



## UGANDA REGISTRATION SERVICES BUREAU

### THE TRADEMARKS ACT, 2010

**IN THE MATTER OF TRADEMARK APPLICATION No. UG/T/2020/067455 “UGANDA YOUNG MEN’ S CHRISTIAN ASSOCIATION-YMCA AND LOGO” IN CLASS 45 BY UGANDA YOUNG MEN’S CHRISTIAN ASSOCIATION**

**AND**

**OPPOSITION THERETO BY THE WORLD ALLIANCE OF YOUNG MEN’S CHRISTIAN ASSOCIATIONS**

#### **BEFORE: SARAH RUKUNDO: ASST. REGISTRAR TRADEMARKS**

1. On the 27<sup>th</sup> February 2020, the Uganda Young Men’s Christian Association (herein the Applicant) applied for registration of the trademark “UGANDA YOUNG MEN’S CHRISTIAN ASSOCIATION YMCA and Logo” for “Education and religious services” in class 45
2. The application was published in the Gazette dated 14<sup>th</sup> August 2020 whereupon the World Alliance of Young Men’s Christian Associations (herein the Opponent) opposed the registration on the following grounds;
  - i) That the Opponent is the worldwide owner of the YMCA trademark and has undertaken registration in several countries.
  - ii) That owing to the use of the mark by the Opponent, the same has obtained goodwill both internationally particularly in Uganda.
  - iii) That the Applicant’s mark is confusingly similar to the Opponent’s registered trademark number UG/T/2020/68118.
  - iv) That the Opponent is the registered owner of the trademark in Switzerland the Country of Origin

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- v) That Registration of the trademark in the name of the Applicant is likely to deceive.
- vi) The Applicant's mark is not distinctive.
- vii) That the Applicant has no claim in law or equity to the trademark because their membership in the Opponent organisation was revoked.

3. The Applicant countered as follows;

- i) That they instituted a search of the same mark before filing their application and found no similar mark on the register.
- ii) That the Applicant has been in existence in Uganda as a duly registered and licensed non-governmental organisation for about 50 years and a registered company limited by guarantee from 31<sup>st</sup> January 2020.
- iii) The Applicant has enjoyed and continues to enjoy monopoly in the use of a trademark since 1963 to date with over six (6) branches across Uganda and has acquired a substantial reputation and goodwill in Uganda.
- iv) That recognition of a trademark in Uganda is dependent on the domestic legislation and;
- v) That registration of the trademark in Switzerland on 28<sup>th</sup> July 2017 per se does not of itself grant recognition in Uganda unless the conditions of the domestic legislation are met.

4. The Applicant and the Opponent submitted evidence by way of statutory declarations.

5. For the Opponent, Carlos Madjri Sanvee, the Secretary General of the Opponent declared that:

- i) The World alliance of Young Men's Christian Associations is the oldest and largest youth focused movement in the world founded in 1844 currently operating in 120 countries reaching 64 million people.
- ii) While in the beginning, the Applicant was a member of the Opponent organization; their membership was revoked because of behavioral issues.



- iii) The World alliance of Young Men's Christian Associations is the worldwide owner of the YMCA Trademark and has undertaken registration in several countries around the world including Uganda
- iv) The Opponent is also the owner of trademark number 68118 in class 41 in respect of education, training, and entertainment services.
- v) Owing to the extensive and effective use of the YMCA trademark the same has acquired a substantial reputation and goodwill both internationally and particularly in Uganda and therefore qualifies as a well-known mark for purposes of trademark law.
- vi) The Applicants conduct concerning this matter is opportunistic, dishonest and malafide.

The Opponent referred to five attachments namely, its trademark registration certificates from Switzerland and Uganda respectively, constitution, letter from the Opponent dated 14<sup>th</sup> August 2010 revoking the membership of the Applicant from the world alliance of YMCA's and the list of countries where the Opponent has registered the trademark "YMCA".

