UGANDA REGISTRATION SERVICES BUREAU
THE TRADEMARKS ACT, CAP 225
IN THE MATTER OF TRADEMARK APPLICATION NO. UG/T/2025/085898

"AL GAZALLEN TEA" IN CLASS 30 IN THE NAMES OF DAF-AGRO LIMITED

AND

OPPOSITION THERETO BY AKBAR BROTHERS (PVT) LTD

AKBAR BROTHERS (PVT) LTD ::OPPONENT

VERSUS

DAF-AGRO LIMITED:: APPLICANT

Ruling

Before: Birungi Denis: Asst. Registrar Trademarks

Background

1. The opponent is a company based in Sri Lanka and the proprietor of trademark number 142960 for the word "ALGHAZALEEN TEA" and the device registered in 2007 in Sri Lanka in class 30 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Agreement) in respect of tea, coffee, cardamoms, cloves, cinnamon, pepper, cocoa, rice, coffee substitutes, floor and preparations made from cereals, bread, biscuits, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices and ice. The Opponent manufactures and distributes tea branded with its Alghazaleen tea brand.
2. The Applicant is a Ugandan company, which has filed an application for the registration of trademark "Al Gazellen Tea," in class 30 in respect of tea and other products in that class.

3. The Opponent filed this opposition objecting to the registration of the Applicant's application pursuant to section 44 of the Trademark Acts Cap 225 (TMA) that provides protection to trademarks registered in country of origin.

Hearing and determination

4. This matter came up for hearing on 16th June 2026.Learned Counsel Kajubi Brian of MMAKs Advocates appeared for the Opponent, while Learned Counsel Mwanje Lawrence of Imran Advocates and Solicitors appeared for the Applicant. The following issues were raised;
   (i) Whether the Applicant's application should be refused on account of the opponent's trademark rights in the country of origin?
   (ii) Whether the Applicant's mark offends section 23 of the Trademarks Act?
   (iii) What are the available remedies?
5. Both Counsel addressed the Registrar by way of written submissions.

The Opponent's case

6. The Opponent's case is that it is the registered proprietor of the mark ALGHAZALEEN TEA registered in Sri-Lanka in class 30 of the Nice Classification in respect of tea and other specified products under that class. Since 1969, the Opponent has been in the business of manufacturing, sale and export of Ceylon tea branded with its trademark.
7. The Opponent states that it has marketed its ALGHAZALEEN TEA branded Ceylon tea widely including on its website www.alghazaleen.com and social media platforms. That the wide marketing efforts have resulted in public recognition and association of the trademark with the Opponent.
8. Based on its registration in the country of origin and prior use, the

Opponent's case is premised on two legal arguments; first, the Opponent contends that the Applicant's application is prohibited under section 23 (1) of the TMA because the mark is likely to deceive the public into confusing the Applicant's goods with those of the Opponent. Second, the Opponent argues that due to its earlier registration in Sri-Lanka, it is entitled to protections accorded to trademarks registered in the country of origin pursuant to the provisions of section 44 of the TMA.

The Applicant's case.

9. In defense of its application, the Applicant maintains that it is the lawful owner of the Word "Al GAZALLEN", which it filed for registration as a trademark upon conducting a search and establishing that the word and device was not registered. The Applicant disputes the Opponent's claim based on section 44, contending that the Opponent's trademark rights in Sri Lanka do not extend to Uganda due to the principle of territoriality. Furthermore, the Applicant avers that it is not proved that the Opponent's trademark is well known and that even if it was, the Opponent would only be required to register it defensively, which it never did. The Applicant argues that the Opponent does not meet the strict requirements of section of 44.
10. With regard to similarity of the marks, the Applicant avers that its mark is different from the Opponent's mark in several ways. The Applicant's mark has a brown background of varying shades, its word mark "Al Gazallen" is stylized with additional Arabic characters and that the mark contains two antelopes standing. On the other hand, the Opponent's mark has a dark background, contains two shields, a half moon and kangaroos jumping, facing the right direction. In addition, the Opponent's word mark is

"ALGHAZALEEN" while that of the Applicant is "Al Gazallen". With regard to Sri Lanka's reciprocal protection of goods originating from Uganda, which is one of the requirements under section 44, the Applicant avers that section 104 (1) (a) of the Sri Lankan Trademark Act relied on by the Opponent does not accord same protection to goods originating from Uganda within the same parameters of section 44 of the Ugandan TMA. The Applicant prays that the opposition is dismissed with costs.

