



The Simplified Handbook on
TRADEMARKS
IN UGANDA

Protecting your trademark and brand



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Uganda Registration Services Bureau

Uganda Business Facilitation Centre,
Plot 1, Baskerville Avenue, Kololo,
P.O.BOX 6848, Kampala, Uganda.

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Introduction

It is not just the things we drive, the clothes we wear, or the food we eat, it's everything. If it is for sale, it has a trademark on it. If it is a business, it has a name on it. One of the most important and most valuable assets of a business is its trademark. Understanding trademarks and how they affect branding strategies, business assets and market outcomes is therefore important.

Uganda Registration Services Bureau (URSB) is the institution mandated under Cap 210 of the Laws of Uganda with the registration of intellectual property rights which include patents, industrial designs, utility models, copyright, and trademarks. The institution is also responsible with providing the public with Intellectual Property (IP) information and promoting use of IP in Uganda.

It is against this background that URSB has created this simplified trademark handbook to ease and deepen public understanding of trademark laws in Uganda in order to increase awareness, knowledge and use of the trademark system for business growth and ultimately, socio-economic development of Uganda.

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WHAT IS A TRADEMARK?

A **trademark** is the sign which distinguishes similar goods or services provided by one trader or business such as JESA milk, from those provided by other traders or businesses such as LATO milk.



A **trademark can be** a word, symbol, slogan, logo, sound, smell, colour, name, phrase, signature, letter, numeral, drawing, picture, shape, or any combination of them.

Trademark protection ensures that the owners of marks have the exclusive right to use them to identify goods or services, or to authorize others to use them in return for payment.

Examples of trademarks.

Plain Words include

MOVIT, RIHAM, AZAM, BELL, JESA, MOVIT, SAFI, DASANI, ENGULE

Logos can be any picture, symbol, or combination of signs.



Plain logos without any words.

movit

Jibu

azam

Sunz

Stylized words in special font, characters or colours.

café Javas

BELLA

Kazire

Shapes

In some cases, the shape of a product or the packaging may be a mark.



A shape mark containing words and elements of chocolate.



The shape of the Coca-Cola bottle registered as a trademark.

Signatures

Taylor Swift

Jack Daniel

Unique slogans



everywhere you go



START YOUR
ADVENTURE

Letters and abbreviations



Colour marks



Sound

Nokia Tune
Nokia

Standard tuning
Moderate J = 120

G-c#

NOKIA phone caller tune

Why are Trademarks important to your business?



Valuable business asset: Trademarks may be licensed or sold in exchange for money. They can also be used as security to obtain loans.

Advertising tool: A trademark is a powerful marketing tool for your brand and products. It conveys information about your organization, its reputation, and the products you provide.

Identify your products: A trademark helps customers to identify you or find your goods or services in the market.

Returning customers: A unique trademark helps you capture customer attention making your products to stand out and establish a strong customer base.

Some trademarks are worth billions. MTN Group was named as the most valuable African brand in 2021 with a brand value of \$2.7 billion. Brand value is the net economic benefit that the brand owner would achieve by licensing or selling their trademark in the open market. Google's trademark value totals a whopping \$44.3 billion. Microsoft's comes in at \$42.8 billion. Walmart's weighs in at \$36.2 billion.

Do Trademarks, Copyrights, and Patents mean the Same thing?

The words "trademark" "copyright" and "patent" are often used interchangeably and incorrectly. Trademarks are one form of intellectual property (IP). Like patents, copyright, industrial designs, and other forms of IP, they afford exclusive rights to an intangible asset. However, trademarks, copyrights, and patents protect different types of intellectual property rights.

A trademark typically protects brand names and logos used on goods and services.

Patents

A **patent** protects an invention which can be a new product or a process that provides, in general, a new way of doing something, or offers a new solution to a problem. Patent protection lasts for 20 years. An invention must be new, inventive and industrially applicable to be granted a patent. Patent protection means an invention cannot be commercially made, used, distributed or sold without the patent owner's consent. Examples of famous expired patents include the telephone, the computer, the bulb, and electricity.



Copyright

Copyright protects an original artistic or literary work. Works covered by copyright range from books, music, paintings, sculpture, and films, to computer programs, databases, advertisements, maps, and technical drawings.



Written



Musical



Artistic



audiovisual

Neighbouring rights protects works of performing artists, producers, and those involved in broadcasting. Works derived from already existing works. Under the Copyright and Neighbouring rights Act, 2006, Copyright is protected for the lifetime of Copyright owner plus 50 years after their death.

There is no requirement that the literary and artistic work should be good or have artistic merits. It should, however, be original.

A single product can be protected by different IP rights. To learn more about these different IP rights, visit the URSB website <https://ursb.go.ug/intellectual-property-2/>

Trademarks

- SAMSUNG
- Startup tone
- Samsung Galaxy

Designs

- Overall look of the phone.
- Arrangement & shape of buttons & screen.



Copyright

- Software
- User manuals
- Images
- Ringtones

Patents

- Lock screen
- Touchscreen
- Data processing methods

Trademarks and website addresses

A website address and a trademark differ. Website names enable an internet user to visit a specific website. For example, in the web address www.ursb.go.ug the domain name is “**ursb.go.ug**”. You register your domain name with an accredited domain name registrar on the internet.

Registration of a domain name on the internet does not give you any trademark rights. For example, even if you register a certain domain name with a domain name registrar, you could later be required to surrender it if it infringes someone else’s trademark rights.

It is important that you choose a domain name which is not the trademark of your competitors, especially if it is a well-known trademark.

