

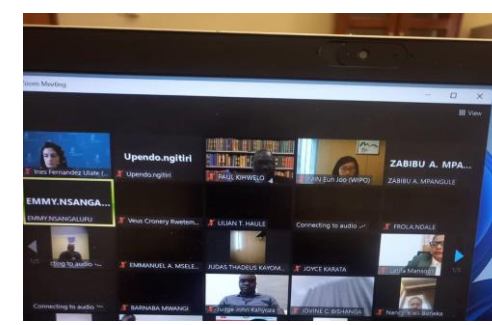


A COMPILATION OF PRESENTATIONS MADE DURING THE JUDICIAL COLLOQUIUM ON COPYRIGHT, TRADEMARKS AND MEDIATION OF IP DISPUTES FOR THE JUDICIARY OF TANZANIA HELD FROM 28TH FEBRUARY TO 2ND MARCH, 2023.

The Judicial Colloquium was organized by the World Intellectual Property Organization (WIPO) in collaboration with the Judiciary of the United Republic of Tanzania, as a part of the implementation of the Memorandum of Understanding executed in 2021.

During the colloquium, the national and international intellectual property experts from WIPO, the Berkeley Judicial Institute, USA, the University College London, UK, the Judiciary of Tanzania and the Judiciary of Kenya presented practical aspects and case studies on Intellectual Property Rights. It is with great honour these materials were compiled for your reference.

Ms. Upendo Ngitiri



OPENING REMARKS

The Colloquium was inaugurated by his Lordship the Principal Judge of the High Court of United Republic of Tanzania, Honorable Justice Mustapher Mohamed Siyani.

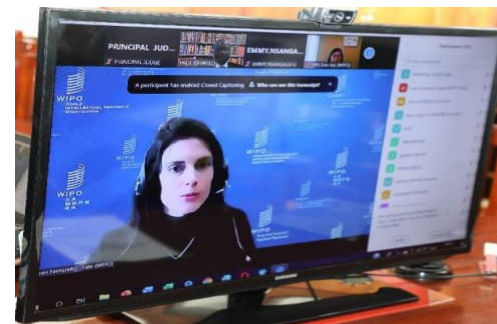
In his acclaimed opening speech, he conveyed the Judiciary of Tanzania's gratitude and profound thanks to the WIPO for their generous financial and technical support offered in various collaborative endeavors undertaken since 2019. He thanked the WIPO Judicial Institute and WIPO Arbitration and Mediation Centre for organizing the fruitful judicial colloquium for members of the Judiciary of Tanzania.

He also reaffirmed the Judiciary of Tanzania's commitment in building capacity of its Judicial Officers and strengthening cooperation with WIPO for the development of a vibrant and sustainable IP and innovation ecosystem in Tanzania.



LIST OF PRESENTATIONS AND PRESENTERS

1. WIPO's work with Judiciaries and International and Regional IP Legal Framework: Inés Fernández Ulate, Legal Officer, WIPO Judicial Institute, IP and Innovation Ecosystems Sector, WIPO, Geneva, Switzerland.
2. Innovation and IP: The Judicial Role: Hon. Judge Jeremy Fogel, Executive Director, Berkeley Judicial Institute; Former Judge; Former Director, Federal Judicial Center, California, United States of America.
3. Nature of Trademarks and Requirements for Registrations: Hon. Dr. Paul Kihwelo, Justice, Court of Appeal, Dar es Salaam, United Republic of Tanzania and Principal, Institute of Judicial Administration.
4. Rights Arising from Trademark Registration: Prof. Ilanah Fhima, Professor of Intellectual Property Law; Faculty of Laws, University College London, London, United Kingdom.
5. Trademark Issues in the United Republic of Tanzania and National Jurisprudence: Hon. Dr. Paul Kihwelo, Justice, Court of Appeal, Dar es Salaam, United Republic of Tanzania and Principal, Institute of Judicial Administration.



LIST OF PRESENTATIONS AND PRESENTERS

6. Nature of Copyright and Obtaining Protection: Hon. Dr. Adam Mambi, Judge, High Court of Tanzania, Dodoma, United Republic of Tanzania.
7. Rights Conferred by Copyright Protection: Hon. Francis Tuiyott, Judge, Commercial and Tax Division, High Court, Nairobi, Kenya.
8. Copyright Infringement: Hon. Francis Tuiyott, Judge, Commercial and Tax Division, High Court, Nairobi, Kenya.
9. Trends in Copyright Litigation in the United Republic of Tanzania and National Jurisprudence: Hon. Upendo Ngitiri, Senior Resident Magistrate, Directorate of Case Management, Judiciary of Tanzania.
10. Adjudicating IP Disputes and Trends in IP Case Management: Hon. Judge Jeremy Fogel, Executive Director, Berkeley Judicial Institute; Former Director, Federal Judicial Center, California, United States of America
11. WIPO Mediation including Online Conduct of Mediation Proceedings: Heike Wollgast, Head, IP Disputes Section, WIPO Arbitration and Mediation Center, and Chiara Accornero, Legal Officer, IP Disputes Section, WIPO Arbitration and Mediation Center, WIPO, Geneva, Switzerland.

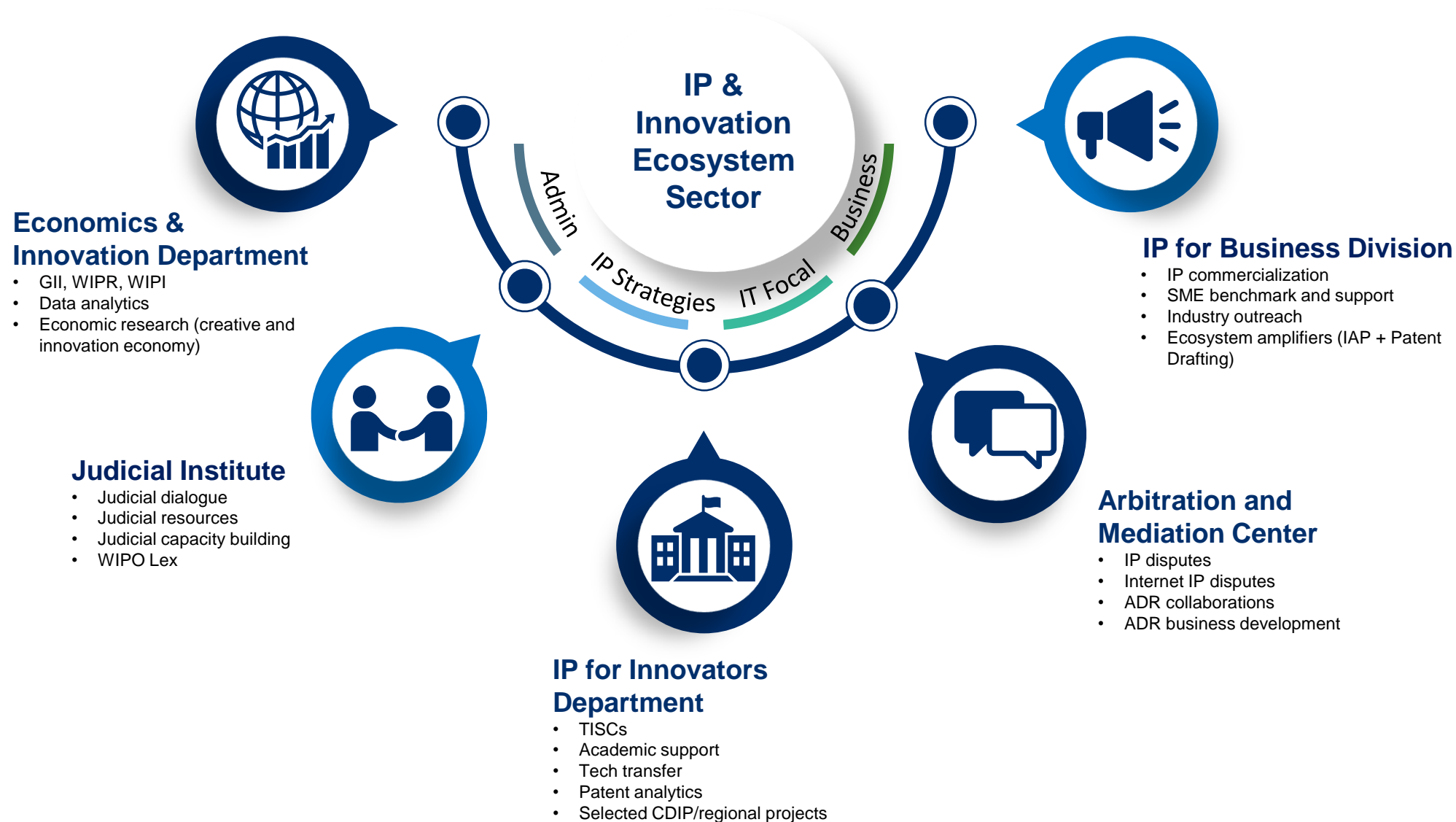
WIPO's Work with Judiciaries

Inés Fernández Ulate

Legal Officer, WIPO Judicial Institute
IP and Innovation Ecosystems Sector

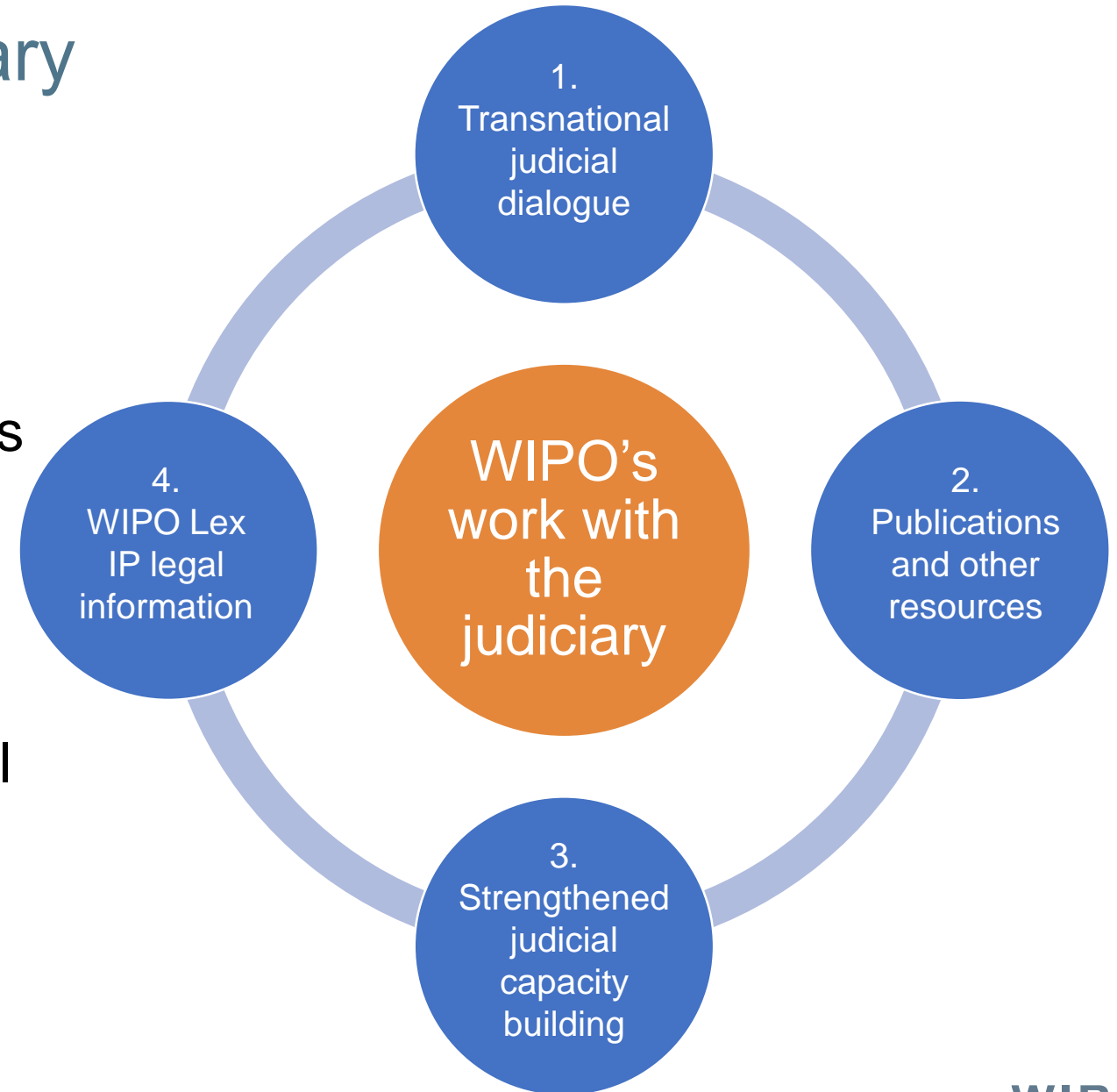


WIPO helps Member States develop their IP and innovation ecosystems to drive enterprise and economic growth



WIPO's work with the judiciary

- Empowers judiciaries to fulfill their vital role in ensuring that IP, innovation and creative ecosystems are balanced and effective
- Contributes to providing IP-related legal knowledge to a wider, general audience



WIPO's work with the judiciary

■ Overarching principles

1. Recognition of the diversity of national judicial structures and approaches across the Organization's membership
2. Emphasis on national ownership and sustainability
3. Prioritization of judicial perspectives through regular consultation with members of the WIPO Advisory Board of Judges

<https://www.wipo.int/about-ip/en/judiciaries/>

The screenshot shows the WIPO website's 'Judiciaries and Intellectual Property' page. The header includes the WIPO logo and navigation links: IP Services, Policy, Cooperation, Resources, About IP, and About WIPO. A search bar is located on the right. The main content area features a section titled 'Judiciaries and Intellectual Property' with a sub-header 'WIPO empowers judiciaries to fulfill their vital role in ensuring that intellectual property (IP), innovation and creative ecosystems are balanced and effective.' Below this, a paragraph describes the WIPO Judicial Institute's work with judges. A 'FEATURED' section on the right shows a 'WIPO Lex' logo with the text 'Connect to WIPO Lex to access our Laws, Treaties and Judgments collections'. Further down, the 'WIPO Advisory Board of Judges' section states that the work is guided by an Advisory Board of Judges who represent broad geographical and technical coverage. A 'News' section lists recent reports, including the 'HCC-IP Report on Identifying Actual and Practical Issues of Private International Law in Cross-Border IP Dealings' and the 'Report of the 2022 WIPO IP Judges Forum'. An 'Email updates' section promotes the 'WIPO Docket Newsletter'. At the bottom, there are three featured events: 'WIPO IP Judges Forum', 'Master Class on IP Adjudication', and 'WIPO Webinars for Judges'.

WIPO Advisory Board of Judges (2023-2024)

(Serving in their personal capacity)



Rian Kalden

Senior Judge, Court of Appeal, The Hague, Netherlands;
Presiding Judge, Second Panel of the Court of Appeal, Unified Patent Court (Chair)



Nehad Al Husban

President, Amman Court of First Instance, Jordan



Olayinka Faji

Justice, Federal High Court, Abuja, Nigeria



Angel Galgo Peco

President, Commercial Law Section, Court of Appeal of Madrid, Spain



Dedar Singh Gill

High Court Judge, Supreme Court of Singapore



Hugo R. Gómez Apac

President, Court of Justice of the Andean Community



Zane Pētersone

Judge, Supreme Court, Riga, Latvia



Jimmie V. Reyna

Circuit Judge, Court of Appeals for the Federal Circuit, United States of America



Zhu Li

Deputy Chief Judge, Intellectual Property Court of Supreme People's Court of China

Pillar 1: Transnational Judicial Dialogue

- WIPO Intellectual Property Judges Forum
- WIPO Master Class on IP Adjudication
- WIPO Webinars for Judges

1. Transnational judicial dialogue

WIPO Intellectual Property Judges Forum

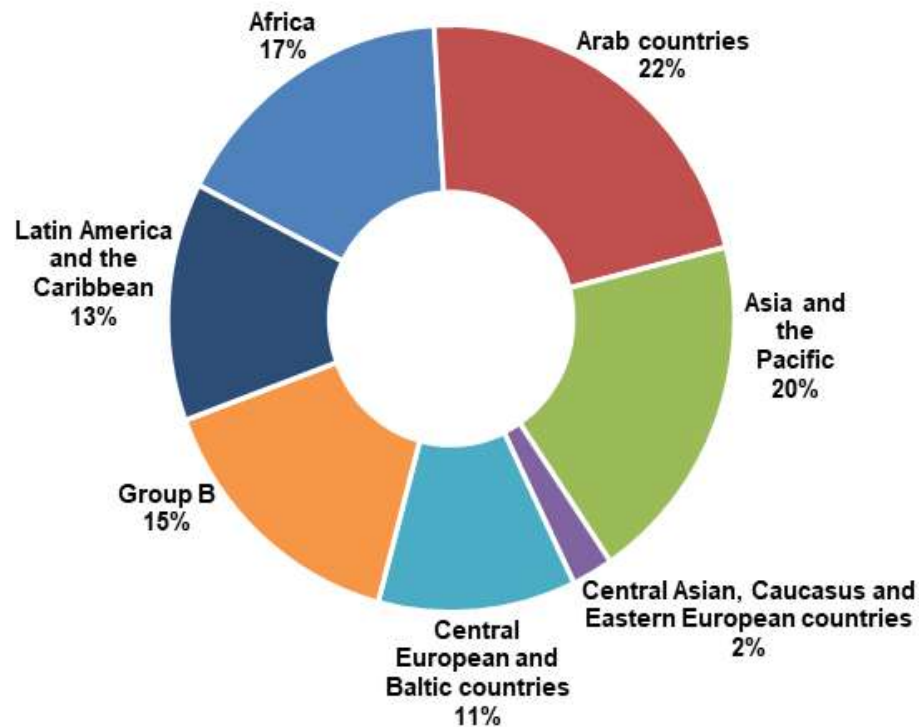
- A platform for judges to **exchange their expertise** on the most pressing IP challenges
- **Observe judicial approaches** of other countries and gain **empirical insight**
- **Inform and strengthen** courts' analyses and reasoning
- Discussions highlight not only the **convergences** in challenges faced across jurisdictions with different legal and judicial systems, but also the **distinct contrasts and variations** to be acknowledged and understood
- **Forum reports** available in 6 languages

Participants in the 2022 WIPO IP Judges Forum

November 16 to 18, 2022

*381 judges from 99 countries and
3 regional courts*

Geographical distribution of all participants



Save the date!

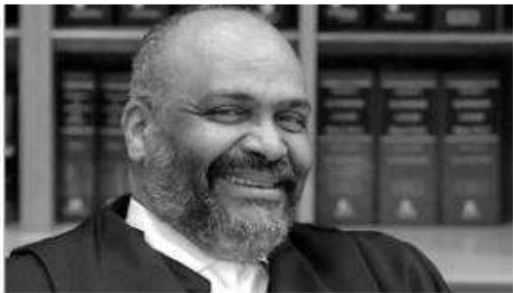
2023 WIPO Intellectual Property Judges Forum

November 15 and 16, 2023

1. Transnational judicial dialogue

Master Classes on IP Adjudication

- Global connections among judges with a higher level of IP expertise
- Opportunity to partner with a national court
 - 2018: Supreme People's Court of China
 - 2019: U.S. Court of Appeals for the Federal Circuit
 - 2023: Federal Court of Justice and Ministry of Justice of Germany



"Judicial conversations across borders are always immensely helpful. One begins to share thinking, experiences. While the law differs in many countries, the judges' approaches are by and large the same. We deal with text, the evidence, we have to interpret legislation."

— Judge Vincent Saldanha, South Africa



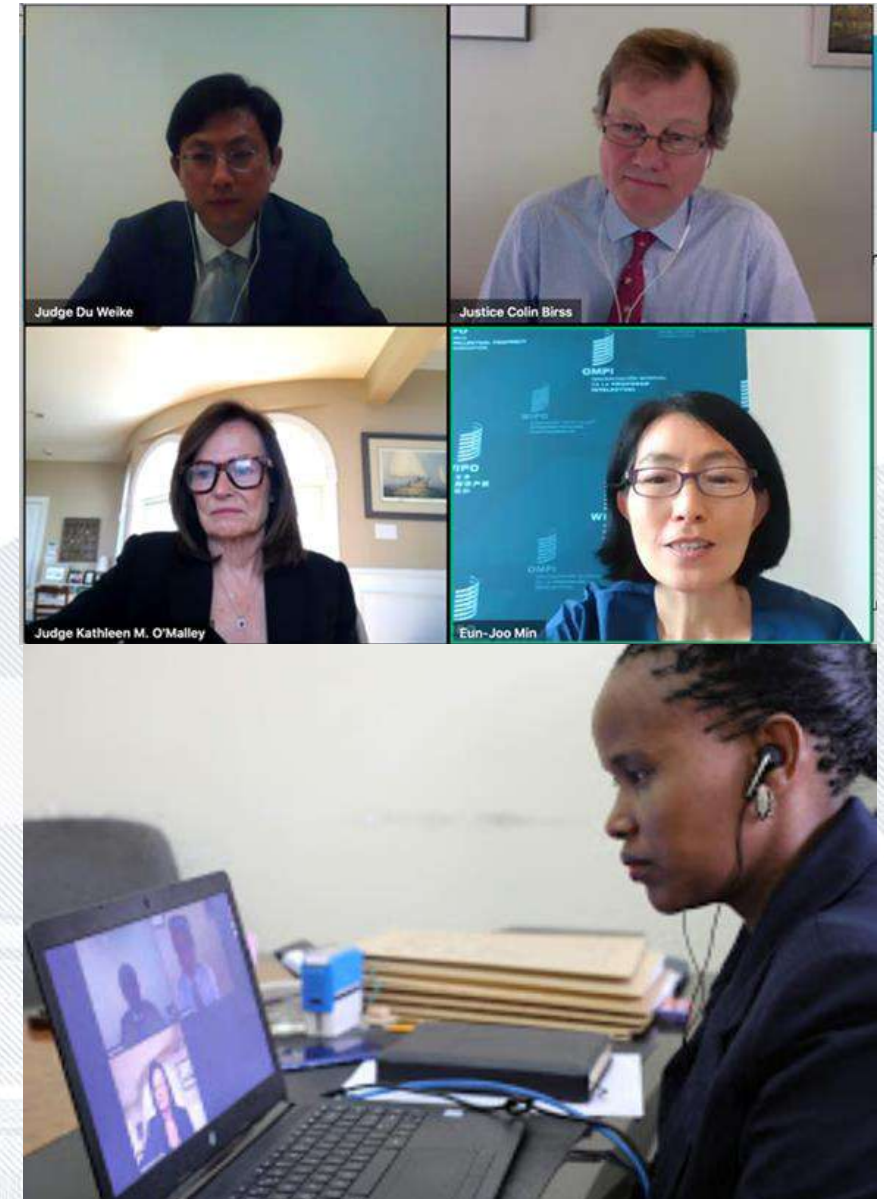
"I'm taking away a lot of personal contacts, and a general overview of the substance, and seeing that most of us struggle with the same issues, and actually the approaches are very equal between different countries. It's useful in the sense that when I read in a foreign judgment, I will be able to understand how it compares to my jurisdiction."