Determination

Issue 1: ***Whether the Applicant's application should be refused because of the Opponent's trademark rights in the country of origin*****?**

11. In the context of opposition proceedings, protections granted to trademarks registered in the country of origin are contained in section 44 of the TMA. Pursuant to that section, the Registrar may refuse registration of a trademark if it is proved to his or her satisfaction that the trademark applied for is identical or nearly resembles the one registered prior in the country of origin in respect of the same goods. In addition, an opponent is required to give an undertaking to register the trademark in Uganda within three months from the date of filing the notice of opposition. For an opponent to qualify for protection, the country of origin must accord goods or services originating from Uganda the same treatment. In brief, the following requirements have to be proved;

    (i) the foreign mark is identical or nearly resembles the opposed mark;

    (ii) it is registered for the same/similar goods or services;

    (iii) it is registered in the country/place from which the goods/services originate;

    (iv) the applicant cannot establish prior and continuous use in Uganda;

(v) the foreign proprietor gives an undertaking to register the mark in Uganda within 3 months; and

(vi) the country of origin gives Ugandan goods/services equivalent treatment.

12. The crux of this opposition is whether the Opponent fulfills the requirements of section 44 of the TMA to be entitled to protection accorded to marks registered in the country of origin. I will begin with the issue of similarity of the marks and the goods. The Applicant's mark and the Opponent's mark are indicated below;

Opponent's mark	*Applicant's mark*
	

Similarity between the marks

13. From a side-by-side comparison, the background color and the device are different. The Opponent's mark has a dark background with peculiar features including a glass filled with dark contents, two small gazelles jumping in the right direction in white color, what appears to be a leaf , two white gazelles jumping in the right direction, among others. The Applicant's mark contains a maroon background, with two antelopes standing facing the left direction.

14. Visually, the two marks are different. However, phonetically, the words "ALGHAZALEEN" in the Opponent's mark and the word "Al Gazallen" in the Applicant's mark are pronounced the same way. The Opponent's mark

is pronounced as *al-ghuh-zah-LEEN* while the Applicant's mark is pronounced as *ahl gah-ZAH-lehn* which is the same. The difference between "GHAZALEEN" and "GAZALLEN" may be less noticeable in ordinary speech than it appears in written form. In particular, the presence of "H" in Opponent's mark does not create a sufficient phonetic distinction.

15. Conceptually, both marks contain images of gazelles or similar antelope-like animals. These images communicate a closely related visual concept, regardless of the differences in colour and artistic style. The concept evoked draws from the animals used, both of which belong to the same group (antelope). Both antelopes and gazelles are members of the *bovidae* family. Hence, the gazelle label invokes the same concept of animals in the same family. A gazelle as a symbol represents grace, speed, beauty, alertness, and gentle strength. Given that both the Opponent and the Applicant's word mark have the idea of a gazelle, the two marks are conceptually similar. Contrary to the Applicant's assertion that the additional Arabic characters make a difference between the two marks, I find that phonetically and conceptually, they are similar.

Similarity between the goods

16. Section 44 (1) (a) of the TMA requires that the goods or description of goods or description of services associated with the goods in question is either identical or nearly resembles those of the opponent. In this case, there is no contention as to whether the goods are identical or nearly resembling. Both the Applicant and the Opponent agree that the use or intended use of the mark in question is for the business of manufacture and sale of tea. The goods are therefore identical.

The opponent is registered in the country of origin

17. The third requirement is that the opponent's mark should be registered in the country of origin and such registration should predate the application being opposed. This fact is not disputed. In a statutory declaration in support of the opposition sworn by Mr Hatim Abbasally Akbarally, the Opponent admits a certificate of registration number 142960 for the mark ALGAZALEEN and the device in class 30 in respect of tea and other products. The said mark was filed with the National Intellectual Property Office of Sri Lanka on 20/12/2007 and a certificate of registration issued to the opponent on 09/12/2020. This requirement is therefore satisfied.

The applicant has not adduced evidence of prior use.

18. Under section 44 (3) (a), should an applicant prove that he or she was using the mark in relation to the goods, prior to the date of the opponent's registration in the country of origin, such evidence would negate the opponent's entitlement to protection. In this case, the Applicant has not made such a case and hence this requirement is equally satisfied.

The opponent does not give an undertaking to register within three months

19. Section 44 (3) (b) provides that the application shall not be refused if the opponent does not give an undertaking to register the opposed mark in Uganda within three months from the date of opposition and indeed take necessary steps to complete registration. This provision has three important components; the first is the requirement for an undertaking. The second is that within three months from the date of filing the opposition, an opponent must actually file the application in Uganda and the third is that upon filing the application, an opponent must "take necessary steps to complete registration". This means the protection under section 44 is not intended just to ring fence the mark but to ensure that an opponent who has genuine

intention to register and use the mark in Uganda can clear an obstacle of an existing application and then formally protect it. This requirement is not satisfied for the reasons stated below;