6. For the Applicant, evidence by statutory declaration was submitted by Roselyne Birungi Ssebaleke that:

- i) The World Alliance of Young Men's Associations has no legal claim to the mark, "YMCA" in Uganda.
- ii) On conducting a search on the trademark register, the 'YMCA" mark was not on the trademark register.
- iii) The Applicant followed all legal procedures for registration of a trademark.
- iv) The registration in Switzerland does not confer legal rights of the same in Uganda.
- v) The Applicant currently has no affiliation or relationship with the Opponent.
- vi) The opposition is in bad faith.

The Applicant referred to ten attachments namely, its certificate of registration as a non-governmental organisation, operation permit, copy of a judgement in Civil suit No.392 /2002, certificate of incorporation as a company limited by guarantee, company Forms 18



and 20, search report from the Registrar of Trademarks dated 21<sup>st</sup> February 2020, letter from the Registrar of Trademarks transmitting this opposition, the certificate of trademark registration of the Opponent's trademark 68118, the Gazette in which the same was published and the several complaints about the extensions granted to the Opponent.

7. In brief, the Opponent replied that;

- i) the Opponent is an apex body and does not operate as independent body in any country in the world
- ii) the Applicant has been affiliated to the Opponent and it's Africa Regional Alliance
- iii) the fact that the Applicant was suspended from the alliance is undisputed
- iv) extensions of time are common place in such proceedings
- v) the application should be refused because it offends Sections 9, 23, 25 and 44 of the Trademarks Act, the Paris convention and the TRIPS Agreement, *inter alia*.

## Issues

8. During the scheduling hearing held on 17<sup>th</sup> June 2022. The following issues were framed for determination;

- i) Whether there is a likelihood of confusion between the Opponent's YMCA trademark and the application by Uganda Young Men's Christian Association for the YMCA trademark
- ii) Whether the application by Uganda Men's Christian Association offends sections 9,23, 25 and 44 of the Trademarks Act,2010
- iii) What are the remedies available?

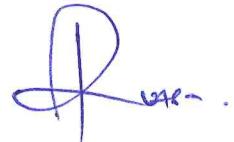
9. At the same hearing, the Applicant raised an objection that one of the statutory declarations sworn by Mr. Carlos Madjri Sanvee was filed out of the time. The Opponent was advised to apply for an extension of time with respect to the said statutory declaration; the said application would be considered in the decision for the main opposition. On 17<sup>th</sup> June, 2022 the Opponent applied for the extension. The

*D* after

grounds of the application were that the Opponent needed more time to collect and collate specific evidence to rejoin the evidence adduced by the Applicant. Further, that since the person responsible for signing the statutory declaration is the Secretary General; the Opponent needed more time to coordinate the signature. In its submissions, the Applicant responded that the extension should not be granted because it was unreasonably filed out of time and would not allow the Applicant to file evidence in reply. It should be noted that the Applicant if it so wished could have requested to file additional evidence.

10. Under regulation 34 of the Trademark Regulations 2012, the Registrar may permit any evidence during any stage of the proceedings upon such terms as the Registrar may think fit. I agree with the principle in the case of **Hussain Hasanali Jivan v Merali Jvra Tadin & Anor Civil Suit No.471 of 2015** that a presiding officer should identify the seriousness and significance of failure to comply with the rule and that if the breach is not serious, evidence already filed maybe validated by extension of time.
11. Further, regulation 80 provides that if in any particular case the registrar is satisfied that the circumstances justify an extension of the time for doing any act or taking any proceeding under the Regulations, the registrar may extend the time upon such notice to other parties, and proceedings on it, and upon such terms as he or she may direct, and the extension may be granted though the time has expired for doing the act or taking the proceedings.
12. Pursuant to the above provisions and the reasons advanced by the Opponent in the application for the extension, I extend the time for filing their evidence, accept the second statutory declaration by Mr. Carlos Madjri Sanvee filed out of time, and proceed to determine the matter on its merit.

