

CHAPTER 326

THE TRADE AND SERVICE MARKS ACT

[PRINCIPAL LEGISLATION]

ARRANGEMENT OF SECTIONS

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CHAPTER 326

THE TRADE AND SERVICE MARKS ACT

An Act to provide for the registration, and protection of trade and service marks and for related matters.

[1st October, 1994]

[G.N. No. 458 of 1994]

Act No. 12 of 1986

PART I

PRELIMINARY PROVISIONS (ss 1-2)

[PCh326s1]1. Short title

This Act may be cited as the Trade and Service Marks Act.

[PCh326s2]2. Interpretation

In this Act, unless the context requires otherwise—

"assignment" means transfer by act of the parties concerned;

"Convention" means the Paris Convention of 20th March, 1983 for the Protection of Industrial property and any of its revisions to which Tanzania is or may become party in the future;

"Court" means the High Court;

"International Classification" means the classification according to the Nice Agreement concerning the International Classification of Goods and Services for the purpose of the Registration of Marks, of June 15, 1957, as last revised;

"limitations" means any limitations of the exclusive right to use of a trade mark given by registration of a person as its proprietor, including limitations of that right as to the mode of use, as to use in relation to goods or services to be sold or otherwise traded in any place in Tanzania or as to use in relation to goods or services to be exported to any marked outside Tanzania;

"Minister" means the Minister responsible for the Trade and Service Marks Office;

"pending trade or service mark" means a trade or service mark which is the subject of an application for registration;

"previous Ordinance" means the Trade Marks Ordinance *;

"register" means the Register of Trade and Service Marks kept under the provisions of this Act;

"registered trade or service mark" means a trade or service mark which is actually on the register;

"registered user" means a person who is registered as such under section 42;

"Registrar" means the Registrar of Trade and Service Marks appointed under section 4;

"Regulations" means the regulations made under section 60 of the Act;

"trade or service mark" means any visible sign used or proposed to be used upon, in connection with or in relation to goods or services for the purpose of distinguishing in the course of trade or business the goods or services of a person from those of another;

"Trade and Service Marks Office" means the Trade and Service Marks Office established under section 3;

"transmission" means transfer by operation of law, demolition on the personal representatives of a deceased person and any other mode of transfer not being an assignment;

"use of a trade or service mark" means subject to the provisions of sections 31 and 32 use in relation to goods or services in a printed or other visible representation;

"visible sign" means any sign which is capable of graphic reproduction, including a word, name, brand, device, heading, label, ticket, signature, letter, number, relief, stamp, seal, vignette, emblem or any combination of them.

PART II

ADMINISTRATION, THE REGISTER, POWERS

AND FUNCTIONS OF THE REGISTRAR

AND OTHER PROVISIONS RELATING

TO THE COLLECTION OF FEES (ss 3-13)

[PCh326s3]3. Establishment of the Trade and Service Marks Office

There is hereby established an Office which shall be known as the Trade and Service Marks Office.

[PCh326s4]4. Officers of the Trade and Service Marks office

(1) The President shall by Government Notice published in the Gazette appoint a Registrar of Trade and Service Marks who shall perform the duties and exercise powers imposed or conferred by this Act and shall be responsible for its administration.

(2) The Minister shall appoint one or more Deputy Registrars of Trade and Service Marks who shall, subject to the directions of the Registrar have all the powers and privileges conferred by this Act on the Registrar.

(3) The Minister shall appoint such examiners and other officers as may be necessary for carrying out the provisions of this Act.

[PCh326s5]5. Seal of the Registrar of Trade and Service Marks

(1) The Registrar shall have a seal of any device which may be approved by the Minister provided always that until the seal has been obtained a stamp in the form which the Minister may approve shall be used in lieu of it.

(2) The Seal shall be used in the manner as shall be directed by the Registrar.

(3) Impressions of the seal or stamp shall be judicially noticed and admitted in evidence.

[PCh326s6]6. Register of Trade and Service Marks

(1) The Registrar shall maintain a register in which he shall record all trade and service marks granted under this Act and any other matters as may be prescribed.

(2) Any person may on request consult the Trade and Service Marks Register and may take extracts or any information from it on payment of a prescribed fee.

[PCh326s7]7. Evidence

Entries made in the Trade and Service Marks Register in pursuance of this Act may be proved by any documents and copies certified in the manner which may be directed by the Registrar, and the copies of the entries shall be evidence of any matter required by this Act.

[PCh326s8]8. Hearing before exercise of discretion

Without prejudice to any law the Registrar shall give any party to a proceeding before him an opportunity of being heard before exercising adversely to that party any discretion vested in the Registrar by this Act or regulations.

[PCh326s9]9. Proceedings before a Registrar

Subject to the provisions of section 10 in any other proceedings before the Registrar under this Act, evidence shall be given by affidavit and the Registrar may, if he deems fit take oral evidence on oath in lieu of or in addition to any other evidence and shall cross-examine any witness on such evidence.

[PCh326s10]10. Oaths and affirmations

Any person who is required under the provisions of this Act to take any oath or swear to an affidavit shall, in lieu of it, make Conditions of Oaths and affirmation conform with the provisions of a "Statutory Declaration" as provided for in the Interpretation of Laws Act *.

[PCh326s11]11. Power to award costs

In all proceedings before the Registrar, under this Act, the Registrar shall award to any party any costs which he may consider reasonable and may direct how and by which parties they are to be paid, and that order may, by leave of the court, be enforced in the same manner as a judgment or order of the court to the same effect.

