



UGANDA REGISTRATION SERVICES BUREAU

THE TRADEMARKS ACT, 2010

**IN THE MATTER OF TRADEMARK REGISTRATION No. 56916 “POKEMON” IN
CLASS 30 BY V.G KESHWALA AND SONS LIMITED**

AND

IN THE MATTER OF AN OPPOSITION BY NINTENDO COMPANY LIMITED

BEFORE: MARIA NYANGOMA : ASST. REGISTRAR TRADEMARKS

Representation

Counsel Ms. Caroline Bamukunda of Nambale, Nerima & Co. represented the applicant and applicant and Counsel Grace Nakabugo of MMAKs Advocates— represented the opponent.

Brief Facts

On the 30th September 2016, V.G Keshwala and sons Ltd applied for a trademark ‘POKEMON’ in class 30 in respect of confectionery and biscuits which was advertised in the Uganda gazette. Nintendo co. Ltd a company of Japanese origin opposed the application when it tried to register the same trademark in Uganda and discovered that there was an application already in regard to the same trademark contending that they have owned the trademark ‘pokemon’ since 1998 in regard to video games and have accordingly expanded to cover the globe since the game can be accessed on the internet. They had at the time registered the trademark in a number of countries but not in Uganda.

Issues

1. Whether the opponent has the right to object to the registration of Trademark No 56916, “POKEMON”?
2. Whether there is a likelihood of confusion between “**POKEMON**” and “**POKEMON**”?
3. Whether Trademark No 56916 **POKEMON** offends Section 9, Section 23, and Section 44 of the Trademarks Act 2010?
4. What are the remedies available for the parties?

Law applicable

The Trademarks Act, 2010

The Trademark Regulations, 2012

The Paris Convention for Protection of Industrial Property 1883

Issue I:

Whether the opponent has the right to object to the registration of Trademark No 56916, POKEMON?

Locus standi was defined in the case of **Fakrudin & Anor v Kampala District Land Board & Anor HCCS 570 of 2015** to mean the legal capacity of a person, which enables him or her to invoke the jurisdiction of the court in order to be granted a remedy.

In **Fenekasi Kiwanuka vs. Malikit Singh Sondh** case (supra) this court had the occasion to observe that one of the basic tenets that underpin the principle of *locus standi* is that court's time should not be wasted on hypothetical and /or abstract issues, or at the instance of mere busy bodies who have no genuine cause.

Registration of a trademark is made under **Section 12** of the Trademarks Act, 2010. **Section 12 (1)** prescribes that any person, may within prescribed time from the date of publication of the application for a trademark, give notice to the registrar objecting to the registration. The objection by the opposing party shall be within 60 days from the date of

advertisement in the gazette and such notice shall be in writing as per **Section 12 (2) and Regulation 28 (1)** of the Trademark regulations.

Section 2 of the Trademark Regulations 2012 defines an “**agent**” to mean advocate of the High Court of Uganda;

Section 10(1) of the Trademark Regulations 2012 states Except as otherwise required by these Regulations—

- (a) an application, request or notice which is required or permitted by the Act or these Regulations to be made or given to the registrar or the court;
- (b) all other communications between an applicant or a person making the request or giving the notice and the registrar, or the court;
- (c) all communications between the registered proprietor or a registered user of a trademark and the registrar or the court or any other persons,

may be signed, made or given by or through an agent.

As it has been stated in the opposition’s pleadings, the law does not specify that the party opposing must be within the country as it is suggested by the applicant in their reply to the opposition.

Regulation 80 empowers the registrar to extend time for an opponent to file their objection if the registrar is satisfied that there is justified reason for extension of time. Therefore, section 25 prohibits the registrar from registering identical trademarks. It is important to note that on 12 .12. 2016 the opponent requested for an extension of time within which to file a notice of opposition which was granted on 10, 2.2017 and the notice of opposition filed on 13.2.2017.

Section 44 (3) of the Trademarks Act 2010 gives a list of requirements that must be in place if a foreign trademark is to be given protection and recognition in Uganda. It is a requirement for the foreign trademark owner to apply to be registered in Uganda within three months from the date of an objection.

