



**THE REPUBLIC OF UGANDA
THE TRADEMARKS ACT, CAP 225**

**IN THE MATTER OF TRADEMARK NO.S UG/T/2020/068855 AND
UG/T/2020/068856 “BLACK ZEBRA” IN CLASSES 32 AND 33 IN THE
NAME OF PRIME CARE INTERNATIONAL LIMITED**

AND

**IN THE MATTER OF A CONSOLIDATED APPLICATION FOR
CANCELLATION THEREOF BY FOUR STAR BEVERAGES LIMITED**

FOUR STAR BEVERAGES LIMITED.....APPLICANT

VS

PRIME CARE INTERNATIONAL LIMITED.....RESPONDENT

RULING

**BEFORE: KUKUNDA LYNETTE AFRICA - ASST. REGISTRAR OF
TRADEMARKS**

Background

1. On 12th April 2023, Four Star Beverages Limited, a company incorporated in Uganda (hereinafter referred to as *the Applicant*), filed an application for rectification of the Register by way of cancellation of the Respondent's trademarks. The Applicant contends that trademark numbers 68855 and 68856 “BLACK ZEBRA” are likely to deceive or cause confusion in the market and to dilute the reputation of its established brand.
2. Prime Care International Limited a company incorporated in Uganda (hereinafter referred to as the *Respondent*) on 14th June 2021, registered trademark numbers 68855 and 68856 in class 33 in respect

of (*Alcoholic beverages including wines and spirits*) and Class 32 in respect of (*Non-alcoholic drinks, carbonated including mineral water*)

3. Both parties duly filed their respective pleadings together with supporting evidence by way of statutory declaration, after which the matter was heard on 5th November, 2024. The Applicant was represented by Counsel Agaba Richard and Counsel Dorothy Bishagenda of Birungyi Barata & Associates. The Applicant's Company Director, Mr. Shajan Matthew was also present. The Respondent was represented by Counsel Angela Kobel and Counsel Patricia Auma of Kiiza & Kwanza Advocates. The parties were directed to file written submissions.

Issues for determination:

The main issues raised by the parties where:

- 1) Whether the Respondent's mark is confusingly similar to the Applicant's mark?
 - 2) Whether the Respondent's mark was filed in bad faith?
 - 3) Whether the Applicant's mark should be cancelled for non-use?
 - 4) Whether the Respondent's mark as used on their products is the same as that registered on the register?
4. Applications for cancellation are governed by the Trademarks Act, Cap. 225 and the Trademarks Regulations, 2023. Proceedings before the Registrar of Trademarks are therefore not bound by the strict application of the Civil Procedure Act, Cap 282 and Civil Procedure Rules S.I 71-1. Nonetheless, where the Trademarks Act and Regulations are silent on certain procedures, the Registrar may adopt procedures and practices of Court contained in the Civil Procedure Act and Rules, as well as decisions of courts of record. Consequently, in

this matter the Registrar has applied certain procedures such as consolidation of the two applications for cancellation of the two trademarks as they relate to the same parties and subject marks. Further, guided by the provisions of Order 15 rule 1(5) of Civil Procedure Rules S.I 71–1, for orderly resolution of the issues, I shall reframe the issues as follows;

- (i) Whether the Respondent's mark was registered in error?
- (ii) Whether the Respondent's mark was filed in bad faith?
- (iii) Whether the Applicant's mark should be removed from the Register on the ground of non-use?
- (iv) Whether the Respondent's use of the impugned mark on its products amounts to infringement of the Applicant's registered mark?
- (v) What Remedies are available to the parties?

5. In the present matter, it is necessary to reframe the issues since the Applicant seeks rectification of the Register through removal or cancellation of a trademark under Section 88 of the Trademarks Act, Cap 225, which specifies the grounds for rectification. However, the issues as raised by the parties are more appropriately aligned with opposition proceedings governed by Section 12 of the Act.
6. Having outlined and reframed the issues for determination, I now proceed to examine each of them in turn.

Issue One: Whether the Respondent's mark was registered in error?

