



UGANDA REGISTRATION SERVICES BUREAU

THE TRADEMARKS ACT, CAP 225

**IN THE MATTER OF TRADEMARK REGISTRATION NO. UG/T/2020/68118
"YMCA" IN CLASS 41 IN THE NAMES OF THE WORLD ALLIANCE FOR YOUNG
MEN'S CHRISTIAN ASSOCIATION**

**APPLICATION FOR CANCELLATION THERETO BY UGANDA YOUNG MEN'S
CHRISTIAN ASSOCIATION**

Ruling

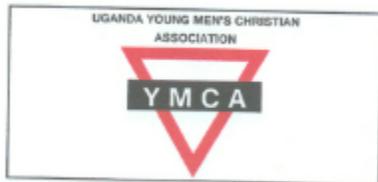
Before: Birungi Denis: Asst. Registrar Trademarks

Background

1. The Applicant is a company incorporated under the laws of Uganda, and a chartered institution of higher learning providing vocation and skills training to youths. The Applicant has provided these services in Uganda since 1986 and is a widely known institution in the Ugandan community, by the acronym YMCA.
2. The Respondent, the World Alliance of Young Men's Christian Associations, is a global youth association operating as a federation and an apex body with a membership of 120 national Young Men's Christian Associations (YMCAs) in different countries of the world.

3. On 27th February 2020, the Applicant, Uganda Young Men's Christian Association (herein Applicant) applied for registration of the mark "UGANDA YOUNG MEN'S CHRISTIAN ASSOCIATION "YMCA" and Logo for "Education and religious services" in class 45 under number **UG/T/2020/067455**. The representation of the mark is indicated below;

UGANDA YMCA



4. The application was published in the gazette dated 14th August 2020. It was opposed by the Respondent on grounds, among others, that it was confusingly similar to its registered mark number UG/T/2020/68118 "YMCA" registered in class 41 in respect of education; providing of training; entertainment; sporting and cultural activities; arranging and conducting of classes, conferences, seminars and workshops; production of educational material; coaching (training); religious education; organization of exhibitions for cultural or educational purposes; sport camp services; holiday camp services (entertainment); organization of sports events and sports competitions; timing of sports events; provision of sports facilities; gymnastic instruction; physical education; rental of sports equipment not including vehicles; rental of stadium facilities; health club services (health and fitness training); providing recreation facilities; provision of sports information; production of audio and/or video recordings; production of radio and television programmes; production of shows; providing on-line electronic publications (not downloadable); publication of electronic books, journals and multimedia material on-line; publication of texts (other than publicity texts); publication of magazines.

5. The application for registration of the mark number 68118 “YMCA” was filed on 29th June 2020, published in the gazette on 11th September 2020 and the Certificate issued on 27th November 2020.
6. The Respondent’s opposition to the Applicant’s trademark application number UG/T/2020/067455 was determined and dismissed by the Registrar on 1st December 2023. The trademark was subsequently registered on 3rd April 2024. Dissatisfied with the ruling of the Registrar, the Respondent lodged an appeal to the High Court vide Civil Appeal No. 0015 of 2024. By Court Order dated 23rd August 2024, the High Court deferred the appeal pending the determination of this application.
7. The Applicant filed this application for cancellation of the Respondent’s mark on the following grounds;
 - i) That the Applicant conducted a search of the mark “YMCA” on 18th February 2020 and found no similar mark;
 - ii) That subsequently, the applicant filed for the mark YMCA and the device on 26th February 2020. The application was given a number UG/T/2020/067455.
 - iii) That the Registrar wrote to the Applicant advising it to limit its application to class 41 instead of class 45. That having complied with this guidance, the Applicant published the mark in the gazette on 14th August 2020.
 - iv) That on 10th March 2020, the Respondent filed an opposition against registration of the Applicant’s trademark application number 67455.
 - v) That subsequently, the Applicant came to learn that while its application was pending opposition proceedings, the Respondent applied for the same mark on 29th June 2020, which was registered and the certificate issued on 27th November 2020. This mark, under number 68118, is the subject of these cancellation proceedings.