— Judge Sam Granata, Belgium

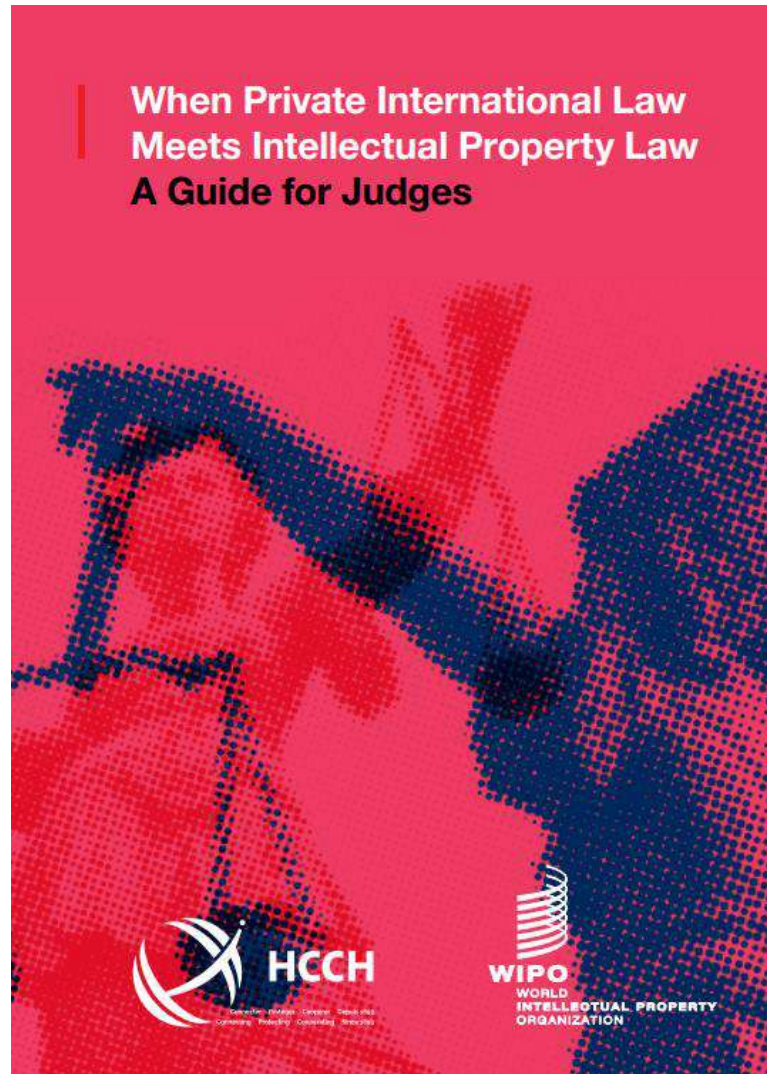
1. Transnational judicial dialogue

WIPO Webinars for Judges

- May 5, 2020: Delivering Justice for IP Cases during Covid-19 Confinement and Beyond
- July 1, 2020: Laying the Boundaries of Patentability in Computer-Implemented Inventions
- September 1, 2020: Tailoring Injunctions to Address IP Infringement in the Digital Environment
- June 2, 2021: Evaluating Similarity of Trademarks and Likelihood of Confusion in the Caribbean Region
- September 30, 2021: Protection of Works of Applied Art in Copyright
- July 6, 2022: Artificial Intelligence (AI) Inventorship in Patents
- September 7, 2022: Trade secrets and patents – alternatives or complements?



2. Publications and Other Resources



IDENTIFYING ACTUAL AND PRACTICAL ISSUES OF PRIVATE INTERNATIONAL LAW IN CROSS-BORDER INTELLECTUAL PROPERTY DEALINGS

Report

December 2022

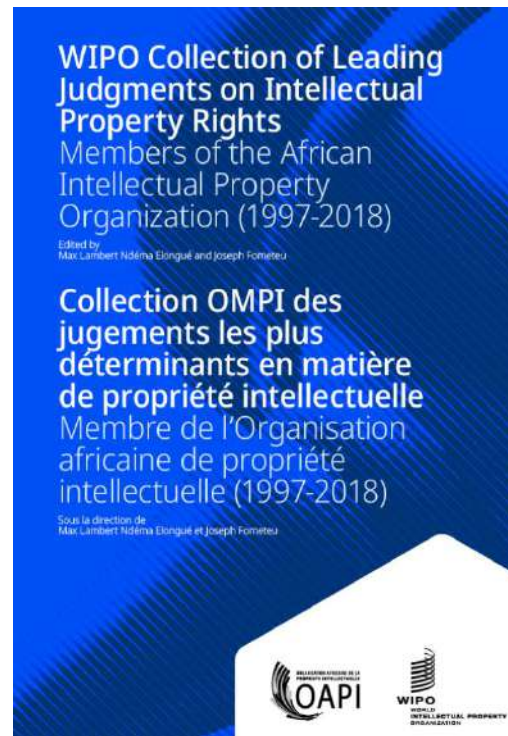
2. Publications and Other Resources

WIPO Collection of Leading Judgments on Intellectual Property Rights

China (2019)



OAPI (2023)



WIPO Intellectual Property Benchbook: Philippines and Viet Nam, supported by the Federal Court of Australia (2023)



3. Strengthened Judicial Capacity Building

- **Principles**

1. National ownership
2. Respect for the judicial function and national needs
3. Sustainability
4. Modern, multidisciplinary and participatory training approach

- **Objectives**

1. Deliver self-sustaining, continuing programs
2. Develop the capacity and skills of judges to adjudicate IP disputes efficiently
3. Enable new judges to gain an initial understanding of IP and experienced judges to receive updated information

- Collaboration with National Judicial Authorities and assessment of national needs

3. Strengthened Judicial Capacity Building

■ National Needs

1. Growing IP docket in the national courts
2. Legislative reforms that affect the adjudication of IP disputes
3. Adoption of National IP Strategies
4. Fast-changing technological, economic and societal context of IP disputes

■ Deliverables

1. Access to the WIPO Academy General Distance Learning Course on IP for the Judiciary
2. Implementation of a Train-the-Trainers program
3. Access to generic reference materials
4. Development of customized reference materials
5. Implementation of single training events on specific topics, in response to time sensitive training needs

3. Strengthened Judicial Capacity Building

- **WIPO Academy Distance Learning Course on IP for the Judiciary**

- 300 judges from Egypt
- 66 judges from the United Republic of Tanzania
- Judges from Lusophone countries

- **Targeted capacity building activities**

- Latvia (regional): September 5-6, 2022
- Dominican Republic: September 14, 21 and 28, 2022
- Morocco: September 29, 2022
- Uruguay (regional): October 31 to November 4, 2022
- Côte d'Ivoire (regional): December 5 to 8, 2022
- Lusophone Countries: January 25 and 26, 2023

Pillar 4: Information on laws, decisions and judicial systems on IP

- WIPO Lex

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WIPO Lex Database Search

WIPO Lex provides free of charge access to legal information on intellectual property from around the world. Use WIPO Lex Database Search to access 48000 legal documents from among our Laws, Treaties, and Judgments collections.

Laws

Treaties

Judgments

Full Text Search

WIPO/WTO/UN Members

Select a Member

Subject Matter

Select a Subject Matter

Type of Text

Select Type of Text

Date of Text
(Search Date of Adoption, Entry into Force, etc.)

From

Format: DDMMYYYY

To

Format: DDMMYYYY

WIPO Lex Publication Date

From

Format: DDMMYYYY

To

Format: DDMMYYYY

Search in Title/Notes

Use quotes for phrase match plus AND/OR operators to create complex queries

Include superseded/repealed laws

☐

Search




Reset

- + 16,000 legal records
- + 40,000 legal documents
- Legislation of 199 States and entities
- 785 international treaties on IP

WIPO Lex Collections

- Three Collections: Laws, Treaties, Judgments
- Organized by Member State/Organization
- Flexible Search Options:

<https://wipolex.wipo.int/>

Laws	Treaties	Judgments
 <small>(PHOTO: BRIAN JACOBSON/ISTOCK/GETTY IMAGES)</small>	 <small>(PHOTO: X.DREW/ISTOCK/GETTY IMAGES)</small>	 <small>(PHOTO: MARILYN NEVILL/ISTOCK/GETTY IMAGES)</small>
IP Legislation by Jurisdiction Collection of IP laws, rules, and regulations of the member states of WIPO, the World Trade Organization (WTO), and the United Nations (UN).	WIPO-Administered Treaties WIPO administers 26 treaties at the international level, touching on a wide range of IP-related topics.	IP Judgments by Jurisdiction Leading IP judgments establishing precedent or persuasive interpretations, curated by participating WIPO member states.
WIPO-WTO Common Portal Access point for national IP offices and national trade offices of WIPO, WTO, and UN members for the submission of IP laws, rules, and regulations.	IP-related Treaties Collection Collection of IP-related treaties involving a variety of international actors.	WIPO's Work with Judiciaries WIPO works with judges from around the world to create a space for dialogue and exchange of information and practices, to deliver capacity building activities, and to increase the availability of information about IP and courts.
	Treaty Parties IP-related treaties organized by Party.	
	Treaty Hosts IP-related treaties organized by Host Institution.	

LAWS COLLECTION SEARCH RESULTS

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WIPO/WTO/UN Members
[United Republic of Tanzania](#)

Total
34 records displayed

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Type Law Title



► SUBJECT MATTER

► TYPE OF TEXT (LAWS)

► CONSTITUTION/BASIC LAW [3 TEXTS]

▼ LAWS/REGULATIONS [29 TEXTS]

Type of Text ↕	Version ▼	Title ↕	Subject Matter
Implementing Rules/Regulations	2020	The Copyright and Neighbouring Rights (Compounding of Offences) Regulations, 2020	Copyright and Related Rights [Neighboring Rights]
Implementing Rules/Regulations	2016	The Copyright and Neighbouring Rights (Copyrighted Works-communication to the Public) Regulations, 2015	Copyright and Related Rights [Neighboring Rights]
Implementing Rules/Regulations	2015	The Zanzibar Industrial Property Regulations, 2014	Geographical Indications, Industrial Designs, Industrial Property, Layout Designs of Integrated Circuits, Patents (Inventions), Trademarks, Utility Models
Main IP Laws	2015	Zanzibar - Plant Breeders' Rights Act, 2014 [Act No. 1 of 2014]	Plant Variety Protection
Main IP Laws	2013	Mainland Tanzania - Plant Breeders' Rights	Plant Variety Protection

WIPO Lex-Judgments

- Launched in September 2020
- **Participating jurisdictions:** Albania, Australia, Benin, Brazil, Burkina Faso, Cameroon, Chile, China, Congo, Costa Rica, Côte d'Ivoire, Egypt, Gabon, Jamaica, Japan, Lithuania, Mexico, Niger, Peru, Philippines, Republic of Korea, Senegal, Spain, Togo, United Kingdom, [United Republic of Tanzania](#), United States of America, Andean Community
- Other jurisdictions in the process of joining
<https://wipolex.wipo.int/en/main/judgments>

JUDGMENTS COLLECTION SEARCH RESULTS

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Country/Regional Organization

[United Republic of Tanzania](#)

Total

41 Citations

Date of Judgment ▾	Issuing Authority ↕	Citation ↕	Subject Matter ↕	WIPO Lex No. ↕
September 23, 2021	High Court of Tanzania	Hamisi Mwinyijuma and Ambwene Yesaya v TIGO Company Ltd., Civil Case No. 38 of 2011, High Court of Tanzania at Dar es Salaam	Copyright and Related Rights (Neighboring Rights)	TZ013-j
July 2, 2021	High Court of Tanzania	Multichoice Tanzania Limited v Maimuka K. Kiganza, Civil Appeal No. 166 of 2020, High Court of Tanzania at Dar es Salaam	Copyright and Related Rights (Neighboring Rights)	TZ023-j
April 27, 2021	High Court of Tanzania	Godrej Consumer Products Limited v Target International (T) Limited, Commercial Case No. 60 of 2019, High Court of Tanzania, Commercial Division at Dar es Salaam	Trademarks	TZ011-j
April 1, 2021	High Court of Tanzania	Rig Co. Limited Water Com Tanzania v Watercom Tanzania Limited, Civil Case No. 150 of 2018, High Court of Tanzania at Dar es Salaam	Trademarks	TZ028-j
November 20, 2020	High Court of Tanzania	MIC Tanzania Limited v Hamisi Mwinyijuma and Ambwene Yesaya, Civil Appeal No.112 of 2019, High Court of Tanzania at Dar es Salaam	Copyright and Related Rights (Neighboring Rights)	TZ024-j
July 2, 2020	High Court of Tanzania	Godrej Consumer Products Limited v Targent International (T) Limited, Miscellaneous Commercial Application No. 54 of 2019, High Court of Tanzania, Commercial Division at Dar es Salaam	Trademarks	TZ010-j

Cooperation with judicial and quasi-judicial bodies

- MoU/Joint Statements with the Supreme People's Court of China, the Patent Court of Korea, Supreme Court of Justice of Paraguay, Judiciary of the United Republic of Tanzania, Central Intellectual Property and International Trade Court (CIPITC) of Thailand, the Higher Institute of Magistracy of Morocco
- Collaboration Agreements for Continuing Judicial Education
- Collaboration Agreements for WIPO Lex-Judgments
- Informal exchanges:
 - Federal Patent Court of Switzerland
 - Caribbean Court of Justice
 - Association of the Court of Appeal Judges of Finland
 - China National Judges College



International and Regional Legal Framework – Trademarks and Copyright

Inés Fernández Ulate

Legal Officer, WIPO Judicial Institute
IP and Innovation Ecosystems Sector



International Legal Framework

Trademarks	Copyright and Related Rights
Paris Convention for the Protection of Industrial Property (1883)	Berne Convention for the Protection of Literary and Artistic Works (1886)
Madrid System Concerning the International Registration of Marks (1891)	International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations (Rome Convention) (1961)
Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957)	WIPO Copyright Treaty (WCT) (1996)
	WIPO Performances and Phonograms Treaty (WPPT) (1996)
	Marrakesh Treaty to facilitate Access to Published Works for Persons Who are Blind, Visually Impaired, or Otherwise Print Disabled (2013)
	Beijing Treaty on Audiovisual Performances (2012)
Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) (1994)	

Paris Convention

- Applies to industrial property in the widest sense.
- The substantive provisions of the Paris Convention fall into three main categories:
 - **National treatment (Arts. 2-3);**
 - **Right of priority (Art. 4);** or
 - **Common rules:** With regard to trademarks, the Paris Convention does not regulate the conditions for filing and registration of marks, which are determined by the domestic law.
- The United Republic of Tanzania is a Contracting Party of the Paris Convention since June 26, 1963.



1873 World's Fair: Rotunda with south portal. – © Wien Museum

Paris Convention

National treatment

Article 2

National Treatment for Nationals of Countries of the Union

(1) Nationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals; all without prejudice to the rights specially provided for by this Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with.

(2) However, no requirement as to domicile or establishment in the country where protection is claimed may be imposed upon nationals of countries of the Union for the enjoyment of any industrial property rights.

(3) The provisions of the laws of each of the countries of the Union relating to judicial and administrative procedure and to jurisdiction, and to the designation of an address for service or the appointment of an agent, which may be required by the laws on industrial property are expressly reserved.

Article 3

Same Treatment for Certain Categories of Persons as for Nationals of Countries of the Union

Nationals of countries outside the Union who are domiciled or who have real and effective industrial or commercial establishments in the territory of one of the countries of the Union shall be treated in the same manner as nationals of the countries of the Union.

Paris Convention

Right of priority

- **Article 4**
- On the basis of a regular application for trademark protection filed by a given applicant in one of the member countries, the same applicant may, within 6 months, apply for protection in all the other member countries.
- The later applications will be regarded as filed on the same day as the first application.

Paris Convention

Common rules in trademarks

- Use of trademarks – Art. 5C(1), (2) and (3)
- Concurrent use of the same trademark – Article 5C(3)
- Grace period for the payment of renewal fees – Article 5*bis*
- Independence of trademarks – Article 6
- Well-known marks – Article 6*bis*
- State emblems, official hallmarks and emblems of international organizations – Article 6*ter*
- Assignment of trademarks – Article 6*quater*
- Protection of trademarks registered in one country, in other countries – Article 6*quinquies*
- Service marks – Article 6*sexies*
- Relationship between the agent and the proprietor – Article 6*septies*
- Nature of the goods – Article 7
- Collective marks – Article 7*bis*
- Trademarks shown at international exhibitions – Article 11

Nice Agreement

- Establishes the Nice Classification (NCL), an international classification of goods and services that is widely used around the world. A trademark application refers to a specific sign in connection with specific goods or services, or classes of goods or services, for which the applicant intends to use the sign.
- Classification is used to record the classes of goods or services in relation to which a sign is sought or registered. The Nice Classification may be used as a subsidiary classification in some countries.
- The United Republic of Tanzania is a Contracting Party of the Nice Agreement since September 14, 1999.

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EDITION-VERSION

12-2023

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☒ Basic No.

NCLPUB v3.2.44

Last modified: 2022.12.19

Classes

Alphabetical

Class Headings

General Remarks

Modifications

Search

Class 30

Coffee, tea, cocoa and substitutes therefor; rice, pasta and noodles; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; chocolate; ice cream, sorbets and other edible ices; sugar, honey, treacle; yeast, baking-powder; salt, seasonings, spices, preserved herbs; vinegar, sauces and other condiments; ice (frozen water).

Explanatory Note

Class 30 includes mainly foodstuffs of plant origin, except fruits and vegetables, prepared or preserved for consumption, as well as auxiliaries intended for the improvement of the flavour of food.

This Class includes, in particular:

- beverages with coffee, cocoa, chocolate or tea base;

- cereals prepared for human consumption, for example, oat flakes, corn chips, husked barley, bulgur, muesli;

- pizza, pies, sandwiches;

- chocolate-coated nuts;

- flavourings, other than essential oils, for food or beverages.

This Class does not include, in particular:

- salt for industrial purposes (Cl. 1);

- food or beverage flavourings being essential oils (Cl. 3);

- medicinal teas and dietetic food and substances adapted for medical use (Cl. 5);

- baby food (Cl. 5);

- dietary supplements (Cl. 5);

- yeast for pharmaceutical purposes (Cl. 5), yeast for animal consumption (Cl. 31);

- milk beverages flavoured with coffee, cocoa, chocolate or tea (Cl. 29);

- soups, bouillon (Cl. 29);

- raw cereals (Cl. 31);

- fresh herbs (Cl. 31);

- foodstuffs for animals (Cl. 31).

1

2

3

300244

agave syrup [natural sweetener]

300056

allspice

300138

almond confectionery

300004

almond paste

300006

aniseed

300263

apple sauce [condiment]

300011

aromatic preparations for food

300315

artificial sweeteners for culinary purposes

300317

aspartame for culinary purposes

300199

baking powder

300200

baking soda [bicarbonate of soda for cooking purposes] / bicarbonate of soda for cooking purposes [baking soda]

300231

baozi

300061

barley meal

300283

batter mixes

300058

bean meal

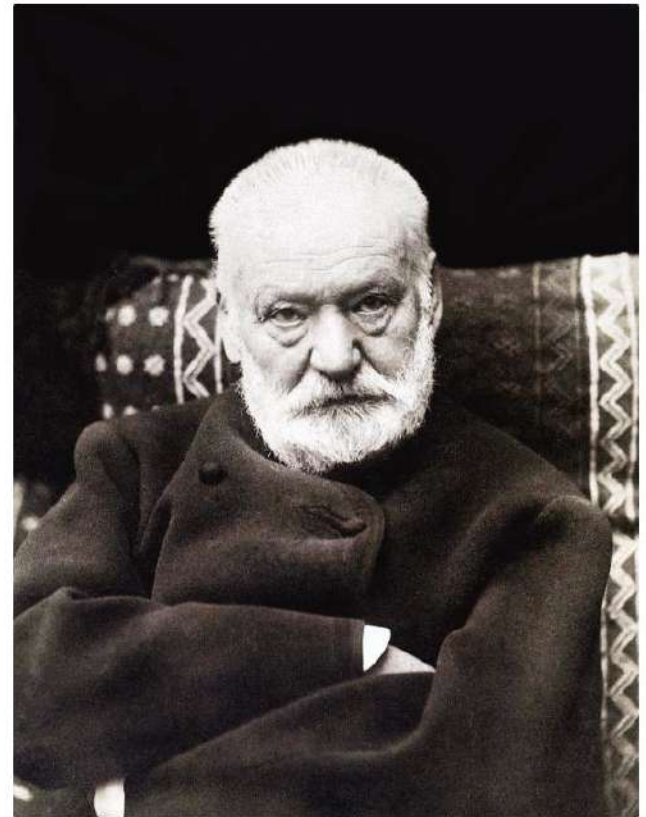
https://www.wipo.int/classifications/nice/nclpub/en/fr/

WIPO

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Berne Convention

- Adopted in 1886; 181 contracting parties (as at January 2023); United Rep. of Tanzania joined in 1994
- Deals with the protection of works and the rights of their authors
- Three broad principles:
 - Principle of national treatment
 - Principle of “automatic” protection
 - Principle of “independence” of protection
- Minimum standards of protection
- Duration of protection: life of the author + 50 years



Victor Hugo, photograph by Science Source

Berne Convention

Article 2. Protected Works

(1) The expression “literary and artistic works” shall include every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression, such as books, pamphlets and other writings; lectures, addresses, sermons and other works of the same nature; dramatic or dramatico-musical works; choreographic works and entertainments in dumb show; musical compositions with or without words; cinematographic works to which are assimilated works expressed by a process analogous to cinematography; works of drawing, painting, architecture, sculpture, engraving and lithography; photographic works to which are assimilated works expressed by a process analogous to photography; works of applied art; illustrations, maps, plans, sketches and three-dimensional works relative to geography, topography, architecture or science.

...