Trademarks and business names

A business name is the full name that your business goes by; for example, “**ABC LTD**” if it is a company. It often ends with (Ltd) if it is a company to denote the legal character of the business. A trademark, however, is the sign that distinguishes the product(s) or service(s) of your business in the market.

Registration of your business name doesn’t give you trademarks rights in the name. You must register the business name as a trademark in order to enjoy trademark rights in the name.

Businesses may use a specific trademark to identify all their products, a variety of products or one specific type of product. Some businesses may also use their trade name, or a part of it, as a trademark.

Example:

HARISS INTERNATIONAL LTD is a Ugandan company that owns various trademarks for different goods such as **ROCKBOOM** for energy drinks and **ONER** for fruit juices.

WHAT CAN BE REGISTERED AS A TRADEMARK?

Not every word or sign is registrable as a trademark. To be eligible for registration, your trademark must meet certain conditions under the Trademarks Act, 2010.

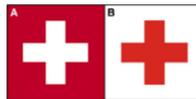
Your chosen trademark should meet the following conditions.

- ❑ It should be distinctive or unique
- ❑ It should not describe the goods you sell or the services you provide.
- ❑ It should not resemble a registered trademark of another business for the similar goods or services.
- ❑ It should relate or be used in respect of specific goods or services.
- ❑ It should be legal; use of certain words and signs is prohibited.

Other obstacles to protecting your trademark

Your trademark may be rejected if;

- ❑ It is deemed immoral, scandalous or contrary to public policy. Example, using **COCAINE** may not be acceptable as the word is scandalous.
- ❑ It is likely to mislead or deceive consumers as to the nature, quality or geographic origin of the goods/services. E.g., calling your trademark "**REAL LEATHER**" for products that are not made out of genuine leather.
- ❑ It is a trademark bearing the "**Red Cross**" or "**Geneva cross**" representations or words to that effect.



- ❑ It is merely a name of a place or a geographical name . E.g., trying to register **NAIROBI** for apples or **MBALE** for steel production.
- ❑ It is primarily a common surname such as "NALULE" "MUGISHA" "AKOL" "AGABA" or "KAKOOZA".
- ❑ It resembles a flag, coats of arm, , army badges, armorial bearings, official signs or other emblems of organizations, countries, organisations or corporations.

What is a distinctive and unique trademark?

A trademark is unique if it differentiates your goods or services from those of other businesses. It must be able to attract the attention of the consumers and inform consumers which company the goods or services come from.

Not distinctive

A consumer would not see this bottle without a label as a sign capable of distinguishing your business from another.

Generic & descriptive – Weak signs

The word 'juice' describes the contents of the bottle. **"FRESHLY MADE"** describes the quality of the juice. Very difficult to register.



Distinctive trademark – Strong sign

The addition on the label of a unique name would make consumers see it as a trademark indicating one particular brand.

Choose a strong word or sign

The strongest trademarks are words or signs that do not describe the goods or services for which they are used. These are easier to register, protect, use and defend.

Trademarks that describe the goods or services you provide may also include **shapes of those goods**. Where the shape describes what you sell, it will not be granted registration.



Apples or apple farming related services.



Not registrable. The trademark is in the shape of the goods or services.

Cars as goods or car related services



Registrable. The shape of an apple doesn't describe cars.

Illustration of weak to strong words.

Descriptive words or signs – WEAK

These words describe a characteristic, quality, feature, or purpose of a good or service. They are difficult to register as a trademark. E.g., "FRESHLY MADE" for fresh juice. "COLD AND DELICIOUS" for ice cream.



Suggestive words –STRONG

These hint on what the good or service might be without actually describing the product. These don't always have the strongest level of defense. Examples include Green Press for pressed Apple juice or LUCKY CAT for pet food.

Random words and symbols – STRONG

Regular words or phrases that have a common meaning, but whose meaning isn't related to the good or service. E.g., CANDLE for juices, CHEERS for juice. SUPREME for flour, APPLE for iPhone or DOVE for soap.



Made-up or invented words – STRONGEST

A random combination of letters with no known definition put together to form a trademark such as WATAFFY for fresh juice. E.g., MOVIT, AZAM, LIVARA, SAMSUNG, KODAK.

Trademarks that resemble or similar for the same goods or services are prohibited

Your trademark should not resemble a registered trademark belonging to another business for the same goods or services.

Illustration

If you wish to file for a trademark called **"TAFFY"** for **Kitchen Furniture**, but there is already a registered trademark, **"TAFFY"** for **mirrors and TV stands belonging to another person**, the examiner may reject your application as these trademarks are the same and are being used for similar goods or services.

Other examples



The registered trademark is **"adidas"** on the left. The mark on the right, **"ABIBAS"** is confusingly similar and may be rejected at application.



SONY is a registered trademark of Sony Group Corporation. The mark on the right, **"SQNY"** is confusingly similar and may be rejected at application.

THE ROAD TO TRADEMARK REGISTRATION PROTECTION

Why should you register your trademark?

- ❑ **Easier to prove ownership:** Registration certificate is concrete proof that you own the trademark.
- ❑ **Easy online registration process:** Trademark filing is easy and online through the www.ursb.com website.
- ❑ **Creation of a valuable asset:** You can License, sell, or give away your trademark.
- ❑ **Protection for a long time:** Registration is for 7 years and can be easily renewed every 10 years thereafter.
- ❑ **Easier to enforce a registered trademark:** You can stop competitors from using trademarks similar to your trademark. You can also stop the importation of goods bearing your trademark.
- ❑ **Right to borrow money using your trademark.** You may use your registered trademark certificate as security to obtain a loan.