7. The Applicant contends that the Respondent's trademarks are presented in a way that is similar to its mark and hence likely to cause confusion in the market and to dilute the distinctiveness and reputation of its trademark. In their submissions, counsel for the Applicant states that the primary function of a trademark is to help a producer maintain

a unique identity in the market, protect distinctiveness and prevent unauthorized users from unfairly benefiting from the goodwill associated from such an identity. Counsel submits that the marks are visually, aurally and conceptually similar and further that the goods dealt in are similar, thus consumers and market channels are also the same. Counsel further submitted that Section 36 of the Trademarks Act provides exclusive protection of a registered proprietor from infringement. Counsel goes on to elaborate on the test of infringement and contends that based on that test, the marks are similar and the Respondent's mark is infringing on their registered mark. Counsel also contends that by adopting and registering a mark similar to that of the Applicant, the Respondent is trying to ride on the goodwill and reputation of the Applicant's established mark.

8. On the other hand, the Respondent, contends that the marks are not confusingly similar. Counsel for the Respondent submits that under Section 4 of the Trademarks Act, a mark is registrable only if it is capable of distinguishing the goods or services of one entity from those of another. Counsel argues that the visual representations of the zebras in the respective marks are sufficiently different and would not confuse consumers. Counsel further states that the average consumer looking at the two marks would not be confused as to which product is from which entity and goes on to elaborate on the average consumer test. In addition, Counsel argues that the Applicant cannot rely on reputation since such a claim would amount to asserting protection as a well-known mark, yet the statutory conditions for such protection have not been satisfied. Finally, Counsel maintains that the word "ZEBRA" is a common word not eligible for exclusive protection and therefore cannot serve as a unique identifier of the Applicant's goods.

9. I observe that both parties have departed from their initial pleadings. It is settled law that a party may not depart from its pleadings. As earlier noted, where the Trademarks Act is silent, the Registrar may rely on the Civil Procedure Act and Rules. Order 6 Rule 7 of the Civil Procedure Rules provides that;

“No pleading shall, not being a petition or application, except by way of amendment, raise any new ground of claim or contain any allegation of fact inconsistent with the previous pleadings of the party pleading that pleading.” [emphasis mine]

10. In **Interfreight Forwarders (U) Ltd versus East African Development Bank Supreme Court Civil Appeal No. 33 of 1993 (unreported)**, court stated that;

*“The cause of action as stated in the plaint and reflected in the issues framed by the party at trial was negligence. But the learned trial judge erred when he found in the alternative that the respondent was liable on a different cause of action namely, as a common carrier, which puts strict liability on the carrier for any change or loss to goods he accepts to carry. **This court upheld the ground of appeal complaining against the trial judge’s finding to that effect on the ground that the cause of action proved was a complete departure from what had been pleaded by the respondent.**” [emphasis mine]*

11. Further in the case of **Captain Harry Gandy vs Caspair Air Charter Ltd. (1956) 23 EACA 139**, Sir Ronald Sinclair said:

“The object of pleadings is of course, to ensure that both parties shall know what are the points in issue between them, so that each may

have full information of the case he has to meet and prepare his evidence to support his own case or to meet that of his opponent."

12. In this instance, the application by the Applicant and the counterstatement by the Respondent contain their initial pleadings. The Applicant did not plead infringement but introduced such arguments in submissions, while the Respondent likewise sought to rely on the doctrine of well-known marks in submissions, though this was not pleaded in the counterstatement.
13. Accordingly, I shall confine my determination to those issues that arise from the submissions which are consistent with, and co-relate to, the matters set out in the parties' original pleadings.
14. The registration of the Respondent's marks was effected under the Trademarks Act, Cap 225. Section 58 of the Act provides as follows:

"In all legal proceedings relating to a registered trademark including applications under section 78 the fact that a person is registered as owner of the trademark is prima facie evidence of the validity of the original registration of the trademark and of all subsequent assignments and transmissions."

15. The trademarks "BLACK ZEBRA" in classes 32 and 33 were registered on 14th June, 2021. In accordance with Section 58, the registration is valid until proven otherwise. As provided under section 101 of the Evidence Act Cap. 8 *He who alleges must prove*; and hence in this application, the onus is on the Applicant to prove its case on a balance of probabilities.
16. Returning to the issue at hand, namely, whether the applicant's disputed marks were registered in error, I turn to the relevant provisions of the Trademarks Act. To begin with, section 88 of the Act states that;

“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.”