Berne Convention

- Exclusive economic rights
 - Translation of a work
 - Reproduction of a work
 - Public performance or recitation of a work and communication of such performance or recitation to the public
 - Broadcasting, or other wireless communication, of a work to the public
 - Adaptation and arrangement of a work
 - Cinematographic adaptation and reproduction of a work and distribution, as well as public performance or communication to the public by wire thereof
 - Receipt of an interest in resale of certain works (in certain countries)
- Moral rights

Berne Convention

- Limitations and exceptions (“free uses”)
 - The Berne Convention provides general conditions for the application of exceptions and limitations.
 - Forms of free uses:
 - Short quotations
 - News reporting
 - Teaching purposes
 - Ephemeral recordings for broadcasting purposes
 - Three-step test: general rule that Member States may provide for free reproduction in:
 1. Certain special cases where the acts
 2. Do not conflict with a normal exploitation of the work and
 3. Do no unreasonably prejudice the legitimate interests of the author
 - Nonvoluntary (compulsory) licenses

Marrakesh Treaty

- First multilateral copyright instrument on limitations and exceptions
- Mandatory limitations and exceptions for the benefit of persons who are blind, visually impaired and otherwise print disabled
- Permit reproduction, distribution and making available of certain published works in formats designed to be accessible to persons who are blind, visually impaired or otherwise print disabled
- Permit exchange of these works across borders by organizations that serve those persons



Image: WIPO/E. Berrod.

TRIPS Agreement

- The TRIPS Agreement (1994) binds Member States of the World Trade Organization (WTO) to further rules and obligations for IP rights in general
- It is administered by the WTO



Image of the WTO building in Geneva: wto.org

TRIPS Agreement

ANNEX 1C

AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS

PART I	GENERAL PROVISIONS AND BASIC PRINCIPLES
PART II	STANDARDS CONCERNING THE AVAILABILITY, SCOPE AND USE OF INTELLECTUAL PROPERTY RIGHTS
	<ol style="list-style-type: none">1. Copyright and Related Rights2. Trademarks3. Geographical Indications4. Industrial Designs5. Patents6. Layout-Designs (Topographies) of Integrated Circuits7. Protection of Undisclosed Information8. Control of Anti-Competitive Practices in Contractual Licences
PART III	ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS
	<ol style="list-style-type: none">1. General Obligations2. Civil and Administrative Procedures and Remedies3. Provisional Measures4. Special Requirements Related to Border Measures5. Criminal Procedures
PART IV	ACQUISITION AND MAINTENANCE OF INTELLECTUAL PROPERTY RIGHTS AND RELATED <i>INTER-PARTES</i> PROCEDURES
PART V	DISPUTE PREVENTION AND SETTLEMENT
PART VI	TRANSITIONAL ARRANGEMENTS
PART VII	INSTITUTIONAL ARRANGEMENTS; FINAL PROVISIONS

TRIPS Agreement

Trademarks

- Incorporates the protections under the Paris Convention for all Members of the World Trade Organization (WTO)
- Part II, Section 2 on Trademarks (Arts.15-21) clarifies and adds certain specific points:
 - Adds a definition of the signs that must be considered as capable of constituting a mark, which is any sign capable of distinguishing the goods and services of one undertaking from those of other undertakings shall be eligible for registration as a trademark
 - Expands the priority right to service marks
 - Clarifies that for signs which are not inherently distinctive, Member States may make registrability depend on distinctiveness acquired through use
 - Adds the possibility to Member States to require as a condition of registration of a mark, that a sign may be visually perceptible
 - Confirms that no ground for denial of a registration of a mark may "derogate" from the provisions of the Paris Convention
 - Adds that Members may not require use as a condition for filing an application for registration but may require use as a requirement for registration
 - Adds that Members may afford a reasonable opportunity for applicants to cancel the registration of a mark and for the registration of a mark to be opposed
 - Provides for the exclusive right to use by the owner of the registration and stipulates that Members States may provide limited exceptions to the rights, such as fair use of descriptive terms
 - Expands the application of Art. 6*bis* of the Paris Convention (well-known marks) to services
 - Prohibits any unjustifiable encumbrance of the use of a mark
 - Adds that the compulsory licensing of trademarks is not permitted
 - Adds that initial registration, and each renewal of registration of a trademark shall be for a term of no less than seven years

TRIPS Agreement

Copyright and Related Rights

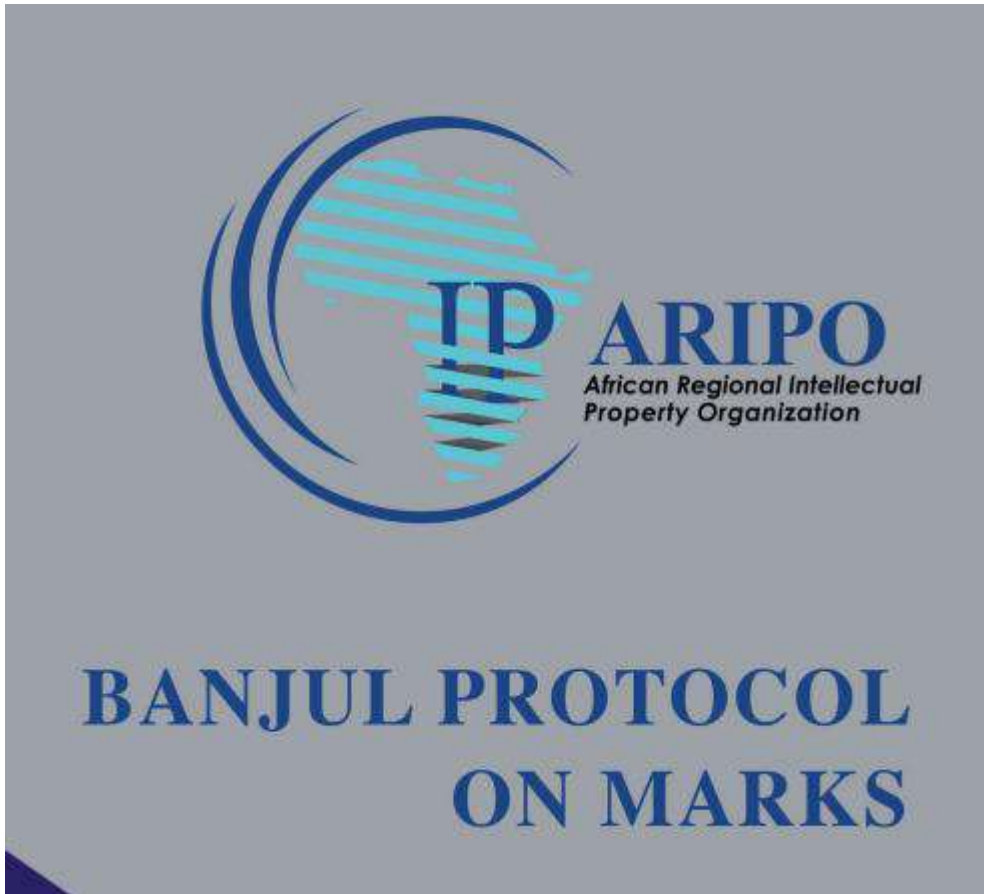
- Incorporates the protections under the Berne Convention for all Members of the World Trade Organization (WTO)
- Part II, Section 1 on Copyright and Related Rights (Arts. 9-14) clarifies and adds certain specific points:
 - Confirms that copyright protection shall extend to expressions and not to ideas, procedures, methods of operation or mathematical concepts as such
 - Provides that computer programs, whether in source or object code, shall be protected as literary works, and the form in which a program is, whether in source or object code, does not affect the protection;
 - Clarifies the protection due to databases and other compilations of data or other material
 - Sets a minimum term of protection applicable whenever the term of protection of a work is calculated on a basis other than the life of a natural person
 - Requires that limitations or exceptions to exclusive rights be confined to certain special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right owner

TRIPS Agreement Enforcement

- It provides for minimum compulsory standards and options for implementation in the national legislations
- The only set of enforcement rules in IP adopted at the multilateral level
- Provisions related to:
 - Provisional measures (injunctions)
 - Civil procedures and remedies
 - Criminal procedures
 - Border measures

Regional Framework

African Regional Intellectual Property Organization (ARIPO)



<https://www.aripo.org/wp-content/uploads/2022/12/Banjul-Protocol-on-Marks-2023-2.pdf>



AFRICAN REGIONAL INTELLECTUAL PROPERTY
ORGANIZATION (ARIPO)

KAMPALA PROTOCOL ON
VOLUNTARY REGISTRATION OF
COPYRIGHT AND RELATED
RIGHTS

<https://www.aripo.org/wp-content/uploads/2021/09/Kampala-Protocol-on-Voluntary-Registration-of-Copyright-and-Related-Rights-2.pdf>

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INNOVATION AND INTELLECTUAL PROPERTY: THE JUDICIAL ROLE

Hon. Jeremy Fogel (Ret.)

Executive Director, Berkeley Judicial Institute

University of California, Berkeley Law School



HOW LAW AFFECTS INNOVATION

Law *encourages innovation* by granting intellectual property rights- holders exclusivity for novel and inventive ideas and products

Law *improves the quality of innovation* by conditioning the grant of intellectual property rights on careful documentation and analysis of the ideas and products as to which rights are to be granted

Law *has a negative impact on both the quantity and quality of innovation* if it does too much or too little in either of these areas



CHALLENGES FOR JUDGES

Understanding the nature and scope of what is protected, especially in areas involving complexity, and determining whether an accused product infringes on those protections

Understanding the context in which infringement typically occurs

Evaluating the actions and state of mind of accused infringers

Determining the economic and other consequences of infringement and imposing an appropriate criminal penalty or money damages

Obtaining legally admissible evidence sufficient to make these determinations



THE IMPORTANCE THE JUDICIAL ROLE

The value of intellectual property rights depends in part on consistent and effective judicial case management

Effective judicial case management in turn depends upon knowledgeable judges

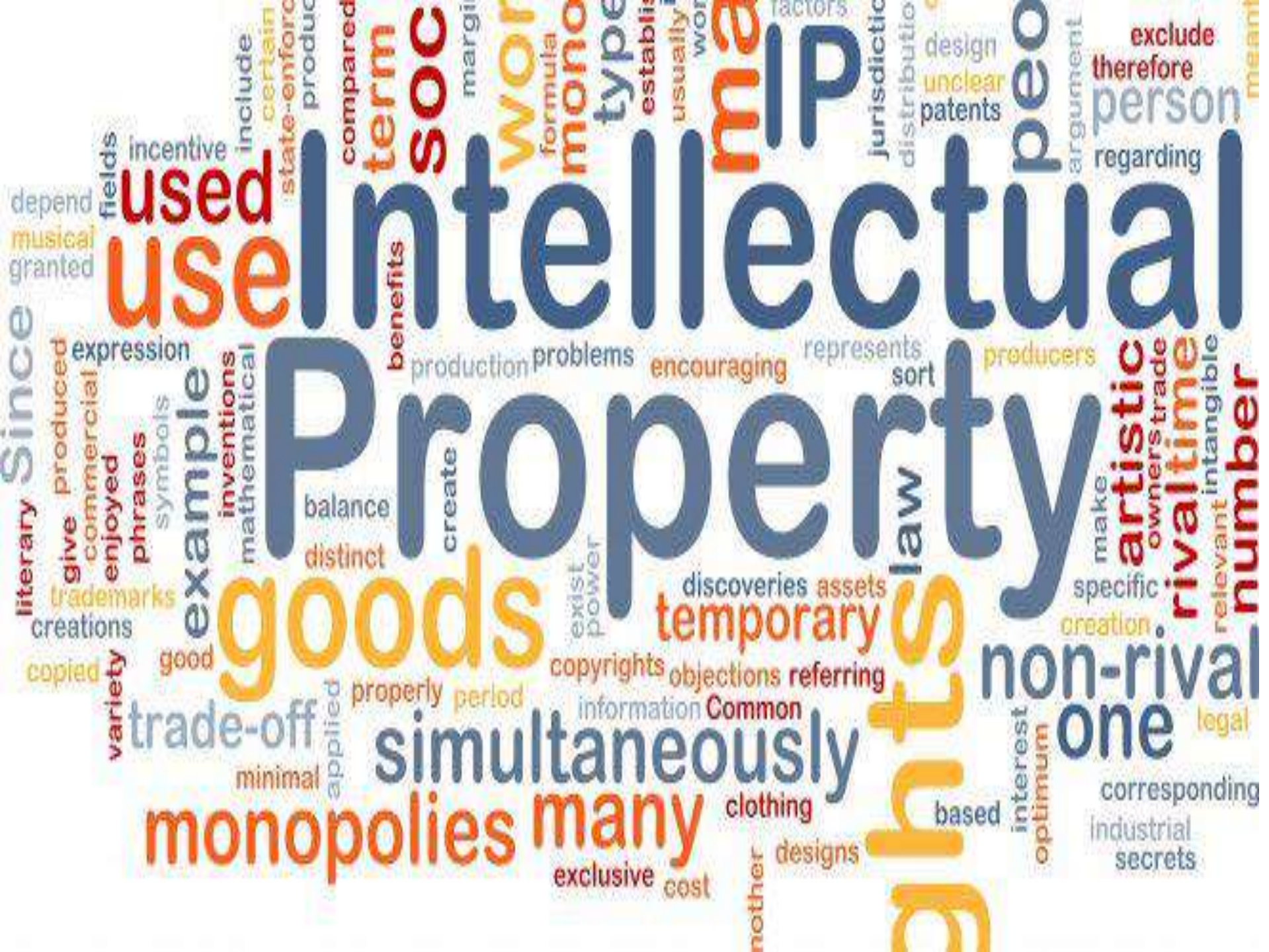
The absence of meaningful legal remedies for infringement discourages innovation and often permits substandard or dangerous goods to enter and remain in commerce



Nature of Trademarks and Requirements for Registration

A presentation done during the virtual Judicial Colloquium on Copyright, Trademarks and Mediation of IP Disputes for the Judiciary of the United Republic of Tanzania on 28th February, 2023

KIHWILO. P.F



The slide features abstract geometric designs. In the top right corner, two triangles in shades of blue and purple meet at a point. In the bottom left corner, there is a blue textured shape and a black line. In the bottom right, a teal triangle and a red triangle meet at a point, with a small dark red circle positioned near their intersection.

AGENDA

Precis

Meaning

Municipal Legal regime

Requirement for
registration

Summary

Precis

A trademark is a
company's persona
and identity in the
marketplace

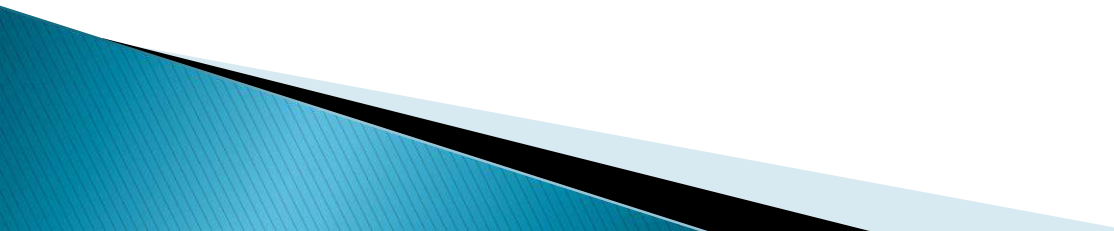


What is a Trademark?



What is a Trademark?

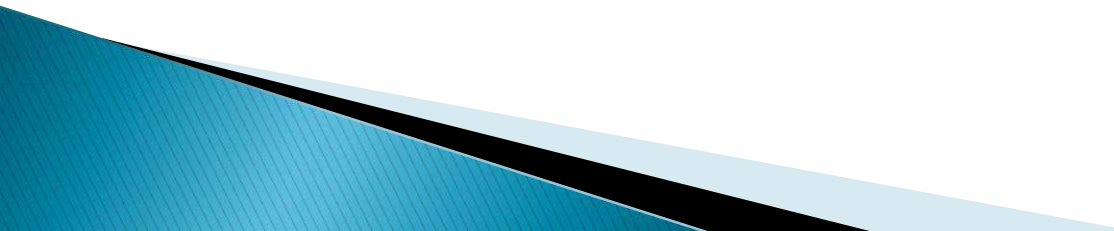
General definition

- ▶ A symbol, word, or words legally registered or established by use as representing products or services of the proprietor or owner.
 - ▶ A mark used or proposed be used by an individual in relation to goods or services for the purpose of distinguishing the goods or services in relation to which the mark is used from the same kind of goods or services.
- 

What is a Trademark?

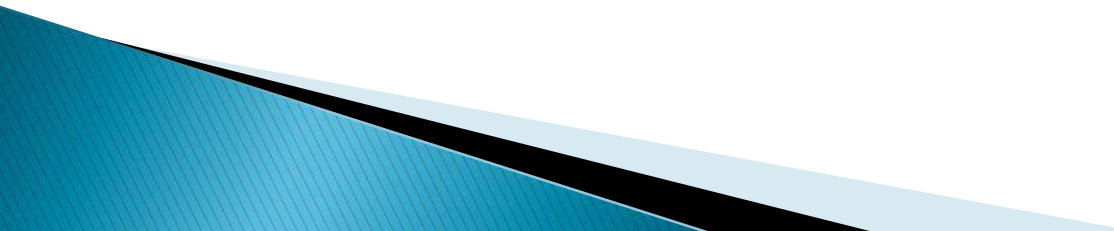
How does the Act define?

Section 2 of the Act defines trade or service mark to mean; **any visible sign** used or proposed to be used upon, in connection with or in relation **to goods or services** for the purpose of **distinguishing in the course of trade or business** **the goods or services of a person from those of another**



What is a Trademark?

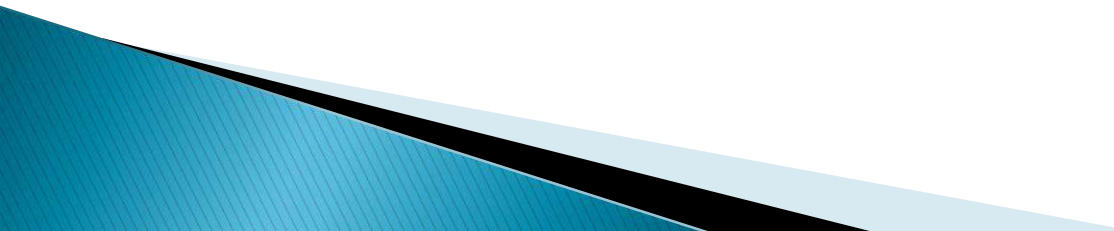
TRIPS Agreement definition

- Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings.....
 - The TRIPS Agreement definition is broad enough because the text is largely the result of several drafting compromises
- 

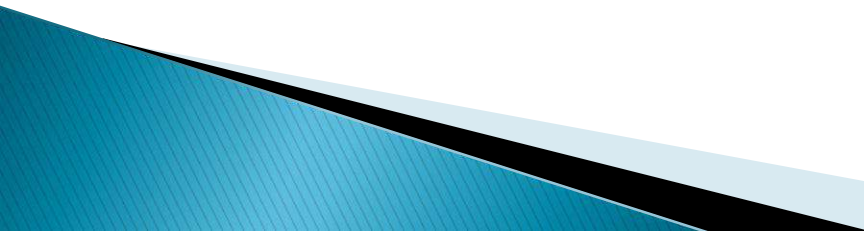
Types of Trademarks

- **Conventional Trademarks** – words, letters, numerals, pictorial devices and others.
- **Non-conventional Trademarks** – shape, colour, smells, sounds and others.