[PCh326s12]12. Fees

(1) Where under the provisions of this Act—

(a) a fee is payable in respect of the performance of any act by the Registrar, the Registrar shall not perform that act until the fee has been paid; or

(b) a fee is payable in respect of doing of any act by any person other than the Registrar, the act shall be deemed not to have been lodged until the fee has been paid; or

(c) a fee is payable in respect of the lodging of a document, the document shall be deemed not to have been lodged until the fee has been paid.

(2) All fees prescribed under this section shall be collected and accounted for in any manner which the Minister with the approval of the Minister for Finance shall direct.

[PCh326s13]13. Trade and Service Marks Journals

The Registrar shall publish a journal to be referred to as the Trade and Service Marks Journal, in which particulars of applications for the registration of trade marks, reports of cases, any other matters arising under the provisions of this Act and any other matters as he may deem fit.

PART III

ACQUISITION OF THE EXCLUSIVE RIGHT

TO A TRADE OR SERVICE MARK

AND CLASSIFICATION (ss 14-15)

[PCh326s14]14. Acquisition of the exclusive right

(1) The exclusive right to the use of a trade or service mark as defined in section 32 shall be acquired by registration in accordance with the provisions of this Act.

(2) Registration of a trade or service mark shall not be considered validly granted until the application has fulfilled the conditions for registration.

[PCh326s15]15. Classification of registration

Trade or service Marks shall be registered in respect of particular goods or services in one or more classes of International Classification and any question arising as to which class any goods or services fall in shall be determined by the Registrar, who shall have the final decision.

PART IV

REGISTRABILITY REQUIREMENTS (ss 16-20)

[PCh326s16]16. Distinctiveness

(1) A trade or service mark shall be registered if it is distinctive.

(2) For the purpose of this section a trade or service mark is distinctive if it is capable, in relation to goods or services in respect of which it is registered or proposed to be registered, of distinguishing, goods or services with which its proprietor is or may be connected in the course of trade or business from goods or services in the case of which no such connection subsists, either generally or, where the trade or service mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of registration.

(3) In determining whether a trade or service mark is capable of distinguishing for the purpose of subsection (2), regard shall be to the extent to which—

- (a) the trade or service mark is inherently capable of distinguishing as aforesaid; and
- (b) by reason of the use of the trade or service mark or of any other circumstances, the trade or service mark is, in fact capable of distinguishing as aforesaid.

[PCh326s17]17. Effect of limitation or absence of colour

(1) A trade or service mark shall be limited in whole or in part to one or more specified colours, and in that case of the fact that it is so limited may be taken into consideration in deciding on the distinctive character of the trade mark.

(2) If in any circumstances a trade or service mark is registered without limitation of colour, it shall be deemed to have been registered for all colours.

[PCh326s18]18. Disclaimer

If a trade or service mark contains a matter or matters common to the trade or it is of a non-distinctive character, in determining whether the trade or service mark should be entered or remain in the register, it shall be required as a condition of its being on the Register—

- (a) that the applicant or the proprietor shall disclaim any right to the exclusive use of any part of the trade or service mark, or to the exclusive use of all or any portion of that trade or service mark as aforesaid to the exclusive use of which he is not entitled; or

(b) that the applicant or the proprietor shall make such other disclaimer as is considered necessary for the purpose of defining his rights under the registration, provided that no disclaimer on the register shall affect any rights of the proprietor of a trade or service mark except such as arises out of registration of the trade or service mark in respect of which the disclaimer is made.

[PCh326s19]19. Prohibition of registration

It is hereby declared that the following cannot be validly registered for the purpose of this Act—

(a) trade or service marks the use of which would be contrary to law or morality or which would be likely to deceive or cause confusion as to the nature, geographical or other origin, manufacturing process, characteristics or suitability for their purpose, of the goods or services concerned;

(b) trade or service marks which consist of solely of the shape, configuration or colour of the goods, or its containers;

(c) trade or service marks which are 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 of any organisation created by an International Convention, unless authorised by the competent authority of that state or international organisation; and

(d) trade or service marks which constitute reproductions in whole or in part, imitations, translations or transcriptions, liable to create confusion of trade or service marks and business or company names which are well known in the country and belong to third parties.

[PCh326s20]20. Prohibition of registration of identical or resembling trade or service mark

(1) Subject to the provisions of subsection (2) trade or service mark cannot be validly registered in respect of any goods or services if it is identical with a trade or service mark belonging to a different proprietor and already on the register in respect of the same goods or services or closely related goods or services or that so nearly resembles that a trade or service mark as to be likely to deceive or cause confusion.

(2) In the case of honest concurrent use, or of other special circumstances, trade or service marks that are identical or nearly resemble each other in respect of the same goods or services or closely related goods or services may be registered in the name of more than one proprietor, subject to any conditions and limitations, if any, which it is considered necessary to impose.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of trade or service marks that are identical or nearly resemble each other in respect of the same goods or services or closely related goods, or services, the Registrar may refuse to register any of them until their rights have been settled by agreement in a manner approved by him, or on appeal, by the court.

PART V

APPLICATION PROCEDURE, EXAMINATION

AND OPPOSITION TO REGISTRATION (ss 21-28)

[PCh326s21]21. Application for registration

(1) Any person who or whose proposed registered user uses or proposes to use a trade or service mark shall apply for the registration of the trade or service mark.

