therefore can be bought, assigned or transmitted. If a trademark is assigned, this should be formally recorded on the Trade Marks Register. Recording the assignment will:

- place on public record the rights over the trademark that have been given out to the third party.
- provide sufficient proof of the rights (if any) that have been reserved over the trademark by the original owner, which may be necessary in instituting or defending legal action.

In most cases, assignment or transmission vests all rights over the trademark to the new owner such that even original owner is prohibited from using the trademark.

Duration of registration

In Tanzania, the first registration period for trademark is seven (7) years. The duration of registration can be renewed for further ten (10) years after expiry of original registration or of the last renewal of registration. In Zanzibar, the first registration period for trademark is fourteen (14) years. The duration of registration can be renewed for further fourteen (14) years after expiry of original registration or of the last renewal of registration.

The following are the requirements for renewing a trademark in Tanzania: (i) payment of renewal fee and maintenance fee (ii) Filing of power of attorney; (iii) filing of statement of use; and (iv) if the trademark has not been used, filing statement of the circumstances that prevented the use.

In Tanzania, the renewal of the trademark registration has to be done any time not more than three months before the expiry of the registration period. However, late filing of the application for renewal is allowed on the condition that additional fee must be paid. Although the law requires that late filing/renewal must be filed not more than one month after the expiry of the registration period, in practice, late filing/renewal can be done anytime before the removal of the mark from the register.

With regard to Zanzibar, the renewal of the trademark has to be done any time not more than three months before the expiry of the registration period. However, late filing of the application for renewal is allowed on the condition that additional fee must be paid. Although the law requires that late filing/renewal must be filed not more than one month after the expiry of the registration period, in practice, late filing/renewal can be done anytime before the removal of the mark from the register.

Contact us

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