Trademark Legal Regime

- ▶ The trademark law in Tanzania as we know it today dates way back during the colonial administration.
 - ▶ During that time the then Tanganyika applied the common law liability (**now passing off**) as well as statutory liability (**now infringement**) in respect of trademark.
- 


Trademark Legal Regime

- ▶ On the other hand, the Merchandise Mark law was applied as against forged trade descriptions and false marking of goods.
 - ▶ Currently, the legal framework that governs trademarks is;
 - The Trade and Service Marks Act, Cap 326 R.E. 2002; and
 - The Merchandise Marks Act, Cap. 85 R.E. 2002
- 

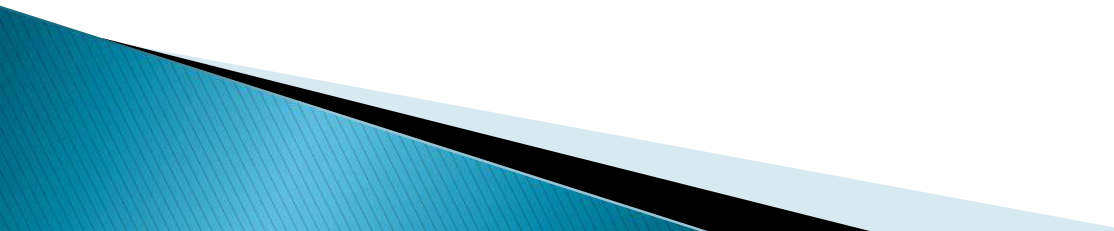
Trademark Legal Regime

- ▶ There is also in place;
 - The Trade and Service Marks Regulations, Government Notice No. 40 of 2000 and
 - The Merchandise Marks Regulations, GN No.89 of 2008.
 - Similarly the International Classification of Goods and Services for the Purposes of Registration of Marks of 1957.
- 

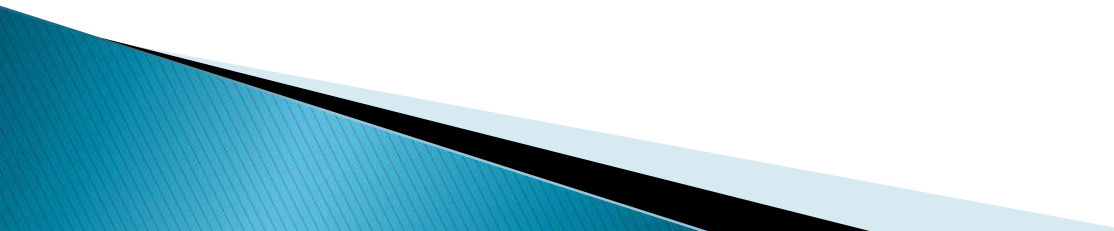
Trademark Legal Regime

- ▶ Prior to 1986 there was no law governing protection of service marks.
 - ▶ The Act has 66 sections spreading over fourteen parts governing both trademark and service marks in Tanzania.
 - ▶ The Act is compliant to both Paris Convention and the TRIPS Agreement.
 - ▶ It is also compliant to Madrid Protocol as well as the Banjul Protocol.
- 

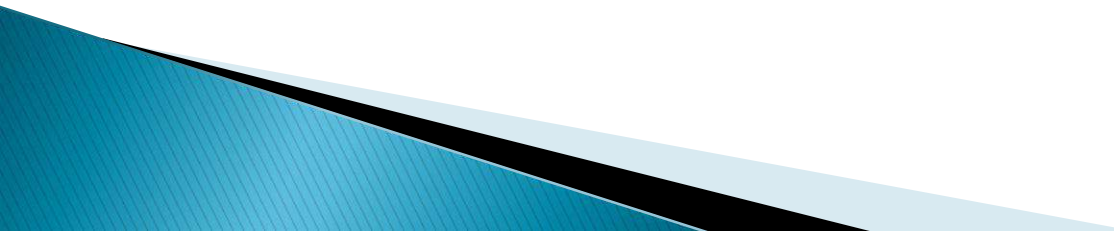
Trademark Legal Regime

- ▶ In 2000 enforcement of the Merchandise Marks Act took full shape under the Fair Competition Commission (FCC).
 - ▶ The Director General of FCC is appointed as the Chief Inspector.
 - ▶ The Act is significant in the enforcement of trademarks through criminalization of importation and manufacture of counterfeit goods in Tanzania.
- 

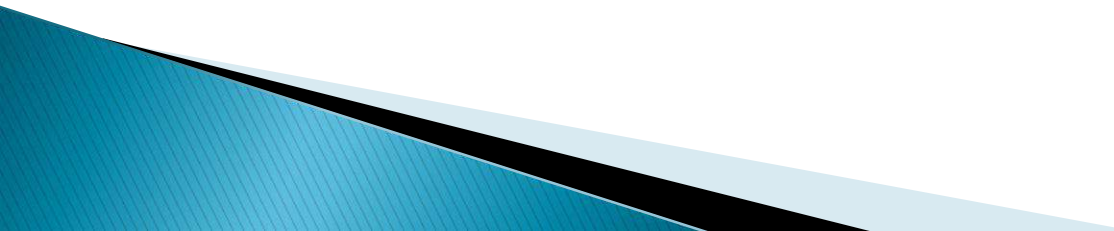
Requirements for Registration of TM& SM

- ▶ For a trade or service mark to be registered it has to meet the **distinctive** criteria (section 16)
 - ▶ This is a critical requirement which has to be met.
 - ▶ A trade or service mark is said to be distinctive if it is capable of distinguishing and thereby not creating likelihood of confusion or deception.
- 

Requirements for Registration of TM& SM

- ▶ Not all trade or service marks are registrable.
 - ▶ There are certain trade or service marks which cannot be registered.
 - ▶ These are trade or service marks the use of which would be contrary to law or morality.
 - ▶ Those which imitate or resembles flags and other emblems, initials, or abbreviations or initials of name of any official sign or hallmark of any state or of any organisations.
- 

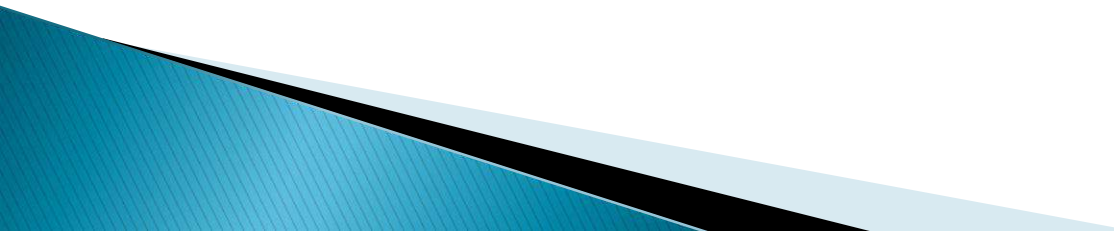
Requirements for Registration of TM& SM

- ▶ Registration confers to the proprietor exclusive right (section 14)
 - ▶ Registration shall be subject to fulfil all the requirements (section 14(2))
 - ▶ A trade or service mark has to be registered for a specific class or classes of goods and that no same mark is to be used by different traders as this will clear confusion or conflicts in the market place.
 - ▶ There are 34 classes for goods and 8 classes for services in accordance to the Classification
- 


Requirements for Registration of TM& SM

- ▶ Prior to registration a trademark application is subjected to advertisement for 60 days, examination and opposition proceedings if any.
- ▶ An aggrieved part may appeal to the High
- ▶ The Registrar may refer the matter to the High Court for determination (*a matter of unusual importance or complexity*)
- ▶ A trademark may be registered as a separate or an Association Mark
- ▶ The Registrar may direct a part to Disclaim non-distinctive or common character

Requirements for Registration of TM& SM

- ▶ Once a trademark is registered it confers unto the registered proprietor an exclusive right as stipulated under section 31 of the Act
 - ▶ Section 32 of the Act infringing acts against the registered proprietor
 - ▶ Once registered the date of application is deemed to be the date of registration
- 

Take Home

- ▶ Registration and protection of trademark is territorial. However, the international regime (Madrid Protocol) and regional regime (Banjul Protocol) have created a convenient and cost-effective solution.
 - ▶ The owner of a trademark which is not registered and who has used it over a prolonged period without interference is an owner in common law entitled to sue for Passing off but not infringement.
- 

THANK YOU

Paul Kihwelo

Judicial Colloquium on Copyright, Trademarks and Mediation of IP Disputes for the Judiciary of the United Republic of Tanzania

organized by
World Intellectual Property Organization (WIPO)
and
Judiciary of the United Republic of Tanzania

Professor Ilanah Fhima

University College London, UK

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28 February 2023

Rights conferred by a trade mark

Rights conferred by a trade mark

A trade mark right is a property right

- Assign/sell (don't need to include the business/goodwill)
- Licence
- Prevent others from using → infringement

Licensing

- Can be exclusive/non-exclusive
- US: problems with 'naked licensing'
 - mark may become deceptive if TM owner doesn't control quality.
 - '[y]ou can get the neutral logo ... just don't use it for commercial purposes or you ... can ... do your own fancy schmancy logo'



FreecycleSunnyvale v. The Freecycle Network, No. 08-16382 (9th Cir. 2010)

Infringement

Types of Infringement

- Confusion - TSMA 1986, s.31(1)(a)
- Dilution - TSMA 1986, s.31(1)(b)
 - Blurring
 - Tarnishment

Types of Confusion

Confusion must be about trade ORIGIN
(Other forms of confusion – unfair competition)

- Direct confusion – consumers mistake trade mark X for trade mark Y
- Indirect confusion – consumers wrongly believe that mark Y is somehow connected with company X such that company X is responsible for the quality of company Y's goods



Types of Confusion

Mere association - one mark brings the other mark to mind - is NOT confusion

Key case: Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* EU:C:1998:442



Approaches to testing for confusion



Checklist



Global appreciation (EU and US)

*Cannon; Polaroid Corp. v. Polarad Elecs.
Corp. - 287 F.2d 492 (2d Cir. 1961)*

Who needs to be confused?

- Average considers of goods/services in question
- Reasonable well-informed, reasonably observant and circumspect
- Level of attention depends on type of goods/services
- Consumers suffer from imperfect recollection

Key case: Case C-342/97 *Lloyd Schuhfabrik Meyer*
EU:C:1999:323

Comparing marks

- Aural
- Visual
- Conceptual
- Particular attention paid to distinctive and dominant components



Key Case: Case C-251/95 *SABEL v Puma* EU:C:1997:528

Comparing goods/services

Look at ALL the relevant factors, including:

- their nature
- their end users (should read intended purpose)
- their method of use
- whether they are in competition with each other
- whether they are complementary.

Comparing goods/services

Other relevant factors might include:

- use as an ingredient of the other product
- same channels of trade
 - though caution with supermarkets
- known to have the same manufacturer

Key case: Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*
EU:C:1998:442

Should particularly distinctive marks gain extra protection?

- Investment in mark
- Product extensions more credible

But

- Consumers remember familiar marks better



Timing of confusion

- Confusion is usually at point of sale
- What if consumers are confused *before* sale – ‘bait and switch’
- What if consumers are confused *after* – e.g. fake prestige goods

Key case: *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons* 523 F.2d 1331 (2d Cir. 1975)



Authentic



Fake

Extended protection – infringement without confusion

- Today's trade marks about more than indicating origin – vehicle for investment and underpins brand reputation
- Should law protect this, or should it be limited to protecting consumers from confusion?

Blurring

- Harm to the distinctiveness of a mark
- Every second use makes a mark less distinctive BUT does it a single use really harm the ability of a mark to indicate origin?
 - ‘Death by a thousand cuts’



Blurring

Both US and EU have struggled

- US – actual dilution
- EU – change in economic behaviour of consumers

Key cases:

Case C-252/07 Intel Corp Inc v CPM United Kingdom Ltd EU:C:2008:655 (UK);

Moseley v. V Secret Catalogue, Inc., 537 U.S. 418 (2003) (US)

Tarnishment

- Harm to the mark's reputation by association with unsavoury, dissonant or poor quality goods
- Constitutionality currently being challenged before US Supreme Court – viewpoint discrimination



Key cases: Case C-252/07 Intel Corp Inc v CPM United Kingdom Ltd
EU:C:2008:655; US – *Jack Daniel's Properties, Inc., v. VIP Products LLC*)

Unfair advantage/misappropriation

- Taking advantage of a mark's reputation
- Parasitism/free-riding
- Controversial
 - All progress builds on others' efforts
 - What makes an advantage into an unfair advantage?

Key case: Case C-487/07 *L'Oreal SA v Bellure NV* EU:C:2009:378



Defences

- These aim to strike the balance between trade mark owners' rights and access needs of competitors/third parties – TMSA 1986, s.32(3),(4)
- Fair use (US)
- Specific types of use identified as being 'fair' (EU)
 - * Own name/address
 - * Descriptive use
 - * Use indicating purpose or TM owners' goods
 - * Comparative advertising

Striking the balance with defences

- Risk of defences being abused/undermining TM rights
- EU – use must be ‘in accordance with honest practices’
- But in US – a degree of confusion can be tolerated
- Limited to commercial use
 - (also, TMSA 1988 s.32(1)(a) and (b) ‘in the course of trade or business’)
- Wider defences for dilution
 - (EU – due cause; US – specific defences)



Free speech and parody

- TM rights may be used to suppress critical views and parodies
- *Jack Daniel's Properties, Inc., v. VIP Products*, claiming:
 - Confusion
 - Unsavoury associations
- US Supreme Court hearing on 22 March



First sale doctrine and exhaustion of rights

The TM owner has the exclusive right to sell goods under the TM

- so, in principle, second-hand sale of genuine goods infringes - even though the TM is 'telling the truth'

First sale doctrine and exhaustion of rights

- US – first sale doctrine
- EU – exhaustion of rights
 - Also allows goods to circulate between countries within the EU
 - Repackaging is also allowed
- BUT TM owner can prevent goods from being resold *if* their condition has been changed.

Losing the rights

- A registered mark can be **revoked** *if*:
 - it is not used for a continuous period
 - it has become generic
 - it has become deceptive
- A registered mark can be **invalidated** *if*:
 - it was registered in error

Online issues

- Keywords
- Online marketplaces
- Desire to facilitate new business models that aid consumers
- Difficulty for platforms to detect fakes and counterfeits



Passing off

Passing off and unfair competition

- Civil law – unfair competition; parasitism
- Common law – basis in deceit; passing off
- Protection without registration BUT need for use



Qualifying for protection – goodwill

- Attractive force that brings in custom
- Consumers have to recognise the indicia
- Requires use
- Examples: name, product shape, advertising theme

Key cases: *Erven Warnick v Townend* [1979] AC 731; *Reckitt & Coleman v Borden* [1990] RPC 341



Misrepresentation

- Defendant's use needs to result in consumers being confused about some aspect of defendant's offering
- Can be origin
- BUT wider - so can be about e.g.
 - quality (second-hand footballs)
 - qualities (alcohol content in vodka)
 - country of origin of goods originate (Swiss chocolate, Greek yogurt)



Extended passing off

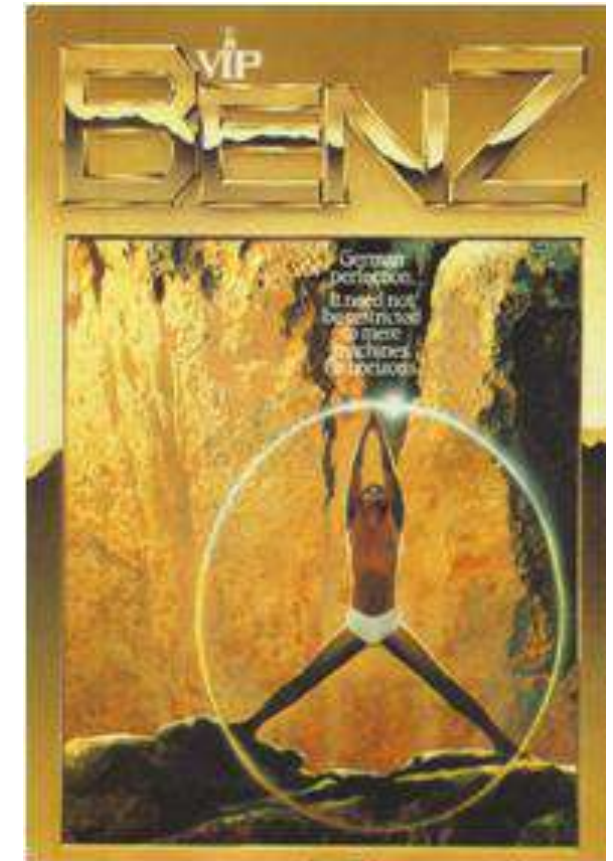
- Action to protect the shared goodwill of a group of traders e.g. advocaat, Champagne, sherry
- Often, but not always, geographical
- Any maker of goods in the category can take action
- Misrepresentation is the implicit claim that the defendant's goods share the common properties of the group when, in fact, they don't



Special protection for well-known marks



Case: *Daimler Benz Aktiegessellschaft v. Hybo Hindustan* [AIR 1994 Del. 239]



Special protection for well-known marks

- The problem: marks may be known in a country without use or registration – spillover reputation
- BUT protection often limited to where there is registration/customers acquired through use, e.g. foreign goodwill in UK

Special protection for well-known marks

- Paris Convention – Article 6bis
 - Well-know mark
 - Identical/similar goods
 - Confusion
- TRIPs
 - Extends Art. 6bis to services
 - Extends Art. 6bis to dissimilar goods

Thank You!

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TRADEMARK ISSUES AND NATIONAL JURISPRUDENCE

Paul Kihwelo

INTRODUCTION

Trademark jurisprudence in Tanzania has been evolving overtime following a number of decisions that the court has pronounced majority of which have been decided by the High Court of Tanzania, Commercial Division. Below, I will explain a selected group of cases as a sample of many decisions that have been handed down.

Issue of Jurisdiction

GODREJ CONSUMER PRODUCTS LTD V TARGET INTERNATIONAL (T) LTD, COMMERCIAL CASE 60 OF 2019, HIGH COURT OF TANZANIA COMMERCIAL

- The Plaintiff sued the Defendant for importation of counterfeit marks and offending goods into the Tanzanian market. The Defendant challenged the maintainability of the suit on the ground that claims of this nature fell under summary proceedings within the original jurisdiction of the Chief Inspector under regulation 12 of the Merchandise Mark Regulations.
- The High Court held that,
- *“Although admittedly Merchandise Mark Act is a subject specific legislation, its application is somehow restricted to remedies which are purely criminal in nature, while the proceedings before this Court is of civil nature.”*

Registrability requirements: Similarities between trademarks ⁴

DISTRIBUTION AFRICA LIMITED VS REGISTRAR OF TRADE AND SERVICE MARKS, MISCELLANEOUS COMMERCIAL CAUSE NO 26 OF 2005, HIGH COURT OF TANZANIA, COMMERCIAL DIVISION AT DAR ES SALAAM

- The appellant filed an application of a Mark **CHIN CHIN** under class 29 in respect of a Tomato Paste. The application was accepted and published. Later, the Registrar learnt that another Trademark under class 30 in the name of **CHIN CHEN** has been accepted and advertised. The appellant received a letter from the Registrar informing him of the withdrawal of acceptance of its application. Dissatisfied the appellant lodged an opposition before the Registrar which was unsuccessful and therefore appealed to the High Court.
- The High Court held,
- *“Where the question of distinctiveness arises between two marks, the Registrar must stop the process of registration and clear the issue or else any registration so carried out will be invalid.”*

Fraudulent registration of a trade mark

TANZANIA CIGARETTE CO. LIMITED VS MASTERMIND TOBACCO (T) LIMITED [2006] TLR 142

- The Plaintiff and the Defendants are both manufacturers of cigarettes and were claiming against each other for infringement of trademark, passing off and unfair competition. The gist of their dispute was perpetuated by the similarity on the labels in the pocket of the cigarette produced by Plaintiff namely, “*Safari*” Cigarettes and that of the Defendant titled, “*Master*” Cigarette. The Plaintiff raised alarm against the Defendant for trade mark infringement but he denied and counterclaimed that the Plaintiff was passing off its product.
- The High Court held,
“Section 20 (1) of the Trade and Service Marks Act 1986 prohibits the registration of a trade or service mark which is identical with a trade or service belonging to different proprietor and already on the register in respect of the same goods and services or closely related goods or services or that so nearly resembles that trade or service mark as to be likely to deceive or cause confusion.”

Application, Opposition and Registration of trademark

DOUBLE HOLDINGS LIMITED V EAST AFRICAN SPIRITS (T) LIMITED & GAKI INVESTMENT LIMITED, COMMERCIAL CASE NO. 8 OF 2018,

The Plaintiff and the Defendant each were manufacturers of gin and spirits respectively. The Plaintiff's trademark was expressed as "*Chase the Ace of Diamonds*" while the Defendants trademark was made of words "*White Diamond*" and its associate registered trademark consisted of words "*Diamond Rock*". The Plaintiff's claimed that the words "Diamond" appearing in the Defendants trademark amounted to infringement and passing off of its trademark.

The mere use of the word “*Diamond*” alone was not enough to prove infringement unless there are established similarities which may cause misleading. The Plaintiff’s trademarks with the word “*Diamond*” had other words, signs and symbols “*Chase the Ace the Ace of Diamonds*” which are different from the Defendants trademark which had only two words “*Diamond Rock*” or “*White Diamond*”.

***KIWI EUROPEAN HOLDINGS BV V.
SAJAD ALI LIMITED [2005] TLR 434***

The Plaintiff was the registered owner of the trade mark “KIWI”. One of the Plaintiff’s representative bought from the Defendant’s shop a KIWI shoe polish which was nearly similar with Plaintiff’s “KIWI “product, he sued the Defendant for infringement of his registered trademark “KIWI”. The Plaintiff sued the Defendant for infringement and passing off.

- A single act of infringement is sufficient to justify the Plaintiff in bringing an action against the Defendant.
- It is upon the Plaintiff to prove that there is a resemblance between the two marks and that such resemblance is deceptive.

In deciding the question of similarity between the two marks, one has to approach it from the point of view of a man of average intelligence and of imperfect recollection, and that an ordinary purchaser is not gifted with the power of observation of a Sherlock Holmes.

Test for considering resemblance between competing trade marks

10

TANZANIA DISTILLERIES LTD VS VITAMIN FOODS (1989) LTD [2000] TLR 15

- Applicant is a registered owner of a trademark Konyagi and device in respect of Gin
- The trademark has been extensively advertised, used and acquired reputation in the market
- The respondent sought to register a trademark in the name of Ginyagi in respect of alcohol
- The applicants opposed on the grounds that the proposed trademark was not distinctive and it so nearly resembled the mark of the applicant as to be likely to deceive or cause confusion.

The word **Giyangi** does not appear to be invented; it is a coinage from two words from which **Gin** and **yagi** have been derived. It has been derived from **Konyi**.

Since **Konyagi** and **Giyangi** are alcoholic drinks of the type of gin, an ordinary consumer who is not sufficiently literate, is likely to be deceived.

Test for considering resemblance between competing trade marks

GLAXO GROUP LIMITED V. JB CHEMICALS AND PHARMACEUTICAL LTD, MISCELLANEOUS CASE NO. 3 OF 2007

- The respondent applied for registration of **RANTAC** in class five as a trade mark.
- The appellant opposed the respondent's registration contending that they are the lawful proprietors of the trade mark **ZANTAC** in class five
- The goods enlisted in the respondent's application were similar to appellant's pharmaceutical, medicinal and veterinary preparations and products and they are likely to confuse the public.

The High Court held,

Goods or services registered under the same class can be the basis to determine the resemblances of trade or service marks. The two trademarks is used simultaneously in the market place are likely to confuse and deceive consumers

RED SEA DETERGENT CO LTD V AKABA INVESTMENTS (T) LTD AND TWO OTHERS, MISCELLANEOUS COMMERCIAL CAUSE 28 OF 2006

- The Applicant applied for cancellation of registration of a trademark registered in the name of Akaba Investments (T) Ltd and for an order directing Akaba Investments Ltd, to produce an account of profits earned by them through the misuse of the Applicant's trademark.
- The duo had an agency agreement to be the sole distributor of the applicants' products in Tanzania and beyond
- The applicant's trademark was WILD CAT while the respondent applied to register WILDCAT in respect of detergent soaps
- Applied for cancellation of the trademark and it was done and an appeal to the High Court met a dead end

**Common law position on un registered
trade mark**

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***IPP LIMITED V PRINCE BAGENDA, SALUMU
INTERNATIONAL MEDIA SYSTEM LTD AND BUSINESS
PRINTERS LTD, COMMERCIAL CASE NO 20 OF 2009***

- The Plaintiff IPP Limited is the owner of an unregistered trademark IPP
- The defendant used the logo IPP in its story
- The Plaintiff sued the defendant for Passing Off

The High Court held

The use of unregistered trademark confers common law right of Passing off but the owner cannot sue for infringement

REMEDIES FOR INFRINGEMENT OF TRADE MARKS AND PASSING OFF***JCDECUAX SA AND ANOTHER V JP DECAUX (T) LTD, COMMERCIAL CASE NO 155 OF 2018***

The Plaintiffs sued for a declaratory order that the Defendant's use of the name JP DECAUX TANZANIA LIMITED infringed on the First Plaintiff's **well-known trademark** "JCDECAUX". The plaintiffs prayed for permanent injunction, a prohibition order, an order for inquiry of damages, destruction or delivery to plaintiffs, compensation for goodwill, punitive and general damages, interest, costs and any other relief that the court may deem fit and just to grant.