Goods or services?

No trademark protection without classification of your products as either goods or services.

You must specify the goods and services for which you seek trademark protection (list of goods and services). Goods and services are categorised in different classes according to the International Classification of Goods and Services for the Purposes of the Registration of Marks under the NICE Agreement (NICE Classification).

The NICE Classification of goods and services classifies the goods and services into 45 categories (or classes). Classes 1 -34 are for goods, and classes 35-45 are for services. These classes define wide areas, referred to as class headings.

For example;

If your trademark was intended to be used on a new shoe, you could select “footwear” as a broad term in class 25. You might also wish to consider class 35 to cover, for example, retail services in relation to footwear and sports shoes.

The list of goods and services is an important component of the trademark application; without such a list the application is incomplete. A correct list of goods and services ensures fast processing of your application.

For more information on NICE classification of goods, see PAGE 33 ANNEX to this handbook or visit www.wipo.int/classifications/nice/en/ for a detailed list.

Who can apply for a trademark?

In general, any person who intends to use a trademark may apply to register it. It may either be an individual or a registered business. The information given will be used to clearly identify you as the owner of your trademark.

A common mistake made is to have a director or employee of the company file for a trademark in their own personal name. The Trademark will be owned by the director or employee and not the company.

Do you need a trademark agent to file a trade mark application?

Any business or person resident in Uganda isn't required to hire a trademark agent to file an application; you may file the application yourself. However, the services of a trademark agent come with many benefits such as:

- ☐ Preparing and following through on your trademark application.
- ☐ Advising you as to whether your trademark application may be refused.
- ☐ Advising you regarding the type of application that should be filed once they are familiar with the applicant's business and branding objective.
- ☐ Defending you if your trademark application is challenged.
- ☐ Assisting you with filing the mandatory post registration documents as they come due for filing such as renewals.

Foreign nationals and businesses registered out of Uganda

All foreign nationals and businesses registered out of Uganda are however required to use the services of a trademark agent based in Uganda.

Where to find a trademark agent

Make sure that any agent you hire has experience prosecuting trademark applications before URSB. URSB keeps a register of Trademark agents on its website; https://agents.ursb.go.ug/search/rm_tmagents_list.php .

THE APPLICATION PROCESS

Step 1 SEARCH	Upon payment of a prescribed fee, request for a search to ascertain whether the trademark exists in the register
Step 2 FILING	Applicant files the trademark application upon payment of application fees
Step 3 EXAMINATION	The application is examined to determine if it is capable of distinguishing the goods or services among other considerations
Step 4 ADVERTISEMENT	Publication of Application: If the application is granted, it will be advertised in the Uganda Gazette for 60 days.
Step 5 REGISTRATION	Certificate of Registration: If there is no opposition after the expiration of 60 days of the advertisement in the gazette, the Registrar shall upon payment of the prescribed fee by the applicant enter the trademark in the register and issue a certificate of Registration.

Trademark fees

FEE	LOCAL (UGX)	FOREIGN (USD)
Search fees	25,000	65
Application fees	50,000	150
Publication fees	100,000	80
Registration fees	100,000	250
Renewal fees	100,000	250

A full list of fees for both local and foreign applicants can be found on our website. Fees are not refundable should your application fail. You will have to pay additional fees if your application covers goods or services in more than one class

The first step is the trademark availability search

Conducting an availability search on your chosen trademark before filing an application is very important because the results may identify potential problems, such as a likelihood of confusion with a prior registered mark or a mark in a pending application.

A trademark search will assist in checking whether any third-party rights already exist. You can save time and money by searching for trademarks that could conflict with yours before you apply.

Example:



TESLA's trademark application was rejected by the Chinese authority in 2009 because "TESLA" had already been registered by another business. Years later, the company was able to negotiate a settlement with the other party that later cancelled its trademark, paving way for Tesla to apply for its trademark.

Registrar's advice as to registrability of your trademark

For an additional fee, you may also consider seeking the preliminary advice of a Trademark registrar as to the strength of your proposed trademark. Also, the search results and advice may show whether your chosen trademark or a part of your mark is generic or descriptive wording in other registrations, and thus is weak and/or difficult to protect. This application can be done by filing form TM 28.

Where can you carry out a trademark availability search?

The Trademark search can be done either online or through email.

Online trademark search

Searches can be done **online on the URSB website**. Visit the link at; <https://ursb.go.ug/dynamic-pages/trademark-search>.

Trademark search using email

You may send the search request by filing Form TM27 and sending it together with the payment receipt to ip@ursb.go.ug.

Illustration on how to complete the Trademark search Form TM27

FORM TM 27



THE REPUBLIC OF UGANDA
THE TRADE MARKS ACT, 2010.

REQUEST FOR SEARCH

To:
The Registrar of Trade Marks,
P.O Box 6848,
Kampala.

Name, address, telephone number and email address of person making the request: **POTATO UGANDA LTD**

Of **Plot 1, Wampe Avenue, P.O.Box 1, Kampala Uganda**

Tel No. **414111222**

Email address: **potatouganda@gmail.com**

I hereby request that a search be made in respect of goods and services in the following classifications:
Clothing, Footwear and Headgear in class 25.

to ascertain whether any mark is on record that resembles the trade mark **SUNSHINE**, duplicate representations of which are attached to this request.
 (Attach trademark in TM Form 3).

Dated the **30th** day of **November**, **2021**.

Insert Date.

Signature
 (Signature)

Class and list of goods or services from the selected class.

