

THE REPUBLIC OF UGANDA

IN THE HIGH COURT OF UGANDA HOLDEN AT KAMPALA

COMMERCIAL COURT DIVISION

HCT-00-CC-MA-0436-2006

Potomac Tobacco Company Ltd

Applicant

Versus

British American Tobacco Co. Ltd

Respondents

British American Tobacco (Brands) Ltd

Legislation referred to:

1. *Trademarks Act, Cap.217*
2. *Civil Procedure Rules*
3. *Civil Procedure Act.*

BEFORE: THE HONOURABLE MR. JUSTICE FMS EGONDA-NTENDE

RULING

1. The applicant is seeking the removal of a trademark, 'YES', from the Register of Trademarks in respect of all goods for which the trademark is registered for none use of the same. The respondent no. 1 is the registered owner of this trademark. The Respondent no. 2 is the person who applied recently for its renewal.

2. The applicant seeks a second order and that is that the recent renewal of the trademark be declared null and void, and a declaration issued to the effect that there has never been a renewal of the same.
3. This application is supported by the affidavit of Mr. Ruchard Rujugiro, Director, Market Development for the applicant. The application is stated to be made under Sections 22 (2) and 28 of the Trademarks Act, and Order LII Rules 1 & 3 of the Civil Procedure Rules and Section 98 of the Civil Procedure Act.
4. The respondents were duly served with copies of this application but they did not appear or file any papers whatsoever in the matter. The hearing of the application proceeded *ex parte*. Ms Sebatindira learned counsel for the applicant appeared for the applicant at the hearing of this application.
5. I shall start by considering the application for de registration for none use. This is governed by Section 28 of the Trademarks Act, Chapter 217. It states, in part,
 - ‘(1) Subject to section 29, a registered trademark may be taken off the register in respect of any class of the goods in respect of which it is registered on application by any person aggrieved to the court, or at the option of the applicant and subject to section 52, to the registrar, on the ground either---
 - (a) that the trademark was registered without any bona fide intention on the part of the applicant for registration that he or she should use it in relation to those goods, and that there has in fact been no bona fide use of the trademark for the time being up to the date one month before the date of the application; or
 - (b) that up to the date of one month before the date of the application a continuous period of five years or longer elapsed during which the trademark was a registered trademark and during which there was no bona fide use of the trademark in relation to those goods by any proprietor of the trademark for the time being.’

6. The applicant before the court must show firstly that it is an aggrieved person in the circumstances of that particular case. Secondly that there is a registered trade mark. Thirdly that trademark was registered without a bona fide intention to use the same and there has been no use of the same up to one month before the application is brought to court, or that for a continuous period of 5 years up to one month before the bringing of the application there was no bona fide use of the trademark in relation to the goods for which it was registered.
7. In the affidavit sworn by Mr. Richard Rujugiro in support of this application it averred, and this is not contested, that the applicant is the registered proprietor of trademark 'YES' in the Republic of South African, Algeria, Adorra, Angola, Benelux, Iran, Jordan, Lesotho, Liberia, Morocco, Sierra Leone, Tajiksitan, Uzbekistan and Zambia. Copies of the registration of trademark have been to the affidavit. The affidavit also asserts that the applicant is the registered trade mark owner under the Madrid Agreement and Protocol with the World Intellectual Property Organisation and a supporting certificate is attached. In South African it has authorised the use of its trademark Mastermind Tobacco South African (Pty) Ltd in relation to the manufacture of cigarettes and smokers articles.
8. Desirous of exploiting the Ugandan Market the applicant applied for registration of the said trademark in Uganda on 24 February 2004 but this was rejected on the ground of the existence of a similar registration by the respondent no.1. I am satisfied the foregoing facts establish the applicant as an aggrieved person for purposes of de registration for non use of the said trademark.
9. On inquiry from the Uganda Revenue Authority the tax agency notified the applicant that no person manufactures or imports into Uganda Tobacco products of the YES brand or trademark. Though the letter in question from the Uganda Revenue Authority does not address the time period to which it refers other than the current period, the obligation must be borne by the trademark owner/respondent to show use of the trademark in relation to the goods in question for which it is registered. The trademark owner is in the best position to show this. The respondent has not done this.
10. I am satisfied that it has been established that the respondent no.1 had no intention to make bona fide use of the trademark in question and has not done so for the last continuous period of 5 years.

11. In light of the foregoing, I order the de-registration of the trademark 'YES', trademark no.19212 in class 34, currently registered in favour of the respondent no.1, from the register of trademarks in Uganda for none use of the same. To that extent, this application is allowed with costs.

12. It is unnecessary to consider the second order sought by the applicant, given my finding and order hereinabove.

Signed, dated and delivered at Kampala this 16th day of November 2006

FMS Egonda-Ntende

Judge