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Measures Against Fraudulent or Bad Faith Trademark Filings: Kenya & Tanzania

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INTRODUCTION

Fraudulent or bad-faith trademark filings pose a growing challenge for brand owners, undermining legitimate rights and creating uncertainty in the marketplace. As trademark systems continue to expand across jurisdictions, so too does the need for effective legal mechanisms to prevent, challenge, and remove improperly obtained registrations. This Special Newsletter provides an overview of the principal measures available to address fraudulent or bad-faith trademark filings in Kenya and Tanzania, with particular focus on opposition and invalidation procedures, and offers practical guidance to assist rights holders in protecting and enforcing their brands.

KENYA

1. Overview of the Trademark System

1.1. First-to-file or first-to-use

Kenya adopts a first-to-file system. In terms of Section 7 of the Trade Marks Act (Cap 506)¹, registration confers exclusive rights to use the mark in relation to the goods/services for which it is registered. Prior use without registration may support a passing-off action if the Applicant can provide evidence of goodwill, misrepresentation and damages suffered. However, registration is the sole basis for instituting trademark infringement proceedings.

1.2. Single or multi-class application system

Kenya applies a multi-class filing system². This is consistent with the Trade Marks Rules (1956)³ as revised, which allow for an application to specify goods or services in more than one class.

1.3. Available filing routes

Direct national applications are filed with the Kenya Industrial Property Institute (KIPI)⁴.

Kenya is a member of the ARIPO. However, as it has not ratified the Banjul Protocol, an applicant cannot currently designate the country in a regional ARIPO application. Kenya is not a member of OAPI.

¹ <https://new.kenyalaw.org/akn/ke/act/1955/51/eng@2022-12-31>

² Rule 21 of the Trademark Rules read with Rule 3 and First Schedule

³ <https://new.kenyalaw.org/akn/ke/act/ln/1956/575/eng@2022-12-31>

⁴ <https://www.kipi.go.ke/>

Kenya is a member of the Madrid Protocol⁵. Applicants can designate Kenya through an international application under the Madrid system. KIPI examines Madrid designations in line with national law.

1.4. Duration

In terms of Section 23 of the Trade Marks Act (Cap 506), the initial registration term for a trademark registration is 10 years. Thereafter, it is renewable indefinitely for a period of 10 years, subject to payment of renewal fees. Renewal must be filed before expiry; late renewal is possible with surcharge.

1.5. Substantive examination

Kenya conducts substantive examination on both absolute grounds and relative grounds. On absolute grounds, Section 14 of the Trade Marks Act provides for refusal if mark is not distinctive, is descriptive, deceptive, scandalous, or contrary to public policy. Section 15 (1) of the Trade Marks Act provides for refusal on relative grounds if a mark conflicts with earlier registered marks for similar goods/services. Examiners assess distinctiveness, likelihood of confusion, and compliance with statutory requirements. Section 15A provides the substantive provisions on well-known marks.

1.6. Fraudulent or bad faith filings

Fraudulent or bad faith filings are subject to opposition and cancellation under statutory provisions and international obligations. Bad faith is often raised during opposition or cancellation proceedings, and not at the initial examination. Kenyan courts have recognized that fraudulent intent undermines validity, even if formal requirements are met.

1.7. Legislative framework / examination guidelines

The following provisions of the Trade Marks Act apply:

- Section 14 provides for refusal if a mark is likely to deceive or cause confusion.
- Section 15 (1) provides for refusal if a mark is identical or similar to an existing registered mark.
- Section 21 provides for opposition proceedings, and bad faith may be raised pursuant to section 20 (1).
- Section 35 provides for applications to be made for an order for making, expunging or varying an entry on the Trade Marks Register. Therefore, a registration obtained by fraud or misrepresentation may be declared invalid under this section.

⁵ <https://www.wipo.int/wipolex/en/text/283484>

- In addition, the Constitution of Kenya⁶, Article 40(5) obliges the State to support, promote, and protect intellectual property rights, which may reasonably be construed as including the prevention of fraudulent registrations.

The following International Obligations are applicable:

- The Paris Convention⁷ (Article 6bis): Protects well-known marks against bad-faith registration.
- The Madrid Protocol provides for fraudulent international applications to be opposed or refused.

2. Trademark Search methods

KIPI does not maintain a public trademark database. The official trademark gazette is published periodically at the end of each month and may be accessed at <https://www.kipi.go.ke/ip-journal>. Information accessible includes application number, trademark, class of goods/services, specification of goods/services, applicant name and address. Information regarding disclaimers, endorsements and other conditional acceptances is also available.

The database is published in English.