The opponent has applied for trademark registration in Uganda, which has not been challenged yet nor has the registrar accepted it. Therefore, the opponent had the legal capacity to institute objection proceedings against the applicant.

The applicant further urges that the Paris Convention for the Protection of Industrial Property and TRIPS Agreement are not domesticated by an Act of Parliament. In the case of **Kampala Stocks Supermarket Co Ltd v Seven Days International Ltd** HCCS 112 of 2015, it was recognized that the Paris Convention of 1883 was applicable in Uganda and other union countries.

A trademark is a duly registered trademark in any country of the Union, which shall be regarded as independent of a similar or same trademark registered in other countries of the Union as was held in **HCCS 112 of 2015**.

Section 44 of the Trademarks Act 2010 provides that the Registrar of Trademarks may refuse to register a trademark relating to goods or in respect of goods or description of goods if it is proved to his or her satisfaction by the person opposing the application for registration that the mark is identical with or nearly resemble the trademark which is already registered in respect of the same goods; the same description of goods; or services or a description of services. The Registrar has such discretion to refuse registration of a trademark as per **HCCS 112 of 2015**.

Therefore, the opponent has the legal capacity to institute proceedings by way of lodging a notice of opposition and the registrar is duty bound to act by according a hearing to the parties and make a decision to either continue to register or refuse to register the trademark.

Now I turn to the issue of a “well-known” mark. The opponent in their argument state that their mark is well known and thus it should be protected. From the start, I must say that the **section 34** of the Trademarks Act prohibits one to institute proceedings for prevention or recovery of damages of an unregistered mark. Therefore, the trademark must be registered in Uganda for it to be protected as per **sections 25 and 34** of the Trademarks Act.

It is the argument of the applicant therefore, that the opponents mark is not protected within Ugandan laws. However, Uganda is party to international conventions as already discussed above and from that basis that Uganda and Japan both benefit protection accorded by the treaty.

In the case of **McDonald's Corporation v Joburgers Drive-Inn Restaurant (Pty) Ltd and Another (547/95) [1996] ZASCA 82; 1997 (1) SA 1 (SCA); [1996] 4 All SA 1 (A)** it was held that a mark was "well known in the Republic" if it was well known to persons interested in the goods or services to which it related. Well-known trademarks are marks that are universally recognizable by the general public and are widely renowned. These marks enjoy wider protection under trademark law, due to their reputation with the general public.¹ I find this decision persuasive.

Article 6bis provides for protection of well-known trademarks and accord a five years protection before registration in a domestic country. Paragraph 4,5,6,7 and 8 of the opponent's application for objection indicate that the trademark POKEMON is well known and provided statistical figures which are reiterated in the Statutory Declaration deposed by the opponent.

The effect of this Article is to extend protection to a trademark that is well-known in a member country even though it is not registered or used in that country. The protection of the well-known trademark results not from its registration, which prevents the registration or use of a conflicting trademark, but from the mere fact of its reputation²

In the Kenyan case of Weetabix Limited v Manji Food Industries Ltd [2015] eKLR held that Section 15A of the Kenyan Trade Mark Act provides that well known trademarks shall be protected in Kenya whether or not they are registered in Kenya. In particular section 15A (4) prohibits the registration of any trademark if that trademark or an essential part thereof is likely to impair, interfere with or take an unfair advantage of the distinctive character of the well-known trade mark.

¹ [Changes for well-known marks \(WKM\) | Harper James](#)

² WIPO Intellectual Property Handbook 2nd Edition page 251 par 5.82

The important question is what are the requirements for a foreign mark to be granted Protection in Uganda where it is not registered in Uganda are provided for under section 44. The opponent must satisfy, on a balance of probabilities, the requirements under **Section 44**.

Under **Section 44 (1)**, the [registrar](#) may refuse to [register](#) a [trademark](#) relating to goods in respect of goods or description of goods if it is proved to his or her satisfaction by the person opposing the application for registration that the mark is identical with or nearly resembles a [trademark](#) which is already registered in respect of the same goods, the same description of goods or services or a description of services which are associated with those goods or goods of that description, in a country or place from which the goods originate.