(2) The applications shall be made in writing to the Registrar as prescribed and shall include—

- (a) the name and address of the applicant;
- (b) the trade or business description of the applicant;
- (c) a reproduction of the trade or service mark;
- (d) the particular goods or services in respect of which registration of the trade or service mark is applied for listed under the applicable classes of the International Classification;
- (e) if the applicant's address is outside Tanzania an address for service within Tanzania;
- (f) a declaration that the applicant or his proposed registered user is using or proposes to use the trade or service mark within Tanzania.

[PCh326s22]22. Priority under the Convention

(1) Any person who has applied for protection for any trade or service mark in a country of the Convention, or his legal representative or assignee (if the assignee is also so qualified), shall be entitled to claim the benefits of the earlier application and its registration date in

Tanzania shall be deemed to be the same date as the date of the application in the country of the Convention, provided that the application for registration is made within six months from the date of earlier application.

(2) Where applications have been made for the registration of a trade or service mark in two or more countries of the Convention, the period of six months referred to in subsection (1) shall be reckoned from the date on which the earlier or earliest of those applications was made.

(3) The application for the registration of a trade or service mark under this section shall be made in the same manner as is required in the case of any ordinary application under this Act subject to any other requirements which may be prescribed.

[PCh326s23]23. Information as to foreign applications

(1) The applicant shall, at the direction of the Registrar, furnish him within the prescribed time limit, with the date and number of any application for a trade or service mark or registration filed with a national industrial property office of another country or with a regional industrial property office having comparable requirements for registration (foreign application) relating to the same or essentially the same trade or service mark as that in the application filed with the Registrar.

(2) The applicant shall, at the direction of the Registrar furnish him within the prescribed time limit with the following documents relating to one of the foreign applications or registrations referred to in subsection (1).

(a) a copy of any communication received by the applicant concerning the results of any search or examination carried out in respect of foreign application;

(b) a copy of the trade or service mark as registered; and

(c) a copy of any final decision rejecting the foreign application or refusing the registration requested in the foreign application or invalidating the foreign registration.

(3) The documents furnished under this section shall merely serve the purpose of facilitating the examination of the application filed with the Registrar or of the Registration entered in the register on the basis of that application.

(4) The applicant shall have the right to submit comments on the documents furnished under this section.

[PCh326s24]24. Joint proprietors

(1) Where the relations between two or more persons interested in a trade or service mark are such that only one of them is entitled as between himself and the other or others to use it except—

(a) on behalf of both or all of them; or

(b) in relation to an article or service with both or all of them are connected in the course of trade or business,

those persons may be registered as joint proprietors of the trade or service mark, and this Act shall have effect in relation to any rights to the use of the trade or service mark vested in those persons as if those rights had been vested in a single person.

(2) Subject as aforesaid nothing in this Act shall authorise the registration of two or more persons who use a trade or service mark independently, or propose so to use it, as its joint proprietors.

[PCh326s25]25. Registration of parts and of series of trade and service marks

(1) Where the proprietor of a trade or service mark claims to be entitled to the exclusive use of any part of it separately, he may apply to register the whole and any of those parts as separate trade or service marks. Each separate trade or service mark shall satisfy all the conditions of an independent trade or service marks and shall, subject to the provisions of section 35(2)(a) and section 41(2) have all the incidents of an independent trade mark.

(2) Where a person claiming to be the proprietor of several trade or service marks in respect of the same goods or services or closely related goods or services which, while resembling each other in their material particulars, yet differ in respect of—

(a) statements of goods or services in relation to which they are respectively used or proposed to be used; or

(b) statements of number, price, quality or names of places; or

(c) other matter of non-distinctive character which does not substantially affect the identity of the trade mark; and

(d) colour,

seeks to register those trade marks, they may be registered as a series in one registration.

[PCh326s26]26. Examination

(1) Upon filing of an application for registration of a trade and service mark and the payment of the prescribed fee the Registrar shall cause an examination to be made as to—

- (a) conformity with the formalities required in this Act and the Regulations;
- (b) the registrability of the trade and service mark in accordance with the provisions of Part IV and of the regulations; and
- (c) whether the trade and service mark is required to be associated in accordance with the provisions of section 41.

(2) If upon the examination it appears that the applicant is entitled to registration of his trade or service mark, the Registrar shall accept the application and cause the trade or service mark to be advertised in the Trade and Service Marks Journal.

(3) If upon the examination aforesaid the Registrar objects to the application, he shall notify the applicant in writing of the objections and shall allow him time to submit his representation or to request a hearing, and if the applicant fails to pursue his application within the time allowed, he shall be deemed to have withdrawn his application.

(4) Where the Registrar under subsection (3) notifies the applicant of his objections, he may, following representations by the applicant, indicate his willingness to accept the application

subject to any amendments, modifications, conditions or limitations which he may deem fit and if the applicant does not object to that conditional acceptance and amends his application accordingly, the Registrar shall cause the application to be advertised in the Trade and Service Marks Journal; save that the Registrar may cause an application to be advertised before acceptance in any case where he considers there are exceptional circumstances for doing so.

(5) In the case of refusal of the application or conditional acceptance to which the applicant objects the Registrar shall, if required, advise the applicant in writing of the grounds of his decision and the materials used by him in arriving at it.

[PCh326s27]27. Opposition

(1) Any person may, within the time limit as prescribed from the date of advertisement of an application, give notice to the Registrar of opposition to the registration, on the grounds that the application does not satisfy the requirements of Part IV.