Keyword search is available via Microsoft Word.

The ARIPO regional database⁸ and WIPO database⁹ are not maintained by KIPI and results may not be fully accurate or current for Kenyan trademarks.

3. Measures Upon Discovering That a Third Party Has Filed or Registered a Mark Identical or Similar to One's Own

3.1. Submission of Information to the Trademark Office Regarding a Fraudulent / Bad-Faith Filing

There is no codified process for “submitting information” regarding a fraudulent or bad-faith filing to trademarks office in terms of the Trade Marks Act Cap 506 (“the Trade Marks Act”). Where such issues arise, an interested party would have to file formal cancellation or opposition proceedings

3.2. Opposition Proceedings

⁶ <https://new.kenyalaw.org/akn/ke/act/2010/constitution/eng@2010-09-03>

⁷ <https://www.wipo.int/wipolex/en/text/288514>

⁸ <https://eservice.aripo.org/pmi/PMIMain.do>

⁹ <https://www.wipo.int/en/web/global-brand-database>

Any person is eligible to file opposition against an advertised mark.¹⁰

Opposition is filed with the Registrar¹¹, the Kenyan Industrial Property Institute (KIPI).

Rule 46 of the Trade Mark Rules No. 575 of 1956 (“the Trade Mark Rules”) provides that opposition is to be filed within 60 days of the date of publication of the impugned application in the Journal.¹² In terms of Trade Mark Rules 102(1) and 102(3) the opposition term can be extended by 30 days and up to a maximum of 90 days¹³, upon request to the Registrar, and without consent of the Trademark Applicant.

Grounds of opposition

The grounds for filing an opposition against an identical or similar mark, including in bad faith, are founded in Sections 14, Section 15(1) and Section 15A of the Trade Marks Act. These grounds encompass opposition on the basis:

- that use of a mark, particularly where identical or similar to one’s own, would be likely to deceive or cause confusion¹⁴;
- that the mark would be disentitled to protection in a court of justice¹⁵;
- that the mark would be contrary to law or morality¹⁶. This ground is broad enough to address a mark filed in bad faith;
- of a prior registration for an identical mark in respect of the same goods or services, or a nearly resembling mark in respect of the same goods or services¹⁷; and
- that a mark shall not be registered if that trademark, or an essential part thereof, is likely to impair, interfere with or take unfair advantage of the distinctive character of the well-known trademark.

Procedure

The Opponent files a Notice of Opposition, on Form TM6¹⁸, within 60 days of the date of the publication of the impugned Application¹⁹, or within the extended period. Although evidence need

¹⁰ Section 21(2) of the Trade Marks Act and Rule 46 of the Trade Mark Rules No. 575 of 1956

¹¹ Rule 46 of the Trade Mark Rules

¹² Rule 46 of the Trade Mark Rules

¹³ Rule 102(1) and 102(3) of the Trade Mark Rules

¹⁴ Section 14 of the Trade Marks Act

¹⁵ Section 14 of the Trade Marks Act

¹⁶ Section 14 of the Trade Marks Act

¹⁷ Section 15(1) of the Trade Marks Act

¹⁸ Rule 47 of the Trade Mark Rules

¹⁹ Rule 46 of the Trade Mark Rules

not be filed at this stage, the Notice of Opposition must include a statement of the grounds of opposition.

The Trademark applicant has 42 days from the date of service of the Notice of Opposition to file a Counter Statement, on Form TM7, in response.²⁰ The 42 days may be extended by a maximum of a further 90 days without requiring the Opponent's consent.

Upon service of the Counter Statement, the Opponent has 42 days within which to file a Statutory Declaration/s (the evidence) in support of the Opposition.²¹ The 42 days may be extended by a maximum of a further 90 days²² without requiring the Applicant's consent.

Upon service of the Opponent's Statutory Declaration, the Applicant has 42 days within which to file a Statutory Declaration/s in support of the registration of the trademark.²³ The 42 days may be extended by a maximum of a further 90 days without requiring the Opponent's consent.²⁴

Upon service of the Applicant's Statutory Declaration, the Opponent has 30 days within which to file a Statutory Declaration in reply.²⁵ The 30 days may be extended by a maximum of a further 90 days without requiring the Applicant's consent.²⁶

If the Trademark Applicant fails to file a counter-statement, or evidence in support of the application, or the Opponent fails to file evidence in support of the opposition, the case shall be deemed to be abandoned and the Registrar may proceed to make an award of costs.²⁷

Once all papers have been filed, the parties are invited by the Registrar to take a hearing date.²⁸ The Registrar may alternatively direct the parties to file written submissions instead and only appear before him to highlight the same or to simply file the submissions and await the delivery of the ruling.