20. First, the sequence of the actions to take in compliance with requirements of section 44 are of paramount importance. The starting point is that the registration of the mark in the country of origin must predate the mark being opposed in Uganda. Secondly, an opponent must first file an opposition against an alleged similar mark to its own mark registered in the country of origin and thereafter, give an undertaking to file for the registration of mark in Uganda within three months from the date of giving notice of the objection. Before the expiry of the three months, an opponent must take actual steps to file for the registration of the mark in compliance with the undertaking given.
21. The evidence on record shows that the Applicant filed the opposed mark on 20th January 2025. The Opponent filed its counter application No. UG/T/2025/086598 on 24th March 2025 and thereafter on 28th March 2025, filed an opposition objecting to registration of the Applicant's mark. The Opponent's application to register its mark therefore predates the opposition it filed against the Applicant's application. Does it therefore qualify as an undertaking required under section 44 (3) (b)? In my view, it does not. An undertaking must be filed as part of the opposition documents. The filing of an application to register in fulfillment of an undertaking does not qualify as an undertaking although actual filing of the application is required and must be done with thin three months from the date of giving the notice of opposition.
22. Filing of an application in fulfilment of an undertaking is a post-opposition process. An earlier filed application cannot be invoked to fulfil that

requirement. This principle is inherent in the language of section 44 (3) (b) by the words "*within three months from the giving of the notice of objection, apply for registration in Uganda.*"

23. Clearly as per the clear and express wording of section 44 (3) (b), the cutoff point for the Opponent to file an application to register in fulfilment of an undertaking is the date of giving the notice of opposition (date of filing the opposition). I have carefully reviewed the grounds of opposition together with statutory declaration. Nowhere does the Opponent unequivocally state that it has given an undertaking to register the trademark in Uganda within three months from the date of the opposition. In paragraph 34 of the statement of grounds for opposition, the Opponent only states that it had also applied to register the trademark in Uganda. The same is stated in paragraph 6.38 of the statutory declaration of Mr. Hatim, which refers to trademark application number UG/T/2025/086598 filed by the Opponent.
24. When filing for the registration of a mark, the Opponent conducted a search, which must have indicated the existence of the application now being opposed. Instead of filing an opposition, the Opponent filed a counter application, which was obviously rejected due to the existence on the register of a similar mark filed by the Applicant herein. This, in my view, is improper as it may lead to multiplicity of oppositions were the Applicant also to oppose the Opponent's mark on ground of its earlier application or were it to be approved in error hence leading to cancellation proceedings. An application filed after a filing an opposition under section 44 in compliance with an undertaking required under that section is treated differently. While it is may not be approved, a decision on it would be stayed pending the outcome of opposition proceedings.
25. For that reason, I do not agree with Counsel for the Opponent's submission

that filing of another application to counter the Applicant's application qualifies as an undertaking within the meaning of section 44 (3) (b). The undertaking envisaged under that section is an unequivocal promise to register the trademark, which must be given in a clear express stipulation in the ground of opposition or may be annexed separately as a formally executed undertaking signed by the Opponent.

26. In **Patron Card International Ltd v Harambee Co-operative savings & Credit Society Ltd Civil Appeal No. 295 Of 2005**, a decision of the Court of Appeal of Kenya, the court while considering whether a letter of undertaking constitutes a binding contract, defined an undertaking as follows;

> *"…according to **Concise Oxford Dictionary of Current English**, 7th Edition,... An undertaking is defined in the same dictionary as, among other things, a pledge, a promise. Thus, a letter of commitment/undertaking may mean an agreement or a mere solemn promise."*

27. In the above decision, Court was considering whether a letter in which the Appellant included a statement of an undertaking committing to print and supply cards, constituted a binding contract. Court held that it did and explained that an undertaking is a binding contract to perform a future act. It noted;

> *"Thus, a letter of commitment/undertaking may mean an agreement or a mere solemn promise. There are other imprecise words used in the letter e.g., ….. "society has duly resolved to order for the printing of members security cards ….." and "we agree that Patron Card International Ltd. will undertake to print the cards". The underlined words may signify actions to be taken in the future."*

28. An undertaking therefore is akin to a promise, which is the commitment to do a future act. It cannot be implied nor fulfilled by an earlier act—in this

case, an application filed before the opposition. An undertaking is one of the mandatory requirements under section 44. The High Court of Uganda in the case of ***Kampala Stocks Supermarket Co. Ltd v Seven Days International Ltd. (Civil Suit No. 112 of 2015) [2015] UGCommC 96 (31 July 2015)*** has emphasized the importance of giving an undertaking in a section 44 opposition. At para 23 and 24 of the ruling, Justice C**hristopher Madrama** (as he then was), while explaining the applicability of section 44, stated as follows;

> ***"The Applicant is required to give an undertaking to the satisfaction of the Registrar that he or she will within three months from making an application under this section apply for registration in Uganda of the trademarks or registered in the country or place of origin and make all necessary steps to complete the registration.***
>
> ***The Defendant has not undertaken to apply for registration in Uganda of the trademarks and the Plaintiff has challenged its locus standi to seek a remedy of removal of its trademark from the Ugandan trademark register."***

29. Plainly and literally construed, section 44 requires that all the conditions stated therein be clearly demonstrated in the grounds of opposition or in the statutory declaration in support filed thereafter. This includes the giving of an undertaking. The grounds of opposition and the statutory declaration filed by the Opponent do not contained an undertaking. They both emphasize the filing of a prior application as equivalent to giving of an undertaking. For example, at paragraph 34 of the statutory declaration, Mr. Hatim states; *"the opponent has also applied to register ALGAZHALLEN TEA label in class 30 in Uganda and intends to take all the necessary steps to complete the registration of its mark in Uganda."*