(2) In addition to the grounds referred to in subsection (1) any of the following are also grounds for the purpose of opposition to the registration of a trade or service mark:

(a) where the trade or service mark resembles, in such a way as to be likely to deceive or cause confusion, with an unregistered trade or service mark used earlier in Tanzania by a third party in relation to the same goods or services or closely related goods or services, provided that, an application for the registration of the earlier used unregistered trade or service mark is filed at the same time as the notice of opposition;

(b) where the trade or service mark resembles in such a way as to be likely to deceive or cause confusion, with a business or a company name already used in Tanzania by a third party; and

(c) where the trade or service mark is filed by the agent or representative of a third party who as the proprietor of the trade or service mark in another country, without the authorisation of that proprietor, unless the agent or representative justifies his action.

(3) The notice shall be given in writing in the prescribed manner and shall include a statement of the grounds of opposition.

(4) The Registrar shall send a copy of the notice to the applicant and, within the prescribed time after its receipt, the applicant shall send to the Registrar, in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and if he does not do so, he shall be deemed to have abandoned his application.

(5) If the applicant sends any counter-statement the Registrar shall furnish a copy of it to the person giving notice of opposition, and shall, after hearing the parties if so require, and considering the evidence, decide whether, and subject to what conditions or limitations, if any registration is to be permitted.

(6) On appeal from a decision of the Registrar under this section the court may, after hearing the Registrar, permit the trade or service mark proposed to be registered to be modified in any manner not substantially affecting its identity but in that case the trade or service mark as so modified shall be advertised in the prescribed manner before being registered.

[PCh326s28]28. Registration

(1) When an application for registration of a trade or service mark has been accepted, and either—

(a) the application has not been opposed and the time for notice of opposition has expired; or

(b) the application has been opposed and the opposition has been decided in favour of the applicant,

the Registrar shall, unless the application has been accepted in error, register the trade or service mark, and the trade or service mark, when registered, shall be registered as of the date on which the application for registration was received, and that date shall be deemed, for the purposes of this Act, to be the date of registration:

Provided that the presiding provisions of this subsection, relating to the date as of which a trade or service mark shall be registered and to the date to be deemed to be the date of registration, shall, as respects a trade or service mark registered under this Act with the benefit of priority under the Convention, have effect subject to the provisions of the Convention.

(2) On the registration of a trade or service mark, the Registrar shall cause to be sealed and shall issue to the applicant a certificate in the prescribed form of its registration.

PART VI

DURATION AND RENEWAL OF REGISTRATION (s 29)

[PCh326s29]29. Term of registration and renewal

(1) The registration of a trade service mark shall be for a period of seven years from the date of registration but may be renewed from time to time in accordance with the provisions of this section.

(2) Subject to subsection (4), the Registrar shall on application made by the registered proprietor of a trade or service mark in the prescribed manner and within the prescribed period, renew the registration of the trade or service mark for a period of ten years from the date of expiration of original registration or of the last renewal of registration, the date which is referred to in this section as the "expiration of the last registration", provided that the registered proprietor—

(a) submits a statement confirming those goods or services described in the registration in respect of which there has been bona fide use of the trade or service mark in Tanzania at any time during the three years immediately preceding the expiration of the last registration, together with a reproduction of the trade or service mark which has been used; or

(b) establishes, to the satisfaction of the Registrar, that special circumstances prevented use of the trade or service mark in respect of any of the goods or services described in the registration during the prescribed period and confirms that there has been no intention to abandon the trade or service mark in respect of those goods or services.

(3) For the purposes of subsection (2)—

(a) the use of the whole of a registered trade or service mark shall be deemed to be equivalent to the use of any registered trade or service mark being a part thereof, registered in the name of the same proprietor by virtue of section 25(1);

(b) where a trade or service mark has been used in relation to some, but not all, of the goods or services in respect of which it is registered, that use shall be deemed to be equivalent to the use of the trade or service mark in relation to all closely related goods or services in respect of which it is registered;

(c) where a trade or service mark is applied to goods or services to be exported from Tanzania, that use shall be deemed to be equivalent to the use of a trade or service mark in relation to those goods or services in Tanzania; and

(d) the use of an associated registered trade or service mark, or of the trade or service mark with additions or alterations not substantially affecting its identity, may be accepted as an equivalent for the use of the trade or service mark.

(4) The renewal referred to in subsection (2) shall be effected in respect of all goods or services covered by paragraphs (a) and (b) of subsection (2) and paragraph (b) of subsection (3).

(5) Where the registration of a trade or service mark has expired through non-payment of the fee for renewal or otherwise, that trade or service mark shall nevertheless, for the purpose of any application for registration of a trade or service mark during the year following the date of expiration, be deemed to be a trade or service mark that is already on the register, provided that

the preceding provisions of this subsection shall not have effect where the Registrar is satisfied either—

(a) that there has been no bona fide use of the trade or service mark whose registration has expired at any time during the three years immediately preceding the expiration; or

(b) that no deception or confusion would be likely to arise from the use of the trade or service mark that is the subject of the application for registration by reason of any previous use of the trade or service mark whose registration has expired.

PART VII

EFFECT OF REGISTRATION, INFRINGEMENT

AND UNLAWFUL ACTS (ss 30-34)

[PCh326s30]30. Unregistered trade or service mark

No person shall be entitled to institute any proceedings to prevent or to recover damages for, the infringement of an unregistered trade or service mark, but nothing in this Act shall be deemed to affect rights of action against any person for passing off goods or services as the goods or services of another person, or the remedies in respect of them.

[PCh326s31]31. Exclusive right

Subject to the provisions of this Act and any limitations or conditions entered in the register, the registration of a trade or service mark shall, if valid, give or be deemed to have given

to the registered proprietor the exclusive right to the use of a trade or service mark in relation to any goods including sale, importation and offer for sale or importation.

