

THE PROTECTION OF WELL-KNOWN TRADEMARKS LOUDLY RECOGNISED IN TANZANIA BY THE DECISION OF THE HIGH COURT COMMERCIAL DIVISION



The High Court of Tanzania (Commercial Division), for the first time has loudly rendered a decision on the protection of well-known trademarks, against infringing company names registered by third parties in Tanzania. Her Ladyship Butamo Kasuka Phillip, Judge, rendered a landmark Judgement on the protection of well-known trademarks in a case involving JC Decaux SA and JC Decaux Tanzania Limited (Plaintiffs) and JP Decaux Tanzania Limited (Defendant).

BACKGROUND

The Plaintiff is a family-owned business, established in France by Jean Claude Decaux in 1964. JC Decaux subsidiaries operate outdoor advertising businesses in over 4000 cities in more than 80 countries worldwide including Tanzania.

JC Decaux SA, the first plaintiff, a South African company has an outstanding international reputation in outdoor advertising, not only in South Africa but in other parts of the world and they entered the Tanzania market in 2015, by acquiring a Tanzanian advertising company and subsequently in 2016 they changed the name of the company to JC Decaux Tanzania Limited, which was the second plaintiff in the suit, and they applied and registered its trademark JC Decaux in numerous classes in Tanzania.

The Plaintiff, while entering the Tanzanian market, the defendant had already incorporated its company since 2014.

DECISION

The similarities of the Defendant's name to the first Plaintiff's trademark, differing by only one letter "P" (JP Decaux Tanzania Limited) vs. "C" (JC Decaux) as well as the type of business, namely outdoor advertising, cannot merely be a coincidence and the issue at hand was whether the defendant's company name was infringing the plaintiff's registered trademark.

Section 27 (2) (b) of the Trade and Service Marks Act of 1986, allows the owner of a company to oppose an application for registration of a trademark, which

is similar to the company or business name, while Section 19 (d) prohibits the registration of trademarks which are confusingly similar to well-known marks and business or company names which are well-known and belong to third parties.

In rendering her Judgment, Her Ladyship Butamo Kasuka Phillip, Judge, was convinced by the evidence adduced by the plaintiffs that the plaintiff's trademarks have been registered in 28 jurisdictions around the world and further there was evidence of use for 50 years. The plaintiffs adduced evidence of its success in domain names disputes before the World Intellectual Property Organisation (WIPO) and Arbitration and Mediation Centre before Czech Arbitration Court in respect of jpdecaux.co.tz and jpdecaux.com which were registered under the names of third parties.

Her Ladyship Butamo Kasuka Phillip, Judge, went further inter alia, in her considered opinion stating that, legally it is not correct for a person to register a Trademark or business/company name confusingly similar to a widely used and known Trademark, with well-established goodwill in its business/trade while aware of the existence of the same, simply because that the Trademark is not registered in his/her country. The Court further stated that, the defendant failed to give any justification and or sufficient explanation on why he decided to use the name "JP Decaux" whereas the name "Decaux" is someone's family name and was aware of the business conducted by JC Decaux.

Her Ladyship Butamo Kasuka Phillip, Judge, decline to agree with the defendant that, the similarity of the defendant's name to the plaintiffs Trademark as well as the type of the business conducted by the plaintiff is just a coincidence, in her opinion the evidence adduced indicates that the same was done by design for the purpose of obtaining some advantage over a goodwill established by the plaintiffs in outdoor advertisement business.

The Court declared that, JC Decaux is an internationally well-known trademark, the protection enjoyed by the plaintiff trademark in Tanzania by far overrode the protection obtained by the defendant, through a mere registration under the Companies Act.

CONCLUSION

While the Judgment echoes and sets a landmark precedent for the protection of well-known trademarks in Tanzania, the same upholds the overriding protection conferred by the law to well-known trademarks. The High Court decision and the recognition of well-known marks in Tanzania should be welcomed by brand owners and Intellectual Property Practitioners, predominantly those with a significant footprint in Tanzania and Africa..

You can read more about us here: <https://vemmaattorneys.co.tz/the-protection-of-well-known-trademarks-loudly-recognised-in-tanzania-by-the-decision-of-the-high-court-commercial-division/>

FURTHER INFORMATION:

Africa IP Practice is a department at Vemma Attorneys, aimed at updating on Intellectual Property laws, developments, policies and regulations across African Countries and at the same time advising on enforcement and commercialization of Intellectual Property Rights in Africa. For further information on any issue raised in this article, please contact:

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