- vi) The Applicant contends that registration of the Respondent's trademark, while there was an earlier similar application pending opposition proceedings was contrary to section 25 (2) of the Trademark's Act, and is likely to cause confusion to its mark, which I should add, has now been registered after the dismissal of the opposition to it on 1st December 2023. Consequently, the Applicant avers that the registration of the Respondent's mark was done in error and is an entry wrongfully remaining on the register.
8. The Respondent on in its counterstatement opposed the application for cancellation and defended its mark on a number of grounds. The Respondent countered as follows;
- i) That it is the oldest and largest youth focused movement in the world, founded in Switzerland in 1884, with affiliated member associations in 120 countries.
 - ii) That it is the registered owner of YMCA trademark in class 41, registered vide number 68118 in respect of services of education, providing training, entertainment and sporting and cultural activities.
 - iii) That the Respondent is also the registered proprietor of the same YMCA mark in different countries including Kenya, Zambia, Sudan and Zimbabwe.
 - iv) That in 2017, the Respondent was registered as a proprietor of the same mark in Switzerland—its country of origin.
 - v) That while applying to register the disputed mark, the Respondent conducted a search and found no similar mark. That the application was subsequently filed, examined by the Registrar and approved, after which the Respondent published it in the Gazette of 11th September 2020. That after complying with the requirements, the trademark was effectively registered.

- vi) That the Respondent is the one that conceptualized the YMCA mark, and the applicant only gained affiliation with it when the Respondent offered to help the Applicant fulfil its global vision in Uganda.
- vii) With regard to use of the YMCA mark, the Respondent explains that it operates as an apex body, and instead of establishing its presence in every country, it supports 120 national organizations which it permits to use the YMCA mark. That this is provided under its constitution, which under article IV.8, provides that *“Members of the World Alliance of Young Men’s Christian Association may use the words “Young Men’s Christian Association” under the authority and license of the Respondent.*
- viii) That the Applicant was a member of the Respondent but its membership was revoked and that because of this, the Applicant is no longer licensed and authorized to use the YMCA brand.
- ix) The Respondent contends that the application to cancel its mark is an attempt to benefit from its good will and reputation by falsely associating with its global brand.
- x) The Respondent also avers that the Applicant sat on its rights when it failed to oppose the Respondent’s application which was advertised for 60 days in the gazette. The Respondent prays that the application is dismissed with costs.

Representation

Mr. Katumba Chrysostom and Mr Tusiime Alex of Lukwago & Co Advocates for the Applicant.

Mr. Kajubi Brian of MMAKs Advocates for the Respondent.

Issues

9. During scheduling conducted on the 23rd January 2025, the following issues were raised;
- (i) Whether Trademark number 68118 in class 41 was registered in error?
 - (ii) Remedies.
10. The parties addressed the Registrar by way of written submissions.

Determination

11. The issue for determination in this case arises from the fact that by the time the application for registration of the disputed trademark was filed by the Respondent and subsequently registered, there was a pending application No. UG/T/2020/067455 for the same mark "YMCA" in respect of the same services filed by the Applicant and undergoing opposition proceedings. For clarity, that application was filed on 27th February 2020 in class 45, covering education and religious services. It was opposed by the Respondent and the opposition was dismissed by a ruling of the Registrar dated 1st December 2023. The Respondent appealed to the High Court. The appeal is now pending determination and awaits the determination of this application.
12. I am now required to determine whether filing and registration of trademark number 68118 was done error and hence should be canceled pursuant to the provision of section 88 of the Trademarks Act. Counsel for the Applicant submits that the Applicant is an aggrieved person within the meaning of section 88 of the Act, relying on the case of **Ritz Hotel Ltd v Charles of the Ritz Ltd (1988 15 NSWLR 158**, cited with approval in application for cancelation of trademark No.44668 "Morning Dew", where Court defined an aggrieved person to mean any person having a real interest in having the register rectified or the trademark removed. Counsel submits that since

it was the Applicant who first applied for the mark YMCA, it has a real interest in having the register rectified.

13. Counsel also cited the decision of this office in application for registration of trademark No.59228 "Weatheguard" by Akso Nobel Coatings International against Kansai Plascon Uganda Ltd, where the learned Registrar held that *"TM 59228 "Weatheguard" in the name of the Respondent from 14th July 2017 was done in error since it resembles TM 25166 "Weatheguard" in the names of the applicant, which registration has been maintained on the register since 9th September 2002 and applies to similar goods"*. Counsel also relies on section 25 of the Trademarks Act for the proposition that an earlier application already on the register takes precedence over a later application, and no similar application should be register while it is pending. Counsel prayed for cancellation of trademark number 68118 on grounds of registration in error.

14. In response, Counsel for the Respondent submitted that the word 'YMCA' belongs to the Respondent, an apex confederation association of several national associations, and that pursuant to a federation constitution, the word YMCA can only be used with authorization of the Respondent. Counsel submits that the membership of the Applicant was suspended in 2002 and revoked in 2010 due to an unresolved dispute between the Applicant and the Respondent. Counsel adds that due to this revocation, the Applicant lost the license and the authority to use the words YMCA pursuant to article 8.2.2 of the Constitution, which requires an affiliate association to cease using the trademarks of the Respondent upon ceasing to be a member.

