

Well-known trade marks recognised in Tanzania

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On 4 February 2021 judgement was handed down by the High Court of Tanzania, Dar Es Salaam, against JP Decaux Tanzania Limited finding that it had infringed the Plaintiff's name JC Decaux, with an order of both punitive and general damages in Commercial Case no. 155 of 2018 JC Decaux / JC Decaux Tanzania Limited vs JP Decaux Tanzania Limited.

The judgement acknowledges well-known trade marks in Tanzania thereby extending the scope of Sections 31 and 32 of The Trade and Service Marks Act, Tanzania in terms of which a registered trade mark proprietor has an "exclusive right" and the unauthorised use of a mark that is deemed identical or confusingly similar to that registration constitutes an infringement.

The general principle remains that the registration of a trade mark in a certain country confers protection in respect of that particular country and, although the Plaintiff did not at that time have a registered trade mark in Tanzania, various other factors were considered in finding in its favour.

The burden of proof for well-known status of a trade mark is high, with the courts requiring substantial evidence taking into account certain factors. The general principle for Paris Convention member countries is that a mark granted well-known status enjoys broader protection than an ordinary mark in that country.

Background

The Plaintiff is a family owned business, established in France by Jean Claude Decaux in 1964. The subsidiaries that comprise the **JC Decaux Group** operate an outdoor or home advertising business in over 4 000 cities in more than 80 countries including Tanzania.

The Defendant was a limited liability private company incorporated in Tanzania under the Companies Act, 2002 in 2014 as **JP Decaux Tanzania Limited** operating an outdoor advertising business.

In July 2015 the Plaintiff, JC Decaux, succeeded in a domain name complaint with the online ADR Centre of Czech Arbitration Court against the Defendant's registration of the domain name JPDecaux.com on the grounds that the domain name is similar to the Plaintiff's trade mark JC Decaux. In October 2015 the Plaintiff succeeded in another domain name complaint with the World Intellectual Property Organisation (WIPO) against the domain name registration of Tanzania cTLD, JPDecaux.tz. Although not registered by the Defendant, the domain name JPDecaux.tz featured on the Defendant's website.

The Defendant contended that the Plaintiff's trade mark JC Decaux was registered after its incorporation as JP Decaux Tanzania Limited by the Business Registration and Licensing Agency (BRELA) and its name is therefore protected under the Companies Act, 2002.

In finding in favour of the Plaintiff, JC Decaux, the Court's considerations included:

- Evidence that JC Decaux is not only known worldwide but that it also bears the family name of its founder Mr Jean Claude Decaux, founded in 1964;
- The Plaintiff has registered the trade mark JC Decaux in at least twenty eight other countries;
- Evidence of sales adduced by the Plaintiff in Tanzania;

- The favourable domain name decisions against JPDecaux.com and JPDecaux.tz;
- The Defendant failed to provide any justification or a sufficient explanation as to why he decided on the name JP Decaux;
- That the similarity of the Defendant's name to the first Plaintiff's trade mark, differing by only one letter "**P**" vs "**C**" as well as the type of business, namely outdoor advertising, cannot merely be coincidence;
- The incorporation of the company name JP Decaux and the fact that it is registered by the Business Registration and Licensing Agency (BRELA) with the result that it is protected under the Company's Act, 2002 does not infer that the registration thereof is acceptable and permitted.

The judgement restates the principle that although a trade mark is territorial one cannot acquire or assume another entity's trade mark if that trade mark is in fact well-known, albeit that it is not registered in that particular territory. This High Court recognition of well-known marks in Tanzania should be welcomed by brand owners, particularly those with a significant footprint in Africa.

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