

**THE OPEN UNIVERSITY OF TANZANIA**

**FACULTY OF LAW**

**ELEMENTS OF INTELLECTUAL PROPERTY**

**LAW**

**MODULE GUIDE**

**UNDERGRADUATE PROGRAMME**

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## **INTRODUCTION**

The Elements of Intellectual Property Law (IP LAW) course is designed to teach the students the basics issues in the Intellectual and Industrial Property Rights protection areas. The course is intended to explore students with the knowledge and understanding on different subjects relating to Intellectual Property Rights (IPRs). However, students are advised to do independent studies(researching) more in order to know the day to day changes on the area of IP Law.

## **MODULE AIMS**

The aims of this module are to enable students to:

- Develop their knowledge of the law relating to intellectual property rights such as copyrights and neighbouring rights, patents, trade/service marks, trade secrets/law of confidence (undisclosed information) and designs/industrial designs.
- Enhance their intellectual, interpersonal and transferable skills as well as developing other skills including independent research, legal research, problem solving, and critical awareness of current problems; and
- Provide education that improves students' prospects of academic, professional or commercial employment.

## **MODULE OBJECTIVES**

- To promote the knowledge of Intellectual Property Law of both the United Republic of Tanzania and Internationally.
- To undertake Researches on Intellectual Property Rights matters, formation and management.
- To provide professional and consultancy services in the area of Intellectual Property Law.
- Updating of already available Intellectual Property materials.

## **LEARNING OUTCOMES:**

Successful students will be able to:

- Demonstrate an in-depth and up-to-date knowledge of various Intellectual Property Law concepts and apply the relevant law to complex, multi-matter problems.
- Demonstrate ability to research complex issues analytically and creatively reaching reasoned conclusions.
- Demonstrate originality in the application of knowledge to complex and unpredictable problem and essay questions as well as the ability synthesis and inter- relate concepts.

- Demonstrate an ability to critically evaluate current legal research in intellectual property law.

### **ASSESSMENT/ EVALUATION**

Students will be assessed through a combination of Assignments/ Coursework, Timed Tests and Annual Examination.

### **MODULE CONTENT**

The course will consider the following elements of industrial and intellectual property law:

- Introduction
- Law of Confidence/ Trade Secrets
- Copyright
- Trade and Service Marks
- Patents
- Industrial Designs
- The relationship between competition law and intellectual property law
- International systems to intellectual property rights (IP Protection)

- Litigation (Infringements, Remedies & Defences)

### **COMPULSORY READINGS**

The recommended text books for the module are:

CORNISH & LLEWLYN, Intellectual Property (5<sup>TH</sup> Ed), 2003

CORNISH Cases & Materials on Intellectual Property (4<sup>th</sup> Ed) 2003

DAVIS, Intellectual Property Law (2<sup>nd</sup> Ed) 2003

However, the reading list provided in this course outline is meant to serve only as a general guide. The list is not exhaustive hence new Titles, Articles, Journals and other materials relevant to the course should be added at student's own initiative over and above those given from time to time by the subject co-ordinator.

## **MODULE 1:**

### **INTRODUCTION AND DEFINITION OF TERMS**

1:1 Meaning of Property.

1:2 The nature, Origins and Meaning of Intellectual Property Rights

1:3 Meaning of Industrial Property Rights; TRIPS

1:4 **Theories underlying Intellectual and Industrial Property Rights**

#### **(IPRs)**

(A) Supply side Theories

(i) Reward - Incentive Theory

(ii) Quality - Guarantee Theory

(iii) Technology - Process Theory

(B) Demand side Theories

(i) Exploitation - Theory

(ii) Market sharing Theory

(iii) Non-Access to Technology or Technology Blocking Theory

1:5 **Types of Intellectual Property Rights:**

(a) Copyright and related rights

(b) Trademarks

(c) Geographic indications

- (d) Patents
- (e) Trade secrets.
- (f) Industrial Designs

## 1:6 **Importance of (Need to Protect) Intellectual Property Rights**

### 1:6:1 **General Reasons**

- Countries have laws to protect Intellectual Property Rights for two reasons related to each other:-
  - (i) It gives statutory expression to the moral and economic rights of creators in their creations.
  - (ii) It promotes, as a deliberate act of government policy, creativity and the dissemination and application of its results, and to encourage fair trading, this contributes to economic and social development.