17. As provided under that section registration in error may be one of the grounds for which the Registrar may rectify the register. However, it is important to first establish whether the Applicant is an aggrieved person, as stated in Section 88.
18. The term “aggrieved person” was defined in **Ritz Hotel Ltd v Charles of The Ritz Ltd and Another (1988) 15 NSWLR 158** where McLelland J stated that:

*“Decisions of high authority appear to me to establish that the expression has no special or technical meaning and is to be liberally construed. It is sufficient for present purposes to hold that the expression would embrace **any person having a real interest in having the Register rectified, or the trade mark removed in respect of any goods, as the case may be, in the manner claimed, and thus would include any person who would be, or in respect of whom there is a reasonable possibility of his being, appreciably disadvantaged in a legal or practical sense by the Register remaining unrectified, or by the trademark remaining unremoved in respect of any goods, as the case may be, in the manner claimed**” [emphasis mine]*

19. In the present case, the Applicant asserts ownership of a prior registered mark to which the Respondent’s marks bear similarity, contending that such similarity is likely to cause confusion in the marketplace and affect the reputation of its mark. Guided by the above authority, I am satisfied that the Applicant qualifies as an aggrieved

person, as his interests are directly affected by the continued registration of the Respondent's marks.

20. The Black's Law Dictionary 4th Edition Revised at Page 637 defines an error as "*A mistaken judgment or incorrect belief as to the existence or effect of matters of fact, or a false or mistaken conception or application of the law.*"

21. Guided by this definition, it follows that registration of a trademark in error arises where, from the outset, the mark ought not to have been admitted to the Register. In particular, where a trademark is found to be confusingly similar within the meaning of Section 25 of the Trademarks Act, its entry on the Register constitutes an error, given the express statutory prohibition against the registration of such marks. Section 25 (1) of the Trademarks Act provides as follows:

*(1) 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. The question before me therefore is whether the Respondent's disputed marks are similar to the Applicant's mark so as to lead to a likelihood of confusion within the meaning of section 25 of the Trademarks Act and therefore continue to wrongfully remain on the register.

23. The test for determining whether two marks are similar so as to cause likelihood of confusion was laid down in **Pianotist Co's application (1906) 23 RPC 774**, where the court stated;

"You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy these goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trademarks is used in a normal way as a trademark for the goods by the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be confusion - that is to say, not necessarily that one man will be injured and the other gain illicit benefit, but there will be a confusion in the minds of the public which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse registration in that case".

24. Further, In **Sabel BV v Puma AG, Rudolf Dassler Sport (1997) C-251/95**, the European Court of Justice (ECJ) stated that: *"In determining whether there is a likelihood of confusion, the court **must focus on the overall impression made by the respective signs.** It is not permissible to isolate one element out of a graphic ensemble and to restrict examination of the likelihood of confusion to that element alone. **However, an individual component may be recognized as having a particularly distinctive character which characterizes the sign as a whole, and, consequently, a likelihood of confusion may be found to exist if another party's sign resembles the whole of the sign so characterized.** Even in such a case, however, **the two signs must be compared in their entirety and the comparison***

must not be confined to their individual (characterizing) elements.” [emphasis mine]

25. In assessing similarity between the marks, I place the trademarks in question side-by side below, as per the guidance in **Pianotist Co’s application (supra)**;

APPLICANT’S MARK	RESPONDENT’S MARK
	

26. The Applicant’s mark contains the words “Four Star” stylized in capital letters in a bright red colour on a squiggly flag like device. Below the words “Four Star”, is the number 4 represented in a unique font. The number 4 has a star in the middle. This representation of the number 4 with the star in the middle, in my view, is a visual representation of the Applicant’s name “Four Star.” Under the number 4 is the word “Special.” In the center of the mark, right below the number 4, appears half a zebra, with its head tilted and facing the viewer. The other half of the would be zebra’s body is the word

“ZEBRA” in capital letters in a bright red colour. The half front facing zebra and word zebra is the dominant part of the mark. Below the zebra device and word, is the word Gin. All these elements are presented on a bright yellow background.

27. On the other hand, the Respondent’s mark is simple in representation whereby, the main component is the zebra device, which is right in the center of the mark. The zebra is captured in its full form and faces forwards to the left. On top of the zebra device are the words “Black Zebra.” However, the word “Black” is in black capital letters but in a small sized font, while the word “Zebra” is in capital letters in the colour Blue and of a much larger font size than the word “Black.” The size of the word “Zebra” in the Respondent’s mark appears to be reinforcing the image of the zebra right below it. The mark is fully presented on a white background.