Name, address, email & telephone of applicant/owner of trademark.

Name of the trademark. Attach photo if trademark is a logo or a picture.

Signature by applicant or authorised agent.

The second step is to file your application with URSB

Once you have established through a trademark search that your trademark is available for registration, you may proceed with applying for your trademark.

Important to note:

- ☐ Your application must contain a representation (illustration) of the trademark. The illustration must show the trademark exactly as you wish to have it protected in the future. Indicate the type of trademark (word mark, figurative mark, sound mark, etc.).
- ☐ Indicate exactly the goods and services for which you intend to use the trademark you are applying for together with the relevant NICE class of goods or services.
- ☐ You must file a separate application for each trademark and class of goods or services.

Example 1: if you manufacture and sell cars, you must lodge two trademark applications: One in class 12 for manufacturing of motor vehicles; and one in class 35 for selling of motor vehicles.

Example 2: If your business is producing knives and forks, your trademark application should be made for the corresponding goods in class 8 of the Nice System. If, however, you wish to market other kitchen utensils (such as containers, pans, or pots) using the same trademark, you will also have to register the trademark for the corresponding goods in class 2.

Where can you submit your trademark application?

A trademark application can be done either online on the URSB website <https://jponline.ursb.go.ug/sp-ui-tmefiling/wizard.htm?execution=e1s1> or by sending an application form TM2 using to the email; jp@ursb.go.ug

Steps to apply online

1. Go to <https://ursb.go.ug/>
2. Click on **E-Services** » **Intellectual Property** » **“Trademark application”** Tab



3. Fill in the fields provided. The fields with the Asterisk * are mandatory.

Under “Part of the Register”, click drop-down and select Part A.

Under “Type of mark”, click on the options depending on whether your trademark sign is a word, symbol, slogan, logo, or any combination of them. Where the trademark isn’t a plain word mark, you will need to upload an image of the mark.

Provide the name of the trademark

Click next to move to the next stage.

4. Provide a list of either your goods or services with the corresponding NICE Class.

Under “Browse terms”, you can browse the list of goods or services, search for your product and select the right class of goods or services from results in the drop-down.

Or

If you already know the class and list of goods or services you provide, under “Provide your list of goods or services”, provide your class and list the products.

Name	Class
Fruit juice	32
Juice of Citrus	32
Fruit juice	32
Fruit Juice	32

5. Provide details of any priority Claim

If you have any trademark applications filed in other countries in the past 6 months, in respect of the same trademark for the same class of goods or services, select “yes” and provide details. If not, select “no” and move onto the next page.

Claims

Do you have a priority claim?

Previous

6. Provide details of applicant

Under “Applicant type”, click drop-down arrow and select whether company or individual applicant from the drop down.

Under “Applicant kind”, click drop-down arrow and select whether local or foreign applicant from drop down.

Provide all the name, address, phone number and email address of the applicant.

Applicants

+ Applicant

Applicant Type * Cancel

Company Corporate

Applicant Kind *

Local applicant

Company Name *

POTATO UGANDA LTD

In which country was this company registered? *

Uganda

Physical address of business (*)

plot 1 Wampye

Country *

Uganda

Phone number *

+1 8000000

email *

potato@gmail.com Cancel

Representatives

+ Agent

Previous

7. Sign the application by writing your full name if an individual or the full business name if applicant is a company. Confirm and pay at the nearest bank with URA services.

Signature

Entering your name below constitutes a signature and confirms that you have checked the details and wish to submit this application form.
Any false information may affect the application and registration thereafter.

Full name *

Capacity of signatory

---SELECT---

Payment

Payment mode *

---SELECT---

Previous

Applications through the email services

You may submit your application form TM No. 2 together with payment receipt and relevant documents through email. All correspondence should be addressed to the email address; ip@ursb.go.ug .

Illustration on how to complete the Trademark Application Form TM2

THE REPUBLIC OF UGANDA
THE TRADE MARKS ACT, 2010
APPLICATION FOR REGISTRATION OF TRADE MARK
IN PART * A OF THE REGISTER
(Regulation 17(2))

POTATO

Application is hereby made for Registration in Part * A of the Register of the accompanying trademark/Series of trademarks in Class .25 In respect of

CLOTHING, FOOTWEAR, HEADGEAR

in the name of (b) POTATO UGANDA LIMITED

Whose trade or business is;

(c) Physical address PLOT 1, WAMPE AVENUE

Postal address P.O.BOX. 1, KAMPALA

Email address/es POTATOUGANDA@GMAIL.COM

Tel No's: 41411222

Trading as (d) A LIMITED LIABILITY COMPANY

by whom it is (e) proposed to be used and who claim(s) to be the proprietor(s) thereof (f)

Dated the 17 day JULY of 2021

(g) SIGNATURE

To: The Registrar of Trademarks
Amamu House, Plot 5, George Street
P.O. Box 6848, Kampala.

FORM TM No.2

* Write distinctly here "A", "B" according to registration desired.

One representation to be fix within this space and fo others to be sent separate Forms TM-No.3

Representations of a large size may be folded, but must then be mounted upon lines or other suitable material ad affixed hereto.

(a) Here specify the goods. Only goods included in one and the same class should be specified. A separate application from the required application required for each class.

(b) Here insert legibly the full name, description and nationality of the individual, firm or body corporate making the application. The names of all partners in a firm must be given in full. If the applicant is a body corporate, the kind and country of incorporation should be stated.

(c) Here insert the full trade or business address of the applicant.

(d) Here insert the trading style (if any).

(e) If the mark is already.....