[PCh326s32]32. Infringement

(1) The exclusive right referred to in section 31 shall be deemed to be infringed by any person who, not being the proprietor of a trade mark or its registered user using by way of the permitted use, uses a sign either—

(a) 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 or in relation to any closely related goods and in such manner as to render the use of the sign likely to be either—

(i) as being used as a trade mark or business or company name; or

(ii) in a case in which the use is upon the goods or in physical relation to them, or in relation to services, or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as a registered user to use the trade marks or to goods or services with which that person is connected in the course of business or trade; or

(b) 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 trade mark.

(2) The exclusive right referred to in section 31 shall, subject to provisions of subsection (3) also be deemed to be infringed by any person who, not being the proprietor of the trade mark

or its registered user using by way of permitted use, does any of the following acts in the course of trade in respect of goods purchased from the proprietor of the trade mark of a registered user—

(a) applying the trade mark upon the goods after they suffered alteration as respects their state or condition, get up or packing;

(b) where the trade mark is upon the goods, altering or obliterating it, whether wholly or partly;

(c) where the trade mark is upon goods, and there is also on it other matter, being matter indicating a connection in the course of trade between the proprietor or registered user and the goods, removing or obliterating, whether wholly or partly, the trade mark, unless that other matter is wholly removed or obliterated;

(d) where the trade mark is upon the goods, applying any other trade mark to the goods; and

(e) 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.

(3) The exclusive right given by registration under section 31 shall not be deemed to be infringed by the use of that trade mark as by any person—

(a) in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk of which they form a part, the proprietor or the registered user conforming to the permitted use has applied the trade mark and

has, not subsequently removed or obliterated it or has at any time expressly or impliedly consented to the use of trade mark; or

(b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been registered if the use of the trade or service mark is reasonably necessary in order to indicate that the goods are so adapted; or

(c) in relation to goods which have been sold or offered for sale in Tanzania under the trade mark by the proprietor or any associated company of the proprietor, wherever incorporated or with the proprietor's consent, unless the condition of the goods is modified or impaired after they have been sold or offered for sale.

(4) The use of a registered trade mark, being one of two or more registered trade marks that are identical or nearly resemble each other in exercise of the right to the use of that trade mark given by registration under section 31 shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

(5) For the purpose of this section, the reference to the use of a sign by a person not being its proprietor or a registered user using by way of permitted use shall be construed as including reference to the audible use of the sign.

[PCh326s33]33. Right to continue use

Nothing in this Act shall entitle the proprietor or a registered user of registered trade or service mark to interfere with or restrain the use by any person of a trade or service mark identical with or nearly resembling it, in relation to goods or services, in relation to which that

person or a predecessor in title of his bona fide use of name or description has continuously used that trade or service mark from the date anterior—

(a) to the use of the first mentioned trade or service mark in relation to those goods or services by the proprietor or his predecessor in title; or

(b) to the registration of the first mentioned trade or service mark in respect of those goods or services in the name of the proprietor or his predecessor in title,

whichever is the earlier, or to object (on that use being proved) to that person being put on the register for that identical or nearly resembling trade or service mark in respect of those goods or services under subsection (2) of section 20.

[PCh326s34]34. Bona fide use of name or description

No registration of a trade or service mark shall interfere with—

(a) the bona fide use by any person of description his own name or of the name of the geographical location of his business, or of the name of any of his predecessors in business; or

(b) the use by any person of any bona fide description of the character or quality of his goods or services, not being a description that would be likely to be taken as importing any such references which are mentioned in subsections (1)(a) and (2) of section 32(1)(a)(2).

PART VIII

REMOVAL FROM, RECTIFICATION AND

CORRECTION OF THE REGISTER (ss 35-39)

[PCh326s35]35. Removal from register on the ground of non-use

(1) A registered trade or service mark shall be removed from the register in respect of any of the goods or services in respect of which it is registered on application by an aggrieved person to the court or at the option of the applicant under the provisions of section 55 of this Act, to the Registrar, on the ground that up to one month prior to the filing of the application a continuous period of three years or longer had elapsed during which the registered proprietor did not use the trade or service mark in relation to those goods or services, provided that failure to use the trade or service mark shall not be taken into account where—

(a) it is attributable solely to special circumstances preventing use of the trade or service mark and not to any intention to abandon or not use the trade or service mark; or

(b) the non-use is within five years from the date of the first advertisement of the trade or service mark in accordance with section 28 or within the period from that date extended to two years from the date of the final decision on the registration, whichever period expires later.

(2) For the purpose of subsection (1)

(a) the use of the whole of a registered trade or service mark shall be deemed to be equivalent to the use of any registered trade or service mark, being a part it registered in the name of the same proprietor by virtue of section 25(1);

(b) where a trade or service mark has been used in relation to some, but not all of the goods or services in respect of which it is registered, that use shall be deemed to be equivalent to

the use of the trade or service mark in relation to all closely related goods or services in respect of which it is registered;

(c) where a trade or service mark is applied to goods or services to be exported from Tanzania, that use shall be deemed to be equivalent to the use of the trade or service mark in relation to those goods or services in Tanzania; and

(d) the use of associated registered trade or service mark, or of the trade or service mark with additions or alterations not substantially affecting its identity, may be accepted as an equivalent for the use of the trade or service mark.

[PCh326s36]36. Rectification

Any person aggrieved by the non insertion in or omission from the Register of any entry, or by any entry wrongly remaining on the Register, or by any error or defect in any entry in the Register, may apply to the court or at the option of the applicant and subject to the provisions of section 55 of this Act, to the Registrar, and the court or the Registrar shall make an order for making, expunging or varying the entry as shall be deemed fit.