30. Furthermore, in a statutory declaration in reply, Mr. Hatim adds; "*The Opponent has furthermore filed application no. UG/T/2025/086598 for the same mark. ALGAZHALLEN TEA label, in class 30 in Uganda. In addition, it has given an express undertaking in paragraph 13 of the its notice of opposition, "to take all the necessary steps to complete the registration of its trademark"*

31. None of the above paragraphs contains an undertaking required under section 44 (3) (b). For clarity, I reproduce the wording of section 44 (3) (b);

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

(a)……..

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

32. In paragraph 4.5 of the rejoinder, the deponent merely refers to the application filed and quotes paragraph 13 of the statement of grounds. While I note that the Opponent intended to refer to paragraph 34 of the grounds of opposition, the same also does not contain an undertaking envisaged under section 44 (3) (b). It merely refers to the application filed by the opponent and adds that it "*intends to take all necessary steps to complete the registration of the application*".

33. Although the language of section 44 (3) (b) also contain the statement quoted by the Opponent, the context of the expression *"and will take all necessary steps to complete the registration in Uganda"* does not mean the application filed before the opposition replaces the requirement for an undertaking. It simply means that the opponent gives an undertaking to file for registration of the trademark that is registered in the country of origin and that upon filing such

an application, he or she shall take all the necessary steps to complete its registration in Uganda. This was intended to cure a lacuna where opponents may file applications just to tick a box, without completing the registration process.

34. I should also hasten to add that even if paragraph 4.5 of the statutory declaration in reply had made a statement qualifying as undertaking, in my view, procedurally an undertaking cannot be given through filing of evidence in reply. Averments in a statutory declaration in reply are limited to responding to new matters raised by the applicant. Regulation 34 of the Trademark Regulations 2023, which provides for evidence in reply states;

"*Evidence in reply by opponent*

Within one month from the receipt by the opponent of the copies of the applicant's declaration, the opponent may leave with the Registrar evidence by statutory declaration in reply, and shall deliver to the applicant copies of the statutory declaration and that evidence shall be confined to matters strictly in reply"

35. The regulation above expressly states that evidence in reply shall be confined to matters strictly in reply. In all proceedings, it is trite law that a rejoinder or evidence in reply is strictly limited to answering new facts or averments in the preceding reply and cannot be used to introduce entirely new claims, alter the core cause of action, or bypass formal pleading amendments.

36. With hindsight, the Opponent ought to have taken the following steps in their sequence to fulfil the requirement of section 44 (3) (b) ;

(i) file an opposition against the registration of the applicants mark.

(ii) give an undertaking either as part of the grounds for opposition or annexed separately to the statutory declaration with a clear unequivocal statement promising to file for its trademark registered in the country of origin and complete the registration.

(iii) Within three months from the date of filing an opposition, file to register its trademark in Uganda.

37. In the instant case, the Opponent started with the last step without a baseline opposition. Application number UG/T/2025/086598 filed by the Opponent on 24 March 2025 was therefore filed outside the operation of section 44. It does not constitute an undertaking nor can it be deemed an act in fulfilment of undertaking if one had been given. Accordingly, I find that the Opponent did not fulfill the requirements of section 44 (3) (b). This takes me to the last requirement under section 44 (4).

Does Sri Lanka accord goods or services originating from Uganda same protection as the one under section 44?

38. Section 44 (4) of the TMA provides for the last, and perhaps most stringent requirement. It requires reciprocal protection from a country of origin of the goods. It states;

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

39. The above requirement can only be fulfilled if Sri Lankan law accords goods or services from Uganda the same protections as those given by section 44. Mr.Kajubi submitted that section 104 (1) (d) of the Sri-Lankan Intellectual Property Act, No.36 of 2003, read together with article 6*bis* of the Paris Convention on the Protection of Industrial Property and article 16 of the TRIPs Agreement, fulfill this requirement.

40. On the other hand Mr. Mwanje, Counsel for the Applicant argued that section 104 (1) (d) of the Sri-Lankan Act does not accord goods originating from Uganda the same protection as those provided under section 44. With

regard to article *6bis* of the Paris Convention and article 16 of the TRIPs agreement, Mr. Mwanje submitted that section 44 is a stand-alone provision that is not anchored on article *6bis* of the Paris Agreement or provisions of the TRIPs Agreement. He further argued that even if section 104 (d) of the Sri Lankan Act could be properly read together with the Paris Agreement and TRIPs Agreement, the Opponent has not proved that its mark is well known in Uganda.