The applicant seeks to register the mark in class 30. The opponent's mark has been registered in several countries in different classes of goods and services including class 30. Third, under **section 44 (1)**, the opposed mark allegedly likely to be infringed by the registration of the applicant's mark must be registered in a country (meaning the country where registration is sought) or in the place (which includes a country) from where those services originate. It is already settled that opponent's mark is not registered in Uganda.

Therefore I will now turn to the second alternative, namely that the opposed mark and its associated goods or services purported to be likely to be infringed by the registration of the applicant's mark, must be registered in a place (country) where the services or goods originate. Under this alternative criterion, the place of origin for the opponent's services is Japan.

Section 44(3) of the Trademarks Act 2010, provides that; "An application to register shall not be refused under this section where— a) the applicant proves that he or she or his or her predecessors in business have in Uganda, in relation to the goods or services, continuously used the trademark for the registration of which he or she has made application from a date before the date of the registration of the other mark in the country or place of origin; or 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. From the evidence adduced, the opponent undertakes to register its mark within 3 months and indeed has already filed applications for registration of the marks. The opponent therefore satisfies the requirements of section 44 (3) (b). On the other hand, the applicant has not adduced any evidence to prove that they or their predecessors in business in Uganda have previously used the mark and that they applied prior to the opponent's registration in the country of origin. There is an overall requirement under **section 44 (4)** which provides that: "The protection given under this section in respect of a trademark 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."

The requirement of **section 44 (4)** is premised on the principle of national treatment that underpin most bilateral and multilateral trade agreements between and among states. Simply put, it is the idea that if a state provides certain rights and privileges to its citizens, it should also provide the same rights and privileges to foreigners as a matter of reciprocal arrangement between states. In brief, it is the principle of giving others the same treatment as one's own nationals, usually based on treaty obligations.

From the analysis, the opponent's services originate from the Japan, which is a state party to the Paris Convention so is Uganda. . In addition Article 53-2 of the Japanese Trade Mark Act 第五十三条の二登録商標がパリ条約の同盟国、世界貿易機関の加盟国若しくは商標法条約の締約国において商標に関する権利（商標権に相当する権利に限る。）を有する者の当該権利に係る商標又はこれに類似する商標であつて当該権利に係る商品若しくは役務又はこれらに類似する商品若しくは役務を指定商品又は指定役務とするものであり、かつ、その商標登録出願が、正当な理由がないのに、その商標に関する権利を有する者の承諾を得ないでその代理人若しくは代表者又は当該商標登録出願の日前一年以内に代理人若しくは代表者であつた者によつてされたものであるときは、その商標に関する権利を有する者は、当該商標登録を取り消すことについて審判を請求することができる. Article 53-2 Where a registered trademark is a trademark pertaining to a right to a trademark (limited to a right equivalent to a trademark right) held by a person in

a country party to the Paris Convention, a member of the World Trade Organization or a Contracting Party to the Trademark Law Treaty or a trademark similar thereto, and the designated goods or designated services thereof are goods or services pertaining to those right or goods or services similar thereto, and further, the application for trademark registration was filed without the approval of the person who has the right pertaining to the trademark, without a just cause, by their agent or representative or by their former agent or representative within one year prior to the filing date of the trademark registration, the person who has the right pertaining to the trademark may file a request for a trial for rescission of the trademark registration³. The Act has domesticated the Paris convention to grant protection to well-known marks registered in their country of origin on this matter the Opposition has satisfied the **section 44** on the balance of probabilities.

The opponent states that the trademark has existed since 1889 and has released games since 1998 and they have been broadcasted in 95 countries and has been viewed by over 72 million viewers, evidence that was not controverted by the applicant. Acceptance of the evidence presented by the opponent has no substantial disadvantage against the applicant unless it has been controverted.

Suffice it to say, television covera'ge and advertisement, and print circulation creates broadcasting spillover because it can be quite extensive and many Ugandans would know the trademark. The opponent is an aggrieved party and has the locus to institute the proceedings by way of notice of opposition.