If the parties have been directed to file written submissions, the Opponent must file its submissions within 14 days of service of the Registrar's letter.

²⁰ Rule 48 of the Trade Mark Rules

²¹ Rule 49 of the Trade Mark Rules

²² Rule 102(1) and 102(3) of the Trade Mark Rules

²³ Rule 50 of the Trade Mark Rules

²⁴ Rule 102(1) and 102(3) of the Trade Mark Rules

²⁵ Rule 51 of the Trade Mark Rules

²⁶ Rule 102(1) and 102(3) of the Trade Mark Rules

²⁷ Rule 52A of the Trade Mark Rules

²⁸ Rule 54 of the Trade Mark Rules

The Applicant will then be served with the same and must file their submissions within 14 days of service.

The Opponent has an opportunity to file submissions in reply to the Applicant's submissions. This must be done within 7 days of service of the Applicant's submissions.

In practice, the time periods for filing written submissions may be shortened or extended as ordered by the Registrar, or as agreed between the parties and confirmed with the Registrar.

Appeals

1st Appeal – which is an appeal of the decision of KIPI on registration, opposition and cancellation decisions, is to the Court²⁹.

2nd Appeal – is to the High Court, for a review or appeal of a decision of the IPT.

3rd Appeal – is to the Court of Appeal, which is on a point of law in trademark disputes.

Other relevant notes

It is recommended that a letter of demand is sent to the Applicant advising of the intention to oppose the Application. The *rationale* for this is that if the Opponent commences opposition proceedings without sending such a letter and the Trademark Applicant voluntarily withdraws its application after it is served with the notice of opposition, the Registrar will take this and whether the proceedings could have been avoided when deciding whether costs should be awarded to the Opponent.³⁰

3.3. Invalidation (Nullity) Proceedings

Section 35(1) of the Trade Marks Act provides that any aggrieved person may apply for the rectification and correction of the Register, with the resulting relief an order for the making, expunging or varying of the entry on the Register.³¹ Depending on the facts and prayer, the outcome of such proceedings can be the expungement or removal of the entire offending trademark registration.

²⁹ Section 21(6) of the Trade Marks Act

³⁰ Rule 57 of the Trade Mark Rules

³¹ Section 35(1) of the Trade Marks Act

Application for rectification and/or correction of the Register is to be made to the Court, but may at the option of the aggrieved person be made to the Registrar (KIPI)³², unless there is an existing action pending against the registration and in which latter case application must be made to the Court.³³

Grounds:

Relevant to the circumstances entailing registration for the identical or similar mark, Section 35 of the Trade Mark Trademarks Act provides for an application for rectification and correction of the Register to be made where an entry is made on the Register without sufficient cause, or it is an entry wrongly remaining on the Register.

A request for rectification of the register and expungement of a registration can therefore be made on the same grounds on which the application could have been opposed and includes that application for registration of a mark was made in bad faith.

Procedure:

For an application for expungement or rectification made to the Registrar, the procedure is as follows.

The Applicant files an application on Form TM25 for the expungement of the trademark, accompanied by a statement of case detailing the grounds in support of the application and reasons why the applicant is aggrieved by the registration.³⁴

The Respondent has 42 days from the date of service of the application and statement of case to file a Counter Statement in response.³⁵ The 42 days may be extended by a maximum of a further 90 days without requiring the Applicant's consent.³⁶

Upon service of the Counter Statement, the Applicant has 42 days within which to file a Statutory Declaration (the evidence) in support of the rectification or expungement.³⁷ The 42 days may be extended by a maximum of a further 90 days without requiring the Respondent's consent.³⁸

³² Section 35(1) of the Trade Marks Act

³³ Section 53(a) of the Trade Marks Act

³⁴ Rule 82(1) of the Trade Mark Rules

³⁵ Rule 83 read with Rule 48 of the Trade Mark Rules

³⁶ Rule 102 of the Trade Mark Rules

³⁷ Rule 83 read with Rule 49 of the Trade Mark Rules

³⁸ Rule 102 of the Trade Mark Rules

Upon service of the Applicant's Statutory Declaration, the Respondent has 42 days within which to file a Statutory Declaration/s in support of the registration remaining in the Register.³⁹ The 42 days may be extended by a maximum of a further 90 days without requiring the Applicant's consent.⁴⁰

Upon service of the Respondent's Statutory Declaration, the Applicant has 30 days within which to file a Statutory Declaration in reply.⁴¹ The 30 days may be extended by a maximum of a further 90 days without requiring the Respondent's consent.⁴²

Unlike with opposition proceedings, Rule 83(b) provides that the Registrar shall not rectify the register or remove the mark from the register merely because the registered proprietor has not filed a counter-statement.