15. With regard to the issue of similarity and likelihood of confusion, Counsel submits that the Respondent's mark was registered in class 41, while that of the Applicant (trademark number 67455) was registered in class 45— which covers different services

from those in class 41. Counsel submits that due to this variance, there was no similar mark to be confused with, when the Respondent applied for its trademark. Counsel finally submits that the Respondent filled its application in good faith, complied with all legal requirements and as such was lawfully registered.

16. I have carefully perused the pleadings, evidence and submissions of both parties. The key issue to determine is whether there was an error in the registration of trademark number 68118. The online Cambridge dictionary defines the word “error” to mean “*a mistake especially in a way that can be discovered as wrong ...*” The Merriam Webster dictionary describes the word “error” in the following ways; “*an act or condition of ignorant or imprudent deviation from a code of behavior*”, “*an act involving an unintentional deviation from truth or accuracy*”, “*a mistake in the proceedings of a court of record in matters of law or fact*”, and “**instance of false belief**” among others.

17. I have labored to elaborately define the term “error” so as to separate the material arguments from those that are not. For clarity, when determining actions done in error, it is immaterial who was responsible for the error. Error is error, regardless of who made the mistake. Actions done in error are subject to rectification to avoid absurd or unjust outcomes. Since time immemorial, the law has treated error as matter needing correction. In contract law for example, the doctrine of *non-est factum*—applies when a person signs a document fundamentally different from what they thought they were signing. As long as they were not negligent, rectification is done to correct the mistake. Similarly common mistake in contract law requires rectification or avoiding the contract. For instance in **Fedrick E Rose (London) Ltd v William H Pim Junior Co LTD**, Lord Denning noted that in order to get rectification, it is necessary to show that the parties were in complete agreement on the terms of their

contract, but by an error wrote them down wrongly. This case therefore shows that in the interest of justice, something done in error cannot be left to pass.

18. Similarly, in financial transactions, money paid mistakenly is recoverable as money had and received. For example in **Obed Toshobya v DFCU Bank Civil Suit No. 742**, the plaintiff was compelled to refund monies which he withdrew from his account pursuant to a cheque that was later dishonored. Court cited with approval the case of **Dextra Bank & Trust Co. Ltd V Bank of Jamaica (2002)1 All ER (Comm) 193** where the Privy Council stated that;

In forming their view, their lordships are much influenced by the fact that, in actions for the recovery of money paid under a mistake of fact, which provide the usual context in which the defence of change of position is invoked, it has been well settled for over 150 years that the plaintiff may recover however careless he may have been in omitting to use due diligence.

19. The purpose of the principle enunciated above is to prevent unjust enrichment. Based on the discussion above, the arguments of Counsel for the Respondent to the effect that the Respondent registered the trademark in good faith, complied with all procedures, and that the Registrar took all the steps in approving the registration, do not hold and Counsel quotes the dictum of the Registrar at para 37 of the ruling in **Liberty Group v Liberty ICD** in application for cancellation of trademark 47160, out of context. The Registrar made those statements, confirming that the Respondent in that case had complied with all registration steps, not as a cover up to the error in registration but in response to the arguments of the Applicant who had accused the Respondent of not conducting a search and following registration steps. Further, while there was an error, which was recognized by the Registrar, the unreasonable

delay on the part of the Applicant was considered as an exceptional circumstance necessitating the Registrar to permit concurrent use. The Registrar in reaching that conclusion also considered that the Applicant had a duty to complete its application in 1 year and that following up after 8 years was negligent on its part. Therefore, that case is distinguishable from the instant application.

20. Like all other situations where error is deemed an issue for rectification, the Trademarks Act under section 88, includes “error” as one of the grounds necessitating rectification of the Register. It provides;

A person aggrieved by an omission, entry, error, defect or an entry wrongly remaining on the register, may apply in the prescribed manner to the court and subject to [section 64](#), to the registrar, and the court or the registrar may make an order for making, expunging or varying the entry as the court or the registrar, as the case may be, may think fit.

21. There is no doubt that having applied for the mark YMCA earlier, the Applicant qualifies as an aggrieved party, and I agree with the submission of Counsel for the Applicant and the Court authorities as well as decisions of the office cited in support of this argument. The Applicant applied earlier, and later discovered that the Respondent applied for the same mark and got registered. This makes the Applicant a person with interest in having the register rectified, to protect its interest. The focus should be to identify whether there was an error and the basis of the error. In my view the error was in non-compliance with the provisions of section 25 of the Trademarks Act, 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”.