### 1:6:2 **Specific Reasons**

#### (a) Patents

Protection of Patent creates a favourable climate for the transfer of technology by means of security it provides for the patentee.

#### (b) Trademarks

Protection of Trademarks enables the enterprise to establish a market position based on the trademark. Hence an effective protection of trademarks is an essential aspect of technological transfer and development.

(c) Copyright.

Protection of copyrights creates an enabling environment for authorship and development of Arts as it acts as a reward to Authors and Artists.

**REFERENCE & OTHER TEXTS**

The Trade and Service marks Act, 1986 Act No. 12 of 1986, The Patents Act 1987 Act No. 1 of 1987, The Copyrights and Neighbouring Rights Act 1999, Act No 7 of 1999.

Alison, C and Jeremy P., Introduction to Intellectual Property Law, 3<sup>rd</sup> edition, Butterworths, London, 1995.

Allison C, Intellectual Property Law, 1<sup>st</sup> edition Longman, London, 1992.

Alexander D. and Jacob R, A Guide Book to Intellectual Property Patents, Trademarks Copyright and Designs, 4<sup>th</sup> edition sweet and Maxwell, London, 1993.

Bainbridge, Intellectual Property, 5<sup>th</sup> edition, 2002

Bently & Sherman, Intellectual Property Law, 2<sup>nd</sup> edition, 2004

Bifani, P., "Intellectual Property Rights and International Trade", UNCTAD, the Uruguay Round, Paper on Selected Issues, UNCTAD, New York, 1989.

Blanco, W.T.A Patents, Trade Marks Copyright and Industrial Designs 2<sup>nd</sup> Edition, Sweet and Maxwell, London 1989.

Cornish W.R., Intellectual Property: Patents, Copyrights Trade Marks and Allied Rights, 2nd edition, sweet and Maxwell, London 1989.

Cottier, A., "Intellectual Property in International Trade Law and Policy; the GATT Connection", 47 Annsenwirtschaft, 1992.

Davis M.H. and Miller A.R., Intellectual Property Patents Trademarks and Copyright 5<sup>th</sup> edition, West Publishing Co, New York, 1987.

Hart & Fazzani, Intellectual Property Law, 3<sup>rd</sup> edition, 2004

James Mellor, et. al., Kerly's Law of Trademarks and Trade Names, 12th edition Sweet and Maxwell, 1986.

Jeremy P. (ed.), Butterwolths Intellectual Property Law Handbook, ButterWorths, London, 1990.

Kerly D.M., Law of Trade Marks and Trade Names 10<sup>th</sup> edition, Sweet and Maxwell, London.

Jussawalla M., A study of Intellectual Property in a World without Frontiers: A Study of Computer Software, Greenwood Press, New York, 1992.

Miller A.R and Davis M.H, Intellectual Property: Trademarks Patents and Copyright, West Publishing Co., New York, 1987.

### **SUGGESTED ARTICLES**

Kihwelo, P.F, "Implications of Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement in the law and Administration of Industrial Property in Tanzania" LL.M Dissertation, UDSM, 2000.

Kihwelo, P.F., "Implications of Trade – Related Aspects of Intellectual Property Rights (TRIPS) Agreement in the Copyrights and Neighbouring Rights Act 1999: General Commentary The Tanzania Lawyer, April – September 2001 issue

Kihwelo, P.F, Industrial Designs Protection in Tanzania: Need for Legislative Reform. The Tanzania Lawyer, July 2004 issue.

Samzugi, A.S. and B. Shabaan, "Implications of Copyright Protection to Distance Education in Tanzania: An Appraisal of the Copyright and Neighbouring Rights Act 199, Huria Journal of the Open University of Tanzania Volume II No. 2 September, 2001.

Laurie, G.T., "Intellectual Property Rights and the Interests of Indigenous Peoples", Lesotho Law Journal Vol. 10. No.1 1997, National University of Lesotho.

Marco B. "The Impact of TRIPS Intellectual Property Protection in Developing Countries", Common-Market Law Review 31:1 245-8, 1994.

Marshall, L., "Protecting United States Intellectual Property Abroad: Toward a New Multilateralism", IOWA Law Review; 76: 273-308, 1991.