28. In order to assess the degree of similarity between the marks concerned, the court or other presiding officer must determine the degree of visual, aural or conceptual similarity between them; and where appropriate, evaluate the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed.

29. When assessing the similarity of the marks, the consumer comes into play. It is recognized that the average consumer does not engage in a detailed side-by-side comparison but relies on an imperfect recollection. The test of the average consumer was laid down in **Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV [1999] ETMR 690 (ECJ)**.

*In addition, the global appreciation of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, **be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components.** The wording of Article 5(1)(b) of the Directive — '... there exists a likelihood of confusion on the part of the public...' — shows that **the perception of marks in the mind of the average consumer of the category of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details** (see, to that effect, SABEL, paragraph 23).*

*For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96 Gut Springenheide and Tusky [1998] ECR 1-4657, paragraph 31). However, **account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.***[emphasis mine]

30. Guided by the above cases, and then looking at both marks side by side, it is evident that both marks prominently feature the word “ZEBRA” as the dominant verbal element, reinforced by the depiction of a zebra animal. In the Applicant’s mark, the half zebra and the word

“ZEBRA” in red are the most exaggerated elements, overshadowing the surrounding text and devices such as “FOUR STAR” “SPECIAL” and “GIN.” In the Respondent’s mark, the word “ZEBRA” in blue and the full zebra image are central, while the word “BLACK” appears in a much smaller font. Both marks prominently display the word ZEBRA as the central element, with accompanying zebra images. Other words present in the marks such as “BLACK” and “FOUR STAR GIN” are secondary.

31. The average purchaser of alcoholic beverages may not exercise a high level of attentiveness when distinguishing between products, particularly in environments such as nightclubs, bars, lounges, restaurants, retail shops, liquor stores, or supermarkets where choices are often made quickly. Given that both marks share the common dominant word element “ZEBRA” and both depict a zebra animal, it is highly likely that a consumer would recall and primarily rely on the dominant element of the mark, namely the zebra, and thus request for the product simply by referencing to the main word or image reflected in the mark i.e “the Zebra.”

32. **Kerly’s Law Of Trade Marks And Trade Names, 12th edition, 17-08** states:

*“Two marks, **when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same.** A person acquainted with one mark, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Thus, for example, a mark may represent a game of football; another mark may show players in a different dress, and in very different positions, and yet*

*the idea conveyed by each might be simply a game of football. It would be too much to expect that persons dealing with trade-marked goods, and relying, as they recently do, upon marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing. **Marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole. Moreover, variations in details might well be supposed by customers to have been made by the owners of the trade mark they are already acquainted with for reasons of their own.***"[emphasis mine]

33. Even if a consumer perceives some differences (e.g. “BLACK” vs. “FOUR STAR”), the shared central identity of “ZEBRA” creates a strong risk of association. Consumers may assume that the marks represent product variations from the same producer or from economically linked undertakings, for example, that “BLACK ZEBRA” is a variant of “ZEBRA GIN.” Such mistaken belief is sufficient to constitute a likelihood of confusion and/or association, wherein the consumer believes that the products originate from the same source.
34. Furthermore, the Applicant’s mark and the Respondent’s first mark, No. 68855, are both registered in Class 33. According to the Nice Classification of Goods 11th Edition, Class 33 covers *alcoholic beverages, except beers, as well as alcoholic preparations for making beverages*. The Respondent’s second mark, No. 68856, is registered in Class 32, which covers *beers, non-alcoholic beverages, mineral and aerated waters, fruit beverages and fruit juices, syrups, and other preparations for making non-alcoholic beverages*. Although Class 32

primarily caters to non-alcoholic drinks, it also specifically includes beers. It is therefore apparent that both Classes 32 and 33 contain elements of alcoholic drinks, namely beers on the one hand and spirits or related alcoholic beverages on the other. By registering in the above mentioned classes, it is apparent that those are the goods the parties are predominantly producing in the market.