The parties then are invited by the Registrar to take a hearing date.⁴³ The Registrar may alternatively direct the parties to file written submissions instead and only appear before him to highlight the same or to simply file the submissions and await the delivery of the ruling.

If the parties have been directed to file written submissions, the Applicant must file their submissions within 14 days of service of the Registrar's letter.

The Respondent will then be served with the same and must file their submissions within 14 days of service.

The Applicant has an opportunity to file submissions in reply to the Applicant's submissions. This must be done within 7 days of service of the Respondent's submissions.

In practice, the time periods for filing written submissions maybe shortened or extended as ordered by the Registrar, or as agreed between the parties and confirmed with the Registrar.

Appeals

1st Appeal – which is an appeal of the decision of KIPI on registration, opposition and cancellation decisions, is to the Court, or the more recently created Industrial Property Tribunal (IPT).

2nd Appeal – is to the High Court, for a review or appeal of a decision of the IPT.

³⁹ Rule 83 read with Rule 50 of the Trade Mark Rules

⁴⁰ Rule 102 of the Trade Mark Rules

⁴¹ Rule 83 read with Rule 51 of the Trade Mark Rules

⁴² Rule 102 of the Trade Mark Rules

⁴³ Rule 54 of the Trade Mark Rules

3rd Appeal – is to the Court of Appeal, which is on a point of law in trademark disputes.

Other relevant notes

Section 36B of the Trade Marks Act addresses acquiescence and precludes a proprietor of an earlier trademark or other earlier right, who has acquiesced for a continuous period of 5 years to the use of a registered trademark in Kenya, from applying for a declaration that the registration of the latter trademark is invalid.

The Section 36B acquiescence provision also precludes the proprietor of an earlier trademark or other earlier right from opposing the use of the latter trademark in relation to the goods or services in relation to which it has been so used, unless the registration of the latter trademark was applied for in bad faith.

3.4. Non-Use Cancellation Proceedings

In terms of Section 29 of the Trade Marks Act application for cancellation of a trademark registration can be made where either:

- application for the mark was filed without any *bona fide* intention to use the mark in relation to the relevant goods or services and there has in fact been no *bona fide* use of the trademark in relation to such goods or services; or
- up to a date 3 months prior to the application, a continuous period of 5 years elapsed without any *bona fide* use of the mark in relation to the relevant goods or services.

Any aggrieved person may apply for cancellation of a registration on the basis of non-use.⁴⁴

Application for cancellation on the basis of non-use is to be made to the Court, but at the option of the aggrieved party may be made to the Registrar (KIPI)⁴⁵, unless there is an existing action pending against the registration and in which latter case application must be made to the Court.⁴⁶

It is not possible to rely on the 5-year period of non-use if such non-use is due to special circumstances in trade and not due to any intention to abandon the trademark.⁴⁷

Procedure:

⁴⁴ Section 29(1) of the Trade Marks Act

⁴⁵ Section 29(1) of the Trade Marks Act

⁴⁶ Section 53(a) of the Trade Marks Act

⁴⁷ Section 29(3) of the Trade Marks Act

For a non-use cancellation filed with the Registrar the procedure is as follows.

The Applicant files an application on Form TM 25 for the cancellation of the trademark, accompanied by a statement of case detailing the grounds in support of the application and reasons why the applicant is aggrieved by the registration.⁴⁸

The Respondent has 42 days from the date of service of the application and statement of case to file a Counter Statement in response.⁴⁹ The 42 days may be extended by a maximum of a further 90 days without requiring the Applicant's consent.⁵⁰

Upon service of the Counter Statement, the Applicant has 42 days within which to file a Statutory Declaration (the evidence) in support of the rectification or expungement.⁵¹ The 42 days may be extended by a maximum of a further 90 days without requiring the Respondent's consent.⁵²

Upon service of the Applicant's Statutory Declaration, the Respondent has 42 days within which to file a Statutory Declaration/s in support of the registration remaining in the Register.⁵³ The 42 days may be extended by a maximum of a further 90 days without requiring the Applicant's consent.⁵⁴

Upon service of the Respondent's Statutory Declaration, the Applicant has 30 days within which to file a Statutory Declaration in reply.⁵⁵ The 30 days may be extended by a maximum of a further 90 days without requiring the Respondent's consent.⁵⁶

Unlike with opposition proceedings, Rule 83(b) provides that the Registrar shall not rectify the register or remove the mark from the register merely because the registered proprietor has not filed a counter-statement.