41. I have carefully read submissions of both Counsel, provisions of TRIPS Agreement and Paris Convention on the Protection of Industry Property. Section 44 (4) requires strict reciprocal treatment by the country of origin. The laws of the country of origin must accord goods or services from Uganda the same protections as those accorded under section 44. In my view such protections must be examined objectively to determine whether a Ugandan trading or doing business in such a country, in this case Sri- Lanka, can quote the equivalent of section 44 in their law, and claim protection in that country equivalent to the one given by section 44 of the TMA. This requires an analysis of the provisions of the law claimed to accord Ugandan goods or services same protection. In this case, the claimed provision is section 104 (1) (d) of the Sri-Lankan Intellectual Property Act.

42. I reproduce the provision ;

> *"104. (1) The Director-General shall not register a mark —*
>
> *(a) ……..*
>
> *(b) ……*
>
> *(c) …….*
>
> *(d) if it is identical with, or misleadingly similar to, or constitutes or translation or transliteration or transcription of a mark or trade name which is well known in Sri Lanka for identical or similar goods or services of a third*

party, or such mark or trade name is well known and registered in Sri Lanka for goods or services which are not identical or similar to these in respect of which registration is applied for, provided in the latter case the use of the mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the well-known mark and that the interests of the owner of the well-known mark are likely to be damaged by such use"

43. While I caution myself for not being an expert in Sri-Lankan law, from a plain and literal interpretation of the above provision, it provides for the protection of well-known marks in Sri-Lanka, which if compared to the Ugandan equivalent, section 47 and not section 44 of the TMA, would come in mind. For a person from Uganda to claim protection under section 104 (1) (d) of the Sri-Lankan Act, he or she must prove that the marks are misleadingly similar and his or her mark is well-known in Sri-Lanka. On the other hand, under section 44 of the Ugandan TMA, a person from Sri-Lanka is not required to prove that his or her mark is well known in Uganda. He or she is only required to prove that the mark is registered prior in Sri Lanka, that the goods are similar to those in respect of which the opposed mark is sought to be registered, he or she then gives an undertaking to file and register in Uganda and then adduces proof that Sri-Lankan law accords Uganda same protections.

44. The difference is that section 104 (1) (d) of the Sri-Lankan Act addresses protection of well-known marks in Sri-Lanka while section 44 of the Ugandan TMA provides protection for trademarks registered in the country of origin if conditions set thereunder are fulfilled. To that end, section 104 (1) (d) of the Sri Lankan Act does not fulfil the condition of reciprocity required under section 44 (4) of the TMA.

45. I take note of Mr. Kajubi's submissions that section 104 (1) (d) of the Sri-Lankan Act only achieves the requirements of section 44 (4) when read together with article 6*bis* of the Paris Convention as well as article 16 (3) of the TRIPs Agreement. Both provisions provide for the obligation of state parties to protect well-known marks. Article 6bis of the Paris Convention states;

> "*The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods"*

46. Article 16 (3) of TRIPs Agreement extends article 6*bis* protections to well-known marks in respect of goods to which they are not registered. Both article 6*bis* of Paris Convention and Article 16 (3) of TRIPs Agreement provide for protection of well-known marks. They do not provide for protections of marks registered in the country of origin the same way section 44 of the TMA does. In Uganda, well-known marks are protected under section 47 of the TMA through defensive registration. Counsel for the Opponent has cited the decision of this office in ***Opposition to Trademark No.UG/T/2022/074413: Wave Intellectual Property Inc. v Agaba Earnest "WAVE"*** and Opposition to ***Trademark No.56916 "POKEMON"*** to support his position based on Paris Convention and TRIPs Agreement provisions on well-known marks.

47. I have carefully read both decisions. In ***Wave***, this office interpreted section

56 of the United Kingdom's Trademarks Act to accord Ugandan goods and services protections similar to section 44 of the Ugandan TMA because of the provisions relating to protection of well-known marks. Similarly in ***Pokémon***, the learned Registrar interpreted section 52-2 of the Japanese Trademarks Act as fulfilling the requirement of section 44 (4) of the Uganda Trademarks Act simply because it provides for protection of well-known marks. Unlike ***Wave,*** in ***Pokémon***, the Registrar had made a determination that Pokémon is a well-known mark.

48. While it is true that the above two decisions anchored reciprocity on multilateral frameworks on the obligation to protect well-known marks, subsequent decisions of the office have since departed from the positions reached in ***Pokémon*** and ***Wave***. In opposition to Trademark ***No.40232 "SAFFI": Krystalline Salt Ltd v S.D.T Group of Companies,*** the opponent whose mark was registered in Kenya as the country of origin, opposed the registration of the applicant's mark under section 44 on the basis that its mark is well-known. In rejecting the claim based on section 44, the Registrar noted on paragraph 15 of the ruling; "*On the second argument, protection of well-known marks is only achieved by defensive registration in all classes within the parameters set by section 47 of the Trademarks Act, and may not be sought in any other way…"*

49. Similarly, in ***Credscan (Proprietary) Ltd v Aquelle Beverages SMC Ltd, application for cancellation of Trademark Registration No. 80314 of 2023, [2026] UGRSB***, the learned Registrar in paragraph 23 of the ruling, emphasized that well-known marks are strictly protected through defensive registration under section 47 of the TMA.