35. The case of **British Sugar plc v James Robertson & Sons Ltd [1996] RPC 281** provided guidance on assessing the similarity of goods or services. The High Court identified six key factors for assessing similarity which include;

- i. The purpose for which the goods or services are used.
- ii. The respective users of the goods or services.
- iii. The physical nature of the goods.
- iv. The channels through which the goods are marketed and distributed.
- v. The location of goods in retail settings, such as whether they are on the same shelves.
- vi. The extent to which the goods compete with each other.

36. From the above description of goods registered, it is evident that the parties are engaged in trade involving goods of a similar nature (alcoholic beverages) which are ordinarily distributed and sold through the same commercial channels; and ultimately sold to the same consumer base. This proximity in trade channels and points of sale amplifies the likelihood of confusion, as the average consumer encountering the marks in the marketplace is unlikely to exercise a heightened degree of care in distinguishing the source of the beverages. As was observed in **Parker-Knoll Ltd v Knoll International Ltd [1962] RPC 265** and reiterated in **British Sugar Plc**

v James Robertson & Sons Ltd [1996] RPC 281, similarity of goods and trade channels significantly increases the risk that consumers will assume a common commercial origin when faced with marks bearing the same dominant element.

37. Given that both marks share the dominant element “ZEBRA,” reinforced by a Zebra image, the consumer is likely to assume that the products are related. The case of **Re Pianotist Co’s Application** (supra) laid down the classic test: the marks must be compared for visual, phonetic, and conceptual similarity. Applying this test here, the similarity in the word “ZEBRA” and the “Zebra image” outweighs the differences.
38. It is my opinion that the marks 68855 and 68856 “BLACK ZEBRA” are visually, aurally and conceptually similar to the “FOUR STAR ZEBRA” mark. The differences earlier highlighted do not impact on the overall impression created by the marks to make the marks different in the eyes of the average consumer. Therefore, the average consumer would most likely not attach any significant importance to the other words contained in the mark or the colours, due to the strong visual, aural and conceptual similarity.
39. Furthermore, taking into account all the above surrounding circumstances, that is, the similarity in goods traded in and thus similar sale and marketing channels and ultimately same consumer base, including the fact that the Applicant is the registered proprietor of UG/T/2014/049445 “FOUR STAR ZEBRA” in class 33, which was registered on 18th August 2014, 7 years prior to the registration of the Respondent’s marks, I find that the Respondent’s marks are similar to the Applicant’s mark in a way that is likely to cause confusion.

40. Consequently, pursuant to Section 25 of the Trademarks Act, Cap 225 trademark numbers UG/T/2020/068855 and UG/T/2020/068856 “BLACK ZEBRA” should not have been registered. The same were registered in error and amount to an entry wrongly remaining on the register within the meaning of section 88 of the Trademarks Act.

Issue 2: Whether the Respondent’s mark was filed in bad faith?

41. The Trademarks Act, Cap 225 does not expressly define the concept of bad faith. Nonetheless, courts have over time, sought to clarify what constitutes bad faith, particularly in trademark matters. In **Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd [1999] RPC 367**, Lindsay J said (page 379):

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealing which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined.”

42. In **Fredrick Zaabwe v Orient Bank and 5 Ors. SCCA No. 004 of 2006**, Katureebe JSC in defining fraud stated that;

“Bad faith” and “fraud” are synonymous, and also synonymous of dishonesty, infidelity, faithlessness, perfidy, unfairness, etc.....”

43. Since bad faith and fraud are synonymous as held in the abovementioned case, bad faith must be specifically pleaded and proved. This principle was confirmed in **Robert Mwesigwa and 134 Others vs Bank of Uganda HCT-00-CC-CS-0588 of 2003**, where court held that;

*“In all cases in which a party pleading relies on any misrepresentation, fraud, breach of trust, willful default or undue influence, and in all other cases in which particulars may be necessary, such particulars with dates shall be stated in the pleadings.”*The Plaintiffs’ case is based on alleged acts of bad faith. The purported acts of bad faith are not pleaded. There is only an attempt to particularize them. From my reading of the plaint, no single instance is pointed out as an act of bad faith on the part of the Defendant or its officers.