(f) For Additional matter if required, otherwise to be left blank.

(g) Signature.

Insert class of goods or services.

Insert Image or name of the trademark.

List of goods or services from the selected class.

Name of applicant/ owner of trademark

Address & contacts of applicant.

Signature by applicant or authorised agent.

Insert Date.

What happens after filing?

You receive an official application number. **The application date – what role does it play?** As a rule, the earlier trademark – that means the trade mark with the earlier filing date – has better chances to succeed in case of conflict.

Examination of your trademark application

The trademark registrar will examine your trademark to ensure it meets the conditions required for registration. You will be informed if any ground against the registration of your trademark is found. For a discussion on conditions a trademark must meet to be registered, refer to page 13.

If your trademark is acceptable for registration, you will receive a notice to publish your application.

Application is advertised

The application including the name and address of the applicant, the filing date, the trademark, and the associated goods and services will be advertised at a fee either in the URSB Trademarks journal published on the URSB website or in the Uganda Gazette. By advertising applications, others are given a chance to object to them before they are registered.

Opposition to your trademark application

Any person can challenge (oppose) your trademark application once it is advertised. The person must file a statement of opposition stating their grounds for objecting to your application within two months from the date of the advertisement.

Registration of your trademark

If there is no objection to your application or where an objection to your application has failed, the Registrar will register your trademark. **A certificate of registration** will be issued, and your trademark entered into the Register of Trademarks.

Registration fees of ush. 100,000/= apply.

Abandonment of your trademark application

If you do not respond to the registrar's report, your application may be considered to be abandoned. You have 12 months within which to complete the registration process of your trademark otherwise your application will be deemed abandoned by you if you fail to do so. You will have to file a fresh application and pay fees.

For how long does registration last?

Your initial registration lasts for 7 years from the application date. The duration of protection starts on the application date and ends after seven years, on the last day of the month of the application date. You may renew your trademark registration for 10 years and every 10 years after that at a fee. Renewal fees of ush.100,000/= apply every time you renew. The form for the renewal of a trademark can be downloaded from the URSB website.



MAINTAINING AND PROTECTING YOUR REGISTERED TRADEMARK

When you register a trademark, you gain a very valuable right. However, you can lose that right if you do not carry out certain responsibilities. Failure to perform these responsibilities will put your Trademark at risk of being removed or losing your rights.

Renew your trademark registration

Your initial registration lasts for 7 years from the date of application. After these 7 years, you will be required to renew your registration by filing form TM10 and paying renewal fees of Ush. 100,000/=.

Late fees apply if the registration is renewed after the expiry date.

Record any changes in your registered details

It is important to ensure that your details in the Trademarks Register are **up to date**. Changes in your details may include a change of address, change of business name, change of ownership for example if you sell or transfer your trademark to another person.

Ensure to register a sale or transfer of your trademark to another person

The person who becomes the new owner of the trademark must apply on the prescribed **form TM15** to URSB to be registered as the proprietor of the trademark. Failure to register your sale or transfer with URSB will leave the buyer without any recognized rights in the trademark. To avoid ownership disagreements, you should formally tell the Registrar about changes in ownership.

Use your trademark

Once your trademark has been registered, you must use it. If it can be proved that your trademark has not been used for longer than three years, it could be cancelled.

How should you use your trademark in advertising and in the market?

To ensure that your trademark doesn't become the generic term for the product, vigilance is the key.

- ❑ Use the trademark as it is registered – don't abbreviate or alter it.
- ❑ Distinguish the trademark on the goods by emphasizing the trademark in some way. **For example**, use capital letters or bold type to make the trademark stand out, so that it is clearly distinguished from other words or logos on the packaging.
- ❑ Use the registered trademark symbol ® if your mark is registered.
- ❑ Use the trademark as an adjective where possible. E.g., "Buy COLGATE toothpaste." It is important to avoid using the trademark as a verb or noun so that it does not come to be perceived by consumers as the description of the product.

Example of a company that lost their trademarks in some countries because they became the generalised term for the goods.



ASPIRIN was originally trademarked by Bayer AG. The company has lost its trademarks in many countries since creation due to the term being used in the market to describe the product. Today, **aspirin** is a generic term for **acetylsalicylic acid** in many countries.

Monitor the use of your trademark in the market

You need to actively look out for competitors using your trademark or a similar trademark without your permission.

What should you do if someone is infringing on your trademark?

Infringement occurs when a competitor uses your trademark on their products without your authorization. You can take action to stop resembling trademarks from being registered and/or used by your competitors without your consent or authorisation.

Making an objection to use by a third party typically begins with issuing a cease-and-desist letter. If the third party does not comply with the demands made, formal proceedings then need to be issued.

If another party has applied to register a trademark that conflicts with yours, you can file an opposition directly at URSB. You must do this within 60 days from the date on which the competitor's trademark was published in the Uganda gazette.

Examples of businesses that paid heavily for infringing on registered trademarks of others



In 2007, Paris Hilton sued Hallmark cards for using her registered trademark, "**that's hot**" on greeting cards. The suit was settled and although undisclosed, it is rumoured that she was paid at least \$500,000 in damages.

Adidas



Payless



Adidas



Payless



In 2008, an Oregon jury found that U.S. retailer **PAYLESS** wilfully infringed Adidas' 3-stripe registered trademark and various Adidas product designs, by selling sneakers bearing 2 and 4 stripes. According to Adidas in its complaint, Payless' sneakers not only contained 2 or 4 parallel stripes on the sides of Payless' products, but many of Payless' sneakers looked very similar to certain Adidas designs. The jury awarded Adidas

over \$300 million in damages, later reduced to \$65 million.