[PCh326s37]37. Fraud in the registration, renewal, assignment, etc.

In case of fraud in the registration, renewal, assignment or transmission of a registered trade or service mark, the Registrar shall himself apply to the court for an order for making, expunging or varying the entry in the Register as may be deemed fit.

[PCh326s38]38. Breach of condition

The Registrar shall, make such order, which he shall deem fit for expunging or varying registration of a trade or service mark on the ground of any contravention of or failure to observe a condition entered on the register in relation to it.

[PCh326s39]39. Correction of the register

(1) The Registrar shall, on request made in the prescribed manner by the registered proprietor—

(a) correct any error in the name, address or description of the registered proprietor of a trade or service mark;

(b) enter any change in the name, address or description of the person who is registered as proprietor of a trade or service mark;

(c) cancel the entry of a trade or service mark in the register;

(d) strike out any goods or services from those in respect of which a trade mark is registered; and

(e) enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by existing registration of the trade or service mark.

(2) The Registrar shall, on request made in the prescribed manner by a registered user of a trade or service mark correct any error or enter any change in the name or address of the registered user.

PART IX

ASSIGNMENT AND TRANSMISSION (ss 40-41)

[PCh326s40]40. Power of assignment and transmission

(1) Notwithstanding any rule or law to the contrary, a pending trade or service mark or registered trade or service mark shall be, and shall be deemed always to have been assignable and transmissible in respect either of all the goods or services in respect of which it is applied for, registered, or was registered as the case may be, or of some, but not all of those goods or services.

(2) An assignment or transmission shall, however, be invalid if the assignment or transmission is likely to deceive or cause confusion, particularly in regard to the nature, origin, manufacturing process, characteristics or suitability for their purpose, of the goods or services in relation to which the trade or service mark is intended to be used or is being used.

(3) A person entitled by assignment or transmission to a registered trade or service mark shall make application to the Registrar in the prescribed manner to register his title.

(4) On receipt of an application as aforesaid in respect of a registered trade or service mark, the Registrar shall cause the particulars of the assignment or transmission to be entered in the register and where the application is in respect of a pending trade or service mark, the particulars of the assignment or transmission shall be provisionally recorded and, upon registration of the trade or service mark, shall be entered in the register.

(5) Assignments and transmission of pending trade or service marks or of registered trade or service marks shall have no effect against third parties until their particulars are entered in the register.

(6) Subject to the provisions of this Act, the person for the time being entered in the Register as proprietor of a trade or service mark shall, subject to any rights appearing from the Register to be vested in any other person, have power to assign the trade or service mark and to give effectual receipts for any consideration for its assignment.

[PCh326s41]41. Associated trade and service marks

(1) Where a pending trade or trade service mark or trade or service mark that is registered in respect of any goods or services is identical with another mark that is registered, or is pending, in the name of the same proprietor in respect of the same goods or services or closely related goods or services, or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the Registrar may at any time require that the trade or service mark be entered in the register as associated trade or service marks.

(2) Where a trade or service mark and any part or parts of it are, by virtue of section 25(1), registered as separate trade or service marks in the name of the same proprietor, they shall be deemed to be and shall be registered as, associated trade or service marks.

(3) All trade or service marks that are by virtue of section 25(2) registered as a series in one registration shall be deemed to be, and shall be registered as associated trade or service mark.

(4) Trade or service marks that are registered as, or that are deemed by virtue of this Act to be, associated trade or service marks shall be assignable and transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate trade or service marks.

(5) Upon application made in the prescribed manner by the registered proprietor of two or more trade or service marks registered as associated trade or services marks, the Registrar shall dissolve the association as respect any of them if he is satisfied that there would be no likelihood of deception or confusion being caused through use by another person, and shall amend the register accordingly.

(6) The registered proprietor of trade or service marks which qualify to be associated shall request them to be associated if the Registrar had not previously entered them as associated trade or service marks in the register.

PART X

REGISTERED USERS (ss 42-47)

[PCh326s42]42. Registered user

(1) Subject to the provisions of sections 43, 44 and 45, a person other than the proprietor of a registered trade or service mark may be registered as a registered user of it in respect of all or any of the goods or services in respect of which it is registered and the use of a trade or service mark by its registered user in relation to goods or services with which he is connected in the course of trade or business and in respect of which the trade or services marked remains

registered in compliance with any conditions or restrictions to which his registration is subject, shall be permitted use of the trade or service mark.

(2) The permitted use of a trade or service mark shall be deemed to be used by the proprietor thereof, and shall be deemed not to be used by a person other than the proprietor.

(3) Subject to any agreement subsisting between the parties, a registered user of a trade or service mark shall be entitled to request its proprietor to take proceedings to prevent its infringement thereof and, if the proprietor refuses or neglects to do so within two months after being so called upon, the registered user may institute proceedings for infringement in his own name as if he were the proprietor, joining the proprietor as defendant.

[PCh326s43]43. Registration of registered users

(1) When it is proposed that a person be registered as a registered user of a trade or service mark, an application for it shall be made in the prescribed manner jointly by registered proprietor and the proposed registered user who shall furnish the Registrar—

(a) either with information that the proposed registered user is wholly controlled by the registered proprietor and that there is no other contractual relationship between the parties, or with a copy of the licence contract between the parties; or

(b) with a statement containing—

(i) the identity of the registered trade or service mark;

(ii) the name and address of the registered proprietor;

- (iii) the name and address of the proposed registered user;
- (iv) the goods or services in issue;
- (v) the restrictions on use, if any, by the proposed registered user; and
- (vi) the period of permitted use.