Minnesota Small Business Assistance Office, A Guide to Intellectual Property Protection, 2<sup>nd</sup> edition, Minnesota, 1987.

Rwezaura, B.A, "Legal Protection of Intellectual Property in Tanzania" 4 Lesotho Law Journal 1,139-254 (1988).

## **CASES**

- London and Provincial Law Assurance Society V London and Provincial Stock Life Assurance Co. (1847) 17 L.J Ch 37
- Wessex Dairies Ltd. V Smith [1935] 2KB 80
- Linoleum Manufacturing Co V Nairn [1878] 7 Ch D 834

## **JOURNALS**

Computer Law & Security Report

Computer & Telecommunications Law Review

Encyclopaedia of Information Technology Law

Entertainment Law Review

European Intellectual Property Review

Information and Technology Communications Law

Intellectual Property Newsletter

Intellectual Property Quarterly

International Journal of Law and IT

Law, Computers & Artificial Intelligence

Law Technology Journal

Lawtel Intellectual Property Bulletin

New Law Journal

Trade Marks Throughout The World.

**WEBSITES**

[www.wto.org](http://www.wto.org)

[www.intellectual-property.org.uk](http://www.intellectual-property.org.uk)

[www.wipo.org](http://www.wipo.org)

[www.patent.gov.uk](http://www.patent.gov.uk)

[www.aripo.wipo.net](http://www.aripo.wipo.net)

[www.oapi.wipo.net](http://www.oapi.wipo.net)

[www.parliament.the-stationery-office.co.uk](http://www.parliament.the-stationery-office.co.uk)

[www.epo.org](http://www.epo.org)

[www.ipo.gov.uk](http://www.ipo.gov.uk)

[www.oami.eu.int](http://www.oami.eu.int)

[www.brela-tz.org](http://www.brela-tz.org)

[www.lexixnexus.co.uk](http://www.lexixnexus.co.uk)

[www.cosota-tz.org](http://www.cosota-tz.org)

## **MODULE 2**

### **2:1 LAW OF CONFIDENCE (TRADE SECRETS)**

This topic looks at the definition, nature and scope of law of confidence. Also, the topic considers its (law of confidence) common law origins, covers the quality of confidence and the application of this area of the law. Trade secrets are regarded as Industrial Properties.

### **2:2 The Law of Confidence: Introduction**

2:2:1 Definitions of Confidentiality, Trade Secrets, Personal Secrets, Government Secrets, confidential obligation, confidential information, unauthorised disclosure.

2:2:2 The nature and origin of Law of confidence at Common Law.

2:2:3 The Rights protected under the Law of Confidence

### **2:3 The Elements of the Law of Confidence**

2:3:1 The Confidential Information

2:3:2 The Confidential Obligation

2:3:3 Unauthorised Use or Disclosure

### **2:4 Protections of Trade Secrets**

### **2:5 Infringement and Remedies for Trade Secrets/ Confidential Information Misuse**

## **READINGS**

Allison C, Intellectual Property Law, 1<sup>st</sup> edition Longman, London, 1992.

Alison, C and Jeremy P., Introduction to Intellectual Property Law, 3<sup>rd</sup> edition, Butterworths, London, 1995.

Bainbridge, Intellectual Property, 5<sup>th</sup> edition, 2002

Cornish, Cases & Materials on Intellectual Property (4<sup>th</sup> Ed) 2003

Cornish & Llewelyn, Intellectual Property (5<sup>TH</sup> Ed), 2003

Davis J, Intellectual Property Law (2<sup>nd</sup> Ed) 2003

Minnesota Small Business Assistance Office, A Guide to Intellectual Property Protection, 2<sup>nd</sup> edition, Minnesota, 1987.

W. Adams, 'Intellectual Property Infringement in Global Networks: The Implications of Protection Ahead of the Curve' IJL & IT 2002. 10(71)

## **CASES**

Coco V Clark [1969] R.P.C 41

Saltman V Campbell (1948) 65 R.P.C 203

Stephens V Avery [1988] FSR 510

Faceenda Chicken V Fowler [1986] 1 ALL ER 617

Argyll V Argyll [1967] Ch. 302

AG V Jonathan Cape [1976] Q. B 752

AG V Guardian Newspapers (No. 2) [1990] 1 A.C 109

## **MODULE 3**

### **3:1 COPYRIGHT LAW**

This topic looks at the definition, nature and scope of the law relating to copyrights and neighbouring rights. The nature of ‘originality’; the concepts of ‘authorship’; the ambit of copyright law and the types of ‘works’ that are protected under the copyright law will be analysed in this topic.