Can I enforce my trademark rights in another country?

Registering your trademark in Uganda protects your rights in Uganda only. It is highly advisable to register your trademark abroad if you wish to use it in other countries.

If you wish to market goods or services in other countries, you should think about getting trademark registration(s) there as well. Registration of a trademark gives you protection only in the country or region where your trademark is registered.



Before the launch of Apple's **iPad**, the company found that the **iPad trademarks** for mainland China were registered under Proview's Shenzhen company. Proview filed a trademark infringement case against Apple in China. Apple was forced to settle the matter for \$60 million in order to obtain the trademarks rights in China mainland.

How can you register your trademark in other countries?

There are three main ways to register your trademark in other countries:

The national route: You may apply to the trademark office of each country in which you are seeking protection by filing the application in the required language and paying the required fees. As indicated earlier, a country may require you to use the services of a locally based trademark agent or lawyer. Some countries do not have a national system and use a regional system instead.

The regional route: If you want protection in countries which are members of a regional trademark system, you may apply for registration with effect in the territories of all member countries by filing an application at the relevant regional office. The regional trademark offices are: the African Regional Intellectual Property Organization (ARIPO) www.aripo.org; the Benelux Office for Intellectual Property (BOIP) for protection in Belgium, the Netherlands and Luxembourg www.boip.int; the European Union Intellectual Property Office (EUIPO) for Community Trademarks (CTM) in the Member States of the European Union www.oami.europa.eu; and the Organisation Africaine de la Propriété Intellectuelle (OAPI) for protection in French-speaking African countries www.oapi.int.

The international route through the Madrid System

The Madrid system provides a central system of trademark applications and registrations in more than 90 member states through a single application that covers more than one country at a time. Madrid now permits the filing, registration and maintenance of trademark rights in more than one jurisdiction, provided that the target jurisdiction is a member state to the system. The Madrid system is administered by the International Bureau of the World Intellectual Property Organization (WIPO) in Geneva, Switzerland.

To file through the Madrid System, you must have connections with it, that is, you must either be a national of, be domiciled in or have your business established within the territory of any of the members of the Madrid Union.

Uganda isn't a member of the Madrid Union. At the moment, you cannot file through the Madrid system unless your business is established in its member states.

OTHER TYPES OF MARKS OR SIGNS

Certification marks

A certification mark is a type of trademark that is used to show consumers that particular goods and/or services, or their providers, have met certain standards or requirements such as safety, fitness for use and/or characteristics for that product, usually specified in a standard.

A certification mark is normally found on the product or its packaging and may also appear on a certificate issued by the certification body. The mark carries a reference to the number or name of the relevant product standard against which the product has been certified.

Examples of certification marks:



The Uganda National Bureau of Standards

(UNBS) certification mark.

If the **UNBS** certification mark appears on a product packaging, it means that

the product has met certain production standards once it was tested.



The government of Uganda through the Ministry of Trade,

Industry & Cooperatives. The mark is issued for all locally manufactured products in Uganda



The Uganda Halal

Bureau certifies products and services for halal compliance based on national standards. When

you see a business or restaurant or product that bears this mark, it means that that business has been certified as having met the halal standards set by the bureau.

Collective Marks

A collective mark is a mark owned by an organization or association, used by its members to identify themselves with a level of quality or accuracy, geographical origin, or other characteristics set by the organization or association.

The association generally establishes a set of rules and standards for using the collective mark; businesses must comply with such standards.

In some circumstances, geographical names can be registered as collective marks for certain goods such as agricultural products that are well-known as products coming from a particular geographical area. For example, Uganda's Mukono Vanilla is known for having the highest vanillin content of any vanilla in the world.

Example



*The **Uganda Law Society** is the Bar Association for lawyers in Uganda. The collective mark is used by members of the society.*



The "CA" device used by the Institute of Chartered Accountants. Courtesy of the institute of chartered accountants.

What is the relationship between trademarks, collective marks and certification marks?

A product can have the business' trademark while also bearing a collective mark or certification mark. Therefore, even if your business can take advantage of a collective mark or certification mark, you should ensure the business's trademark remains its highest priority. The trademark is the only mark that connects the product to your business.

Well-known trademarks are trademarks that are so popular in Uganda. These include **MTN, AIRTEL, OMO, NOMI, JESA, BRITANIA and MOVIT.**

Use in Uganda of such a popular trademark by another person is likely to cause confusion over the source of goods or services. This may also damage the business reputation of the trademark owner which has been built up through great effort.

James Dear of Arbroath, Angus attempted to register the names of Ronaldinho and Thierry Henry as trademarks, arguing that he was free to do so on the ground that there are no rights to protect a person's image or likeness in the UK (which are known as personality rights). The registration was ultimately refused by UKIPO on the grounds that the trademarks were filed in bad faith and were an attempt to take advantage of the famous brands.