The parties then are invited by the Registrar to take a hearing date.⁵⁷ The Registrar may alternatively direct the parties to file written submissions instead and only appear before him to highlight the same or to simply file the submissions and await the delivery of the ruling.

⁴⁸ Rule 82(1) of the Trade Mark Rules

⁴⁹ Rule 83 read with Rule 48 of the Trade Mark Rules

⁵⁰ Rule 102 of the Trade Mark Rules

⁵¹ Rule 83 read with Rule 49 of the Trade Mark Rules

⁵² Rule 102 of the Trade Mark Rules

⁵³ Rule 83 read with Rule 50 of the Trade Mark Rules

⁵⁴ Rule 102 of the Trade Mark Rules

⁵⁵ Rule 83 read with Rule 51 of the Trade Mark Rules

⁵⁶ Rule 102 of the Trade Mark Rules

⁵⁷ Rule 54 of the Trade Mark Rules

If the parties have been directed to file written submissions, the Applicant must file their submissions within 14 days of service of the Registrar's letter.

The Respondent will then be served with the same and must file their submissions within 14 days of service.

The Applicant has an opportunity to file submissions in reply to the Applicant's submissions. This must be done within 7 days of service of the Respondent's submissions.

In practice, the time periods for filing written submissions maybe shortened or extended as ordered by the Registrar, or as agreed between the parties and confirmed with the Registrar.

Appeals

1st Appeal – which is an appeal of the decision of KIPI on registration, opposition and cancellation decisions, is to the Court⁵⁸, or the more recently created Industrial Property Tribunal (IPT).

2nd Appeal – is to the High Court, for a review or appeal of a decision of the IPT.

3rd Appeal – is to the Court of Appeal, which is on a point of law in trademark disputes.

Other relevant notes

In Kenya, while a non-use investigation is not a strict legal requirement, it is very important to conduct same as in practice the Registry will look for confirmation of no use by way of such a report. Internet searches will not suffice and one would need some formal report in hand. A full investigation and a report with non-use results is recommended before filing a non-use cancellation action.

3.5. Other Procedures

An interested or aggrieved party can send a letter of demand to the proprietor of a registration for the identical or similar mark requesting voluntary surrender of the registration in terms of Section 36A of the Trade Marks Act or voluntary cancellation of its own registration.

Where a trademark registration has not been renewed following the 10-year period and renewal fees are not paid, the registration lapses and the right is extinguished. An interested party can write to the Registrar to help kick-start the process in line with Section 23(3) of the Trade Marks Act.

⁵⁸ Section 21(6) of the Trade Marks Act

An interested party can approach the owner of a registered mark for the purchase of the desired trademark and should the parties reach an agreement, as assignment of the mark would be recorded against the desired trademark in terms of Section 28 of the Trade Marks Act.

TANZANIA

1. Overview of the Trademark System

1.1. First-to-file or first-to-use

Tanzania adopts the first-to-file system. In terms of Section 31, Trade and Service Marks Act (Cap. 326)⁵⁹, registration confers exclusive rights to use the mark in relation to the goods/services for which it is registered. Prior use without registration may support a passing-off action, but registration is the primary basis for enforceable rights.

1.2. Single or multi-class application system

Tanzania does not permit multi-class applications⁶⁰. Although the Trade and Service Marks Act (Cap. 326) does not expressly state that applications must be filed per class, this requirement arises from the Trade and Service Marks Regulations, G.N. No. 40 of 2000⁶¹, which prescribe application forms and fees on a per-class basis (see, in particular, the First Schedule – Fees, referring to an application “for goods included in one class”). Each application must thus be filed separately for each class of goods/services. The Registry practice is consistent with the Act and its implementing rules.

1.3. Available filing routes

Direct national applications are filed with the Business Registrations and Licensing Agency (BRELA)⁶² in mainland Tanzania.

Tanzania is a member of ARIPO, however ARIPO trademarks designating Tanzania do not automatically have legal effect within the country. This was confirmed by the Court of Appeal of Tanzania in its decision issued on 26 September 2025.⁶³ Tanzania has not fully ratified or domesticated the Banjul Protocol under national law, meaning that enforceable IP rights must be obtained through BRELA.

⁵⁹ https://media.tanzlii.org/media/legislation/305702/source_file/7532a23d0a292b1b/1986-12.pdf

⁶⁰ Regulation 21 of the Trade and Services Marks Regulations

⁶¹ <https://tanzlii.org/en/akn/tz/act/gn/2000/40/eng%402002-07-31?utm>

⁶² <https://brs.go.ke/>

⁶³ <https://tanzlii.org/en/akn/tz/judgment/tzca/2025/999/eng@2025-09-26>

Tanzania is not a member of OAPI, and not a member of the Madrid Protocol.