REMEDIES FOR INFRINGEMENT OF TRADE MARKS AND PASSING OFF***JCDECUAX SA AND ANOTHER V JP DECAUX (T) LTD, COMMERCIAL CASE NO 155 OF 2018***

Where the Plaintiff is not claiming for a monetary relief in trademark cases, it is not possible to indicate the value of the subject matter in terms of Rule 1(1) of Order 7 of the Civil Procedure Code, Cap 33 RE 2002.

SUMMARY

Trade and service marks law seeks to protect businesses as well as consumers from use of counterfeit goods through deception.

It also seeks to reward proprietors for the fruits of their investment in research and development (R&D)

THANK YOU

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www.judiciary.org.tz



Judicial Colloquium on Copyright, Trade Marks & Mediation of IP Disputes For The Judiciary of the United Republic of Tanzania
1ST March 2023

Topic: *Nature of Copyright & obtaining Protection*

Facilitator: Justice Dr.. A.Mambi , Judge of the High Court of Tanzania, Expert on Cyber Security, Cyber/ICT Law, Intellectual Property Law& Competition Law

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****Nature of CPOYRIGHT: KEY AREAS**



- **1. What is copyright?. How does it differ from other IPRs?**
- **2. Obtaining Protection: How & what are the criteria**
- **3. Requirements/Conditions/ Legal Principles for valid Copyright Protection**
- **What does Copyright cover/What is protected by Copyright**
- *As a Judge or Magistrate or Judicial Officer, what factors & guiding principles do you need to consider before deciding on the substance, ownership and protection of copyright?*
- *What is the link between The idea-expression dichotomy & originality in determining copyright?*
- **4. National Legal Framework: What are the relevant laws & how copyright is protected under the law?**
- What are the categories of copyright that qualify protection under the Law?
- What are the criteria for protection under the law?
- **We will start our discussion from Down to Earth !! sa**

Copyrighted Work--MAMBI



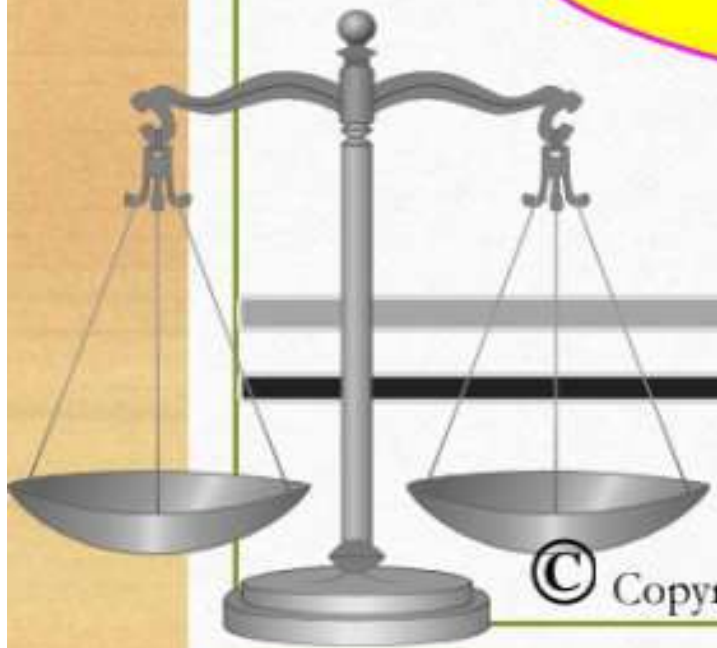
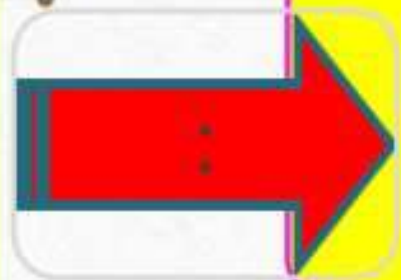
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****CENTRE OF THE PRESENTATION ****



****RULE of the Day****

- ***“What is Worth Copying is prima facie worth protecting”***





Rolling the Ball *I: *What is copyright?*



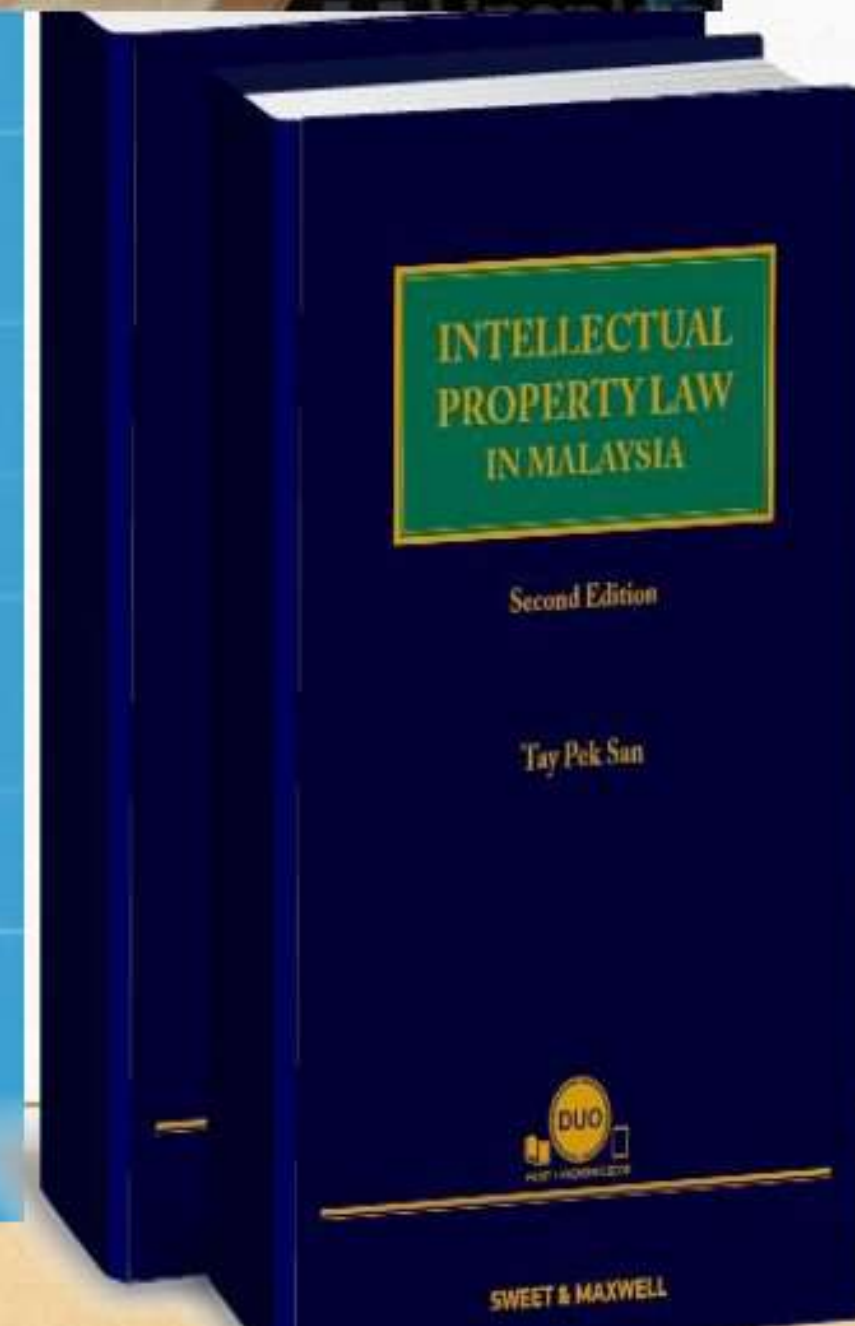
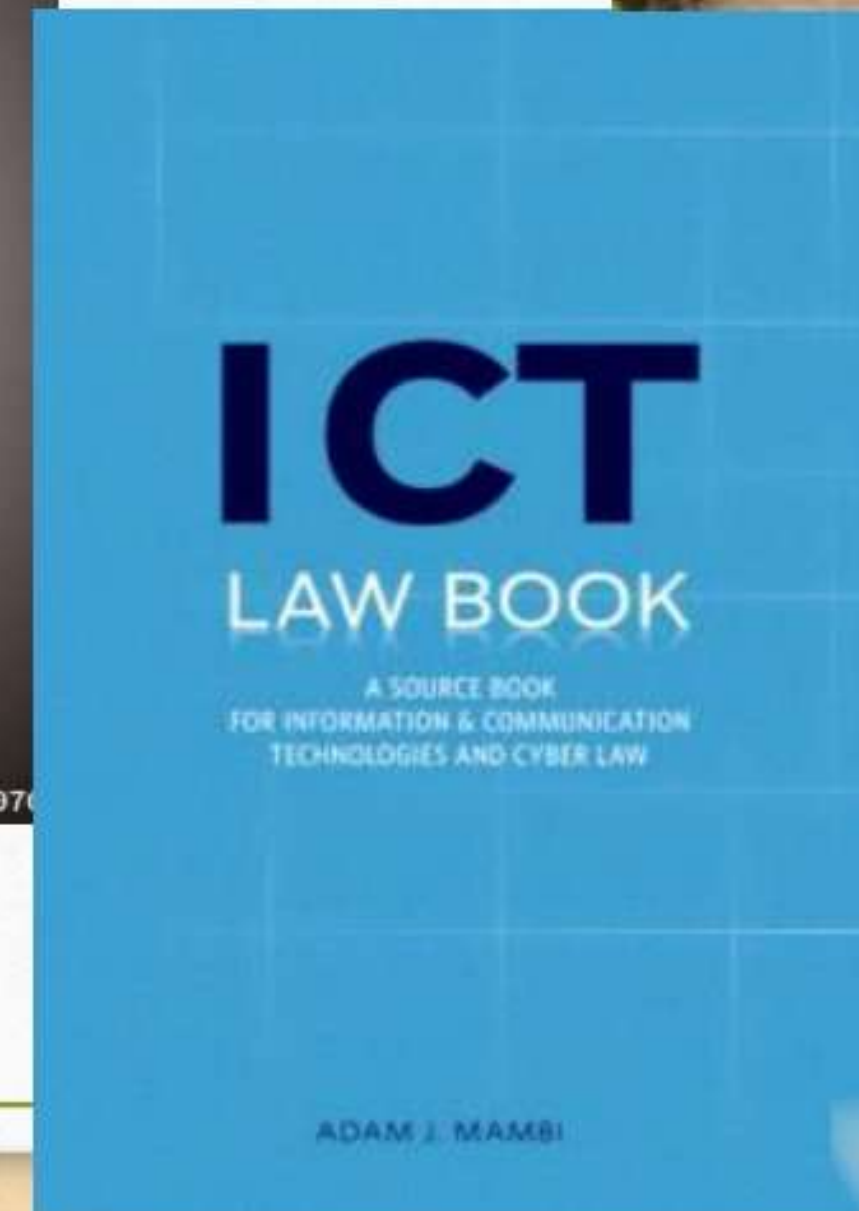
- Refers to legal right of the owner of intellectual property in copyrighted work
- The essence of copyright can be deduced from the **name itself**
- Simple meaning: **COPY-RIGHT= RIGHT TO COPY**
- E.g If you are an author of the Literary work like book, you are the only one who has right to copy
- **Section 4 of Copyright & Neighbouring Rights Act Cap 218: defines**
- "copyright" means **the sole legal right to print, publish, perform, film or record a literary or artistic or musical work;**
- ***The Berne Convention** for the Protection of Literary and Artistic Works (1886)- Most relevant specific Convention on copyright protection*
- *The Convention defines these works in general terms to **include** every production in the **literary, scientific and artistic domain, whatever may be the mode or form of its expression***

**Important thing to Remember about copyright as we go*

- *Copyright protection:* The right of the copyright owner to **prevent** others from making copies of his work
- Copyright protects **Literary, Dramatical and Artistic works** such as writings, drawings, music, computer programmes and neighbouring/related rights by granting the right holder the **exclusive right** to reproduce the work and communicate to the public

**Copyright as result of human Brain/ creations of the human mind*

- Result of the person using his brain, skill, labour & Judgment to come up with creative endeavour .
- **Copyright** is a type of IP that protects the **original work** of authorship as soon as authors an **author fixes the work into tangible** thing as we will see later



*Development & Genesis of Copyright Protection/Role of the Judiciary

- * The development of copyright has been supported by the Court through judges through creating precedents or judgment
- *: University of London Press Ltd v University Tutorial Press Ltd [1916]2Ch 601: Most celebrated Case
- This is in my view is the the genesis of all intellectual Property Rights
- **Issue:** Did the court consider the **exams** to be a literary work with copyright protection?
- **Held:** Yes, they were subject to copyright protections still protectable as **literary works**
- * During 20th Century Copyright protection developed to include photographs, films, broadcasts, sound recordings, cable programs, computer programs, work produced by or with the aid of a computer

**Major types of copyrighted Works*

The law categorizes copyright as **Property right** in various copyrighted works

Copyright protects two major works that are **literary & artistic work**

These two works require minimum level of **originality** requirement

1) **Authorial/Primary** (2) **entrepreneur/Secondary**

➤ **1)Authorial/Primary** (Works of authors) include literary, dramatic, musical and artistic works (LDMA)

➤ **Entrepreneur/Secondary/Derivative/Neighbouring rights (related rights), works;** created by entrepreneurs from already existing work.

❖ **2) related rights/Neighbouring"** (entrepreneur/secondary) or rights related to copyright

❖ Rights that protect the **performers, producers of phonograms, and broadcasters, sound recordings**

❖ Section 4 Cap 218 "**neighbouring rights**" are the secondary right of copyright which performers are entitled;

***WORKS (subject matter) PROTECTED BY COPYRIGHT:**

**Authorial/Primary
WORK**

• **LDMA**



Derivative Rights

- **Sound- Recordings**
- **Films**
- **Broad cast**
- **Cable-programmes**

*Requirements for/Qualification for Copyright Protection: Legal

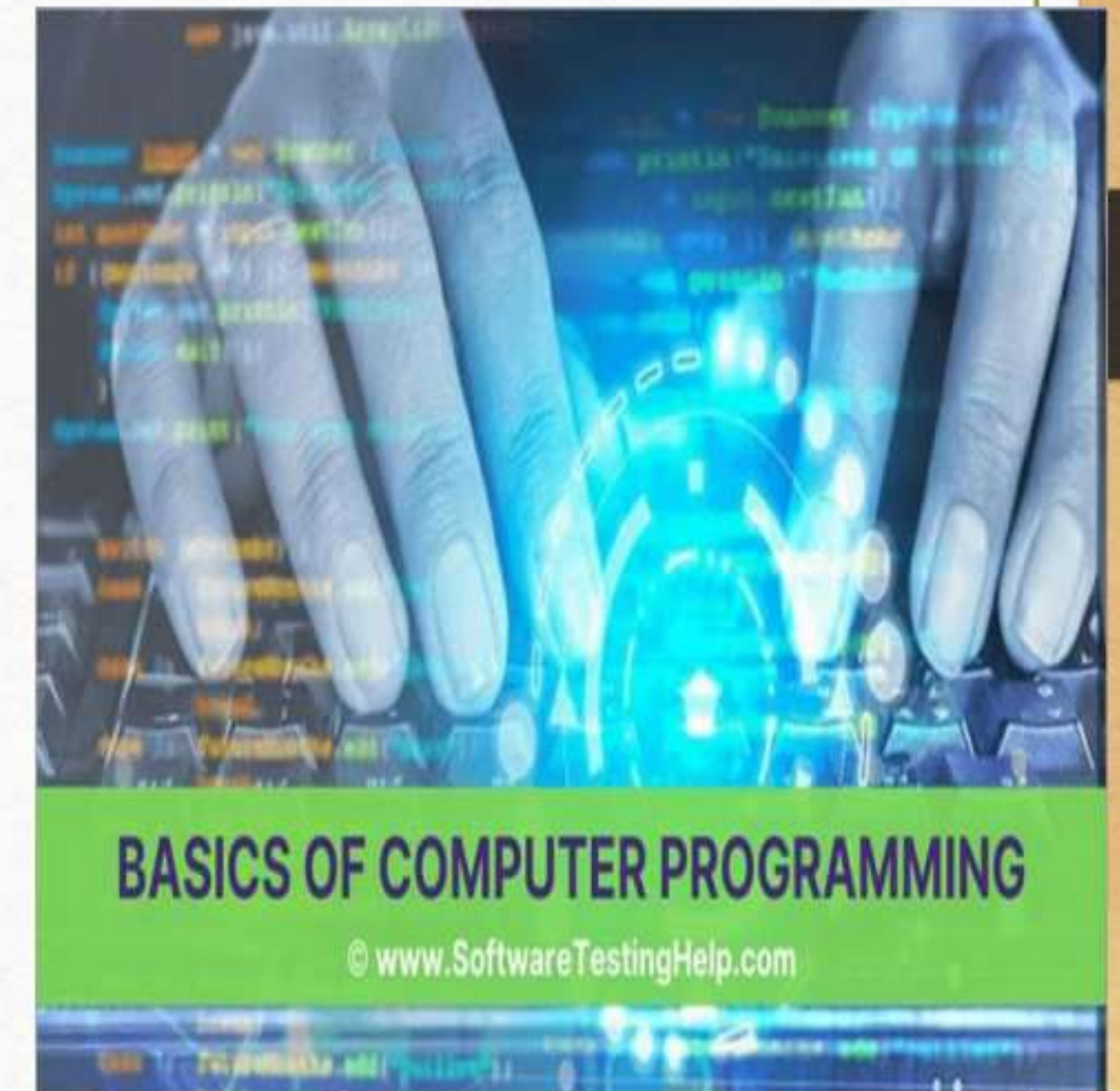
Key Principles: Expression of Ideas & Originality Requirements

- Copyright protects **expressions of ideas** put into some permanent/tangible form (*fixed, written or recorded*).
- Copyright does not protect ideas themselves rather **ideas expressed** into a tangible thing (fixation / writing / recorded)
- Copyright does not subsist in literary or musical works until they are **recorded** in writing or otherwise
- All works in literary, dramatic, musical, or artistic) have in common the originality requirement.
- Authors of copyright may only claim in original works they create
- The author must have spent '**skill, labour, and judgment or 'selection, judgment & experience'**',. (*Ladbroke (Football), per Lord Pearce at 479 and 291; and University of London Press per Peterson J at 609.*

*****Example of Expression of ideas(Book, CD etc)***

- The books you have is about ideas in intangible form on Intellectual Property Law, ICT/Cyber-law, Sakar on Evidence, Muller on Civil **fixed in written form**
- The **book** you have is not only about ideas on Intellectual Property Law, ICT/Cyber Law, evidence etc : it is about ideas skillfully **expressed in writing**
- The **CD** or flash Disk that contain music is not only about ideas: it is about ideas on music/song (lyrics & melody) skillfully **expressed in recorded form (fixed)**
- **The USB/Mmemory flash** that contain computer pogrammes/software is about ideas on the programmes/applications skillfully expressed in recorded form (fixed)
- Your ideas can only be protected by copyright if they are expressed **in tangible form**
- ***Article 9 (2) TRIPS AGREEMENT*** *Copyright protection shall extend to expressions*
- *and not to ideas.....*

*Expression of Ideas on **Computer Programmes** protected by **copyright**: Note: Computer programmes can be protected in both copyright & patent



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Work—Hon.Dr.MA

**Evolution of IPRs (e.g copyright) from Human Brain-intellectual to valuable commercial property
copyright protection cycle*

An *Idea* From
Human Brain-use
intellectual



Beginning of Copyright Protection

Expression of
Ideas

- Written, recorded or
- Fixed into tangible object
- Originality



- IPRs
- Copyright Protection

Copyright Law &
Convention



****KEY PONT'S TO REMEMBER**

- Consideration of The **idea-expression** dichotomy
- The key preliminary point is that **ideas are not protected**
- The dichotomy between **"idea"** & **"expression"** is a key element in copyright law
- ***Article 9 (2) TRIPS AGREEMENT** Copyright protection shall extend to **expressions** and **not to ideas**.....
- The authors need to invest ,**a minimum** amount of skill and labour in his work
- Copyright protects works that are **author's own intellectual creation**
- See ***Designers Guild vs Russel William Textiles Ltd [2000] 1 WLR 2416***

*Obtaining & Protection of copyright;Criteria

- What are the **subject matters** for Copyright Protection?
- *Are there any formalities?*
- Under the current Copyright Law, copyright protection exists in "original works of authorship fixed in a tangible medium of expression."
- No need of registration of copyright so long as there is expression of ideas fixed in material form or permanent form
- **There is no requirement** the work be **registered** for copyright protection to arise, the right arises **automatically**
- This goes in line with **Berne Convention principle** of automatic protection (Protection must not be conditional upon compliance with any **formality** (principle of "**automatic**" protection)
- *Who has the burden/onus of proof copyright?:*
- The fact that copyright is not registered means that a person who wishes to assert copyright must prove **the subsistence of copyright**
- *What are the criteria for copyright protection?*

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* Criteria for protection of copyright/subsistence

- (1) the 1ST requirement for copyright to subsist/obtaining copyright: the work must be **recorded in a material form**.
- Only applies to Literary, Dramatical & Artistic Work (LDMA)
- (2) The 2nd requirement that must be satisfied for obtaining protection is that the work must be **original**.
- 1ST & 2nd Requirements do not apply in derivative/neighbouring/Secondary works (sound recordings, film, broadcasting, cable programme, typographical arrangements). WHY??????
- (3) the work is not the one excluded from protection on public policy/morality
- ***Who has the burden/onus of proof copyright?***: The fact that copyright is not registered means that a person who wishes to assert copyright must prove **the subsistence of copyright**

****** Conditions for *Subsistence* of copyright

- Copyright protects **expressions of ideas** put into some permanent/tangible form (*fixed, written or recorded*).
- protects the form of expression (e.g. the actual words and notes in a song) and not the underlying subject matter or idea (e.g. the topic of the song).
- **Copy right does not protect ideas themselves rather ideas expressed into a tangible thing**(fixation /writing)
- *Merchandising Corp of America v. Harpond (1983)* and *Komesaroff v. Mickel (1988)*
- Copyright does not subsist in literary or musical works until they are recorded in writing or otherwise;
- E.g computer program, it **must be 'original'** and it must be **'recorded'**

***Protection: Copyright Protection Rules**

Is there any Rule of Thumb for copyright protection?: YES

- a) Legal requirement of expression of ideas
- b) Legal requirement of the originality (Originality principle)
- c) Legal requirement of Fixation (fixation principle)
- d) Legal requirement of Recording in a tangible
- e) Legal requirement of Expending Labour, Skill, effort and Judgment

N,B: Where do we find these Rules & principles under the Law & International Legal instruments??