#### **Determination**

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**(i) Whether there is a likelihood of confusion between the Opponent's YMCA trademark and the application by Uganda Young Men's Christian Association for the YMCA trademark**

13. A brief factual background is critical to the resolution of this opposition. The Applicant filed for the disputed mark on the 27<sup>th</sup> February 2020. On 10<sup>th</sup> October 2020, the Opponent filed a notice of opposition together with grounds, among others, contending that the impugned mark belongs to it, having registered the same in numerous countries, including Uganda. In the evidence and submissions, the Opponents claims that the mark offends its registered mark in Uganda. The Opponents filed Trademark No.68188 for the mark "YMCA" which is the subject of separate cancelling proceeding between the same parties. For clarity, trademark No.68118 for the same word mark, was filed on 29<sup>th</sup> June 2020, four months after the Applicant had filed their application and hence cannot and should not be the basis for the Opponent's opposition. Section 25 of the Trademarks Act, 2010 prohibits registration of a trademark when there is an identical one already existing on the register. It states;

*"Subject to section 27, a trademark relating to goods shall not be registered in respect of goods or description of goods that is identical with or nearly resembles a trademark belonging to a different owner and already on the register in respect of—(a)the same goods;(b)the same description of goods; or(c)services or a description of services which are associated with those goods or goods of that description".* The underlined words "already on the register" include applications filed.

14. While there are separate cancellation proceedings relating to trademark No.68118, I can state that trademark no.68118 was registered in error owing to the existence on the Register of the of the Applicant's trademark application 67455 that was filed on 27<sup>th</sup> February 2020. The Opponent's trademark therefore ought not to have registered until the determination of this opposition. As such, I will not consider arguments based on it in these proceedings. At the time the applicant filed their application, the Opponent did not have trademark rights in Uganda for which potential confusion with

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the Applicant's mark would arise. Hence, there was no trademark on the register, which would be confusingly similar to the Applicant's applied for trademark.

15. It is trite law that Intellectual property rights, including trademarks rights are territorial and hence acquired by registration in a given jurisdiction. Per the record, as at 27<sup>th</sup> February 2020, the Opponent was not a registered owner of trademark similar or identical with the disputed mark in Uganda. It's only legitimate claim would be based on the rights accorded to trademarks already registered in the country of origin and the protections they are entitled to in Uganda with regard to objecting to registration of similar or identical marks. I will therefore examine the law and evidence to ascertain whether the Opponent qualifies for protection because of prior registration in its country of origin within the meaning of section 44 of the Trademarks Act, 2010.
16. Before I address claims based on section 44—rights accorded to marks registered in the country of origin, let me briefly comment on issue 2. Given my findings on issue 1, the second issue, namely "**Whether the application by Uganda Men's Christian Association offends sections 9,23, 25 and 44 of the Trademarks Act,2010**" in my view becomes redundant. The application does not offend the said sections. Section 9 provides the test for distinctiveness and arguments by the Opponent that the Applicant's mark lack distinctiveness because of their registered trademark in Uganda are not tenable. Similarly, there is no basis for the arguments that section 25 is contravened as that section protects the first to file, and in this case, the Applicant was the first. I am also unable to see how section 23 is offended by the Applicant's application.
17. Section 23 prohibits registration of trademarks that are likely to deceive, those that are contrary to law, morality or those that are scandalous designs. I do not see how the Applicant's mark does any of the above. I also reject the Opponent's arguments based on protections accorded to well-known marks. Under the Trademarks Act, 2010, such protection is only claimed with regard to defensive registration as spelt under section 47 of the Trademarks Act, 2010 and cannot be the basis for opposition proceedings

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as the Opponent contends. At all times, before the Applicant filed its application, the Opponent was free to defensively register its mark in Uganda to protect it from use by others if it was convinced that its mark is well known within the meaning of section 47 of the Trademarks Act. Having failed to do so, it cannot therefore object to registration on the basis that its trademark is well known. Article 6bis of the Paris Convention operates as domesticated by national legislation and Uganda domesticated that provision within the confines of section 47 of the Trademarks Act.