Issue II: Whether there is a likelihood of confusion between POKEMON and POKEMON

The opponent raised an issue as to the likelihood of confusion likely to be created by the applicant's trademark among the customers of their products. Counsel for the opponent in their submissions aver that that there is similarity between the marks, the overall

³ Transalation of the Act, [Trademark Act - Japanese/English - Japanese Law Translation](#)

impression given by the mark and degree of similarity of the goods and/or services in respect of the mark as the parameters to guide on determination of this issue.

Having found that the opponent has the legal capacity and a valid cause of action, the argument by the applicant that the opponent has no right to raise the issue thus fails.

However, I shall consider whether the two marks are similar and capable of causing confusion and deception among the opponents' customers.

The **English Cambridge dictionary** defines "**Similarity**" means "the fact that people or things look or are the same".

The **English Cambridge dictionary** defines "**deception**" to mean "dishonest or illegal methods that are used to get something, or to make people believe that something is true when it is not". The same dictionary further defines "**confusion in marketing**" to mean the activity of selling products or services together that makes it difficult to decide who produced it.

The guiding principle must be evaluated in view of the likelihood of confusion that is in view of the conflicting marks being capable of suggesting that the goods or services have their origin in the same or economically linked undertakings. The likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case.

In the case of **Nice House of Plastics v Hamidu Lubega HCT-00-CC-CS-0695-2006** court held that in matters of intellectual property, a trade mark is a word, phrase, symbol, product feature, or any combination of these that distinguishes in commerce the goods or services of its owner from those of others. A trademark, therefore, is an indicator of source. It does not tell what the goods or services are, but where they come from.

In the case of **SABEL BV v Puma AG** court held that global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. Therefore, the marks or signs must be looked at together or independently to establish the existence of a similarity.

It's important to note that when considering a mark, one has to also appreciate the fact that an average consumer perceives a mark as a whole and does not proceed to analyze its various details. This position was emphasized in the case **Nairobi Java House Ltd v Mandela Auto Spares Ltd HCCA 13 of 2015**.

The opponent insists that the words POKEMON and POKEMON as used by the applicant are arranged and presented in the same manner and order of arrangement thus making them identical. **Section 25 (2)** prohibits registration of such a mark as it is likely to cause confusion.

The applicant in their submissions state that the opponent did not adduce evidence of consumers, franchise or agents in Uganda as to prove confusion. I take note that there is evidence to the numbers and global recognition of the opponent and being a member of Paris Convention, which Uganda is party, gives the opponent capacity to register the trademark in Uganda.

Representation of Marks

POKEMON	 POKEMON
Applicants mark Name only	Opponents Mark Name & Logo

In line with the nature of the trademark the applicant intends to register; the question is would it cause confusion among customers? I am persuaded to believe so; the only difference in the marks is the use of letter (E) by the applicant as presented by the opponent. Visually the marks resemble and are identical, the whole mark is presented horizontally and in the same format save for the applicants and opponents mark both being in capital letters and the opponents logo having the letter E with an apostrophe. Placed side by side the marks are the same.

In the case of **Wagamama ltd v City Center Restaurants PLC, [1995] FSR (Ch. D)** the test for likelihood of confusion was essentially practical in the sense that the court would not consider just what the marks looked like but also what they sounded like. This principle was brought out in In the case of **Standard Signs Uganda Ltd v Fred Leo**

Ogwang T/a Shandard & Anor (High Court Civil Suit 240 of 2006) [2012] The Hon. Lady Justice Hellen Obura, cited with emphasis the case on the audio sound of the two marks of *Parke Davis & Company Limited v Opa Pharmacy Limited [1961] EA 556*, the appellant company was selling tubes of ointment packed in distinctive cartons under the registered trade name “**Capsolin**”. On the other hand, the respondent company was selling a similar ointment under the registered name “**Capsopa**”. The appellant sued the respondent claiming for an injunction to restrain it from passing off its product as that of the appellant and damages or an account of the profits made. The trial judge dismissed the suit on the ground that there was no evidence of confusion among the public and that “**Capsopa**” was not likely to be confused with “**Capsolin**”. On appeal it was held *inter alia* that: “(i) *since the first two syllables in the trade name used by each of the parties were identical and there were resemblances in the containers there was a real probability of confusion and the appellant company was entitled to an injunction*”.