*Discussion on Copyright Protection Principles & Rules

* *expression of ideas rule & Originality requirement rule*

- a) Copyright **will not protect ideas** but only their *expression of ideas*
- b) *The author just needs ,minimum amount of skill and labour (di minimas rle)*
- c) *That makes an expression of ideas and it therefore protected by copyright*
- d) *Copyright thus protect the works that are **the authors own expression of the underlying idea***
- e) *What will be the threshold for that expression to be protected?:*
 - ❖ Copyright uses the concepts of **idea-expression** and **originality** to determine what can be appropriate for copyright protection and grant
 - ❖ Protection depends on the **objective attainment of the result**

****The *originality* requirement**

- *Authors of copyright may only claim in *original works* they create
- *Only '**original**' works will attract copyright. *What do we mean??:*
- Work should not be copied but should originate from the author and its creation should involve minim amount (di minimas) of skill, labour & judgment
- The work **cannot be a mere** mechanical reproduction of a previous work, **nor** can the work consists of only a few words or a short phrase
- *Ladbroke (Football) Ltd v. William Hill (Football) Ltd [1964] 1 WLR 273, University of London Press Ltd v. University Tutorial Press Ltd [1916] 2 Ch 601*

* *Does Originality requirement for protection applies to all works?*

- The answer is NO. Why?
- Originality requirement only applies to LDMA.
- LDMA Works must be original (originate from the author- University of London Press v. University Tutorial Press CA (1916) 2 Ch 601)
- Originality is not necessary Secondary works (sound recording, film, broadcasts, cable programmes, typographical arrangements) to be original for them to qualify for copyright protection
- *What does original requirement means in copyright?*. Simply means that the author must have executed the requisite **labour, skill** or **effort** in producing the work

Originality & Fixation requirement on Musical works;

- ☐ Music contain various types of Copyright
- ☐ A Song will contain **literary** (lyrics) and **musical work** (tune/melody)
- ☐ Lyrics are protected as literary works, so what remains of a song is the music.
- ☐ Music can also contain performers right
- ☐ The general rules (originality) governing the two previous categories apply to musical works as well.
- ☐ There is no subjective quality requirement:
- ☐ what is a beautiful piece of music to one person is nothing more than an awful cacophony and noise to another person, and a couple of notes and chords will be sufficient to attract copyright.

**** * As a Judicial officer: What is the test to establish whether the work is original or not?***

- *As the judicial officer or copyright administrator what test will you use to establish that certain work is original?*
- ***Note: literary, Dramatical, Musical and artistic works,*** have to satisfy original requirement to qualify for protection

❖ *What is the test for establishing originality on the work?*

- 1) Novelty or invention is not required to establish originality
- 2) The **starting point** is that; the work is not copied but originates from the author
- 3) The tests of establishing originality should be based on the fact that the work of the author satisfies **minimum effort standard**
- 4) whether the work is original or not
- 5) Two cumulative **requirements** that are involved:
 - a) The work must originate from the author
 - b) There must have been the minimum investment by the author of skill, labour & judgment

* * *How do the court determines Originality?*

- 1) As a Judicial Officer what **As a Judicial Officer** What **Approach** will you use on determining originality requirement?
- 2) **ISSUES:** As a Judge/Magistrate, before you make the decision you may frame the following **legal issues**
- 3) * Whether the subject matter on the work require originality or not.
- 4) Whether the author have employed the requisite **labour, skill** in creating his work
- 5) * Whether the work is just **a copy from** the existing original work or not
- 6) * Whether the work (such as computer programme, database/ selection and arrangements of contents of database etc) **resulted from author's own intellectual** creation
- 7) Whether the author has produced his or her own expression of the idea,
- 8) Whether the work meets Cumulative Requirements of originality

* KEY PONTS TO REMEMBER;

What are the key determining factor for protection ?

- The key preliminary point **Originality** requirement must be linked to **idea-expression** dichotomy
- **Expression of ideas** themselves is not enough without presence of originality
- Copyright uses the concepts of **idea-expression** and **originality** to determine what can be appropriated through the grant of copyright
- Anything else will be in a public domain and will not be subject to an exclusive protection

*Key Legal questions on copyright legal principles for Judicial Officers

- *Originality & Fixation requirement on LDM works;:How do we determine originality?*
- *Fixation principle: How does it apply?*
- *Recorded in a material form : How?*
- *Does fixation principle requirement apply to all copyrighted works?*
- *Why there is no fixation requirements in other works?*
- *What are the 4 key requirements for one to have copyright in his work?*

** How do the courts approach originality on the following types of works?*

- 1) New works
- 2) Primary works
- 3) Derivative/secondary/neighbouring works
- 4) Tables and compilations
- 5) Databases, computer programmes & photographs
- 6) Computer generated works

Fixation principle as legal requirement for subsistence of copyright : *How does it apply?*

- Copyright requires all expression of ideas to exist in some permanent form (fixed form) before attracting copyright
- What is **fixation** in copyright??
- **a computer program** is fixed when stored on a computer' memory
- a song can be fixed by writing it down on a piece of paper
- Section 3 Cap 218 "**fixation**" means the **embodiment** of sounds or images or both or representations of sounds or images in a material sufficiently **permanent** or stable to permit them to be **perceived, reproduced** or otherwise **communicated** during a period of more than transitory duration;
- *Read also Article 2(c) WIPO Performances and Phonograms Treaty (WPPT) (1996) which defines "fixation"*
- See also *Komesaroff v. Mickle [1988] RPC 204*
- ©Dr.Mambi,J

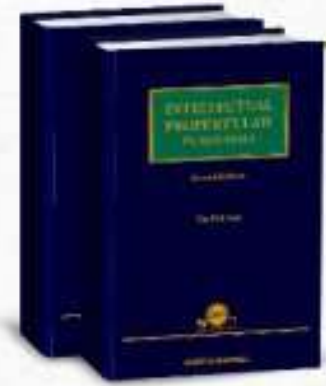
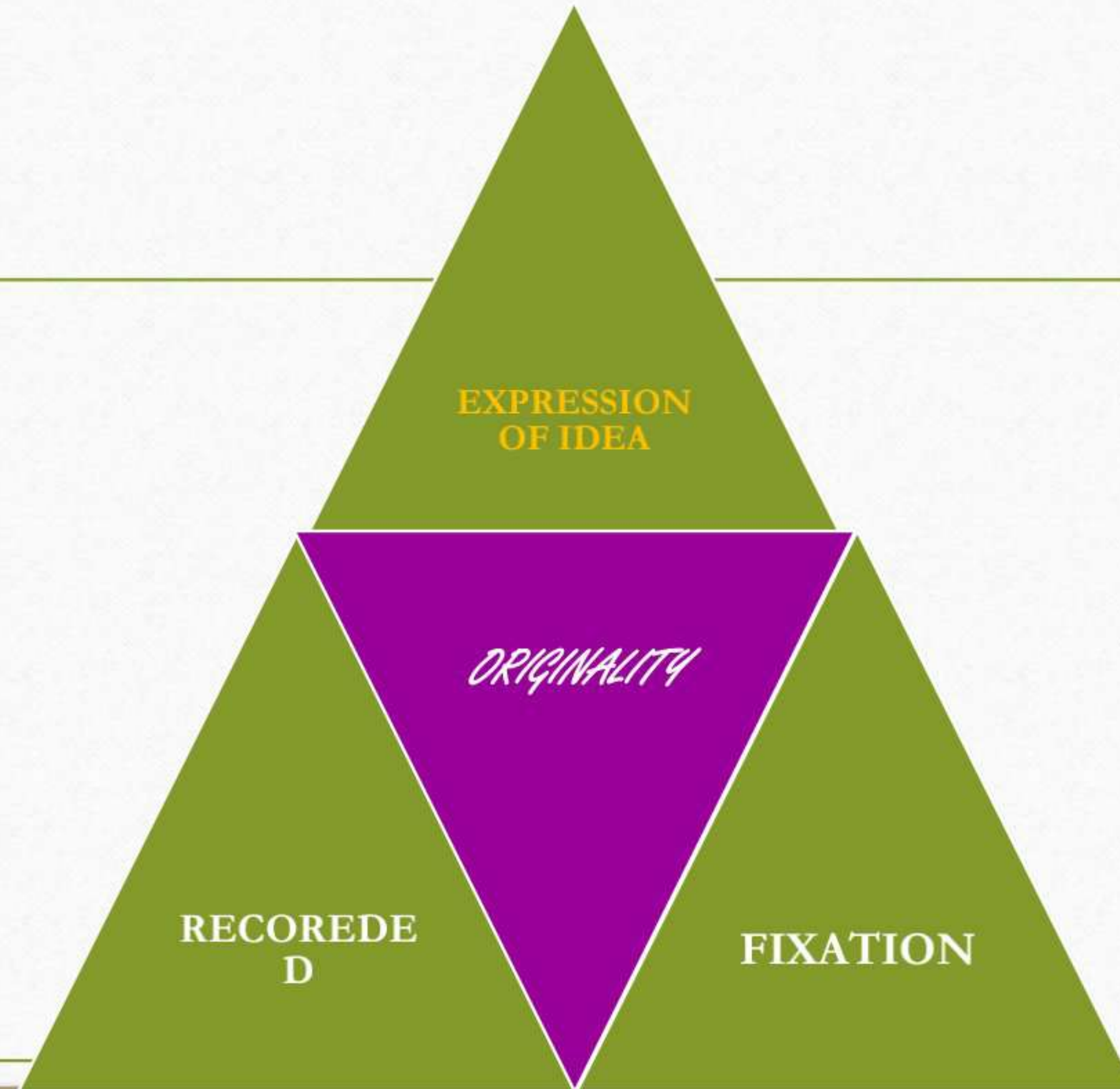
*Recorded in a material form: *How?*

- According to the law, copyright does not subsist in LDMA unless and until the work are **recorded in writing** or otherwise
- **In order for a work in LDMA to be protectable, it must be recorded or fixed in a tangible medium of expression.**
- It can be done in writing or any other form including technological recording or fixation methods
- A work is considered fixed when it is stored on some medium in which it can be perceived, reproduced, or otherwise communicated.
- For example, a work (ideas about song or book) is fixed when you write it down or record it.

Why fixation of work?: What are the benefits?

- There are many benefits arising from fixation or recording of creative ideas
- One of the legal benefits are **evidential** when there is dispute of ownership or infringement
- The law requires the **evidence** that is fixed (written, taped, or filmed)
- The other benefit of reducing ideas into material form is that it increases the probability that **work may continue to be accessible beyond the death of its author**

*****PRINCIPLES FOR COPYRIGHT © PROTECTION***



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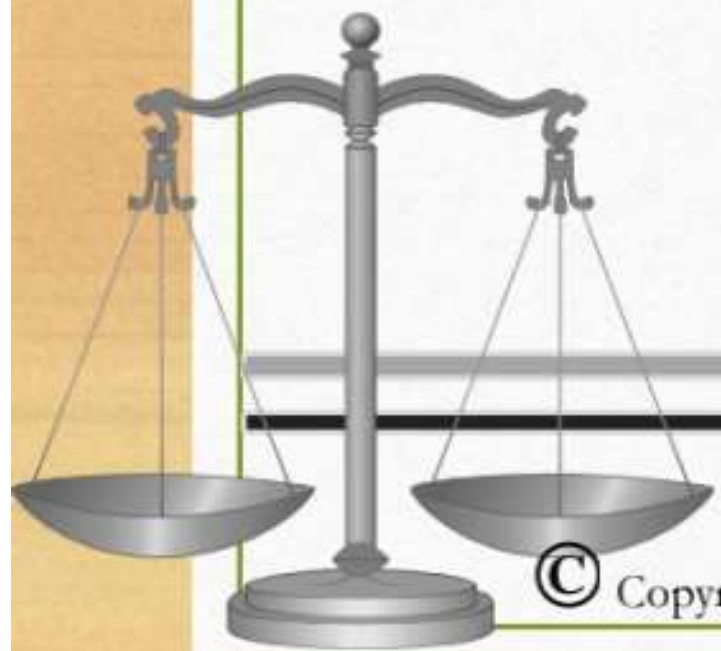


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*Summary of Rights of the copyright owners/**Economic rights:**

Rights Of
Copyright
owners:S.9

- make
- Copy
- publish
- perform
- Adaptation/translation
- Reproduction
- Broadcasting
- Sale, rent,
- Moral Rights



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3/3/2023

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Legal framework

- Copyright in Tanzania is protected under *the Copyright & Neighbouring Rights Act Cap 218*
- ***Objectives of the Act:***
- a) **protects the moral and economic interests of authors** relating to the works, by recognising exclusive authors' rights
- (b) provides for the **protection of expressions of folklore** by rendering certain uses thereof subject to authorisation
- (c) **protects lawful interest of performing artists, producers of phonograms and broadcasting organisations** relating to their productions, by granting them relevant rights
- (d) to **promote the creation of literary and artistic works, to safeguard expressions of traditional culture /expression of folklore,**
- **Copyright Laws provide on exhaustive lists of protected subject matter**

***SUBJECT MATTER/CRITERIA: WORKS IN WHICH COPYRIGHT MAY SUBSIST**

- **Examples of copyrighted work that can be protected under section 5 CAP 218** Copyright Laws provide on exhaustive lists of protected subject matter
- **Section 5, CAP 218:** provides works that qualify for copyright protection: works in which copyright may subsist
 - (1) Authors of **original** literary and artistic works shall be entitled to copyright protection for their works under this Act, by the sole fact of the **creation** of such works
 - (2) In this section **literary** and **artistic** works shall **include** in particular—
 - (a) books, pamphlets and other writings, including computer programs; (b) lectures, addresses, sermons and other works of the same nature; (c) dramatic and dramatic-musical works; sculpture, engraving, lithography and (d) musical works (vocal and instrumental), whether or not they include accompanying words;

Other recognized copyrighted works under the law s.5

- e) choreographic works and pantomimes;
- (f) **cinematographic works**, and other **audio-visual works**;
- (g) works of **drawing, painting, architecture, sculpture**
- (h) **photographic works including works expressed by** processes analogous to photography;
 - (i) works of applied art, whether **handicraft** or produced on an industrial scale;
 - (j) illustrations, **maps, plans, sketches** and three dimensional works relative to geography, **topography**, architecture or science

Derivative works S.6. *Which derivative works can qualify for copyright protection under the Law?*

- 1) The following works are be protected as **original works**—
- (a) **translation, adaptations, arrangements** and other **transformation** of literary and artistic works; and
- (b) collections of literary and artistic works, such as **encyclopaedias and anthologies**; or **collections of expressions of folklore** and **compilation of data or data bases** which, by reason of selection and arrangement of their contents **constitute intellectual creation**; and (
- c) works inspired by expression of folklore

Other areas (related rights) covered by copyright (Section 6 Cap 218)

- **Sound recording;** recording of sounds from which sound producing works may be reproduced .
- **Sound & Television Broadcast:** the provision of a service which involves communications. See The Rome Convention
- **Cable programmes:** cable programme service, sending visual images, sounds, information by means of telecommunications system
- **Broadcast-** e-transmission of visual images, sounds of other information which is transmitted to the recipients
- **Satellite broadcasts-** emission and reception by Satellite broadcasts
- **Film:** recording on any medium from which is moving image by any means reproduced.

Subject matter not protected

- Section 7 provides for the list of work that may not be protected by copyright as individual property
- Notwithstanding the provisions of sections 5 and 6, protection shall not extend to—
 - (a) **laws** and **decisions** of courts and administrative bodies as well as to official translations thereof;
 - (b) **news of the day published, broadcast or publicly communicated** by any other means; and
 - (c) **any idea**, procedure, method of operation, concept, principle, discovery or mere data, even if expressed, described, explained, illustrated or embodied in a work.

Subsistence of copyright under the law

- Section 8 provides that:
- *Substance of copyright in a **literary and artistic work** comprises the **exclusive** economic and moral **rights** of the author as provided for under sections 9 to 11*

expression of folklore/Traditional Cultural Expression

- This is another area protected by Copyright Law
- ‘**traditional cultural expressions**’ or expressions of folklore’ are ‘any forms, whether **tangible and intangible**, in which **traditional culture and knowledge are expressed**, appear or are manifested’,
- Section 4: Cap 2`18 defines "expression of folklore" to mean production consisting of characteristic elements of the traditional artistic heritage developed and maintained over generations by a community or by individuals reflecting the traditional artistic expectations of their community;
- Examples:
 - **Verbal**- folk tales, poetry, riddles, signs, words, stories, names, symbols
 - **Musical**- folk songs, instrumental music
 - **Actions**-dances, plays, ceremonies, rituals and other performances
- (iv) **tangible expressions**, such as productions of art, in particular, **drawings, designs, paintings** (including body painting), **carvings, sculptures**,

- section 24 provides for the list of work that may be protected by copyright as expression of folklore against illicit exploitation
- Section 24:
- This Act protects expression of folklore such as—
 - **(a) folk tales, folk poetry, riddles;**
 - **(b) folk songs and instrumental folk music;**
 - **(c) folk dances, plays and artistic forms of rituals;**
 - **(d) production of folk art, in particular, drawings, painting, carvings, sculpture, pottery, terracotta; mosaic, woodwork, metalware, jewellery, baskets, costumes; and**
 - **(e) traditional musical instruments.**



Part III Of The Law on Protection of **Expression Of Folklore** Against Illicit Exploitation

Provisions

- S.4 "**expression of folklore**" means production consisting of characteristic elements of the traditional artistic heritage developed and maintained over generations by a community or by individuals reflecting the traditional artistic expectations of their community;
- 24. Protected expression of folklore.
- 25. Utilisation subject to authorisation.
- 26. Exceptions.
- 27. Acknowledgement of source.
- 28. Authorisation.
- 29. Competent author



Part IV of the Act protects Performers, Producers of Sound Recordings and Broadcasting organisations

- **Provisions of the Law:**
- 31. Acts requiring authorisation of performers.
- 32. Acts requiring authorisation of producers of sound recordings.
- 33. Equitable remuneration for use of sound recordings.
- 34. Acts requiring authorisation of broadcasting organisations.
- 35. Limitations on protection.

Regulations made under the Copyright & Neighbouring Rights Act

- 1) The Copyright & Neighbouring Rights (Production & Distribution of sound & Audio-Visual-Recordings) Rights Regulations G.No.18 of 2006***
- 2) The Copyright & Neighbouring Rights (Communication to the public) Regulations G.No.29 of 2016***
 - ❖ Takes on board ICTs***
- 3) Licensing and Rights to benefit from resale Regulations G.N.No.137 of 2022: payment of tariffs/royalty***
- 4) Regulations made under the Copyright & Neighbouring (Compounding of offenders) Regulations G.No.18 of 2006***

Challenges on the Law

- The Law does not give details on the protection of digitized copyrighted works in line with WIPO Copyright Digital Treaties
- More copyrighted works can be easily **infringed** under the digital environment/cyberspace
- Copyright is the Most important IP rights in ICTs but the most **affected** area by ICTs
- The vast majority **of songs, books, journals, articles, papers, images, videos** available online are eligible for copyright protection
- Various elements of website are subject to copyright protection
- **Website contents** also qualify for copyright protection
- **Textual materials, individual images** and pictures contained in a website may all separately subject to copyright protection as literary, pictorial, or graphic works
- The Act/Law is not in compliance with ***WIPO Copyright Treaty 1996 & WIPO Performances and Phonograms Treaty (WPPT) 1996*** (Internet/Digital Treaties)



International Legal instruments on Copyright that binds Tanzania

- 1) *TRIPS Agreement*
- 2) *The Berne Convention for the Protection of Literary and Artistic Works*
- 3) *WIPO Performances and Phonograms Treaty*
- 4) *Universal Copyright Protection Treaty*
- 5) *Rome Convention for the Protection of performers, Producers of Phonograms and Broadcasting organizations*
- 6) *WIPO Copyright Treaty 1996 ?????*
- 7) *WIPO Performances and Phonograms Treaty 1996????????*

END



WAMBI



QUESTIONS/COMMENTS



❖ *Dr. Adam Mambi, J*

- *Judge of the High Court of Tanzania*
- *Expert in Cyber-security/ICT/Cyber Law, Intellectual Property Law, Competition Law, Oil & Gas Law*
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VIRTUAL JUDICIAL COLLOQUIUM ON COPYRIGHTS, TRADEMARKS AND MEDIATION OF IP DISPUTES FOR MEMBERS OF JUDICIARY OF TANZANIA



28th FEBRUARY, 2023 - 2nd MARCH, 2023





**TRENDS IN COPYRIGHT LITIGATION IN TANZANIA;
AND NATIONAL JURISPUDENCE
UPENDO NGITIRI
JUDICIARY OF TANZANIA
1/3/2023**

Outline

- Introduction
- Courts with Jurisdiction to adjudicate Copyright Cases in Tanzania
- Common Copyrights disputes in Tanzania
- National jurisprudence
- Challenges/Gaps
- Measures taken



Introduction

- Copyright is a bundle of exclusive legal rights conferred to the owner of literary and artistic work.
- Copyright confer economic and moral rights to the copyright holder.
- Once the copyright is infringed the owner has the right to institute a Civil suit for infringement of his copyright.



Introduction cont....

- A criminal case may also be instituted against a person who violate the copyrights .
- Offences relating to infringement of Copyright are provided under S. 42 of the Copyright and Neighbouring Rights Act Cap 218 R.E 2002 and S. 24 of the Cyber Crime Act,2015 Act No.14 of 2015



Key Copyright Stakeholders in Tanzania



Right holders
(Authors, artist, performers,
broadcasting organizations
producers etc)



Users (Hotels, clubs,
online platforms,
distributors ,TV, radio,
Universities,
advertising agencies
etc)

International legal Instruments governing Copyrights

Copyrights is governed by International Copyrights related treaties such as;

- Berne Convention for the Protection of Literary and Artistic Works (1886)
- International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations (Rome Convention) (1961)
- WIPO Copyright Treaty (WCT) (1996)
- WIPO Performances and Phonograms Treaty (WPPT) (1996)
- Marrakesh VIP Treaty (2013)
- Beijing Treaty on Audio-visual Performances (2012)
- Agreement on Trade-related Aspects of Intellectual Property Rights (WTO TRIPS)

Tanzania has ratified the Berne Convention, Marrakesh Treaty and TRIPS Agreement.