ANNEX: NICE CLASSIFICATION OF GOODS AND SERVICES. 11TH EDITION

<i>Class 1</i>	Chemicals for use in industry, science and photography, as well as in agriculture, horticulture and forestry; Unprocessed artificial resins, unprocessed plastics; Fire extinguishing and fire prevention compositions; Tempering and soldering preparations; Substances for tanning animal skins and hides; Adhesives for use in industry; Putties and other paste fillers; Compost, manures, fertilizers; Biological preparations for use in industry and science
<i>Class 2</i>	Paints, varnishes, lacquers; Preservatives against rust and against deterioration of wood; Colorants, dyes; Inks for printing, marking and engraving; Raw natural resins; Metals in foil and powder form for use in painting, decorating, printing and art
<i>Class 3</i>	Non-medicated cosmetics and toiletry preparations; non-medicated dentifrices; Perfumery, essential oils; Bleaching preparations and other substances for laundry use; Cleaning, polishing, scouring and abrasive preparations
<i>Class 4</i>	Industrial oils and greases, wax; Lubricants; Dust absorbing, wetting and binding compositions; Fuels and illuminants; Candles and wicks for lighting
<i>Class 5</i>	Pharmaceuticals, medical and veterinary preparations; Sanitary preparations for medical purposes; Dietetic food and substances adapted for medical or veterinary use, food for babies; Dietary supplements for human beings and animals; Plasters, materials for dressings; Material for stopping teeth, dental wax; Disinfectants; Preparations for destroying vermin; Fungicides, herbicides
<i>Class 6</i>	Common metals and their alloys, ores; Metal materials for building and construction; Transportable buildings of metal; non-electric cables and wires of common metal; Small items of metal hardware; Metal containers for storage or transport; Safes
<i>Class 7</i>	Machines, machine tools, power-operated tools; Motors and engines, except for land vehicles; Machine coupling and transmission components, except for land vehicles; Agricultural implements, other than hand-operated hand tools; Incubators for eggs; Automatic vending machines
<i>Class 8</i>	Hand tools and implements, hand-operated; Cutlery; Side arms, except firearms; Razors

- Class 9* Scientific, research, navigation, surveying, photographic, cinematographic, audio-visual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; Apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; Recorded and downloadable media, computer software, blank digital or analogue recording and storage media; Mechanisms for coin-operated apparatus; Cash registers, calculating devices; Computers and computer peripheral devices; Diving suits, divers' masks, ear plugs for divers, nose clips for divers and swimmers, gloves for divers, breathing apparatus for underwater swimming; Fire-extinguishing apparatus
- Class 10* Surgical, medical, dental and veterinary apparatus and instruments; Artificial limbs, eyes and teeth; Orthopaedic articles; Suture materials; Therapeutic and assistive devices adapted for persons with disabilities; Massage apparatus; Apparatus, devices and articles for nursing infants; Sexual activity apparatus, devices and articles
- Class 11* Apparatus and installations for lighting, heating, cooling, steam generating, cooking, drying, ventilating, water supply and sanitary purposes
- Class 12* Vehicles; Apparatus for locomotion by land, air or water
- Class 13* Firearms; Ammunition and projectiles; Explosives; Fireworks
- Class 14* Precious metals and their alloys; Jewellery, precious and semi-precious stones; Horological and chronometric instruments
- Class 15* Musical instruments; Music stands and stands for musical instruments; Conductors' batons
- Class 16* Paper and cardboard; Printed matter; Bookbinding material; Photographs; Stationery and office requisites, except furniture; Adhesives for stationery or household purposes; Drawing materials and materials for artists; Paintbrushes; Instructional and teaching materials; Plastic sheets, films and bags for wrapping and packaging; Printers' type, printing blocks
- Class 17* Unprocessed and semi-processed rubber, gutta-percha, gum, asbestos, mica and substitutes for all these materials; Plastics and resins in extruded form for use in manufacture; Packing, stopping and insulating materials; Flexible pipes, tubes and hoses, not of metal

- Class 18* Leather and imitations of leather; Animal skins and hides; Luggage and carrying bags; Umbrellas and parasols; Walking sticks; Whips, harness and saddlery; Collars, leashes and clothing for animals
- Class 19* Materials, not of metal, for building and construction; Rigid pipes, not of metal, for building; Asphalt, pitch, tar and bitumen; Transportable buildings, not of metal; Monuments, not of metal
- Class 20* Furniture, mirrors, picture frames; Containers, not of metal, for storage or transport; Unworked or semi-worked bone, horn, whalebone or mother-of-pearl; Shells; Meerschaum; Yellow amber
- Class 21* Household or kitchen utensils and containers; Cookware and tableware, except forks, knives and spoons; Combs and sponges; Brushes, except paintbrushes; Brush-making materials; Articles for cleaning purposes; Unworked or semi-worked glass, except building glass; Glassware, porcelain and earthenware
- Class 22* Ropes and string; Nets; Tents and tarpaulins; Awnings of textile or synthetic materials; Sails; Sacks for the transport and storage of materials in bulk; Padding, cushioning and stuffing materials, except of paper, cardboard, rubber or plastics; Raw fibrous textile materials and substitutes therefor
- Class 23* Yarns and threads, for textile use
- Class 24* Textiles and substitutes for textiles; Household linen; Curtains of textile or plastic
- Class 25* Clothing, footwear, headwear
- Class 26* Lace, braid and embroidery, and haberdashery ribbons and bows; Buttons, hooks and eyes, pins and needles; Artificial flowers; Hair decorations; False hair
- Class 27* Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; Wall hangings, not of textile
- Class 28* Games, toys and playthings; Video game apparatus; Gymnastic and sporting articles; Decorations for Christmas trees
- Class 29* Meat, fish, poultry and game; Meat extracts; Preserved, frozen, dried and cooked fruits and vegetables; Jellies, jams, compotes; Eggs; Milk, cheese, butter, yogurt and other milk products; Oils and fats for food
- Class 30* Coffee, tea, cocoa and artificial coffee; Rice, pasta and noodles; Tapioca and sago; Flour and preparations made from cereals; Bread, pastries and confectionery; Chocolate; Ice cream, sorbets and other edible ices; Sugar, honey, treacle; Yeast,