(ii) “The application of the logo and company name is not only applied on billboards and stationery but also using audio. When it comes to sound (audio) *Standard Signs and Shandard Signs*, there I visualize total confusion of their clientele. They might sound like identical twins in the same business handling same clients”

The two marks do not just look alike but have the same pronunciation, any average reasonable customer is likely to associate the two marks and attribute them to the same producer and thus the applicant will be benefiting from the reputation of the opponent. In the case of **Arsenal Football Club versus Matthew Reed Case C-206/01**, the European court of justice held that the function of trademarks is to guarantee the identity of origin of the trademarked goods or services to the consumers or end-user by enabling them without any possibility of confusion to distinguish the goods and services from others with another origin. The condition of use of a sign identical to the trademark for the purpose of distinguishing goods or services, is a concept which should be interpreted broadly, so as to include in particular use as a badge of support for or loyalty or affiliation to the proprietor of the trademark.

Ordinarily to consider the owners right, the owner has to either to 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 which states that, Subject to subsection

(3), the court may, on application in writing within seven years from the registration in Uganda of a trademark relating to goods by a person aggrieved by the registration, remove that trademark from the register if it is proved to the satisfaction of the court that the trademark is identical with or nearly resembles a trademark which was, prior to the registration in Uganda of the trademark, registered in respect of—

(a) the same goods;

(b) the same description of goods; or

(c) services or a description of services which are associated with those goods or goods of that description,

in a country or place from which the goods originate.

There is no speculation as to the identity of the opponent's mark therefore, the mark by the applicant is not only similar but the same as the opponent's mark which contravenes **section 25** of the Trademarks Act, 2010.

Issue III: Whether Trademark No. 56916 POKEMON offends against the Trademarks Act

The applicant in their written submission state that the registrar was satisfied that POKEMON was distinctive and allowed it to proceed to publication.

First and foremost, the registration of trademarks is governed by the Trademarks Act 2010. For emphasis the procedure is as follows;

Section 1 defines “**trademark**” to mean, a sign or mark or combination of signs or marks capable of being represented graphically and capable of distinguishing goods or services of one undertaking from those of another undertaking.

Section 5 provides that a person who intends to apply for the registration of a trademark shall carry out a search to ascertain whether the trademark exists in the register upon payment of a prescribed fee.

Section 6 requires that the applicant may be required to obtain preliminary advice from the registrar to whether the proposed trademark appears to the registrar to be inherently adapted to distinguish or capable of distinguishing goods or services of the proposed undertaking from those of other undertakings and the registrar shall advise accordingly.

Then the applicant shall be required to apply for registration of the trademark and the registrar shall accept absolutely or with conditions or limitations under **section 7** of the Act. Subsequently, the registrar shall cause the publication of the accepted trademark and the publication shall be for 60 days as per **section 11**.

Needless to say, the purpose of this publication is to encourage anyone with a claim to or against the published trademark to object to the registration of the trademark. This is buttressed under **section 12 (1)** that provides for a person may, within the prescribed time from the date of publication of an application, give notice to the registrar of **AN OBJECTION TO THE REGISTRATION**. Therefore, mere acceptance by the registrar with or without conditions or limitations does not in itself determine the end of the registration process. The argument by the applicant does not suffice in the circumstances. Registration does not end at acceptance since it is a process with concurrent stages.

Distinctiveness

Section 9 (2) (a) defines distinctiveness to mean in the case of a trademark relating to goods, adapted in relation to the goods in respect of which the trademark is registered or proposed to be registered, to distinguish goods with which the owner of the trademark is or may be connected, in the course of trade, from goods in the case of which no connection subsists.

In **Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc (1999) RPC 117**, it was noted that a distinctive mark is one that enables members of the public to distinguish the product or service that it designates from those which have a different trade origin and to conclude that the products and services that it is designated have been manufactured, marketed or supplied under the control of the owner who is responsible for the identity.

The distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or

services covered by the two trademarks is sufficient to give rise to the likelihood of confusion.