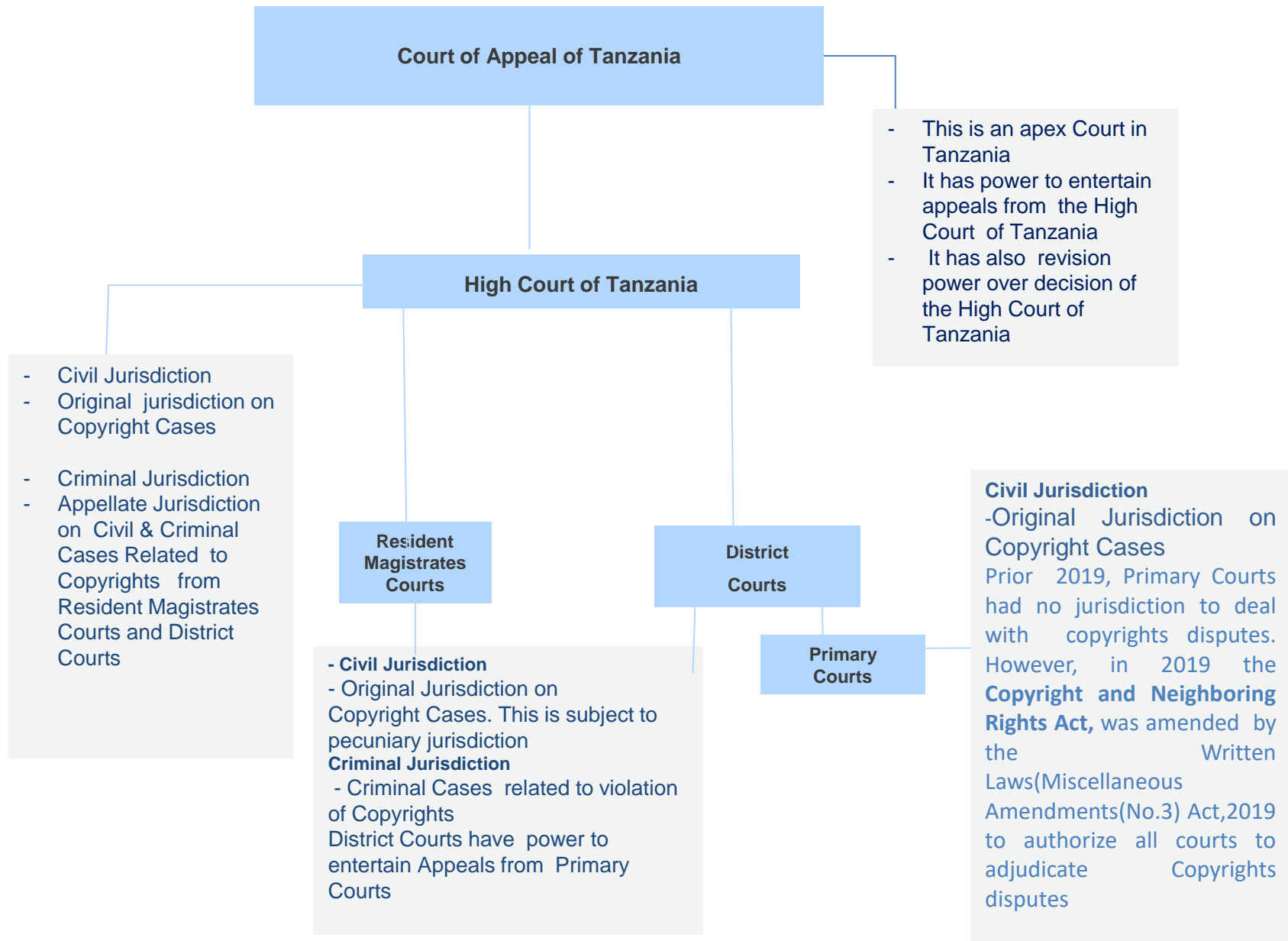


Copyright litigation is governed by the Copyright and Neighboring Rights Act (Cap. 218 R.E 2002) and Subsidiary Legislations made under the act.

-Litigation of civil suit arising out of breach of Copyrights is also governed by the Civil Procedure Code (Cap 33, R.E 2019) while prosecution of Criminal Cases is governed by the Criminal Procedure Act (Cap 20, R.E. 2022) and other relevant statutes such as The Evidence Act (Cap 6, R.E 2022) and The Penal Code (Cap 16, R.E 2022).



Courts with Jurisdiction to entertain Copyright Matters



Common Copyrights Disputes in Tanzania

Unauthorized use of musical work

- Copy of musical work without Authorization
- Communication of musical works to the public without authorization

Airing/communication to the public of films on TV programs

Unauthorized use of Artistic Works
eg drawings , design pattern

Unauthorized reproduction of
Literary work e.g book

Photographic Works





National Jurisprudence



This part will highlight the Copyright Jurisprudence in Tanzania

- Recently there is an increase of Copyright infringement related cases brought before Courts for determination.
- Despite the fact that this is one of very peculiar and technical subject, Tanzania courts have issued decisions on copyright infringement that have laid the foundation on Copyright Jurisprudence. Below are some of the cases that have laid the copyrights jurisprudence in Tanzania



Proof of Originality



- **RSA Limited Vs Hans Paul Automechs Limited and Another**, Commercial Case No. 160 of 2014, High Court of Tanzania, Commercial Division at Dar es Salaam, (Unreported);

Brief facts

The plaintiff being an engineering company dealing in converting bodies of Toyota Land Cruiser and Nissan into famous RSA model safari cruiser and selling them claimed that the defendants had infringed their copyright by copying and using their original artistic engineering drawings and used it to make, and sale similar "Safari" cars and caused loss in their business. The main reliefs sought by the plaintiff in court were perpetual injunction, special and general damages for infringement of its copyright. In their defense, the defendants claimed that the Plaintiff is not original copyright owner of the said engineering drawing

Holding;

1. For a work to be protected as a copyright, under section 5 of the Copyright and Neighbouring Rights Act Cap 218 [R.E. 2002], the plaintiff has to prove that, the work is original in the real sense and it belongs to him in the real sense.
2. The plaintiff's and the defendant's models of convertible cars, even if their visual appearance looks the same, their appearance was not necessarily caused by using similar drawings but because the models of cars were the same.



Proof of Originality and Work Created by Employee

- **Tanzania-China Friendship Textile Company Limited Vs. Nida Textile Mills(NIDA)**
Civil Case No.106 of 2020, High Court of Dar es Salaam , (Unreported)

Brief Facts

The plaintiff, Tanzania-China Friendship Textile Company Limited filed a suit against the defendant, Nida Textile Mills (NIDA) for infringement of a plaintiff artistic work . It was contended that the defendant copied the plaintiff' design pattern of its printed fabric popularly known as khanga and vitenge created by the plaintiff employee. In his defence the defendant denied to have infringed the plaintiff copyright and alleged that the design pattern on their fabric were drawn by local artist and other were acquired along with the acquisition of Sungura Textile Mills in 2003.

Holding;

i. Where the author or creator of the artistic or literary work is an employee, the employer is still considered to be the owner of the rights. The designs pattern on the printed fabric are an original work of the plaintiff, created by the plaintiff's employee.

ii. Infringement of copyrights arises or occurs where a party, not the owner exploits copyrights without permission. It entails improperly copying or



Proof of Originality and Work Created by Employee cont...



- **Tanzania-China Friendship Textile Company Limited Vs. Nida Textile Mills(NIDA)**, High Court of Dar es Salaam , Civil Case No.106 of 2020 (Unreported)

iii. The overall appearance of the defendant's designs is similar to that which was registered by the plaintiff. Any imitation or substantial use in the products manufactured by the defendant was an act of violation or infringement of the plaintiff's rights.

Decision: The Court ordered the plaintiff to compensate the defendant by paying a sum of 150,000,000/- for infringement of copyright



Unauthorized airing of a film



Multichoice Tanzania Limited Vs. Maimuna K.Kiganza, Civil Appeal No. 166 of 2020, High Court of Tanzania at Dar es salaam(Unreported).

Brief Facts

The respondent successfully sued the appellant for infringement of copyright of her protected film titled Penzi Biashara at the District court where he alleged that the appellant aired his film through digital satellite TV over one of his channels, namely "Maisha Magic Bongo." without authorization. In his defence, the respondent claimed that he only provides subscriber management services and he doesn't own the digital satellite TV through which the film was broadcasted without authorization.

Dissatisfied with the decision of the District Court, the appellant appealed to the High Court where he prayed the court to reverse the judgment of the District Court



Unauthorized airing of a film cont....



Multichoice Tanzania Limited Vs. Maimuna K. Kiganzi, Civil Appeal No. 166 of 2020, High Court of Tanzania at Dar es Salaam(Unreported)

Holding;

- i. The appellant did infringe the appellant copyright by airing the appellants movie titled “Penzi Biashara” without authorization.
 - ii. The appellant being a coordinator and a manager of DSTV subscribers’ services, cannot disown the liability on unauthorized aired movie as he is duty bound to coordinate the contents broadcasted in the Digital Satellite Television.
 - iii. Failure to witness the movie aired on the claimed DSTV channel does not negate a factual finding that the movie was broadcasted through the digital satellite TV managed and owned by the appellant. This is because the appellant could not have managed its subscribers' services without coordinating the contents aired through satellite TV.
- Decision: The District Court decision was affirmed. The Court found that there was ample evidence which proved that the appellant did infringe the copyright of the respondent by airing her moving without authorization. All orders were confirmed save for special damages.



Reproduction of Literary work without authorization



Jutoram Kabatale Mahalla Vs. Vocation Training Authority Civil Appeal 63 of 2019, CAT - Dar es Salaam(Unreported).

Brief Facts

The appellant being the copyright owner of the Literary Work which contain five road traffic signs for people with disabilities instituted a copyright infringement suit at the High Court of Tanzania claiming that the Respondent(VETA) reproduced his Literary work in their book “titled Taaluma ya madereva Toleo la pili” without authorization and sold it for gain. The appellant lost the case at the High Court of Tanzania but he successfully appealed against the decision of the High Court.

Holding;

- i. The act of the respondent in reproducing, distributing and selling book that contained the appellant’s recognized creative work without his consent was an infringement of the appellant’s copyright.



Reproduction of Literary work without authorization cont..



Jutoram Kabatale Mahalla V. Vocation Training Authority ,Civil Appeal No. 63 of 2019 CAT- Dar es Salaam(Unreported).

ii. Copyright infringement as defined in the Black's Dictionary 9th edition demand evidence of the defendant access to the original work and substantial similarity of the defendant's work to the original. The evidence on record clearly establishes that the respondent had access to the appellant's work

iii. The 5 road traffic signs found in the respondent's book are similar to those created/designed and registered by the Appellant. There is no doubt that the rights of the appellant as a creator of the road traffic signs, recognized as original material warrants protection envisaged under the provision of S. 5 of the Copyright and neighbouring Act which protect owner of original literary work.

Decision: The respondent was ordered to pay a sum of 50,000,000/= for infringing the appellant's copyright.



Limitation of time



Anselm Tryphone Ngaiza aka Soggy Doggy Anter & 2 others vs Home Box Office Inc, Civil Case No. 162 of 2021 , High Court at Dar es Salaam (unreported).

Brief facts

The Plaintiffs filed a lawsuit against the defendant, for copyright infringement of their musical work. It was alleged that the defendant has used the plaintiff song in a movie that was produced and sold in 2005. The Plaintiff prayed the court to order the defendant to pay a sum of **USD 10,000,000 (ten Million Dollars)** which is (equivalent to **Tshs. 22,879,100,000/=** for copyright infringement.

The defendant raised two preliminary objections against the Civil Suit to the effect that: The High Court Court has no pecuniary jurisdiction to entertain the suit and the suit is time barred. It is their findings that the suit has been founded on tort and since infringement occurred in 2005 the matter is time barred.



Limitation of time cont...



Anselm Tryphone Ngaiza aka Soggy Doggy Anter & 2 Others Vs. Home Box Office Inc, Civil Case No. 162 of 2021, High Court of Tanzania at Dar es Salaam (Unreported).

Holding;

- i. Copyright matters are not tort. Copyright infringement pertains to the violation of someone's intellectual property. It is another term for piracy to the theft of someone's original creation, especially when one uses original creation without consent of the owner.
- ii. The movie is not something which is played once and barked, it is something that is produced, distributed and more copies are being made and played from time to time. The nature of this infringement infer that there is a continuing wrong which constitutes a new cause of action every time the movie is played.

Decision: The Preliminary Objections were dismissed for lack of merits.



Copyright protection and Infringement



Macmillan Aidan (T) Limited Vs. Nyambari Nyangwine, J.A. Masebo and Nyambari Nyangwine Publishers, Commercial Case No. 81 of 2010, High Court of Tanzania, Commercial Division at Dar es Salaam (Unreported)

Brief facts

The plaintiff, the author of the book Mfadhili, sued the defendants, for violating his copyright through publication, selling and distribution of the book titled as Tahakiki which in essence was a review of the plaintiff book “Mfadhili”. The plaintiff alleged further that the defendant used quotations from Mfadhili. In his defense the defendant contended that he had expressly acknowledged the author and publisher of the Mfadhili.

Holding;

i. The infringement of the reproduction right must show substantial similarity between the work and the allegedly infringing material.



Copyright protection and infringement cont....



Macmillan Aidan (T) Limited Vs. Nyambari Nyangwine, J.A. Masebo and Nyambari Nyangwine Publishers, Commercial Case No. 81 of 2010, High Court of Tanzania, Commercial Division at Dar es Salaam(Unreported)

ii. Criticism of a book does not constitute infringement of copyright. A literary work or book, can receive comments and criticism or more often, reviews from different persons who might not be the same or may differ in certain aspects in their view towards such literary work, without infringing any copyright.

Decision: “Tahakiki” is substantially different in the expression of its ideas (content, form, and style) from “Mfadhili.” Thus, there is no copyright infringement. The defendants were awarded the costs of the suit and the suit was dismissed.



Assignment of Copyright



Patrick Balisidya Vs. The Executive Director Audi and Others, Civil Case No. 37 of 1989 High Court of Tanzania at Dar es Salaam, (Unreported)

Brief facts

The plaintiff, the author and composer of the musical production sued the defendants for producing, selling and distributing cassette copies of “Bahati Album” without licence, permission or assignment from the plaintiff or AI Records (K) Ltd, the latter being the sole producer and seller of the “Bahati Album”. The plaintiff argued that while he was the author and composer of musical production and AI Records was the sole producer and seller of the album, the copyright was owned jointly by the two of them. The defendants contested the suit on the ground that the plaintiff had no cause of action against them in terms of section 13 (2) of the Copyright Act, 1966.

Holding;

i. Under section 12 (1) of the Copyright Act, 1966, copyright “shall be transmissible by assignment, by testamentary disposition or by operation of law, as movable property.”



Assignment of Copyright Cont..



Patrick Balisidya v The Executive Director Audi and Others, Civil Case 37 of 1989, High Court of Tanzania at Dar es Salaam (Unreported).

- ii. Once the first owner assigns or licenses his work to assignee or an exclusive licensee, he ceases to be the owner of copyright and the assignee or licensee becomes the owner exclusively.
- iii. The right to sue in cases of infringement of copyright is conferred to the owner of copyright in terms of section 13 (2) of the Copyright Act, 1966

Decision:

- Under the Copyright Act, 1966, copyright could be assigned or disposed of and there is ample evidence that the plaintiff assigned or disposed of the copyright in his composition to Al Records (K) Ltd
- Al Records (K) Ltd were the owners of the copyright in the “Bahati Album”, not the plaintiff. Thus, the plaintiff is not the correct party to sue for copyright infringement of the album.

Commentary –The Current provision for Assignment of Copyrights is S. 16 of the Copyright and Neighbouring Right Act, (CAP 218 R.E 2002)



Assignment of Copyright Cont..



Patrick Balisidya v The Executive Director Audi and Others, Civil Case No. 37 of 1989, High Court of Tanzania at Dar es Salaam (Unreported).

Decision:

- Under the Copyright Act, 1966, copyright could be assigned or disposed of and there is ample evidence that the plaintiff assigned or disposed of the copyright in his composition to Al Records (K) Ltd.
- Al Records (K) Ltd were the owners of the copyright in the “Bahati Album”, not the plaintiff. Thus, the plaintiff is not the correct party to sue for copyright infringement of the album.

Commentary: The Current provision for Assignment of Copyrights is S. 16 of the Copyright and Neighbouring Right Act, (CAP 218 R. E 2002).



Jurisdiction



- **Hamisi Mwinyijuma and Ambwene Yesaya v TIGO Company Ltd**, Civil Case No. 38 of 2011, High Court of Tanzania at Dar es Salaam(Unreported)

Brief facts

The plaintiffs, two musicians, filed a lawsuit against the defendant for copyright infringement of their musical work(ringtones). The plaintiffs sought injunctive relief, special damages, and cost of the case. The defendant raised a preliminary objection challenging the jurisdiction of the High Court.

Holding;

District Courts have jurisdiction to hear disputes arising out of the Copyright and Neighbouring Rights Act (Cap 218 R.E 2002).

Decision:

- The Copyright and Neighbouring Rights Act specifically provided that the Court with jurisdiction in copyrights matters is the District Court .The case was dismissed for lack of jurisdiction.

Commentary: This was the position before 2019. The Written Laws (Miscellaneous Amendment (No.3) Act, 2019 amended the Copyright Right and Neighbouring Rights Act. The law has conferred all Courts jurisdiction to entertain Copyright suits subject to pecuniary jurisdiction.



Challenges/Gaps



Despite the fact that the higher Courts had developed precedents, there are still challenges associated with litigation of Copyrights disputes in Tanzania.

The Judiciary of Tanzania has however undertaken various steps to ensure excellence in delivery of justice in this area; The Common challenges include;

Low IP awareness
among judicial officers

Lack of IP Guidelines,
Bench books

Low IP awareness
among Advocates
,public prosecutors
and the public

Measures taken cont....

The Judiciary of Tanzania commenced collaborative endeavours with WIPO in 2018 with the view to strengthening Judicial System and Services for IP protection. In 2021 WIPO and the Judiciary of Tanzania formalized the collaboration by signing the MoU. Some of the activities undertaken since 2018 includes:-

- ✓ The exchange of Judicial experiences through participation of Tanzania Judges in the WIPO Judges Forum, WIPO Webinars, Conferences and Seminars, Judicial capacity building Training Programmes and WIPO Academy learning Distance Courses for Judges



Measures taken cont....

eg In 2019 , WIPO in collaboration with the Judiciary of Tanzania conducted physical IP building capacity training to 30 Resident Magistrates in Dar es Salaam -Tanzania ,In 2022 more than 60 Judicial officers completed the WIPO Academy learning distance course for Judges .

Other activities undertaken by the Judiciary in cooperation with WIPO includes:-

- ✓ Developing Compendium of Training Materials for Judicial Officers & Digest of IP Cases.
- ✓ Establishment of a WIPO Depository Library in the Judiciary of Tanzania Library.
- ✓ Collaboration between the Judiciary of Tanzania and WIPO Arbitration and Mediation Centre.



- ✓ The Institute of Judicial Administration(IJA) in collaboration with the Judiciary of Tanzania had also conducted two IP online Training programs to 200 Judicial Officers in 2021 & 2022.
- ✓ Collaboration with key IP stakeholders eg In 2022 The Judicial Institute of Administration(IJA) in collaboration with the Copyright Society of Tanzania (COSOTA) and the Judiciary of Tanzania had conducted physical Copyright building capacity Training to 30 Resident Magistrates.



Measures taken cont....

Apart from the ongoing collaboration between the Judiciary of Tanzania and WIPO, the Judiciary of Tanzania is also participating in developing Africa Regional IP Bench book in collaboration with United State Department of Justice and African Regional Intellectual Property Organization(ARIPO). The bench book intends to serve as quick reference and guiding materials to Judges & Magistrates.



**THANK YOU FOR LISTENING
UPENDO NGITIRI**





ADJUDICATING IP DISPUTES AND TRENDS IN IP CASE MANAGEMENT

Hon. Jeremy Fogel (Ret.)

Executive Director, Berkeley Judicial Institute

University of California, Berkeley Law School



WHO ARE THE ADJUDICATORS?

Some countries have specialized IP courts with technically-trained judges

Others have identified IP dockets assigned to judges who develop practical expertise over time

Still others assign IP cases in the same manner as other cases

Countries without specialized IP courts vary widely in the training they provide to judges who adjudicate IP disputes



GUIDING PRINCIPLES

Active judicial case management resolves IP cases; allowing IP cases to linger on the docket tends to benefit infringers

If the volume of cases makes active judicial case management in all cases impracticable, it may make sense to consider a separate track for IP cases

It is difficult for judges to manage IP cases effectively without at least some specialized training focused on the nature and implications of IP rights and on skills that facilitate expedited case management



WHAT ARE CURRENT BEST PRACTICES FOR MANAGING IP DISPUTES?

