TRADEMARK REGISTRATION IN TANZANIA
(TANGANYIKA AND ZANZIBAR)

INTRODUCTION

Trademark registration in Tanzania is not the union matter as such each region of the union has its own laws regarding trademark registration. Though, the application of these laws is geographically limited, the laws are providing for almost similar procedure for registration of trademark in Tanzania.

Therefore, Tanzania mainland has its own Laws and Regulations dealing with trademark registration and maintenance and as well as Zanzibar has its own regime. For one to enjoy protection of trademark registration across the United Republic of Tanzania, separate applications for registration of trademark must be filed in both regions of the Union.

In Tanzania mainland trademarks are regulated by different legislations including, Trade and Service Mark Act. NO 12 of 1986, Trade and Service mark regulations of 2000, Merchandise Mark Act NO 20 of 1963 and Merchandise Mark Regulations of 2008, while in Zanzibar trademarks are governed by the Zanzibar Industrial Property Act of 2008 which superseded the Trade Mark Decree of 1930.

Most of the issues covered in this article apply to Tanzania mainland and Zanzibar unless stated otherwise.

A Trademark is a distinctive sign which identifies certain products or services as those produced or provided by a specific person, enterprise or a group of persons/enterprises allowing the consumer to distinguish them from goods or services of others.

A visible sign means any sign which is capable of graphic reproduction, including words, name, brand, devise, heading, label, ticket, signature letter number, relief, stamp, seal, vignette, emblem or any combination thereof.

**SIGNIFICANCE OF TRADEMARK**

The trademarks play an important role for the commercialization and growth of the industry. It is an asset, which forms the foundation of any business to the ultimate purchaser or the consumer. It is the trademark, which provides a link between the goods and the manufacturer. The reputation built by a trademark on account of its quality or performance coupled with the customer satisfaction, influences the customer's mind for repeat orders.

The customer may not even know the name or the address of the manufacturer but it is the mark, as an ambassador of the manufacturer, which weights his decision to buy or not to buy a particularly branded product. It takes a long journey for any manufacturer to establish goodwill or reputation of his trademark in the eye of the ultimate purchaser so as to reap long-term benefits. The publicity of the trademark by the proprietor also plays an important role in a reputation built up exercise.

Trademarks establish goodwill between the source of a product or service and the consumer. A well-chosen and well-publicized trademark often has value far beyond the physical assets of a company. Trademarks uniquely associate a product or a service with a particular source, even if that source is unknown to
the consumer. Thus, trademarks help businesses build and retain demand for their products and services while enabling consumers to quickly identify and make a purchase decision based upon a recognized trademark.

REGISTABILITY AND REGISTRATION OF TRADEMARK PROCESS IN TANZANIA MAINLAND AND ZANZIBAR

What can be registered as Trademark?

In order for a trade or service mark to be eligible for registration it must fulfill the criteria for registration. A registrable trade or service mark should not be generic or descriptive but should be distinctive. The laws provide that “A trade or service mark shall be registered if it is distinctive”.

A trade or service mark is distinctive if it is capable, in relation to goods or services or in respect of which is registered or proposed to be registered, of distinguishing goods or services with which its appropriator is or may be connected in the course of trade or business from goods.

Unless such mark is a visible sign, graphically presentable, distinctive in nature, lacks any conflict with public order or morality, not a geographical name or identical with or imitate the armorial bearings, flags, and other emblems, initial names or abbreviations or initial of names or official signs or hallmark of any state, or organization, not a reproduction of well-known marks, business or company names and not likely to deceive or cause confusion, it won’t be eligible for registration under the laws of Tanzania.

The descriptiveness of a trademark is determined only after an evaluation of the mark relative to the goods or services, not in the abstract. One must consider the possible significance the mark would have to the average consumer of those goods or services.
If the average purchaser would recognize the trademark as describing an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services, then the mark would be refused to be registered for being merely descriptive. For example, marks which identify or describe a product or service, or which are in common use, or which are used as geographical indicators, must remain available for use to anyone.

For this reason, a generic term such as ‘apple’ or descriptive term such as ‘red’ or ‘juicy’ generally could not be registered in relation to apples.

**TRADEMARK REGISTRATION PROCESS.**

As indicated above the trademark registration is governed by two different laws between the regions of the United Republic of Tanzania, the procedure and requirements are more or less similar in both regions.

It worth noting that, multi-class Trademark applications are not permitted in both regions of the United Republic of Tanzania. As such the applicant who wants to apply for registration of trademark on more than one class has to file separate application for each class of his Trademark

1. **Search on availability of Trademark**

Registration process may start by conducting search of the trademark you want to register with the Trademark Registry, that is Business Registration and Licensing Authority (BRELA) for Tanzania Mainland and Zanzibar Business and Property Registration Agency (ZBPRA) for Zanzibar.

Trademark search is not compulsory in both Tanzania mainland 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.
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 important to conduct search before filling a trademark application.

2. Filing Application for Registration of Trademark

After the applicant or his agent has conducted a search and is satisfied that there is no any other word, logo or mark of the same kind or resemblance that has been registered then the applicant has to fill in the respective forms for application for Registration of Trademark.

The application is made through BRELA online system, and by physical paper at the ZBPRA, Accordingly the law requires that the application must contain and be filed together with;

i. the name and address of the applicant, the trade or business description of the applicant,
ii. one print of trade or services mark proposed for registration,
iii. a list of goods or services to which the sign would apply (class),
iv. a certified translation of the mark in English language if the mark is on language other than English and Swahili.
v. Power of Attorney, which is a specified as Form TM/SM 1 (no notarization or legalization is required).