(2) When the requirements of subsection (1) have been complied with and the Registrar, after considering the information furnished to him under that subsection, is satisfied that in all the circumstances the proposed use of the trade or service mark by the proposed registered user, subject to any conditions or restrictions which he thinks proper, would not be contrary to the public interest, he may register the proposed registered user as a registered user in respect of goods or services as to which he is so satisfied.

[PCh326s44]44. Guarantee of control

(1) A licence contract shall be invalid in the absence of relations or stipulations between the registered proprietor of the trade or service mark and the proposed registered user, ensuring effective control by the registered proprietor of the quality of the goods or services of the proposed registered user in relation to which the trade or service mark is to be used.

(2) In the absence of any provision to the contrary in the licence contract, the grant of a licence shall not prevent the registered proprietor from granting further licences to third parties or from using the trade or service mark himself.

(3) The grant of an exclusive licence shall prevent the registered proprietor from granting further licences to third parties and from using the trade or service mark himself.

(4) In the absence of any provision to the contrary in the licence contract the registered user shall be entitled to use the trade or service mark during the whole duration of registration, including renewals, in the entire country, and in respect of all the goods or services for which the trade or service mark is registered, subject to any conditions or limitations entered in the register.

[PCh326s45]45. Approval of licence contracts

The Minister or other competent authority may, by order provide that, on pain of invalidity, licence contracts or certain categories of them, and amendments or renewals of those contracts, shall require the approval of the Registrar taking into account the needs of the country and its economic development.

[PCh326s46]46. Variation and cancellation

Without prejudice to the provisions of section 36, the registration of person as a registered user—

(a) may be varied by the Registrar on the joint application in writing in the prescribed manner of the registered proprietor and the registered user who shall, in amending a previous registration of the licence contract, take into account the facts, procedure, regulations and any other requirements considered at the time of the previous registration of the licence contract between the registered proprietor and the proposed registered user;

(b) may be cancelled by the Registrar on the application in writing in the prescribed manner of the registered proprietor or of the registered user or of any other registered user of the trade or service mark; or

(c) may be cancelled by the Registrar on the application in writing in the prescribed manner of any person on any of the following grounds:

(i) that the registered user has used the trade or service mark otherwise than by way of the permitted use, or in such a way as to cause or to be likely to cause deception or confusion;

(ii) that the proprietor or the registered user misrepresented or failed to disclose some fact material to the application for registration, or that the circumstances have materially changed since the date of registration; and

(iii) that the registration ought not to have been effected, having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested.

[PCh326s47]47. Prohibition of assignments and sub-licences

A licence shall not be assignable to third parties and the registered user shall not be entitled to grant sub-licences.

PART XI

LEGAL PROCEEDINGS (ss 48-55)

[PCh326s48]48. Appeals

A person may appeal from any decision made by the Registrar subject to the provisions of this Act and its Regulations and that appeal shall be made to the Court.

[PCh326s49]49. Reference to the court by Registrar

When any matter to be decided by the Registrar under this Act appears to him to involve a point of law or to be of unusual importance or complexity, he may, after giving notice to the parties, refer that matter to the court for a decision and and shall after that, in relation to that matter act in accordance with the decision of the court.

[PCh326s50]50. Validity of registration

(1) In all legal proceedings relating to a registered trade or service mark including applications under section 36 the fact that a person is registered as proprietor of the trade or service mark shall be prima facie evidence of the validity of the original registration of the mark and of all its subsequent assignments and transmissions.

(2) Subject to section 62, in all legal proceedings the original registration of the trade or service mark shall, after seven years from the date of registration of that mark, be taken to be valid in all aspects, unless—

(a) that registration was obtained by fraud; or

(b) the trade or service mark should not have been registered in view of the provisions of section 19 and the same ground for prohibiting the original registration under that section prevails at the same time as the validity of the original registration is contested.

[PCh326s51]51. Certification of validity

In any legal proceeding in which the validity of the registration of a registered trade or service mark comes into question and is decided in favour of the proprietor of the trade or service mark, the court shall certify to that effect.

[PCh326s52]52. Registrar's right to appear

(1) In any legal proceeding in which the relief sought includes alteration or rectification of the register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Court.

(2) Unless otherwise directed by the court, the Registrar in lieu of appearing and being heard, may submit to the court a statement in writing, signed by him, giving particulars of any proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting it, or of the practice of the Trade and Service Marks Office in like cases, or of any other matters relevant to the issues, and within his knowledge as Registrar, which he deems fit, and the statement shall be deemed to form part of the evidence in the proceeding.

[PCh326s53]53. Court's power to review Registrar's decision

The court, in dealing with any question of the rectification of the register (including all applications under the provisions of section 36), shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.

[PCh326s54]54. Court's discretion in appeals

In any appeal from the decision of the Registrar to the Court, the court shall have and exercise same discretionary powers as under this Act are conferred upon the Registrar.

[PCh326s55]55. Procedure in case of option to apply to court or Registrar

Where under any of the preceding provisions of this Act an applicant has an option to make an application either to the court or to the Registrar and if that application is made to the Registrar, the Registrar may, at any stage of the proceedings, refer the application to the court or may, after hearing the parties, determine the question between them, subject to appeal to the court.

