



ORIGO

ADVOCATES

[Formerly Kitaka & Associates Advocates]



**THE CASE OF KYANINGA ("4 star") V KYANINGA ("3 star"):
IS THERE AN INHERENT CONFLICT BETWEEN LOCAL
CONTENT, LOCAL TOURISM AND
INTELLECTUAL PROPERTY IN UGANDA?**

www.origolaw.ug

"Wealthy traders are habitually eager to enclose part of the great common of the English language and to exclude the general public of the present day and of the future from access to the enclosure."



The trading names of upcountry Safari lodges in Uganda have become synonymous with the names of either local tourist attractions or geographical locations. This is by no means an attempt to take away the heritage of the local attraction but a calculated marketing plan to provide more visibility to the tourist attractions, which in turn brings more tourists to the facilities. However, this has sometimes come with serious contention whenever another accommodation facility tries to take advantage of the same local name and goodwill attached to the name notable among which is the case of Kyaninga Lodge and Kyaninga Royal Cottages Limited. Other notable lodges using geographical names include: Mweya Safari lodge, Chobe lodge, Paraa lodge, Kyambura Gorge Lodge to mention but a few.

Generic terms are those that relate to a characteristic or definition that is general to a whole class or group. The traditional purpose of a trademark has always been to be able to distinguish the goods or services of one manufacturer from those of another. However, in modern times, many businesses in different industries have since adopted the use of basic words that were once in common parlance and these according to the respective

industry have then adopted a new meaning. The subsequent objections have then been for the ineligibility of broad or generic names for trademark registration.

Trademarks in Uganda are protected under the Trademarks Act, 2010 that is the law relating to trademarks, registration thereof, their duration, effect of registration and action for trademark infringement. The primary function of a trademark is to distinguish the goods and services of one proprietor from those of another. Trademarks are a regime of intellectual property that are granted by virtue of registration. The Trademarks Register is kept electronically and contains everything about the life of a trademark and what is not registered is not protected. Marks that are similar to ordinary words are construed to be a springboard for confusion and so may be rejected upon registration. This is the same case for descriptive words or generic names. Trademark statutes have always guarded against business men who attempt to adopt marks which others in the same nature of business are more likely to use generally or descriptively, and so they may counter objections, conditional acceptances or rejections at substantive examination of the marks.



Trademarks jurisprudence has evolved so that it is now possible to have such marks registered. The grounds of argument are that a trader in a specific business may adopt a work that is generic for it to garner recognition as identifying the origin of goods or services and then to claim for trademark protection. The objection to this is that certain businesses are assuming common words that belong in the public domain as trademarks warranting registration.

Generic names may extend to geographical names, that is words or names that are used in reference to a geographical location such as a town, city, river, mountain or lake.

In connection to the function of a trademark that is to distinguish goods or services of or undertaking from those of another, it may be argued that marks that portray a geographical origin can be distinctive.

According to section 9(d) of the Trademarks Act, 2010, a mark has the distinctiveness character requisite for registration in Part A of the Register when it is a word or words having no direct reference to the character or quality of the goods or services, and not being according to its ordinary signification, a geographical name or surname. This means that words that may form a trademark should not be in relation to a geographical name.

Trademarks in the travel or hospitality business have been litigated in Uganda as seen in the case of Kyaninga Estates Limited V Kyaninga Royal Cottages. A generic name may be distinctive if it has adopted a new meaning to customers and has thus ceased to be generic. The crux of the matter is for customers to in fact perceive the term as originating from the proposed trademark proprietor. Generic names are so only if that is the meaning it connotes to customers. This salient feature applies similarly to geographical names under the Trademarks Act, 2010. For customers, the mark has to signify or identify the services of the proposed trademark proprietor. The benefit of a trademark is to attach the goodwill of the business and protect the ability of customers to distinguish the trademark proprietor among many other competing producers. A customer should be able to identify the desired goods or services in the market place.



The difference between word marks and logos was one of the main issues of contention in the Kyaninga case. In this case, the plaintiff and Respondent in the Application, according to the judgment on page 10, sought to protect the words, "Kyaninga Elegance at its Peak". The judgment stated that the words are not distinct in their character.

The judgment referred to a dictionary search of the words to mean they are in commonplace words in the English language. This illustrates that courts may rely on dictionaries or usage by customers or any other source to perceive a term's meaning. Although commonplace words may be distinctive, it can only be when they communicate a meaning that is specific in relation to the products used.

According to the judgment, the combination of "Kyaninga and " Elegance at its peak" is that of a geographical name and English words and so Kyaninga lodges according to the judgment had failed to demonstrate any right protected by law and consequently no violation by the Applicant to warrant trademark infringement. According to the judgment, the words were not shown to be adapted to describe a distinctiveness in the provision of hospitality services.

It is important to make a distinction between word marks and logos. A trademark according to the Trademarks Act, 2010 is defined as a sign or mark or combinations signs or marks capable of being represented graphically and capable of distinguishing goods or services of one undertaking from those of another undertaking.

