



A Legal Brief

Legal Updates on the legal validity of ARIPO trademarks in Tanzania and the applicability of the territoriality principle in trademark.



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Trademark law updates from Tanzania

[Lakairo Industries Group Co. Limited & Others V. Kenafrica Industries Limited and Others, Civil Appeal No. 593 of 2022]

- **Restatement of the principle of territoriality of intellectual property rights,**
- **The legality of trademarks registered in Tanzania through the African Regional Intellectual Property Organization (ARIPO) system, and**
- **implications for cross-border trade under the East African Community (EAC)**

1. Background

The case involved competing claims to ownership and use of the trademarks “*Pipi Kifua*”, “*Special Veve*”, and “*Orange Drops*” in Tanzania. The Respondent, Kenafrica, a Kenyan company, alleged infringement by Lakairo, a Tanzanian Company, and sought expungement of the Tanzanian registrations and damages. The High Court of Tanzania ruled in favour of the Respondent (the Plaintiff in the High Court). Aggrieved, Lakairo (the Appellant) appealed to the Court of Appeal of Tanzania (CAT), the supreme Court under Tanzania’s court system. Apparently, the two companies had a prior business relationship, in which the latter served as an agent of the former in Tanzania.

The core legal issues were:

- (a)** *Whether Lakairo’s registered trademarks infringed Kenafrica’s marks.*
- (b)** *Whether marks registered under ARIPO (via Banjul Protocol) are legally enforceable in Tanzania.*

2. The Ruling

The CAT restated and upheld the **principle of territoriality** in trademark law, stating that:

- (a) Exclusive rights over a trade or service mark arise **only upon domestic registration** under the Trade and Service Marks Act (Cap. 326).



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- (b) Trademarks registered through ARIPO registrations **cannot be enforced in Tanzania** as the Banjul Protocol, though signed by Tanzania, is yet to be ratified or domesticated (*Tanzania being a dualist state, international agreements/protocols signed by Tanzania are not automatically enforceable, instead, they can only become legally enforceable after undergoing a domestication process – enacting the implementing legislation*).
- (c) Foreign trademark registrations cannot override a trademark which have been locally registered in Tanzania (presumably, it is subject to the rule of priority filing), reaffirming the territoriality principle of intellectual property rights.
- (d) The CAT annulled the High Court's order and held that Lakairo's Tanzanian trademarks did **not infringe** Kenafrica's trademarks registered in Kenya and purported to be registered in Tanzania through the ARIPO's route under the framework of the Banjul Protocol.

3. Commentary and Critique

We have singled out some issues from the ruling, which, in our view, may have some practical, far-reaching implications:

3.1. Territoriality of Trademarks

- (a) **Territoriality:** The Court correctly applied the **territorial principle**, rooted in section 14(1) & 20 of the Trade and Service Marks Act, Cap. 326 and Article 6(3) of the Paris Convention.
- (b) **Controversy in Regional dimensions:** The judgment adds to the list another Court's rulings on trademark law within the EAC, which is likely to have an impact on (inhibit) cross-border trade/investments. Other rulings are: From Rwanda: *Bakhresa Grain Milling (Rwanda) Ltd. v. Mikoani Traders Ltd.*, Case No. RCOMA 00276/2016/CHC/HCC (upholding the territoriality rule) and from Uganda: *Nairobi Java House Ltd. v. Mandela Auto Spares Ltd., High Court of Uganda*, Civil Appeal No. 13 of 2015 (stating that the EAC Treaty objectives should take precedence over the territoriality rule).



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3.2. Legality of ARIPO Registrations

- (a) *Tanzania is a member of ARIPO*: While Tanzania is a signatory to the Banjul Protocol, it has yet to ratify/domesticate it to make it enforceable, based on the principle of dualism as applied in public international law. Thus, the CAT has held that ARIPO marks designating Tanzania lack **legal effect**.
- (b) *The CAT ruling creates a **regulatory paradox***: Business Registration and Licensing Agency (BRELA), (Registrar of Trademarks in Tanzania) routinely cooperates with ARIPO in trademark registration filed through ARIPO (accepting designation fees, issuing “no objections”), yet this CAT ruling has denied the legality and enforceability of such marks in Tanzania. It remains to be seen whether proprietors of trademarks registered in Tanzania through the ARIPO route, alarmed by this ruling, will challenge the verdict by filing an application seeking, among other things, a Declaratory Order on the validity of their Trademarks, relying on the rule of estoppel against the Government of Tanzania.

3.3. Implications for Cross-Border Trade

- (a) Cross-border businesses face **legal uncertainty**: a Kenyan trademark purportedly valid under ARIPO cannot block a later Tanzanian registration.
- (b) This may foster “trademark squatting” in Tanzania, where local traders can quickly register foreign brands domestically.
- (c) The judgment may deter foreign investment and undermine regional integration goals under the EAC and the African Continental Free Trade Area (AfCFTA).

3.4. Marks Registered in Tanzania through the ARIPO System

Admittedly, proprietors of ARIPO marks face a significant legal dilemma in Tanzania. Possible recourse:

- (a) File **fresh national applications in Tanzania** (most practical), subject to availability checks of their trademarks.



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- (b) Seek a **declaratory order** at the CAT invoking the rule of **estoppel**. The estoppel argument is novel but possible, as BRELA's administrative actions created legitimate expectations.
- (c) Lobby for *retrospective ratification* of the Banjul Protocol by Tanzania.

3.5. Institutional and Professional Guidance

(a) BRELA

- (i) Should publish clear guidance that ARIPO marks designating Tanzania **lack effect** until ratification.
- (ii) Stop accepting and charging ARIPO designation fees unless Tanzania intends to honour them.
- (iii) Urgently advise the Ministry to resolve the gap through retrospective ratification.

(b) Trademark Agents:

- (i) Should advise clients always to file trademark applications in Tanzania through the national route until the Banjul Protocol is ratified.
- (ii) Advise ARIPO proprietors already holding "phantom" rights to refile nationally or consider estoppel-based litigation.

(c) The Government of Tanzania:

- (i) Ratify the Banjul Protocol **retrospectively**.
- (ii) Harmonize with EAC IP frameworks to prevent forum shopping and inconsistent enforcement.

4. Conclusion

The CAT reaffirmed that only domestic registration grants trademark rights in Tanzania, sidelining ARIPO marks. While legally and doctrinally correct, this decision has created a legal and regulatory dilemma for dozens of trademarks filed in Tanzania through the ARIPO system. Until legislative reforms are made, it is advisable for trademark owners to register directly in Tanzania, regardless of ARIPO designations.



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Disclaimer:

This legal brief summarizes our reflections on the recent Court of Appeal of Tanzania's decision in *Lakairo Industries Group Co. Limited & Others V. Kenafrica Industries Limited and Others*. It is not intended to serve as legal advice for any specific case you may be dealing with. For tailored legal guidance, please consult your preferred attorney or the undersigned.

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