



ARIPO – IP Case Study – Trade mark protection and enforcement

Background

A Belgian company, Rooftop Company, manufactures iron sheets under the trade mark ROLLO. Rooftop Company is mainly active across Europe. It registered an ARIPO trade mark a few years ago designating Uganda and Namibia for two licensing projects. These projects, however, fell through.

The company later learned that in Uganda, products bearing the ROLLO trade mark were being sold without authorisation, likely imported through Kenya.

They also learned that a trade mark application ROLLOS for iron sheets had been applied for in Namibia by a third party.

Action undertaken

In Uganda, before initiating a court action for trade mark infringement, a trade mark owner must undertake a market survey to confirm the volume of counterfeit goods on the market. The Rooftop Company initiated this survey, as they also hoped to uncover more information as to the importer(s) of the ROLLO iron sheets. The market survey revealed that the volume of goods was low and linked the goods to one importer, the Cover Up Company. Keeping this in mind, the Rooftop Company decided to send a cease-and-desist letter to the importer, Cover Up Company. Discussions ensued. An agreement was finally found between the parties, allowing the importer, Cover Up Company, to become an official distributor of Rooftop Company for the ROLLO iron sheets.

The Rooftop Company also recorded its trade mark in Kenya with the ACA, given that the goods were likely imported from Kenya.

In Namibia, the trade mark application for ROLLOS was refused (examination for relative grounds) for being highly similar to Rooftop Company's ROLLO trade mark.

Lessons learned

- A market survey is an essential tool and a must before initiating proceedings in Uganda. Although it is not always possible to ascertain the identity of the importer(s) of the goods, the market survey will always provide valuable information as to the volume of counterfeits, the areas where counterfeits are being sold, and the price point.
- It is essential to consider the route counterfeits take. Uganda is a landlocked country, and goods must either be manufactured locally or imported through neighbouring countries (especially heavy goods). Where goods are imported from or through neighbouring countries, acting in the neighbouring countries might effectively stop the supply of infringing goods.



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- There are many ways to fight infringement of a registered trade mark in Uganda. Both civil and criminal suits are possible. Civil prosecution allows for several remedies, including Anton Pillar orders, account for profits, damages, and injunctions against infringers.
- Before initiating a court case based on trade mark infringement, it is important to consider the use requirement. Companies that have a trade mark, but which they are not using, must be aware of the use requirement before filing a suit.
- At times, innovative solutions rather than a court case suit the client's needs better. This is particularly the case where goods sold by the unauthorised person are not sold on the market by the rightful trade mark owner (in this case the risk that the trade mark owner will lose the court action due to non-use is relevant). At times, infringers are interested in selling genuine products. They know the value of the trade mark and the products, and they have built a market and created a solid network.

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