Registration of a trade mark may be refused, despite a lesser degree of similarity between the goods or services covered, where the marks are very similar and the earlier mark, in particular its reputation, is highly distinctive.

Section 9 (3) provides that in determining the trademark the registrar or court may consider that the trademark is inherently and factually adapted to distinguish goods or services.

The premise is that goods or services must be distinguished from each other and the law provides for such protection. The capacity of communication by the mark to the consumer about the origin of the goods and the quality makes it distinctive. In **British Sugar v James Robertson & Co Ltd**, the court held that; to be distinctive a sign must be in cable of fair & honest application to the goods of anyone else. The basic feature of a trademark is to distinguish the goods and services on which it is applied from that of others in the market.

In the premises the opponents undisputed decades reputation globally warrants a broader protection on account of its distinctiveness. The applicant has not shown any evidence or controverted the evidence adduced by the opponent as regards distinctiveness of the trademark they intend to register.

The appearance of the trademark as present by the applicant is the same or similar in every context of the trademark from its visual appearance and thus not distinct. The word "POKEMON" is not a common noun in Uganda. There is no dictionary meaning attributed to it. The dictionary simply defines "poke" which ordinarily means to push a finger or other pointed object quickly into someone or something.

The mark has obtained distinctiveness due to the use by the opponent for the many years as has been attributed to it globally as stated in the Statutory Declaration deposed by Toshio Hibino. When the word/s is/are devoid of any distinctive character or are contrary to morality or public order among other grounds the registrar is mandated to reject its registration.

The opponent's mark comes from Japan, which is a state party to the Paris Convention and has domesticated the convention under the aforementioned Article 53-2 of the Japanese Trade Mark Act. As previously noted, Uganda has domesticated the Paris Convention through judicial precedents. In the case of **Nairobi Java House Ltd v Mandela Auto Spares Ltd Civil Appeal No 13 of 2015**, the High Court of Uganda recognized Uganda's domestication of the principle of reciprocal protection among member states to the Paris Convention, where Justice Christopher Madrama (as he then was) stated that: "The Ugandan Trademarks Act 2010 has domesticated some of the principles of the Paris Convention for the Protection of Industrial Property under sections 44 and 45 thereof."

For a foreign mark to be protected in Uganda it should either be registered or should satisfy the ingredients of section 44(3 & 4) of the Trademarks Act. Section 44 (3) provides that the Registrar shall not refuse the application for registration in Uganda if the Applicant proves prior use continuously of the mark before the registration of the foreign trademark in the country of origin. According to the facts, the applicants did not adduce any evidence that they been using this mark, Section 44 (4) requires the country of origin to grant Uganda the same treatment. The fact that both countries are signatories to the Paris Conventions means they both accord each other the same protection. While both countries do not provide for articles 6bis protection in the same way, they are hinged on the same multilateral framework as noted in the dictum of Madrama J above. Consequently, from the reading of Article 53-2 of the Japanese Trade Mark Act, it is clear that Uganda being a member of the Paris Convention, goods and services originating from its territory would benefit from the protection. As such the opponent meet the requirements of **section 44 (4)** and the opposition accordingly succeeds.

Issue IV: What are the remedies available for the parties?

The opponent prayed for cost for these proceedings against the applicant.

The decision in **Obong v Kisumu Council [1971] EA 91**, is well settled law on award of costs. It is trite law that damages are the direct probable consequences of the act complained of. Such consequences may be loss of use, loss of profit, physical inconvenience, mental distress, pain and suffering.

In awarding costs, one may take into account factors such as malice or arrogance on the part of the defendant and this is regarded as increasing the injury suffered by the plaintiff, as, for example, by causing him humiliation or distress.

Therefore, this means that costs are intended to make good to the aggrieved party as far as money can do for the losses he or she has suffered as the natural result of the wrong done to him or her. In the instant case, the parties have incurred costs in legal proceedings for this hearing, application for registration of the trademark and other costs. It's on this premise that it would be grave to impose costs on the applicant in the circumstances and therefore, each party shall bear its costs.

I so order,

Given under my hand, this **23rd** day of **August, 2023**



Digitally signed by Maria
Nyangoma
Location: Uganda Registration
Services Bureau
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