#### **Protection of marks registered in the country of origin.**

18. Section 44 of the Trademarks Act, 2010 protects marks, which are registered in the country of origin, and allows owners of such marks to object registration of similar marks, for as long as they meet the full criteria set out in section 44. I reproduce section 44 for clarity;

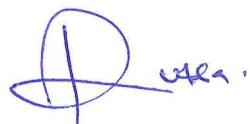
#### **"44. Protection of marks registered in a country of origin**

*(1) Subject to subsection (3), the registrar may refuse to register a trademark relating to goods in respect of goods or description of goods if it is proved to his or her satisfaction by the person opposing the application for registration that the mark is identical with or nearly resembles a trademark which is already registered in respect of—*

- (a) the same goods;*
- (b) the same description of goods; or*
- (c) services or a description of services which are associated with those goods or goods of that description, in a country or place from which the goods originate.*

*(2) Subject to subsection (3), the registrar may refuse to register any trademark relating to services in respect of any services or description of services if it is proved to his or her satisfaction by the person opposing the application for registration that the mark is identical with or nearly resembles a trademark which is already registered in respect of—*

- (a) the same services;*
- (b) the same description of services; or*

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*(c) goods or a description of goods which are associated with those services or services of that description, in a country or place from which the services originate.*

*(3) An application to register shall not be refused under this section where—*

*(a) the Applicant proves that he or she or his or her predecessors in business have in Uganda, in relation to the goods or services, continuously used the trademark for the registration of which he or she has made application from a date before the date of the registration of the other mark in the country or place of origin; or*

*(b) the person objecting does not give an undertaking to the satisfaction of the registrar that he or she will, within three months from the giving of the notice of objection, apply for registration in Uganda of the trademark registered in the country or place of origin and will take all necessary steps to complete the registration.*

*(4) The protection given under this section in respect of a trade mark in relation to goods and services originating from a country other than Uganda shall only be accorded if the country of origin of the goods and services accords to goods and services originating from Uganda the same treatment”*

19. Section 44 above sets the principles upon which a registrar may refuse registration of a mark on basis of the same being registered by a person in the country of origin.

20. First, the marks must resemble or be confusingly similar and in this case, it is not disputed that the mark “YMCA” claimed by the opponent and the mark “UGANDA YOUNG MEN’ S CHRISTIAN ASSOCIATION-YMCA and Logo” which is being opposed resemble and are confusingly similar.

21. Second, registration cannot be refused where it is proved that the Applicant has used the mark continuously in Uganda prior to the registration date in the country of origin. Registration can also not be refused unless the Opponent has given an undertaking to register the mark in Uganda within three months.

22. Third, per section 44 (4), it must be proved that the country of origin accords trademarks originating from Uganda, similar protections.

23. In this case, the Opponent's trademark was registered in Switzerland in 2017. The Applicant has used the name Uganda Young Men Christian Association with the acronym "YMCA" since 1963, and upon ceasing its association with the Opponent, continued to use the same to this day. Accordingly, they are entitled to registration under Section 44 (3) which protects a person that has used the mark continuously prior to the claimed date of registration in the country of origin. It states:

*"An application to register shall not be refused under this section where—(a) the Applicant proves that he or she or his or her predecessors in business have in Uganda, in relation to the goods or services, continuously used the trademark for the registration of which he or she has made application from a date before the date of the registration of the other mark in the country or place of origin"*

24. The Applicant has proved that it has used the mark since 1963, and even after ceasing relations with the Opponent, continued to use it up to date. The Opponent on the other hand registered its mark in Switzerland in 2017. Clearly the Applicant is entitled to the protection of section 44 (3) and accordingly its application cannot be refused. I see no need to analyze the last test under section 44 (4) as the opposition fails at this stage.

25. Consequently, the opposition is dismissed with no order as to costs.

I so order.

Given under my hand, this 1<sup>st</sup> day of Dec 2023

  
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Rukundo Sarah  
Asst. REGISTRAR/TRADEMARKS



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by Rukundo  
Sarah  
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