At registration, one may opt to register a word mark or a logo. With a word mark, the Applicant seeks registration or words or letters only. This means that the combination of words or letters is what is registered. There is no concern for the graphical representation of the letters. The main advantage of this is that upon registration it offers wider protections as the words are protected regardless of the manner in which they are depicted. With a logo mark, it is a graphical representation of the word mark and may combine colours, fonts and font sizes. The brand name may be incorporated in the logo. However, with a logo a trademark proprietor has to use the logo in the format that it is depicted and a change in use may mean call for another trademark registration as this has created a new mark. Some may argue that this was the crux of the matter in the Kyaninga case as the trademark registered was for "Kyaninga Elegance at its peak" while the Defendants only adopted the word Kyaninga from the trademark.



A word mark may be generic, descriptive, suggestive or a phrase and still acquire the character of distinctiveness. A mark may also be inherently distinctive, where it has no other meaning in language and is purely invented. This is also provided for in section 9(c) of the Act. But for a generic word to be registered, it must connote such a meaning to the customers in that nature of business and thereby have acquired a another meaning or acquired distinctiveness over time.

In Uganda's travel and hospitality business, it has no doubt become common that business owners acquire trade names that are adopted from the area the business is located such as a safari lodge near a lake, river or mountain. From the above, the key points for a trademark proprietor in the hospitality business is to ensure the tradename is not adopted to the geographical location or a physical feature, as it may be difficult to seek trademark registration. The word Kyaninga is not from the English language but trademarks law is jurisdictional and so it is vital to restrict the interpretation to dialects in Uganda except where the audience may be considered a negligible minority or the connotation has another meaning to a small percentage of the population.

The distinctiveness character which makes a mark capable of registration in Part A of the Trademarks Register was one of the grounds of contention in the Kyaninga case. The argument was that the meaning of the word Kyaninga is not just a reference to the lake near the lodge but that in the hospitality business the word has acquired another meaning and thus it has met the distinctiveness requirement.

In assessing whether a mark is a geographical word or whether it is generic the mark is referenced as a whole and not just a section of the words registered. It is taken that the depiction of the word or log as registered is what the trademark proprietor is seeking protection for. Still, the eligibility for registration, is being able to achieve the function of a trademark- that it is capable of distinguishing the goods or services of one undertaking from those of another undertaking. For section 9 of the Trademarks Act, 2010, in order for a mark to meet the distinctiveness of registration, a mark has to be able to direct a customer towards the origin or the manufacturer of those goods. For those who are claiming ownership for geographical words, they have to be able to demonstrate that the registered mark has become the generic name of those goods and services.



It has acquired another meaning and the customer's perception demarcates the term's new meaning.

In the hospitality business, it has to signify to customers or travellers the particular services such as the lodge or hotel. Then, if it is not generic to customers it can be taken that it has ceased to be a generic word. However, this tested is applied either in courts at litigation or at examination of the desired mark for registration by the Registrar of Trademarks.

Thus, combining a geographical word with the nature of the business yields a generic composite and the statute disallows such a registration.

The rationale behind section 9(d) and the judgment in the Kyaninga case is that a geographical name only provides the business man with a name that is already attributed to another meaning in parlance. Trademarks may have the function of distinguishing good or services but they also serve the purpose of preventing one trader from appropriating for its own exclusive use a terminology that is already used by others to describe that geographical location.

This will preserve geographical names from being adopted for exclusive use as the term is already being used to identify something.

A generic term is not eligible for use as a trademark if that particular term in priority is already being used to refer to a geographical feature. In addition, it closes out a competitor or someone else who would desire to adopt the name of that geographical feature to their business and also obtain some of the perceived commercial benefit that may accrue to the name.

For those in the hospitality business, it may be attractive to adopt the name of a nearby geographical feature and so it is important to be alert to this rule of trademarks law so as not to cause confusion, lose out on exclusivity of a name or lead to future litigation.

Additionally, a mark may be unable to escape this rule by combining the geographical word with another generic term such as "hotel" or "haven". Courts will still determine whether the combination is eligible for registration and that addition of another word to grant it designation does not confer distinctiveness and right to exclusivity because addition of this word is merely a necessary component to the business or its scope. It still remains descriptive of the nature of business that the business owner is operating.

Terms that refer to geographical features or are generic should remain free for the common parlance. For those in the hospitality business, they should be alert to use of geographical names and subsequently seeking trademark registration for the same. These words have already been adopted to identify a physical feature and so assuming them for one's business would mean creating a monopoly that excludes other traders in similar business who may desire the same advantage and for the public it dismisses their previous use of the word.

Disclaimer

Every effort has been made to ensure this information is up-to-date as of the date of the publication. It is not intended to be a full and exhaustive discussion of the law in any area. This information is not intended as legal advice and may not be used as such.

Contact us

Bakwanye House, 2nd Floor, Plot 26, Wampewo Avenue, Kololo,
P. O. Box 11223, Kampala, Uganda.

Email: info@origolaw.ug

Website: www.origolaw.ug



www.origolaw.ug



Origo Advocates



@AdvocatesOrigo