Judges have access to training that focus on the nature and legal implications of IP rights

Judges have access to training in calendar management skills

Judges learn to identify technological issues and obtain expert assistance when needed

To the extent possible within a country's legal system, trials are continuous rather than spread out over multiple weeks and months

Judgments and other forms of relief in IP cases are clear, specific and informed by the context in which they will be enforced



Introduction

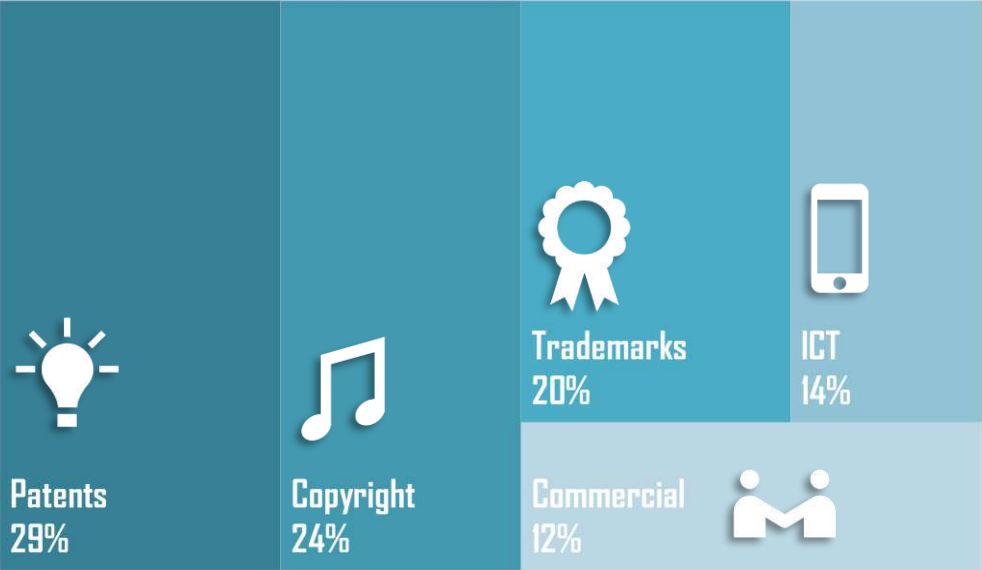
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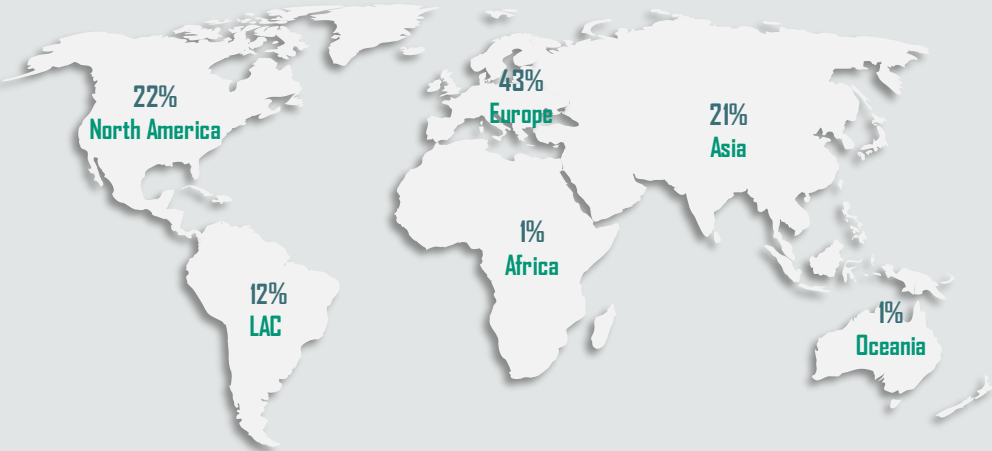
Heike Wollgast, WIPO Arbitration and Mediation Center

WIPO ADR Caseload

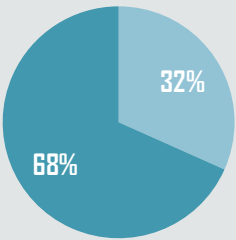
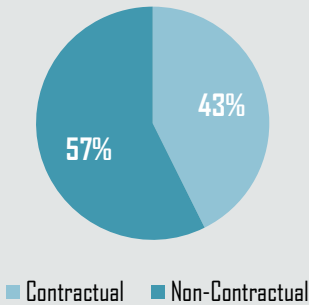
Legal Areas - WIPO ADR



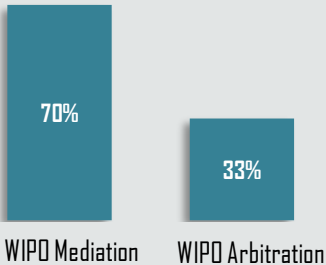
Party Location – WIPO ADR



Case Source – WIPO ADR



Settlement Rate – WIPO ADR

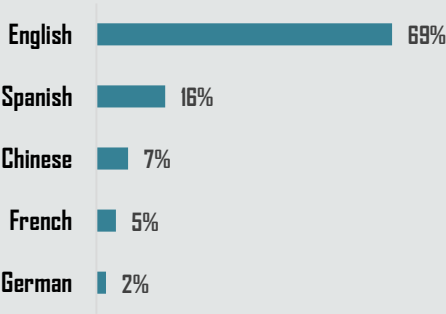


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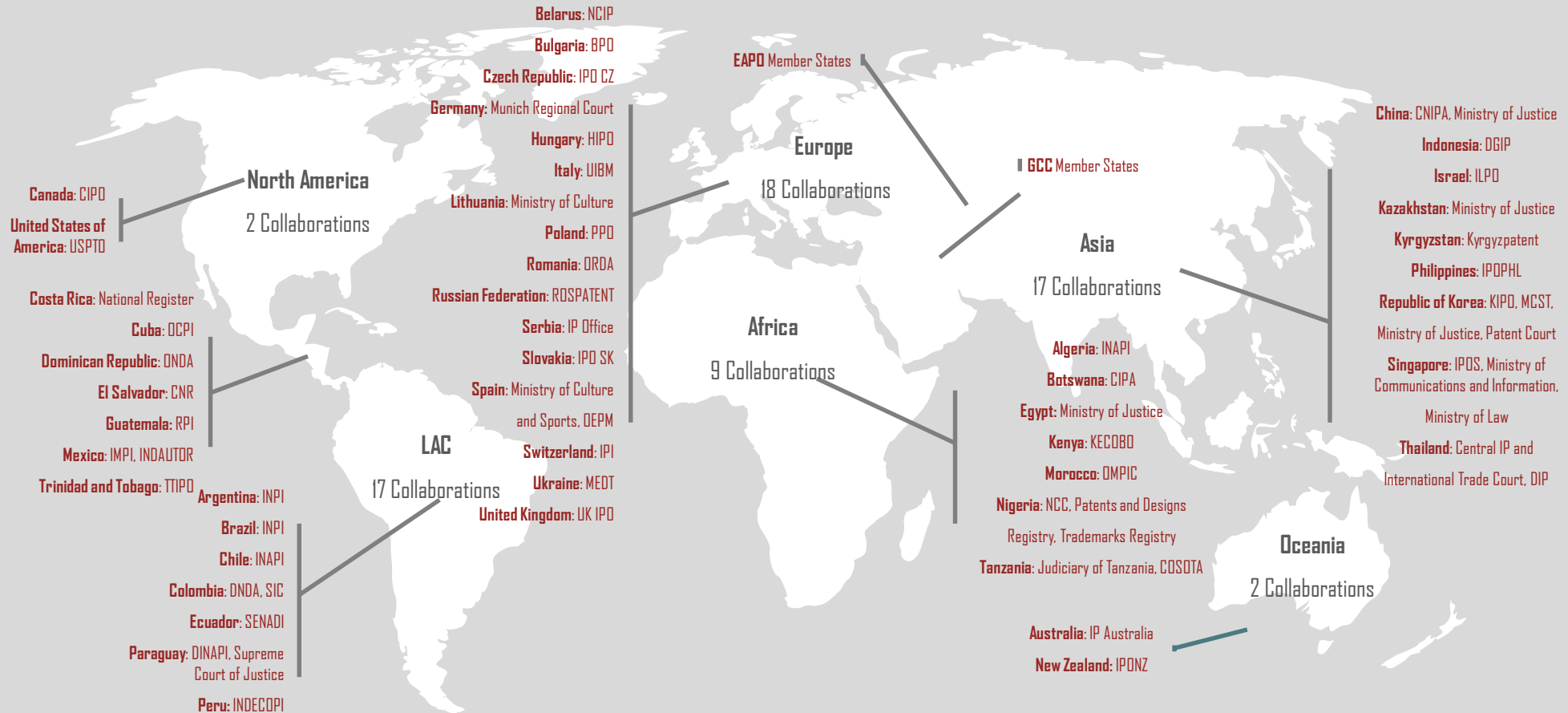
Use of **WIPO online case tools**

+45% in 2021
+105% in 2022 (including co-administration of disputes with DND, Colombia, and INDAUTOR, Mexico).

Language – WIPO ADR



WIPO ADR Collaborations with IP Offices and Courts



Total: 66 collaborations

WIPO Mediation including Online Conduct of Mediation Proceedings

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Chiara Accornero, WIPO Arbitration and Mediation Center

World Intellectual Property Organization (WIPO)

- Promotes innovation and creativity
- For the economic, social and cultural development of all countries
- Through a balanced and effective international IP system
- IP services that encourage individuals and businesses to innovate and create
 - **Alternative Dispute Resolution (ADR)** services to reduce the impact of disputes on innovation and creative processes



WIPO Arbitration and Mediation Center

- IP and Innovation Ecosystems Sector (IES)
- IP- and innovation-related commercial disputes
- Global, neutral and specialized
- Users from across the world; increased use by innovators and SMEs
- Mediation, arbitration, expert determination and domain name disputes




Why ADR for IP Disputes

- Cost and duration of IP court litigation
- Internationalization of creation and use of IP
- Technical and specialized nature of IP
- Short product and market cycles in IP
- Confidential nature of IP
- Collaborative nature of IP creation and commercialization



Role of the WIPO Center

- Procedural assistance
 - Information and guidance on ADR
 - Drafting ADR clauses and submission agreements
- Administering cases
 - Containing time and costs
 - WIPO eADR and **online tools**
- Assisting selection and appointment of mediators and arbitrators; negotiating fees
 - 2,000+ WIPO experts from all regions
 - Specialized in IP and technology



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WIPO Checklist for the Online Conduct of Mediation and Arbitration Proceedings

Preliminary Considerations

1) Do the WIPO Mediation, Arbitration and Expedited Arbitration Rules (WIPO Rules) address the online conduct of proceedings?

Yes, the WIPO Rules allow parties, mediators and arbitrators to conduct proceedings online as appropriate (Article 10 [WIPO Mediation Rules](#), Article 37(a) [WIPO Arbitration Rules](#), Article 31 (a) [WIPO Expedited Arbitration Rules](#)). In addition, mediators and arbitrators have the duty to ensure that proceedings take place with due expedition (Article 11 WIPO Mediation Rules, Article 37(c) WIPO Arbitration Rules, Article 31(c) WIPO Expedited Arbitration Rules). In the WIPO Center's case experience, this has included the online conduct of mediation meetings and arbitration hearings.

Pursuant to Article 40 WIPO Arbitration Rules/Art. 34 WIPO Expedited Arbitration Rules, the preparatory conference can be held in any format; in practice, it normally is conducted via telephone, videoconference, or increasingly using online tools.

2) Is it possible to conduct WIPO Mediation and Arbitration proceedings in a hybrid format?

Yes, the WIPO Center has administered some proceedings where some parties, mediators, or arbitrators participated in meetings or hearings in-person while others joined through online tools.

Choice of Online Platform

3) Are parties, mediators and arbitrators in WIPO proceedings free to choose the online platform they wish to use for their proceedings?

Yes, parties, mediators and arbitrators are free to agree on the online platform(s) they wish to use. In WIPO mediations and arbitrations, this has included the use of WebEx, Zoom, Teams, Bluejeans, WhatsApp, and Skype for Business.

The Move Online

- Sudden environment change
 - Covid-19: travel restrictions and social distancing considerations
 - 2020-2022: almost all WIPO ADR meetings and hearings took place virtually
 - Good opportunity to develop and «test» online tools
 - Very positive experience (increased time- and cost-efficiency, increased flexibility)
 - Notable increase in WIPO Center's caseload; may be due in part to the move online

Online Case Administration Tools: Online Meetings and Hearings

- Videoconferencing tools
 - Choice of platform
 - Need to consider specific functionalities
 - Be mindful of data protection and confidentiality issues
 - Do not neglect test sessions
 - WIPO Center can assist parties and neutrals in that regard
- Consider adapting the schedule of the meetings and hearings



- Questions: arbiter.mail@wipo.int
- Information: www.wipo.int/amc/en/
- Clauses: www.wipo.int/amc/en/clauses/
- Resources: [Newsletter ADR](#)
[Webinars](#)
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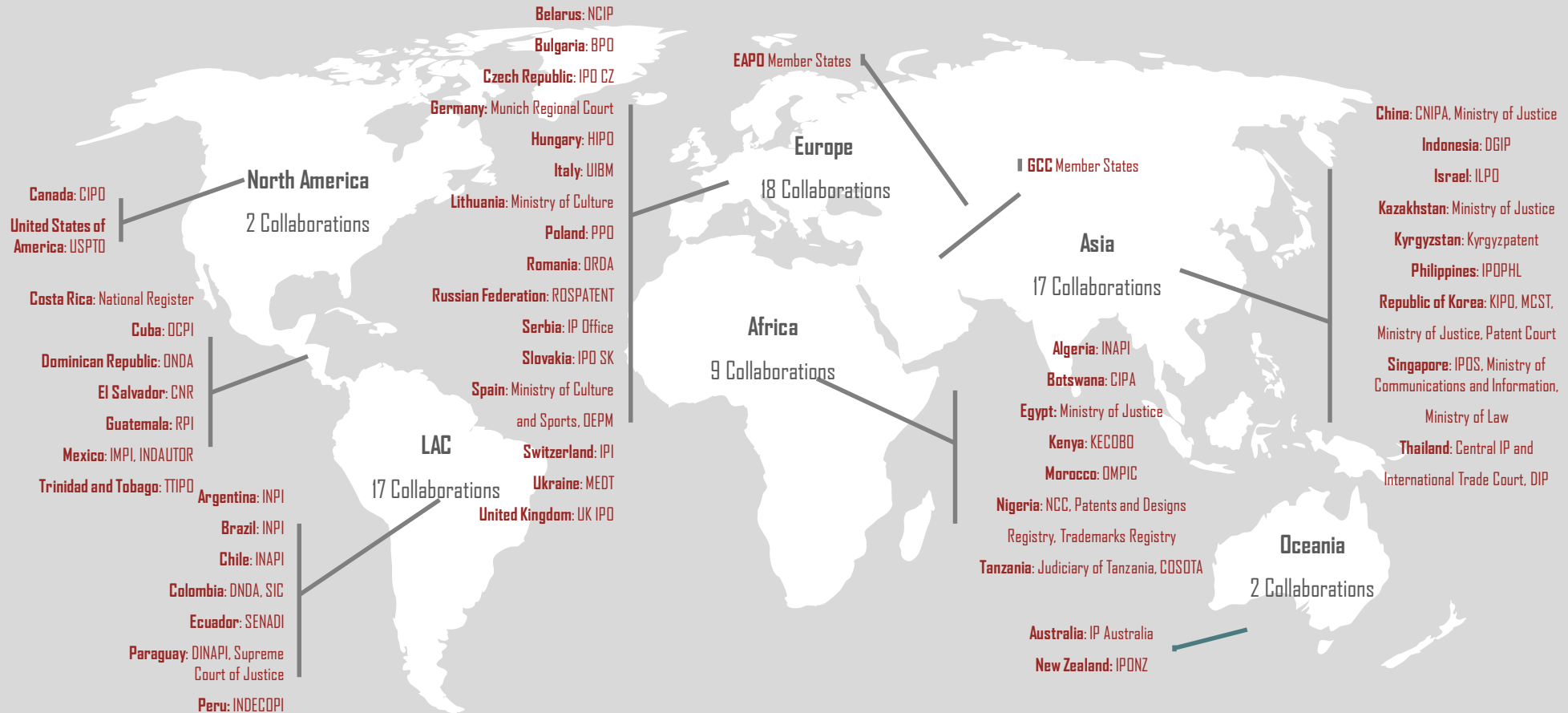
WIPO Mediation Case Examples

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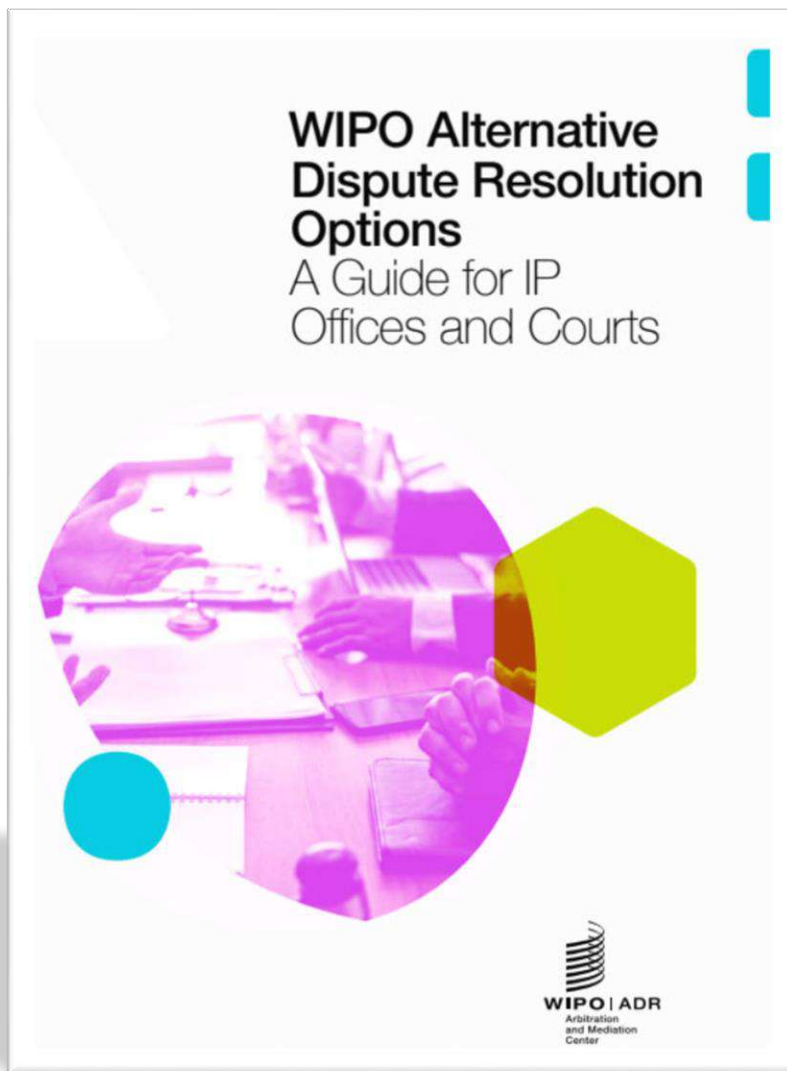
Chiara Accornero, WIPO Arbitration and Mediation Center

WIPO ADR Collaborations with IP Offices and Courts




Total: 66 collaborations

WIPO ADR Guide for IP Offices and Courts



- New 2022 edition
- Available in Chinese, English, French and Spanish

www.wipo.int/publications/en/details.jsp?id=4613&plang=EN



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WIPO Alternative Dispute Resolution (ADR) Options for Intellectual Property and Technology Cases pending before National Courts

Where intellectual property (IP) and technology disputes are pending before national courts, alternative dispute resolution (ADR) procedures can offer additional benefits in bringing such cases to a successful conclusion.


[WIPO ADR Model Submission Agreements](#)
[WIPO Guide on Alternative Dispute Resolution Options for Intellectual Property Offices and Courts](#)

ADR may present a suitable opportunity for cases pending before national courts where the parties are willing to explore settlement or need the assistance of an expert in a technical or scientific matter. The WIPO Arbitration and Mediation Center (WIPO Center) administers cases referred to ADR by national courts as well as by other adjudicative bodies, including [Intellectual Property and Copyright Offices](#) (IPOs).

Current Collaborations

China	Supreme People's Court (SPC)	The WIPO Center collaborates with the SPC in the promotion of the use of mediation for intellectual property disputes in China.
Germany	Munich Regional Court	The WIPO Center collaborates with the Munich Regional Court in the promotion of the use of ADR options for patent/FRAND disputes.
Paraguay	Supreme Court of Justice of Paraguay	The WIPO Center collaborates with the Supreme Court of Justice of Paraguay in the promotion of the use of ADR options for intellectual property disputes in Paraguay.

https://www.wipo.int/amc/en/clauses/national_court.html



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WIPO Checklist for the Online Conduct of Mediation and Arbitration Proceedings

Preliminary Considerations

1) Do the WIPO Mediation, Arbitration and Expedited Arbitration Rules (WIPO Rules) address the online conduct of proceedings?

Yes, the WIPO Rules allow parties, mediators and arbitrators to conduct proceedings online as appropriate (Article 10 [WIPO Mediation Rules](#), Article 37(a) [WIPO Arbitration Rules](#), Article 31 (a) [WIPO Expedited Arbitration Rules](#)). In addition, mediators and arbitrators have the duty to ensure that proceedings take place with due expedition (Article 11 [WIPO Mediation Rules](#), Article 37(c) [WIPO Arbitration Rules](#), Article 31(c) [WIPO Expedited Arbitration Rules](#)). In the WIPO Center's case experience, this has included the online conduct of mediation meetings and arbitration hearings.

Pursuant to Article 40 [WIPO Arbitration Rules](#)/Art. 34 [WIPO Expedited Arbitration Rules](#), the preparatory conference can be held in any format; in practice, it normally is conducted via telephone, videoconference, or increasingly using online tools.

2) Is it possible to conduct WIPO Mediation and Arbitration proceedings in a hybrid format?

Yes, the WIPO Center has administered some proceedings where some parties, mediators, or arbitrators participated in meetings or hearings in-person while others joined through online tools.

Choice of Online Platform

3) Are parties, mediators and arbitrators in WIPO proceedings free to choose the online platform they wish to use for their proceedings?

Yes, parties, mediators and arbitrators are free to agree on the online platform(s) they wish to use. In WIPO mediations and arbitrations, this has included the use of WebEx, Zoom, Teams, Bluejeans, WhatsApp, and Skype for Business.

Referral to WIPO Mediation Example

<i>Parties</i>	Two European companies specializing in augmented reality technology for the media and entertainment industries
<i>Dispute</i>	Ownership and infringement of patents and copyrights
<i>Basis</i>	Submission agreement to WIPO Mediation pending court proceedings
<i>Process</i>	Mediator with expertise in IP, neutrality, intercultural awareness, emotional competence and legal language skills Joint conference call One-day mediation session in two languages
<i>Result</i>	Settlement in three months

Referral to WIPO Mediation Example

<i>Parties</i>	Chinese and US companies in the fashion industry
<i>Dispute</i>	Trademark infringement and unfair competition claims, litigation pending before Pudong District Court (Shanghai)
<i>Basis</i>	Submission agreement to WIPO Mediation and court proceedings suspended for 30 days
<i>Process</i>	Mediator with experience in Chinese trademark law One-day mediation meeting in Shanghai
<i>Result</i>	Settlement confirmed by the court and withdrawal of litigation

Referral to WIPO Mediation Example

<i>Parties</i>	German and US companies in the biotech industry R&D collaboration concerning the development of a vaccine No dispute resolution clause in the agreement
<i>Dispute</i>	Payment and performance delays, litigation pending before US court where the judge suggested mediation
<i>Basis</i>	Submission agreement to WIPO Mediation and court proceedings suspended
<i>Process</i>	Mediator with experience in IP and R&D collaborations Preparatory calls and mediation meeting in the US
<i>Result</i>	Settlement in five months

Referral to WIPO Mediation Example (Online)

<i>Parties</i>	Two European companies in the transport industry
<i>Dispute</i>	Patent infringement
<i>Basis</i>	Submission agreement to WIPO Mediation pending court proceedings
<i>Process</i>	Two co-mediators Two mediation sessions followed by individual meetings (caucus) with each party and a third mediation session Mediation sessions conducted online
<i>Result</i>	Settlement in five months



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