1.4. Duration

In terms of Section 32, Trade and Service Marks Act (Cap. 326), an initial registration is valid for 7 years. It is renewable indefinitely for further periods of 10 years each. Renewal must be filed before expiry; late renewal is possible with surcharge.

1.5. Substantive examination

Tanzania conducts substantive examination which covers both absolute grounds and relative grounds. On absolute grounds, Section 16 of the Trade and Service Marks Act provides for refusal if mark is not distinctive, or which is descriptive⁶⁴, while Section 19 deals with marks which are deceptive, scandalous, or contrary to public policy⁶⁵. Section 20 of the Trade and Service Marks Act provides for refusal on relative grounds if a mark conflicts with earlier registered marks or well-known marks⁶⁶. Examiners assess distinctiveness, likelihood of confusion, and compliance with statutory requirements.

1.6. Fraudulent or bad faith filings

Fraudulent/Bad-Faith Applications are subject to refusal, opposition, and cancellation under statutory provisions. The following provisions of the Trade and Service Marks Act apply:

- Section 19(a) provides for refusal if mark is likely to deceive or cause confusion.
- Section 20 provides for refusal if identical or similar to an existing registered mark.
- Section 27 provides for opposition proceedings, and bad faith can be raised in terms of Section 19(a).
- Section 37 provides that registration obtained by fraud or misrepresentation can be declared invalid.

1.7. Legislative framework / examination guidelines

Regarding Registry practice, examiners may refuse an application that is a copy of a well-known mark, provided the well-known mark is also registered in Tanzania.

⁶⁴ S16(1) and (2) of the Trade and Service Marks Act

⁶⁵ S19(a) – (c) of the Trade and Service Marks Act

⁶⁶ S19(d) of the Trade and Service Marks Act; S20(1) of the Trade and Service Marks Act

Bad faith is often raised during opposition or cancellation proceedings, rather than at initial examination. Tanzanian courts have recognized that fraudulent intent undermines validity, even if formal requirements are met.

2. Trademark Search methods

There is no online system available. An official search must be conducted via a local agent as the trademark database is not publicly accessible.

3. Measures Upon Discovering That a Third Party Has Filed or Registered a Mark Identical or Similar to One's Own

3.1. Submission of Information to the Trademark Office Regarding a Fraudulent / Bad-Faith Filing

"Submission of information" to the Business Registrations and Licensing Agency (BRELA) is not a recognized or codified mechanism under the Trade and Service Marks Act, Chapter 326 of the Laws of Tanzania ("the Trade Marks Act") or the Trade and Service Regulations.

Any challenge to a fraudulent or bad-faith filing must be made through the formal procedures prescribed by law specifically, opposition (before registration) or cancellation/rectification (after registration).

3.2. Opposition Proceedings

Any person is eligible to file opposition against an advertised mark.⁶⁷

Opposition is filed with the Registrar⁶⁸, BRELA.

Opposition is to be filed within 60 days of the date of publication of the impugned application in the Journal.⁶⁹

It is possible to secure extensions of the opposition term⁷⁰ if sufficient cause is shown. The Registrar has absolute discretion to grant an extension. When granted, in practice, the duration of the extension will not exceed 60 days.

⁶⁷ Section 27(1) of the Trade Marks Act and Regulation 34

⁶⁸ Section 27(1) of the Trade Marks Act and Regulation 34

⁶⁹ Regulation 34

⁷⁰ Regulation 43

Grounds of opposition

The grounds for filing an opposition against an identical or similar mark, including in bad faith, are founded in Section 27 read with Sections 27(2), 19(a), 19(d) and 20(1) of the Trade Marks Act. These grounds encompass opposition on the basis:

- that use of the mark would be contrary to law or morality⁷¹;
- that the mark constitutes a reproduction in whole or in part, imitations, translations or transcriptions, liable to create confusion with trade or service marks, business or company names, which are well-known in Tanzania and belongs to a third party⁷²;
- that the mark is identical to a trade or service mark already on the Register in respect of the same goods or services, or closely related goods or services, or so nearly resembles the mark as to be likely to deceive or cause confusion⁷³;
- of conflict with an unregistered trade or service mark used earlier in Tanzania. Reliance on this ground requires that an application for registration of the earlier used unregistered trade or service mark is filed at the same time as the notice of opposition⁷⁴;
- that the mark resembles in such a way as to be likely to deceive or cause confusion with a business or company name already used in Tanzania⁷⁵; and
- that the mark was filed by the agent or representative of a third party as proprietor of the mark, without authorization of the proprietor, unless such action can be justified⁷⁶.