44. Further in **Kyamugisha v Mutungo Executive Hotel Ltd vs Uganda Revenue Authority (Civil Suit No. 285 of 2019) [2025] UGHC 181 (14 April 2025)** Boniface Wamala, J stated that:

*“It is for this reason **that in order to succeed in an action against the 1st defendant, the plaintiff had to plead and prove existence of malice, bad faith or ill-motive on the part of the 1st defendant.** In absence of such plea and evidence, I am unable to find any liability against the 1st defendant on account of the information provided to the 2nd defendant...”*

45. Considering the above provisions and cases, it evident that a party raising a claim of bad faith must specifically plead it with particulars. However, a careful reading of the Applicant’s Application does not reveal specific pleadings of bad faith nor are there any particulars to that effect. Therefore, raising the issue of bad faith in submissions is a departure from pleadings. In **Byamukama and another v Kompaire Civil Appeal No.42 of 2021** at para 12, Court noted;

*“ It is a settled position of the law that not every inconsistency between the pleadings and evidence adduced during trial constitutes a departure. (See **Acaa Bilentina vs Okello Micheal (High Court Civil Appeal No. 53 of 2015)**).*

46. In **Waghorn vs Wimpey (George) and Co. [1969] 1 WLR 1764** it was persuasively held that an *“inconsistency which is a mere variation whose effect is in essence only a modification or development of what is already pleaded is not a departure from pleadings. However, an inconsistency which by its nature introduces something new, separate and distinct is a departure.”*

47. As stated **Acaa Bilentina vs Okello Michael (supra)**, a departure, which is likely to cause, prejudice can be struck out. I accordingly strike out the arguments on bad faith.

Issue 3: Whether the Applicant’s mark should be removed from the register on grounds of Non-use?

49. Section 46 (1) of the Trademarks Act, Cap 225 provides for removal of a mark from the register for non-use. It is reproduced below for ease of reference;

*(1) Subject to sections 47(1) and 48(1), a registered trademark may be removed from the register in respect of goods in respect of which it is registered, **on application** to the court by an aggrieved person and subject to section 67 on an application to the registrar, on the grounds that—*

(a) the trademark was registered without a bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or her or, if it was registered under section 54(1), by a body corporate or registered user concerned and that there has in fact been no bona-fide use of the trademark in relation

to those goods or services by any owner up to the date one month before the date of the application; or

*(b) at least one month prior to the date of the **application** a continuous period of three years or more elapsed during which the trademark was a registered trademark and during which there was no bona-fide use in relation to those goods or services by any owner.*

50. Regulation 71 (1) of the Trademarks Regulations provides as follows:

(1) An application to the Registrar under section 46, 48, 88 and 89 of the Act for making, expunging or varying any entry in the register shall be made in Form TM 37 and shall be accompanied by a statement setting out in full the nature of the applicant's interest, the facts upon which the applicant bases his or her case and the relief sought.

51. A reading of Regulation 71 indicates that it expressly sets out specific sections under which a party may apply for a mark to be expunged or removed from the Register as well as the prescribed form for making such an application. Since section 46 is one of the provisions listed, it follows that an application for removal under section 46 on the ground of non-use must be filed as a distinct and independent application. This is because section 46 sets out its own criteria that must be met for such an application to succeed, and the nature of evidence required in a non-use application differs from that required under, for instance, Section 88.

52. Having found that non-use can only be pursued through a separate application, I will accordingly refrain from determining this issue in the present proceedings.

Issue 4: Whether the Respondent's use of the impugned mark on its products amounts to infringement of the Applicant's registered mark?

53. The Applicant, under paragraph 1.6 of its statement of grounds, contends that the Respondent is using on its products a mark that differs from the one registered with the Registrar of Trademarks. It is further submitted that the mark actually used by the Respondent bears a close resemblance to the Applicant's mark and is therefore likely to cause confusion among consumers. In addition, at paragraph 1.4 of the statement of grounds, the Applicant avers that Prime Care International Limited is engaging in commercial activities that directly compete with its business, resulting in loss of revenue and damage to the Applicant's brand and reputation. On the other hand, the Respondent in paragraph 13 of their counterstatement, rejects the Applicant's assertions and maintains that the mark it uses in the market is the same as that registered with the Registrar of Trademarks.

54. When addressing any matter before the Registrar, the first consideration must be whether the Registrar has jurisdiction to hear it. Jurisdiction was defined in **URA v Rabbo Enterprise(U) Ltd and Anor SCCA No.12 of 2004**, to mean *the authority which the court has to decide matters that are before it or take cognizance of the matter presented in formal way for its decision*. The court must have both jurisdiction and competence.