A person has the right to make application to claim and enjoy the benefits of an earlier protection, if he has applied for protection for any trade or service in a country which is party to the Paris Convention for Protection of Industrial Property, 1983, when his application succeed his application will be deemed to
be the same date of application in the country provided that application for registration in Tanzania is made within Tanzania is made within six months from the date of earlier application.

3. Examination of the Trademark Registration Application.

After the application has been received by the registrar and upon payment of the necessary fees, examination will be conducted to whether the requirements are met. The registrar may require additional information regarding trademark registration application to enable him to accept the mark, if the registrar will find the mark does not meet the requirements even after provision of additional information, may reject the application by giving out his reasons and if practicable, will require the applicant to amend the mark so as to meet the required standard.

If the trademark is **accepted** the registrar will proceed to advertise it on the government gazette for 60 days to invite the public to file opposition if any within that specified time.

4. Opposition of Trademark registration Application

The opposition of Trademark registration Application may be filed at any time within 60 days from the date of advertisement. Any person who wants to make an opposition shall file a notice of objection that stipulates all the grounds for the opposition before the expiration of the time for advertisement, however the laws allow the registrar to extend the time to file opposition as he deems reasonable upon application for extension of time by the person who intends to oppose the registration of the mark. (Mostly the extension is given for up to 60 more days from the day of application).

Upon receiving the opposition and relevant evidences, the registrar will notify the applicant of the same and invite him to file a counter statement and relevant evidences against the opposition. Thereafter the registrar will invite
both parties to appear for hearing where both parties will be given a chance to present their case, the registrar will finalize the hearing and give out his decision.

5. **Registration of the Trademark**

Where no objection has been received within 60 days, and upon the final determination of the opposition against application for registration, if the registrar, ruled against the opposition, then the registrar will proceed to register the trademark and issue the certificate of registration. The registration shall be effective as from the date of application for registration.

**DURATION AND EFFECTS OF REGISTRATION OF TRADEMARK**

One of the effects of registration is to disentitle any person to institute any proceedings prevent or to recover damages for infringement of unregistered trademark. However, this restriction is not available for action against any person for passing off goods or service of another person or the remedied in respect thereof.

As such, upon registration, the registered proprietor acquired exclusive right to the use of the trademark in relation to any goods including sale, importation and offer for sale or importation.

The registered owner of the trademark in Tanzania mainland is entitled to enjoy protection and exclusive rights and benefits for the period of consecutive **seven (7) years** for the first registration and such registration is subject to renewal for further consecutive **ten (10) years** upon the expiration of the original time. While in Zanzibar the period of consecutive **ten (10) years** is enjoyed for first registration and upon expiration of such time can be renewed for further periods of consecutive **seven (7) years**.
MAINTAINING, LICENSING AND ASSIGNMENT OF REGISTERED TRADEMARK

Removal and Cancellation of registered trademark

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.

Licensing of registered trademark

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 provision in licensing agreement may lead to the trademark being removed from the Trademarks Register on the basis that its use is deceptive.

Assignment or Transmission of registered trademark

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 Trademark Register. Recording the assignment will;

❖ Place on public record the rights over the trademark that has 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.

**TRADEMARK INFRINGEMENTS AND REMEDIES**

Trademark infringement is a violation of the exclusive rights attached to a registered trademark without the authorization of the owner or any licensees. Infringement may occur when another person uses a trademark which is identical or confusingly similar to a registered trademark owned by another person, in relation to products or services which are identical or similar to the products or services which the registration covers. The owner of such registered trademark may commence legal proceedings against the infringer.

An exclusive right granted as a result of registration is deemed to be infringed by any person who, not being the proprietor of a trademark or registered user thereof using by way of the permitted use, uses a sign;

- Which is identical with or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade or business, in relation to any goods in respect of which it is registered
- Which is identical with or nearly resembling it in the course of trade or business in any manner likely to impair the distinctive character or acquired reputation of the trademark
- In applying the trademark upon the goods after they suffered alteration as respect to their state or condition
- Where the trade mark is upon the goods, altering or obliterating it, whether wholly or partly
❖ Where the trade mark is upon the goods, applying any other trade mark to the goods; and
❖ Where the trade mark is upon the goods, adding to the goods any other matter in writing that is likely to injure the acquired reputation of the trade mark.

In the event that there has been an infringement on one’s exclusive right attached to a registered trademark, the following remedies may be explored;

❖ To request that the fact of infringement be declared by the High Court of Tanzania.
❖ To request an injunction to stop the infringement and to forbid the infringer from carrying out further infringing activities.
❖ To demand satisfaction from the infringer by way of a declaration or other appropriate means; if necessary, the owner of the mark may demand that such declaration be published by the infringer or at the infringer’s expense.
❖ To claim full damages under the general law of tort or contract, in case the trademark infringement has caused any material damage; when establishing the damages, the prejudicial effects of the infringement for all economic activities of the enterprise are taken into consideration.

Additional Information;

The experienced Trademark attorneys and agents at Abbay Attorneys are ready to assist our clients and render highly professional services in all trademark related matters including filing and prosecution of application for trademark registration, representation of clients during the opposition of application, renewal of registered trademarks, Recordial of Assignment, Change of address, name or Merger, litigating and defend trademark actions instituted before the courts in Tanzania.

You may also visit our website; https://www.abbayattorneys.co.tz/, for more information on our services, or you may send an email to us for a specific inquiry and we will be sure to respond within 24 hours.