### **3:2 The Concept of Copyright**

3:2:1 Definitions of Copyright, Neighbouring Right, Author, Authorship, Owner, Literary Work, Dramatic Works, Musical Works, Artistic Works

3:2:2 Historical Development of Copyright Law at Common Law (England)

3:2:3 History of Copyright Law in Tanzania

3:2:4 Copyright as a temporary property right.

3:2:5 Economic perspective of Copyright

3:2:6 Copyright and unfair competition

3:2:7 The Copyright monopoly.

### **3:3 Law on Copyright and Neighbouring Rights in Tanzania**

### **3:3:1 Originality, Authorship, Ownership and Dealings**

- (i) Nature of “originality”
- (ii) What is a work?
- (iii) Who is the author of a work?
- (iv) Concepts of “authorship”
- (v) Authorisation
- (vi) Exclusive Rights

### **3:4 Types of Protected Works**

- (i) Literary Works
- (ii) Musical Works
- (iii) Dramatic Works
- (iv) Artistic Work
- (v) Derivative Works

Films, Sound Recordings (Cassette tape; Cassette

Player/recorder, gramophone record, discs, CD and LPs

#### **3:4:1 Speeches, Lectures, Judgements etc**

#### **3:4:2 Tables & Compilations**

### **3:4:3 Broadcasts**

- (i) Definition of 'Broadcast'
- (ii) Encrypted transmission
- (iii) What is transmitted?
- (iv) Satellite Broadcasts.

### **3:4:4 Cable and Computer Programmes**

- Cable programmes
- Cable programme under the 1999 Act.

### **3:4:5 Published editions of works**

- Originality and derivative works. To attract copyright, literary, dramatic, musical and artistic works must be 'original' in the sense of originating from their authors, who have expended independent skill and labour, and not just copied.

### **3:4:6 Creatorship and ownership**

- (i) Sound recording and films
- (ii) Ownership of copyright in broadcasts
- (iii) Protection of expression of Folklore

### **3:4:7 Principles for copyright protection**

- (i) Moral Rights
- (ii) Economic Rights

- (iii) Assignment of Author's Rights
- (iv) Duration of Author's Rights
- (v) Permitted Acts
- (vi) Qualifications for Copyright Protection
- (vii) Licenses
- (viii) Misuse of Copyright by Copyright owner
- (ix) Estoppels
- (x) Abandonment of Copyright
- (xi) Fair Dealing
- (xii) Rights in Performances
- (xiii) Res judicata

### **3:4:8 The Copyright Society of Tanzania (COSOTA)**

- (i) The Purposes/ Importance/ Objectives of the Society
- (ii) The Roles of the Society
- (iii) Procedures

## **READINGS**

The Copyrights and Neighbouring Rights Act 1999, Act No 7 of 1999.

Alexander D. and Jacob R, A Guide Book to Intellectual Property Patents, Trademarks Copyright and Designs, 4<sup>th</sup> edition sweet and Maxwell, London, 1993.

Allison, C. and Jeremy P., Introduction to Intellectual Property Law, 3<sup>rd</sup> edition, Butterworths, London, 1995.

Blanco, W.T.A Patents, Trade Marks Copyright and Industrial Designs 2<sup>nd</sup> Edition, Sweet and Maxwell, London 1989.

Cornish W.R., Intellectual Property: Patents, Copyrights Trade Marks and Allied Rights, 2nd edition, sweet and Maxwell, London 1989.

Cottier, A., "Intellectual Property in International Trade Law and Policy; the GATT Connection" 47 Anssenwritschaft 1992.

Davis M.H. and Miller A.R., Intellectual Property Patents Trademarks and Copyright 5<sup>th</sup> edition, West Publishing Co, New York, 1987.

Jeremy P. (ed.), Butterwoths Intellectual Property Law Handbook, Butterworths, London, 1990.