Procedure

The Opponent files a Notice of Opposition, on Form TM/SM 5, within 60 days of advertisement of the application⁷⁷, or within any extended period granted by the Registrar. Although evidence need not be filed at this stage, the Notice of Opposition must include a statement of the grounds of opposition and cite the details of any earlier marks.⁷⁸

The Trademark Applicant has 60 days from receipt of the Notice of Opposition to file a Counter Statement, on Form TM/SM 6, in response.⁷⁹ Failure to file a counter-statement will result in the application being deemed abandoned.⁸⁰

⁷¹ Section 19(a) of the Trade Marks Act

⁷² Section 19(d) of the Trade Marks Act

⁷³ Section 20(1) of the Trade Marks Act

⁷⁴ Section 27(2)(a) of the Trade Marks Act

⁷⁵ Section 27(2)(b) of the Trade Marks Act

⁷⁶ Section 27(2)(c) of the Trade Marks Act

⁷⁷ Regulation 34

⁷⁸ Regulation 35

⁷⁹ Regulation 36

⁸⁰ Section 27(4) of the Trade Marks Act

Upon receipt of the Counter Statement, the Opponent has 60 days within which to file a Statutory Declaration/s (the evidence) in support of the Opposition.⁸¹ If the Opponent does not file any evidence the opposition will be deemed abandoned.⁸²

Upon receipt of the Opponent's Statutory Declaration, the Trademark Applicant has 60 days within which to file a Statutory Declaration/s in support of the registration of the trademark.⁸³

Upon receipt of the Applicant's Statutory Declaration, the Opponent has 2 months within which to file a Statutory Declaration in reply.⁸⁴

When all the evidence has been filed, the Registrar issues at least 30 days' notice of the hearing, and each party must confirm attendance within 15 days, failing which they may be treated as not wishing to be heard.⁸⁵ After the hearing, the Registrar decides whether the application should proceed to registration and may impose conditions or limitations as appropriate.

Appeal

Section 48 of the Trade Marks Act affords any party aggrieved by any decision of the Registrar an option to appeal to the High Court.

An appeal must be filed within 60 days from the date of the Registrar's decision.⁸⁶

The appellant files a notice/ memorandum of appeal with the High Court, attaching the Registrar's decision and relevant records.⁸⁷

Should either party be aggrieved by the High Court's decision, further appeal lies with the Tanzania Court of Appeal.

3.3. Invalidation Proceedings

Section 36 of the Trade Marks Act provides that any aggrieved person may apply for the rectification and correction of the Register, with the resulting relief an order for the making, expunging or varying

⁸¹ Regulation 37

⁸² Regulation 38

⁸³ Regulation 38

⁸⁴ Regulation 39

⁸⁵ Regulation 42

⁸⁶ Section 48 of the Trade Marks Act

⁸⁷ High Court jurisdiction over matters per Part XI of the Trade Marks Act

of the entry on the Register.⁸⁸ Depending on the facts and prayer, the outcome of such proceedings can be the expungement or removal of the entire offending trademark registration.

Application for rectification and/or correction of the Register is to be made to the Court, but may at the option of the aggrieved person be made to the Registrar (BRELA).⁸⁹

Section 50(1) of the Trade Marks Act provides that the fact that a person is registered as the proprietor of a trade or service mark is *prima facie* proof of validity of the registration. In addition, where a registration has been registered for 7 years from the date of registration, the registration will be taken to be valid in all aspects⁹⁰, unless:

- registration was obtained by fraud⁹¹; or
- the mark should not have been registered considering the provisions of Section 19 (the same grounds on which an application could be opposed), and those grounds prevail at the time that validity of the registration is being contested⁹².

Procedure

For an application for expungement or rectification made to the Registrar, the procedure is as follows.