PART XII

OFFENCES AND PENALTIES (ss 56-60)

[PCh326s56]56. Falsification of entries in register

Any person who makes or causes to be made a false entry in the Register, or writing falsely purporting to be a copy of an entry in the register, or who produces or tenders in evidence any such writing, knowing the entry or writing to be false, commits an offence.

[PCh326s57]57. Penalty for falsely representing a trade or service mark as registered

(1) Any person who makes representation—

(a) with respect to a trade mark or service mark not being a registered trade or service mark to the effect that it is a registered trade or service mark;

(b) with respect to a part of a registered trade or service mark not being a part separately registered as a trade or service mark to the effect that it is so registered; or

(c) to the effect that a registered trade or service mark is registered in respect of any goods or services in respect of which it is not registered; or

(d) to the effect that the registration of a trade or service mark gives an exclusive right to its use in any circumstances in which, have regard to limitations entered in the register the registration does not give that right,

commits an offence and upon conviction is liable to a fine of fifty thousand shillings or to imprisonment for a term not exceeding seven years or to both the fine and imprisonment.

(2) For the purposes of this section, the use in Tanzania in relation to a trade or service mark of the word "registered" or the symbol "R", or of any other word or symbol referring, whether expressly or impliedly, to registration, shall be deemed to import a reference to registration in the register except—

(a) where that word or symbol is used in physical association with other words delineated in characters at least as large as those in which that word or symbol is delineated and indicating that the reference is to registration as a trade or service mark under the law of the country outside Tanzania, being a country under the law of which the registration referred to is in fact in force;

(b) where that word (being a word other than the word "registered") or symbol is of itself such as to indicate that the reference is to that registration;

(c) where that word or symbol is used in relation to a trade or service mark under the law of a country outside Tanzania and in relation to goods or services to be exported to that country.

[PCh326s58]58. Deceiving or influencing the Registrar or an officer

Any person who—

(a) for the purpose of deceiving the Registrar or any other official of the Trade and Service Marks Office in the execution of the provisions of this Act; or

(b) for the purpose of procuring or influencing the doing or omission of anything in relation to this Act or any matter under it,

makes or submits a false statement or representation, whether orally or in writing, knowing the same to be false, commits an offence.

[PCh326s59]59. Penalties

Save where otherwise provided in this Act, any person who commits an offence under this Act shall upon conviction be liable to a fine not exceeding ten thousand shillings, or imprisonment for a period not exceeding three years or to both the fine and imprisonment.

[PCh326s60]60. Regulations

(1) The Minister may, by statutory instrument, make Regulations, prescribing anything which under this Act is to be prescribed and generally for the better carrying out of the objects and purposes of this Act, or to give effect to its provisions and for its better administration.

(2) Without prejudice to the generality of subsection (1), Regulations made by the Minister may provide—

- (a) for regulating the practice under this Act including the service of documents;
- (b) for making or requiring duplicate reproductions of trade or service marks and other documents;
- (c) for regulating the publishing and selling or distribution of copies of trade and service marks and other documents; and
- (d) for the fees which shall be payable in respect of any application, registration or any other matter under this Act.

PART XIII

APPLICATION OF THE ACT AND

TRANSITIONAL PROVISIONS (ss 61-64)

[PCh326s61]61. Application of Act

Save as otherwise provided in this Part, the provisions of this Act shall apply in respect of all trade or service marks, including trade marks registered before the commencement of this Act.

[PCh326s62]62. Prior Part B registration R.L. Cap. 394

For the purpose of this Act any trade mark registered under the previous Ordinance in Part B of the then existing Register of the Trade Marks shall not be taken to be valid in all

respects subject to the provisions of section 50(2) until a period of seven years has elapsed from the commencement of this Act.

[PCh326s63]63. Reclassification

Trade Marks which have been registered before the commencement of this Act under existing systems of classification under the International Classification shall, upon application for their renewal under section 29, be reclassified into the International Classification system.

[PCh326s64]64. Validity of previous register

(1) Subject to the provisions of this section and section 50(2) of this Act, the validity of the original entry of any trade marks existing at the commencement of this Act shall be determined in accordance with the enactments in force at the date of that entry and that trade mark shall retain its original date, but for all other purposes shall be deemed to have been registered under this Act.

(2) No trade mark which was on the register at the commencement of this Act shall be removed from the register on ground that it was not registrable under the enactments in force at the date of its registration and that trade mark shall remain in force in Tanzania for the remainder of the unexpired period for which it was in force under the previous enactment.

(3) Nothing in the Act shall be taken to have invalidated the original registration of a trade mark which immediately before the commencement of this Act was validly on the register.

(4) Where a person is registered as registered user of a trade mark on an application made within one year from the commencement of this Act, section 42(2) shall have effect in relation to

any previous use (whether before or after the commencement of this Act) or the trade or service mark by that person, being used in relation to the goods or services in respect of which he is registered and, where he is registered subject to conditions or restrictions, being used such as to comply substantially with them, as if that previous use had been permitted use.

PART XIV

REGISTER OF TRADE AND SERVICE MARK AGENTS (ss 65-66)

[PCh326s65]65. Register of Trade and Service Mark Agents

(1) Subject to subsection (3) any person desirous of acting as an agent for an applicant, proprietor, registered user or other person concerned in any proceeding or matter before or affecting the Registrar under this Act and Regulations, shall apply to the Registrar in the prescribed manner, to be entered on the Register of Trade and Service Mark Agents to be kept by the Registrar.

(2) The qualifications for a person to be entered on the Register of Trade and Service Mark Agents shall be as prescribed.

[PCh326s66]66. Repeal of R.L. Cap. 394

[Repeal of the Trade Marks Ordinance.]