



## **Trademark cancellation in Tanzania?**

A trademark cancellation is a mini-lawsuit filed to attack a trademark registration. Cancellations deal with only registered trademarks, and not pending applications. A third party may seek to cancel a registration in whole or in part. Here are helpful tips to defend against a trademark cancellation.

In Tanzania, a registered trademark can be nullified on the basis of, among other things: (a) non-use; (b) loss of distinctive character; (c) fraud in the registration; and (d) failure to observe the conditions for registration. A cancellation action can be filed by any person on the basis of that the registration process violated third party rights or through proving that the registration was otherwise illegal under the Trade and Service Marks Act, RE 2002. If the trademark owner has acquiesced in the use of a later trademark while being aware of such use, he/it shall no longer be entitled to challenge the use of the later trademark, nor can he/it have the later trademark cancelled if the action is time barred under the law of limitation.

The use of a sign that is identical to a registered mark or similar to a registered mark in respect of goods or services that are identical or similar to those for which the mark is registered, without the consent of the owner of the registered mark, is considered infringement. The unauthorized use of a registered trademark having a reputation in Tanzania even in relation to different goods and services can also be considered as infringement, if the use of the mark without justified reason would be detrimental to, or would take unfair advantage of the distinctive character or reputation of the earlier trademark having a reputation.

Subject to any agreement subsisting between the parties, a registered user of a trade or service mark is entitled to request its proprietor to take proceedings to prevent its infringement thereof and, if the proprietor refuses or neglects to do so within two months after being asked, the registered user may institute proceedings for infringement in his own name as if he were the proprietor, joining the proprietor as defendant.

In case of infringement the owner of the mark may have recourse to the following remedies:



1. request that the fact of infringement be declared by the High Court of Tanzania.
2. to request an injunction to stop the infringement and to forbid the infringer from carrying out further infringing activities.
3. to demand satisfaction from the infringer by way of a declaration or other appropriate means; if necessary the owner of the mark may demand that such declaration be published by the infringer or at the infringers expense.
4. to demand surrender of the enrichment (account for profit) obtained through the infringing activities.
5. to request that the High Court to order the seizure of the means or equipment used for the infringement and of the products provided with the infringing sign (in which case the High Court may rule that the seized means or products be divested of their infringing character or that they be auctioned; in the latter case the High Court shall decide what is to be done with the proceeds).
6. to claim full damages under the general law of tort or contract, in case the trademark infringement has caused any material damage; when establishing the damages the prejudicial effects of the infringement for all economic activities of the enterprise are taken into consideration to request temporary injunction.

The plaintiff in a cancellation proceeding, known as the “petitioner,” must have a personal stake in the case and a reasonable basis for believing they will be damaged by the trademark registration. Standing is typically not an issue for a trademark owner who alleges likelihood of confusion and priority. For trademarks alleged to be merely descriptive, a petitioner may show standing in their interest to use a term to describe their own goods or services.

### **defence against trademark cancellation claims**

Preparing a proper cancellation defense requires understanding of the reasons for filing a trademark cancellation. Here are some of the more common grounds for cancellation.

#### **Abandonment / Nonuse**

Competitors may seek to cancel a registration on the basis of nonuse and/or abandonment. In such cases, registration owners can build a helpful defense by keeping good records of continuous use of the mark from the registration date to the present.



### **What are the factors for likelihood of confusion?**

An owner of an arguably similar trademark, whether registered or unregistered (common law), may seek to cancel your registration on the basis that your trademark is confusingly similar to theirs. Keep in mind that a cancellation claim on the basis of likelihood of confusion and priority must be filed within five years of the registration date.

To analyze whether a particular situation has developed the requisite “likelihood of confusion,” courts have generally looked at the following factors:-

1. The similarity in the overall impression created by the two marks (including the marks’ look, phonetic similarities, and underlying meanings);
2. The similarity of goods and services involved (including an examination of the marketing channels for the goods);
3. Any evidence of actual confusion by consumers;
4. The intent of the defendant in adopting its mark;
5. The physical proximity of the goods in the retail marketplace;
6. The degree of care likely to be exercised by the consumer; and
7. The likelihood of expansion of the products lines.