22. Section 25 prohibits registration of similar or identical marks in respect of the same goods, same description of goods or services with a mark which is already on the register belonging to a different owner. The underlined words “*already on the register*” include applications filed, even though registration is not yet complete. I disagree with Counsel for the Respondent’s arguments that there was no similarity because the Applicant applied in class 45, while the Respondent’s later mark was applied for and registered in class 41. First, the basis for determination of similarity and likelihood of confusion is not the class in which the marks are registered. It is the goods and services of the undertakings in question. This is evident in section 25. The words used therein are “goods or services”, and not “classes”. Secondly, as stated in its evidence, the inclusion of class 45 in the applicant’s application, was an error which was later rectified by filing an amendment reflecting the correct class. The amendment filed on 11th December 2023 stated :

We hereby request for permission to amend the abovementioned application from application no. 2020/67455 in class 45 in respect to education and religious to application no. 2020/67455 in class 41 in respect to education; providing of training; entertainment; sporting and cultural activities

23. The above amendment was as a result of a conditional notice issued by the Registrar on the 10th March 2020, advising the Applicant to limit the specifications to the indicated class. She guided that services such as provision of education and religious

services, which the Applicant had included, fall under class 41 and not class 45. In response to this guidance, and in accordance with section 7 (9) of the Trademarks Act, the Applicant filed an amendment changing the class from 45 to 41 so that it covers the desired services. This amendment was accepted by the Registrar and the application was subsequently approved. Amendment of an application is clearly provided in the procedure for trademark registration, under section 7 (2) (b) of the Trademarks Act, which grants the Registrar discretion to refuse an application or approve it subject to conditions or limitations. I reproduce it below;

“Subject to this Act, the registrar may—(a) refuse the application; or (b) accept it absolutely or subject to amendments, modifications, conditions or limitations, as he or she may deem fit.”

24. Accordingly, I agree with Counsel for the Applicant’s submissions in rejoinder. I find no fault in the Applicant’s amendment of its application to reflect the correct class, under which its desired services fall. Therefore, the two trademarks—trademark number 067455 “YMCA” registered in respect of Education; providing of training; entertainment; sporting and cultural activities belonging to the Applicant and trademark 068118 registered in respect of Education; providing of training; entertainment; sporting and cultural activities; arranging and conducting of classes, conferences, seminars and workshops; production of educational material; coaching (training); religious education; organization of exhibitions for cultural or educational purposes; sport camp services; holiday camp services (entertainment); organization of sports events and sports competitions; timing of sports events; provision of sports facilities; gymnastic instruction; physical education; rental of sports equipment not including vehicles; rental of stadium facilities; health club services (health and fitness training); providing recreation facilities; provision of sports information; production

of audio and/or video recordings; production of radio and television programmes; production of shows; providing on-line electronic publications (not downloadable); publication of electronic books, journals and multimedia material on-line; publication of texts (other than publicity texts); publication of magazines, belonging to the Respondent are similar and are likely to cause confusion.

25. It goes without saying that the Applicant's trademark number 68118, filed on the 29th June 2020, should not have been approved owing to the fact that there was an earlier similar application number 067455 in respect of the same services, filed on the 27th February 2020 and pending opposition proceedings. The Respondent's trademark number 68118 should have been refused or paused until the determination of the opposition against trademark number 067455. It is against this background that, in response to the Respondent's argument (then opponent) in opposition to application number 067455 contending that it already has a registered trademark in Uganda, the learned Registrar referring to the current application noted as follows;

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 27th February 2022. The opponent's trademark therefore ought not to have been filed and registered until the determination of this opposition. As such, I will not consider arguments based on it in these proceedings. Therefore, this issue is framed wrongly since by the 27th February 2023, the opponent did not have trademark rights in Uganda for which potential confusion with the applicant's mark would arise. Hence, there was no trademark, which would be confusingly similar to the applicant's applied for trademark. "

26. The Registrar, in making those remarks, was not pre-determining this application as Counsel for the Respondent argues. The Registrar made a finding of fact in response to the Respondent's pleading that it already had rights based on the registration it had acquired in trademark number 68118—the subject for the present cancellation proceedings. It is the Respondent that brought the validity of trademark 68118 in question, by asserting it as the basis for opposing trademark application number 067455. Had the Respondent not pleaded it, the Registrar would not have made those remarks.