50. This position has also been reiterated by the High Court in ***Modino Furniture company Limited v Homert Uganda Limited and Others, (Civil Suit No. 427***

of 2020; Civil Suit No. 724 of 2019) [2024] where Justice Susan Abinyo noted at para 20 of the Judgment;

> *"In addition, PW1 testified that the country of origin means where the goods are made, and that well-known marks acquire protection in Uganda as defensive marks meaning that there is no requirement that once you register that mark it must be used, it can be on the register without being used and it would still be protected by virtue of being a well-known mark whereas other regular trademarks have to be used for them to maintain that protection"*

51. In augmenting that position and while rejecting arguments based on treaty provisions to secure protection for an unregistered mark, the learned Judge elaborated at para 30 and 35 of the Judgement;

> *"In other words, registration of the "DOGTAS" trademark in the country of origin under the Paris Convention for the Protection of Industrial Property, to which Uganda and Turkey are signatories neither accords automatic protection of the said mark in Uganda nor bars registration in Uganda. (**See Article 6 of the Paris Convention for the Protection of Industrial Property (as amended on September 28, 1979**) on the territorial principle, which provides that a mark duly registered in a country of the union shall be regarded as independent of marks registered in the other countries of the union, including the country of origin"*

52. The departure from *Pokémon* and *Wave* and Court's affirmation of the same in *Modino Furniture company Limited v Homert Uganda Limited and Others* (supra) is aimed at ensuring that principles contained in international IP treaties such as Paris Convention and TRIPs Agreement are strictly applied in the exact way Parliament domesticated them in national legislation. This is consistent with Uganda's constitutional arrangement as a dualist country. Unlike monist countries, in international law, dualist countries such as

Uganda cannot apply international law until the government passes formal domestic legislation incorporating it.

53. Protections for well-known marks as set out in the Paris Convention and TRIPs agreement do not fulfill the requirements of section 44 (4) of the TMA because domestication of the provisions relating to well-known marks was provided for differently under section 47 of the TMA. This view is also consistent with the provisions of the same international frameworks. For example as observed by the learned Judge in ***Modino Furniture*** (supra), article 6 of the Paris Convention provides that conditions of filing and registration are to be determined by national legislation of each member state.

54. Similarly, TRIPs Agreement, in Article 1.1, states that; "…*Members shall be free to determine the appropriate method of implementing the provisions of this Agreement within their own legal system and practice."* International IP treaties contain "flexibilities" such as the one in article 6 of the Paris Convention and article 1.1 of TRIPs to enable countries to develop intellectual property laws and policies in a manner consistent with their development needs. Under section 47 of the TMA, Uganda has set appropriate conditions for protection of well-known marks—through defensive registration.

55. As a way of comparison, the Republic of Kenya has domesticated the above treaty provisions differently under section 15A of the Kenyan Trademarks Act. It states as follows;

    "*15A. Protection of well-known trade marks*

    (1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO Agreement as a well-known trade mark, are to a mark which is well known in Kenya as being the mark of a person who—

(a) is a national of a convention country; or

(b)is domiciled in, or has a real and effective industrial or commercial establishment in, a convention country, whether or not that person carries on business or has any goodwill in Kenya…"

56. Had Uganda domesticated treaty protections for well-known marks the same way Kenya did, arguments based on Paris Convention and TRIPs agreement provisions on protection of well-known marks would have merit. Under the current framework however, the strict provisions of section 47 of the TMA bind the office until such a time when Parliament amends the law to provide otherwise.

57. In light of the above, I find that the Opponent has not fulfilled the requirements of section 44 of the TMA.

Issue 2: Whether the Applicant's mark offends section 23 of the Trademarks Act?

58. Section 23 (1) of the TMA prohibits registration of a mark that would be likely to deceive, or is contrary to law, morality or that would constitute a scandalous design. Mr. Kajubi submitted based on this section, that since the Applicant's trademark is similar to the one of the Opponent, there is a likelihood of confusion, which is likely to affect the Opponent's reputation. He submitted that use of a similar mark to that of the Opponent amounts to passing off and hence is contrary to law in terms of section 23 of the TMA. On the other hand, Mr. Mwanje argued that actions based on section 44 could not be joined with an action based on section 23. As to arguments regarding similarity with the Opponent's mark, Mr Mwanje contends that such are inapplicable due to the principle of territoriality. Furthermore, he submitted that actions for passing off are separate common law actions triable by the High Court.