55. The jurisdiction of a hearing officer is crucial and in **Owners of the Motor Vessel "Lillian S" v Caltex Oil (Kenya) Ltd 1989 KLR 1**, it was stated that;

"Jurisdiction is a serious issue. Any decision taken without jurisdiction is null and void. Jurisdiction is a creature of statute and

cannot be conferred by either consent or complacency of the parties nor by acquiescent of the hearing officer. Exercising jurisdiction which is not conferred by statute is an act done ultra vires....a question of jurisdiction ought to be raised at the earliest opportunity and the court seized of the matter is then obliged to decide the issue right away on the material before it. Jurisdiction is everything. Without it, a court has no power to make one more step. Where a court has no jurisdiction, there would be no basis for a continuation of proceedings pending other evidence.”

56.This office has previously pronounced itself on the limits of the Registrar’s jurisdiction. In **Megha Industries (U) Ltd v Royal Mabati Uganda Ltd (Trademark Application 59819 of 2017) [2024]** it was held that disputes regarding the manner in which trademarks are used in the market fall outside the scope of the Registrar’s powers. While considering the extent of the Registrar’s powers under Section 88 of the Trademarks Act, it was observed that:

“The section does not confer upon the Registrar the authority to determine whether the manner in which one trademark owner uses its trademark infringes another’s rights, as a basis for removal or cancellation. A party alleging infringement has recourse to the civil remedies available in courts of law under Section 71 of the Act. In opposition proceedings, the Registrar’s jurisdiction is confined to examining whether the statutory grounds for refusal of registration are met, not to adjudicating actions for passing off.”

57.Under the Trademarks Act, Cap. 225, the Registrar’s jurisdiction is primarily confined to matters concerning registration. This

encompasses the examination and registration of applications on absolute or relative grounds. Absolute grounds addressing the inherent registrability of a mark by its very nature, and relative grounds addressing conflicts with prior rights already on the register. It further extends to objections to registration. Objections to registration are either by way of opposition under Section 12, which is raised before a mark is registered, or by rectification and cancellation under provisions such as Sections 45, 46, 48, 50, 88 and 89, which apply to marks already entered on the Register but challenged for removal on certain statutory grounds.

58. Disputes concerning the use of a registered mark in a manner different from the way it is presented on the register, would imply that the disputed mark is not registered and consequently fall outside the jurisdiction of the Registrar. Hence, section 34 of the Trademarks Act provides that “***A person may not institute proceedings to prevent or to recover damages for an unregistered trademark.***”

59. The above section is further supported by Section 35 which states that ***Nothing in this Act shall be taken to affect a right of action against a person for passing off goods or services as the goods or services of another or the remedies in respect of the right of action.***[emphasis mine]

60. These provisions, read together, indicate that infringement and passing off disputes lie outside the Registrar’s jurisdiction and must be pursued in the High Court. Accordingly, by raising issues and arguments about how the Respondent’s mark is used in the market as opposed to how it appears on the Register, the Applicant has, in effect,

invited the Registrar to determine claims of infringement and passing off. These matters are beyond the statutory jurisdiction of the Registrar and cannot be determined in the present proceedings.

61. In light of the foregoing, I find that the Registrar has no jurisdiction to determine questions of whether the Respondent's use of the impugned mark constitutes infringement of the Applicant's mark. Such matters fall within the jurisdiction of the High Court.

Issue 5: Remedies available

62. Having established under issue one that the Respondent's marks "BLACK ZEBRA" Nos. 68855 and 68856 are confusingly similar to the Applicant's prior registered mark "FOUR STAR ZEBRA" no. UG/T/2014/049445 and thus wrongly remain on the Register, the Applicant's request for rectification by way of cancellation succeeds.

63. Accordingly, the Register is hereby rectified by the removal of trademark numbers 68855 and 68856 "BLACK ZEBRA" in Classes 33 and 32 in the name of Prime Care International Limited.

64. Each party shall bear its own costs.

I so order.

Dated at Kampala this 12th day of September, 2025

.....

Kukunda Lynette Africa

ASSISTANT REGISTRAR OF TRADEMARKS