The Applicant files an application on Form TM/SM 23 for the expungement of the trademark, accompanied by a statement of case detailing the grounds in support of the application and reasons why the applicant is aggrieved by the registration.⁹³

The Trademark Registrant/ Respondent has 60 days from receipt of the expungement request to file a Counter Statement, on Form TM/SM 6, in response.⁹⁴

Upon receipt of the Counter Statement, the Applicant has 60 days within which to file a Statutory Declaration/s (the evidence) in support of the expungement.⁹⁵

Upon receipt of the Applicant's Statutory Declaration, the Trademark Registrant/ Respondent has 60 days within which to file a Statutory Declaration/s in support of the registration of the trademark.⁹⁶

⁸⁸ Section 36 of the Trade Marks Act

⁸⁹ Section 36 of the Trade Marks Act

⁹⁰ Section 50(2) of the Trade Marks Act

⁹¹ Section 50(2)(a) of the Trade Marks Act

⁹² Section 50(2)(b) of the Trade Marks Act

⁹³ Regulation 66(1)

⁹⁴ Regulation 67 read with Regulation 36

⁹⁵ Regulation 67 read with Regulation 37

⁹⁶ Regulation 67 read with Regulation 38

Upon receipt of the Trademark Registrant / Respondent's Statutory Declaration, the Applicant has 2 months within which to file a Statutory Declaration in reply.⁹⁷

Unlike with opposition proceedings, Regulation 67 provides that the Registrar shall not rectify the register nor remove the mark from the register merely because the registered proprietor has not filed a counter-statement.

When all the evidence has been filed, the Registrar issues at least 30 days' notice of the hearing, and each party must confirm attendance within 15 days, failing which they may be treated as not wishing to be heard.⁹⁸ After the hearing, the Registrar decides whether the registration should be expunged or any variation entered into the Register.

Appeal

This is the same as that for opposition matters, namely Section 48 of the Trade Marks Act affords any party aggrieved by any decision of the Registrar an option to appeal to the High Court.

An appeal must be filed within 60 days from the date of the Registrar's decision.⁹⁹

The appellant files a notice/ memorandum of appeal with the High Court, attaching the Registrar's decision and relevant records.¹⁰⁰

Should either party be aggrieved by the High Court's decision, further appeal lies with the Tanzania Court of Appeal.

3.4. Non-Use Cancellation Proceedings

In terms of Section 35(1) of the Trade Marks Act a registered trademark may be vulnerable to cancellation if the mark was not used in relation to its goods or services covered by the registration, for a continuous period of 3 years, up to 1 month before the application.

Any aggrieved person may apply for cancellation of a registration on the basis of non-use.¹⁰¹

⁹⁷ Regulation 67 read with Regulation 39

⁹⁸ Regulation 67 read with Regulation 42

⁹⁹ Section 48 of the Trade Marks Act

¹⁰⁰ High Court jurisdiction over matters per Part XI of the Trade Marks Act

¹⁰¹ Section 35(1) of the Trade Marks Act

Application for cancellation on the basis of non-use is to be made to the Court, but at the option of the aggrieved party may be made to the Registrar (BRELA).¹⁰²

Non-use is not taken into account (and therefore trademark registrant a defence) where:

- It is due solely to special circumstances preventing use and is not due to any intention to abandon or not use the trade or service mark¹⁰³;
- Non-use is within 5 years from the date of first advertisement of the mark, or within the period from that date extended to 2 years from the date of the final decision on the registration, whichever period expires later¹⁰⁴;
- Use that will be considered for the purposes of a non-use cancellation includes use of the whole of a mark as being equivalent to use of part of the mark¹⁰⁵, use in relation to some goods or services is equivalent to use of all closely related goods or services¹⁰⁶, use on exported goods or services¹⁰⁷, and use of an associated registered mark with additions or alterations not substantially affecting its identity, may be equivalent for use of the mark¹⁰⁸.

Procedure:

The procedure will be the same as for invalidation proceedings.¹⁰⁹

Appeal

This is the same as that for opposition matters and invalidation matters, namely Section 48 of the Trade Marks Act affords any party aggrieved by any decision of the Registrar an option to appeal to the High Court.

An appeal must be filed within 60 days from the date of the Registrar's decision.¹¹⁰

The appellant files a notice/ memorandum of appeal with the High Court, attaching the Registrar's decision and relevant records.¹¹¹

¹⁰² Section 35(1) of the Trade Marks Act

¹⁰³ Section 35(1)(a) of the Trade Marks Act

¹⁰⁴ Section 35(1)(b) of the Trade Marks Act

¹⁰⁵ Section 35(2)(a) of the Trade Marks Act

¹⁰⁶ Section 35(2)(b) of the Trade Marks Act

¹⁰⁷ Section 35(2)(c) of the Trade Marks Act

¹⁰⁸ Section 35(2)(d) of the Trade Marks Act

¹⁰⁹ Regulation 66

¹¹⁰ Section 48 of the Trade Marks Act

¹¹¹ High Court jurisdiction over matters per Part XI of the Trade Marks Act

Should either party be aggrieved by the High Court's decision, further appeal lies with the Tanzania Court of Appeal.

3.5. Other Procedures for Revoking or Extinguishing Rights

Not applicable.

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