59. This office has determined the applicability of section 23 in a number of decisions. In ***Procter & Gamble Company V Momeasy Enterprises Opposition to trademark No 73609 and 73610 "Momeasy"***, it was argued that the opponent had copyright inherent in the opposed mark and hence its use by the applicant would constitute copyright infringement, contrary to law, particularly, contravening the Copyright and Neighboring Rights Act Cap 222. The Office rejected such a claim on grounds that the Registrar of Trademarks sitting as such had no jurisdiction to determine copyright infringement claims and that a finding of that nature could only be made if there was a determination by a competent court on the question of copyright eligibility and infringement of the alleged works. It was further held that section 23 only applies to illegibility in the composition of the mark, for example, trademarks promoting the sale of prohibited goods.
60. The above decision clarified that the Registrar can apply section 23 where the illegality is inherent in the mark or the proposed use of the mark—for example, a mark whose use would plainly involve an unlawful activity. Where the allegation is that registration infringes another person's copyright or another private legal right, the Registrar should not determine the underlying dispute (for lack of jurisdiction) unless there is an authoritative legal determination establishing the illegality or the rights claimed, made by a competent court or tribunal.
61. In ***Ninsiima Moreen v Trust Sate Uganda Ltd opposition to trademark application No.082777" IMITRUST***", the office having established bad faith in the conduct of the applicant, concluded that the use of the trademark registered in bad faith by the applicant was likely to deceive within the meaning of section 23 and hence section 23 was applicable. The same position was emphasized in application for cancellation of trademark

no.080314 ***"Aquelle"***.

62. In ***Colgate-Palmolive Company v Bi Wang opposition to trademark application No 83781 'GOOD DOCTOR"***, the applicant had obtained registration of a trademark yet there was a pending opposition. The Opponent argued that such an act was illegal within the meaning of section 23 of the Trademarks Act. The office did not agree. It instead distinguished procedural and substantive illegality and held that illegality under section 23 is substantive illegality. The Registrar noted at paragraph 13 of the ruling;

> *"I agree with Mr. Kajubi's submission that the law bars the issuance of a certificate until the Registrar has confirmed that the application satisfies the conditions under Section 16 (1) (a) and (b) of the Trademarks Act. However, I do not agree with the submission that section 23 applies to this situation. The prohibition on registration of a trademark or part of a trademark that is contrary to law, under section 23, refers to the illegality in substance of the trademark itself such as a trademark promoting violence, and not illegality in procedures of registration. In the present case, the illegality is in the procedures and not the substance of the trademark."*

63. The office had another opportunity to determine the applicability of section 23 in ***Isima Ssewankambo T/A Kanga shoe care v Kangaroo Brands Ltd opposition to trademark No. 081536 "Kangaroo"***. In response to a contention that the manner in which the trademark was being used in the market offended section 23 of the Trademarks Act, the Registrar held that passing off is a reserved right (cause of action) under section 35 of the TMA which is outside the jurisdiction of the Registrar of trademarks. This position followed similar decisions in ***Megha Industries U Ltd v Royal Mabaati Uganda Ltd, Application for cancellation of Trademark No. 05981*** and ***East African Roofing Systems Ltd v Metal Wood Industries Ltd, Opposition of***

64. Having reviewed the jurisprudence of the office on the application section 23, I can summarize the findings as follows; section 23 is a substantive registrablitity provision, which restricts the registrar from registering certain trademarks. The restrictions are directed at the trademark itself and its proposed use. It restrains the Registrar from registering a mark that is inherently deceptive or whose use would be unlawful, is contrary to morality or would constitute a scandalous design. Bad faith may, where established by objective evidence, constitute conduct rendering registration contrary to law. However, section 23 does not confer a general jurisdiction to determine passing off, marketplace misconduct, or independent infringement disputes requiring adjudication of separate proprietary rights or causes of action outside the Registrar's jurisdiction. Nor does procedural illegality in the registration process, by itself, constitute a section 23 violation.

65. The consistence in the jurisprudence of the office is well settled. I therefore do not agree with Mr. Kajubi's submission that use of the Opposed mark by the Applicant would constitute passing off. For the Registrar to uphold such an argument requires a finding of passing off by High Court which is vested with jurisdiction to determine actions for passing off. In fact, for the Applicant to pass off goods, it need not have applied for the opposed mark in the first place. Passing off arises in the packaging of one's goods, which misrepresents those of another causing damage. In passing off, one has to prove existence of good will, misrepresentation and damage. Passing off can arise independent of trademark registration. Passing off is a common law cause of action, reserved under section 35 of the TMA and triable by the High Court. A person-alleging passing off has a right to file an action in High Court. Accordingly, a claim of passing off cannot succeed, as ground of

opposition simply because passing off is an illegal act presumably contrary to law under section 23 of the Trademarks Act.