- baking-powder; Salt, seasonings, spices, preserved herbs; Vinegar, sauces and other condiments; Ice [frozen water]
- Class 31* Raw and unprocessed agricultural, aquacultural, horticultural and forestry products; Raw and unprocessed grains and seeds; Fresh fruits and vegetables, fresh herbs; Natural plants and flowers; Bulbs, seedlings and seeds for planting; Live animals; Foodstuffs and beverages for animals; Malt
- Class 32* Beers; Non-alcoholic beverages; Mineral and aerated waters; Fruit beverages and fruit juices; Syrups and other non-alcoholic preparations for making beverages
- Class 33* Alcoholic beverages, except beers; Alcoholic preparations for making beverages
- Class 34* Tobacco and tobacco substitutes; Cigarettes and cigars; Electronic cigarettes and oral vaporizers for smokers; Smokers' articles; Matches
- Class 35* Advertising; Business management, organization and administration; Office functions
- Class 36* Financial, monetary and banking services; Insurance services; Real estate affairs
- Class 37* Construction services; Installation and repair services; Mining extraction, oil and gas drilling
- Class 38* Telecommunications services
- Class 39* Transport; Packaging and storage of goods; Travel arrangement
- Class 40* Treatment of materials; Recycling of waste and trash; Air purification and treatment of water; Printing services; Food and drink preservation
- Class 41* Education; Providing of training; Entertainment; Sporting and cultural activities
- Class 42* Scientific and technological services and research and design relating thereto; Industrial analysis, industrial research and industrial design services; Quality control and authentication services; Design and development of computer hardware and software
- Class 43* Services for providing food and drink; Temporary accommodation
- Class 44* Medical services; Veterinary services; Hygienic and beauty care for human beings or animals; Agriculture, aquaculture, horticulture and forestry services
- Class 45* Legal services; Security services for the physical protection of tangible property and individuals; Personal and social services rendered by others to meet the needs of individuals

LINK DIRECTORY FOR REFERENCED AND USEFUL INFORMATION

URSB

www.ursb.go.ug

The Economics of Trademarks

https://www.wipo.int/edocs/pubdocs/en/wipo_pub_944_2013-chapter2.pdf

Brands – Reputation and Image in the Global Marketplace

https://www.wipo.int/edocs/pubdocs/en/intproperty/944/wipo_pub_944_2013.pdf

IP issues from a business perspective

<https://www.wipo.int/sme>

Trademarks in general

www.wipo.int/trademarks

Making a Mark - An Introduction to Trademarks for Small and Medium-Sized Enterprises; a WIPO Publication

https://www.wipo.int/edocs/pubdocs/en/wipo_pub_900_1.pdf

List of websites of national and regional trademark offices from around the world

<https://www.wipo.int/directory/en/urls.jsp>

The International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement

www.wipo.int/classifications/nice

WIPO Arbitration and Mediation Center

www.wipo.int/amc

Global Brand Database – free-of charge trademark-related searches across multiple collections

www.wipo.int/reference/en/branddb

Intangible Capital in Global Value Chains

https://www.wipo.int/edocs/pubdocs/en/wipo_pub_944_2017.pdf

Online trademark availability search

<https://ursb.go.ug/dynamic-pages/trademark-search>.

Online trademark application

<https://iponline.ursb.go.ug/sp-ui-tmefiling/wizard.htm?execution=e1s1>

Trademark agents

https://agents.ursb.go.ug/search/rm_tmagents_list.php

Trademark agents

https://agents.ursb.go.ug/search/rm_tmagents_list.php

What is trade mark classification? :What is trade mark classification? - CITMA, <https://www.citma.org.uk/trade-marks-ip/how-to-get-a-trade-mark/what-is-trade-mark-classification.html> .

What is a trademark?, <https://govt.chinadaily.com.cn/s/201812/28/WS5c0a0bd4498eefb3fe46e5fa/what-is-a-trademark.html>.

brand value: <https://retail.economictimes.indiatimes.com/news/industry/covid-19-to-shave-usd-25-bn-off-from-top-100-domestic-brands-value-report/76135844>.

Trademark process | USPTO - United States Patent and ..., <https://www.uspto.gov/trademarks/basics/trademark-process>.

ENHANCING YOUR RIGHTS THROUGH FEDERAL REGISTRATION,

https://www.uspto.gov/sites/default/files/BasicFacts_0.pdf.

Registering a Trademark - The Chronicle, <https://www.chronicle.co.zw/registering-a-trademark-step-by-step-guide-for-smes/>.

What is product certification? How is it different from, <https://www.unilibrary.org/content/books/9789213618141s023-c007>.

Collective trade mark, https://en.wikipedia.org/wiki/Collective_trade_mark.

REGIONAL OFFICES

GULU

Ministry of Justice and Constitutional Affairs Building,
Plot 68, Princess Road, Gulu.

MBARARA

Ministry of Justice and Constitutional Affairs Building,
Plot 1, Kamukuzi Hill,
Mbarara.

MBALE

Ministry of Justice and Constitutional Affairs Building,
Plot 3, Park Crescent
Mbale.

ARUA

Ministry of Justice and Constitutional Affairs Building,
Plot 42/44 Pakwach Road.

GREATER MASAKA REGION

Mayors Chambers
Plot 26, Edward Avenue, Masaka.

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POSTA UGANDA

Plot 35 Kampala Road, Posta Uganda
Booth 2 & 3.

NAKIVUBO

Nakivubo Mews,
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