27. It is trite law that Uganda follows the first to file system, as opposed to the first to use system. Section 27 emphasizes this framework. Rights are acquired not by use but by registration. This rule of priority is a long established general principle of law, and has been accepted in trademark law and practice in many countries. I am persuaded by the decision of the High Court of Zimbabwe in **TRUWORTHS LTD V THE GAP, INC. HC-13440/2000** where the High Court confirmed the decision of the Chief Registrar Controller of Patents and Trademarks, when he cancelled a later registered mark on grounds that there was an earlier application. Hlatshwayo J, in dismissing the appeal, noted;

“...it appears to me that the decision of the Chief Registrar was correctly premised on correction of errors committed by his office. In my view, he rightly concluded that the breach of these procedures of registration, required by practice and law, so adversely affected the priority of rights of the initial applicant GAP, INC. and the integrity of the system that was supposed to protect such rights that the registration certificate of TRUWORTHS was not and could not be valid or allowed to remain on the register...it is common cause that GAP, INC. had

applied for the trademark "GAP" three years prior to the TRUWORTH Application and had it not been for the errors in the Registrar's office, GAP,INC. was legally entitled to have the mark GAP registered in its name and the TRUWORTH application would not have been permitted to proceed to registration. This legal entitlement is based on a long standing principle of law in Trademark law and practice in the Trademark Office, not only in Zimbabwe but other Countries worldwide, that the first applicant filing an application for registration of a trademark is entitled to proceed with registration over any other subsequent applicant unless the subsequent applicant has raised an objection to the first applicants application and has established to the satisfaction of the Registrar that the subsequent applicant had prior right or entitlement to the registration of the mark " (emphasis mine)

28. The above authority clearly summarizes the guiding principle of rule of priority. Indeed in the instant case the Applicant's application was the first in time and the Respondent's application should not have been registered. It is already alluded that the Respondent's opposition to prove that it had prior rights was dismissed by the Registrar, hence making it clear that the Applicant was entitled to register the words YMCA for the relevant services in 41 pursuant to the rule of priority.
29. Together with the principle of territoriality premised on Article 6 of the Paris Convention for the Protection of Industrial Property and section 36 (3) of the Trademarks Act, this framework protects a person who files first in the territory of Uganda. I therefore disagree with the argument by Counsel for the Respondent to the effect that the Respondent is an owner of the mark because it is registered in Switzerland and other countries and secondly that its constitution prohibits the Applicant from using the words YMCA after ceasing the relationship/ association

with the Respondent. With regard to registration in other countries, Counsel's argument does not stand because of the principle of territoriality. Its remedies would only be available in section 44 and 45 which protects rights of trademarks registered in the country of origin but the Respondent does not meet the strict requirements of those sections. Indeed in opposition to the Applicant's trademark registration number, 067455, the learned Registrar, in considering the rights of the Respondent under section 44, found that the Respondent did not meet the requirements of that section and dismissed its opposition.

30. Regarding arguments based on the constitution of the Respondent, by which Counsel contends it restricted a member that ceased its relationship with the Respondent from using the words YMCA. First, a private constitution is deemed a contractual arrangement between the parties to it. Therefore, where the Respondent deems that by registering the words YMCA, the Applicant was in breach of contractual obligations, the right course of action is for the Respondent to file a suit in court to enforce its rights, against the Applicant for breach of an undertaking not to use the words YMCA. On this, I take note of the remarks of the High Court in an earlier dispute in which the constitution of the Respondent and its effect on the Applicant was brought in question in **Civil Suit No.392 of 2002: Canon J. Bakibinga and others v The Registered Trustees of Uganda Yong Men's Christian Association & Others** where Hon. Justice Musoke Kibuuka stated;

"The Court must, in regarding issue number four, emphasize the fact that affiliation of the first defendant to the African Alliance or the World Alliance, is not a matter that is covered by the constitution of the first defendant. Those are contingent and purely voluntary matters, which the first defendant may or may not engage in even though there must be tangible benefits. They are matters with regard to which court would ordinarily not easily base orders affecting the first

defendant because they are activities that fall outside the purview of its own constitution”

31. While in the above case the court was determining questions of governance and management of the affairs of the Applicant, the case before me is purely one of rectification of the register and is strictly limited to Trademark issues. The Applicant being a separate and distinct identity with its own governance documents, the Respondent cannot rely on its own constitution as a shield in defense of cancellation proceedings before the Registrar. If any reference is made as to constitutional arrangements between the parties, it is usually as a matter of evidence to determine trademark issues and not as a basis for an action or a cross-action.

32. Accordingly, I find that trademark number 68118 “YMCA” in class 41 in the names of the Respondent was registered in error. The same is hereby cancelled and the register rectified pursuant to section 88 of the Trademarks Act. Consequently, the application succeeds. The Applicant is awarded costs of the application.

I so order.

Given under my hand, this 01st day of **April** 2025

Birungi Denis
Ass. Registrar of Trademark