66. Similarly, the argument that a locally applied for mark is similar or identical to a foreign registered mark and hence is likely to cause market confusion, in and of itself, is not a sufficient ground of opposition unless the opponent succeeds through available pathways for protection of foreign registered trademarks. These pathways include successfully arguing bad faith, which must be specifically pleaded and proved, filing an opposition under section 44 and fulfilling the strict requirements of that section, or where the trademark is already registered, filing for cancellation under section 45 of the TMA. This principle has been recognized by the High Court in **Kampala Stocks Supermarket v Seven Days International Ltd Civil Suit No. 112 of 2015**. Faced with a similar situation where a locally registered mark was identical with a foreign registered mark, Justice Christopher Madrama (as he then was) noted at paragraph 27 of the ruling;

> *"I have already referred to provisions of the Trademark Act 2010 on registration. The Ugandan domestic law does not expressly forbid the registration of a trademark on the ground that it could be registered elsewhere. The law accords a right to register by an owner registered in the country of origin. Ordinarily to consider the owners right, the owner has to either apply for such registration or apply to deregister a person who has registered a similar trademark i.e. under section 45 of the Trademarks Act 2010"*

67. The principle in the above decision is that the law does not grant blanket protection to foreign registered trademarks. The international legal framework contained in the Paris convention on the Protection of Industrial Property established one of the fundamental principles underpinning

intellectual property protection: *the principle of territoriality*. Simply put territoriality principle means that one's intellectual property right is protected in a country where they have sought and obtained protection in accordance with the domestic law of that country. For rights acquired through registration or grant, protection of a right granted in one country does not extend to another. In fact, the basic premise of this core principle is that others are free to exploit intellectual property rights in a territory where they are not protected. Therefore, any intellectual property rights owner who considers a given country a strategic market for his or her products or services must take proactive steps and seek protection in that country.

68. Domestic laws of each country however, may provide certain pathways for foreign registered trademarks to secure their rights when faced with a situation of a similar or identical mark filed or registered in that country. With regard to trademarks, the Ugandan legal framework has provided such pathways under section 44 and 45 of the TMA, albeit under very stringent conditions. It also allows bad faith challenges to locally filed or registered marks.

69. In para 5.22—5.24 of his submissions, Counsel for the Opponent argues that the conduct of the Applicant in filing for a similar mark to that of the Opponent is evidence of bad faith and hence constitute conduct contrary to morality. The office has considered bad faith both as a ground of opposition and cancellation in numerous decisions. The Office has consistently held that bad faith must be specifically pleaded and proved and the standard of proof is slightly above the balance of probabilities (***See Elite Gold Ltd v Indo-Bali Distributors Ltd – TMs 045697, 043533 and 032264***). In ***IMITRUST – Opposition to Application No. 082777***, the Registrar following the same principles, concluded that the new company was being used as an

instrument to obtain trademark rights and frustrate the purchaser's freedom to operate and hence found that the application was filed in bad faith. In ***BLACK ZEBRA – Application for cancellation of TMs 068855 and 068856***, the applicant's original pleadings did not contain proper particulars of bad faith. The Registrar held that introducing bad faith through submissions constituted a departure from the pleadings. In ***AQUELLE – Application for cancellation of TM No. 80314,*** at para 48 of the ruling, the Registrar rejected arguments of international reputation as evidence of bad faith and noted;

> *"In this case, there is no evidence of any prior commercial relationship between the Applicant and the Respondent. The Applicant's claim of bad faith is based on circumstantial inference that the Respondent "must have known" due to the Applicant's international reputation, which is a much higher evidentiary bar to clear."*

70. Similarly, in ***DIAMOND –***Application for cancellation of TM No. **83036**, a bad faith claim failed because it was not specifically pleaded and proved to the required standard.
71. Bad faith, as consistently held in each of the above decisions, must be assessed at the time of filing. Satisfactory evidence must be adduced linking the opponent to the applicant to establish acts that assist the Registrar is assessing the applicant's state of mind. Each of the above decisions stand on the principles laid down in **Sky Kick UK Ltd v Sky Ltd [2024] UKSC 36** where bad faith in the context of trademark law, was explained as follows;

> *"While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the 7 use of marks in the course of trade. Further, it must have regard to the objectives of the EU law of trade marks, namely the*

establishment and functioning of the internal market, and a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trademarks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin…"

72. The intention of an applicant is a subjective factor, which is to be determined objectively by the hearing officer. Hence, any claim of bad faith must be the subject of an overall assessment, taking into account all the factual circumstances relevant to the particular case (***see, judgment of 11 June 2009, Chocoladefabriken Lindt & Sprüngli, C 529/07, EU:C:2009:361***, paragraphs 37 and 42)

73. I have carefully examined the grounds of opposition filed on 28 March 2025. Nowhere does the Opponent plead and particularize bad faith. Arguments of bad faith have only appeared in submissions, which is a departure from pleadings. Had the Opponent pleaded bad faith as a ground, the same would have been raised as an issue during scheduling. Therefore, arguments of bad faith are an afterthought. The Opponent's opposition was solely premised on section 44 of the TMA. The Opponent having failed to satisfy two mandatory requirements of section 44, this opposition accordingly fails and is dismissed with costs.

I so order.

Given under my hand this 03rd day of November 2026

URSB UGANDA REGISTRATION SERVICES BUREAU Birungi Denis REGISTRAR

Digitally signed by Birungi Denis
Location: Uganda Registration Services Bureau
Date: 2026.11.03 08:57:35 +03'00'

Birungi Denis

Ass. Registrar of Trademarks