Laurie, G.T., "Intellectual Property Rights and the Interests of Indigenous Peoples", Lesotho Law Journal Vol. 10. No.1 1997, National University of Lesotho.

Trade-Related Aspects of Intellectual Property Rights Implications for Development Countries. World Trade and Development Report, 1991

Wangwe, J.M, Industrial Property Protection and Technological Innovation: A case study of the United Republic of Tanzania UNCTAD/ITP/TEC1991.

Micheal, F. Flint, A user's Guide to copyright 4<sup>th</sup> edition, Butterworths, London, 1997.

Minnesota Small Business Assistance Office, A Guide to Intellectual Property Protection, 2<sup>nd</sup> edition, Minnesota, 1987.

Miller A.R and Davis M.H, Intellectual Property: Trademarks Patents and Copyright West Publishing Co. New York. 1987.

Trade-Related Aspects of Intellectual Property Rights Implications for Development Countries. World Trade and Development Report, 1991

Williams J.F, A Manager's Guide to Patents Trademarks and Copyright 1<sup>st</sup> edition Billing and Sons Ltd., London 1986.

## **CASES**

- British Leyland Motor Corporation ltd. V Armstrong Patents ltd.  
[1986] AC 577
- Tolley V Fry [1931] AC 333
- A-G V Observer Ltd. [1990] AC 109
- Glyn V Weston Feature Film [1916] 1 Ch 261
- Donaldson V Beckett [1774] 2 Bro. P.C 129

- Gramophone Co. V cawardine [1934] Ch 450
- Ladbroke V Hill [1964] 1 W.L.R 273
- Tate V Thomas [1921] 1 Ch 503
- Tate V Fukkbrook [1908] 1 KB 821
- University of London Press V University Tutorial Press [1916] 2 Ch 601
- Kenrick & Co V Lawrence & Co [1890] 25 QBD 99
- Stannard V Harrison [1871] 13 WLR 811
- Donoghue V Allied Newspapers Ltd. [1938] Ch 106
- Chaplin V Leslie Frewin (Publishers) ltd. [1966] Ch 71
- Cummons ltd. V Isond [1977] 1 Ch 167
- Weatherby & Sons V International Horse Agency and Exchange ltd. [1910] 2 Ch 297
- Exxon Corpn V Exxon Insurance Consultants International Ltd. [1982] Ch 119
- Interlego AG V Tyco Industries Inc [1989] AC 217
- Hensher V Restawile Upholstery [1976] Ac 64, [1973] 1 WLR 144
- Express Newspaper ltd. V Liverpool Daily Post [1985] 3 ALL ER 680

## **MODULE 4**

### **4:1 TRADE AND SERVICE MARKS**

The topic looks at the development of trademark law in Tanzania; the rights which are granted by ownership of a trademark; the types of marks that can be afforded protection. Trade and Service Marks are parcels of Industrial Property.

### **4:2 The Trade Mark Legal Systems in Tanzania**

**4:2:1** Meaning of Trade Marks; Service Marks; Trade Dress; Product Packaging; Trade Mark Dilution; Domain Names; Passing Off.

#### **4:2:2 The Functions of Trade Marks Protection**

#### **4:2:3 Historical Development of Trade Mark Law at common law and in Tanzania**

#### **4:2:4 Criteria for Registration of Trade/ Service Marks**

#### **4:2:5 Types of Marks**

#### **4:2:6 Loss of a mark**

- (i) Trade/ Service Mark Dilution
- (ii) Domain Names
- (iii) Passing Off
- (iv) Trade/Service Mark Infringement

### **4:3 Grounds for Refusal of Registration at common law**

### **4:4 Protecting Famous Trade Marks around the World**

### **4:5 The Trade and Service Marks Act 1986.**

- (i) Protectable Subject matter (Part III)
- (ii) Registrability and Priority Rights (Section 16)
- (iii) Distinctiveness (Section 16(i))
- (iv) Visually Perceptible Signs
- (v) Application for Trade or Service Marks (Part V)
- (vi) Rights conferred to owners of Marks (Section 31,32 and 33)
- (vii) Exceptions
- (viii) Term of Protection (Section 29 (iv))
- (ix) Requirement of use (Section 35(i))
- (x) Licensing and Assignment.(Part ix Section 40)

### **4:6 Business Registrations and Licensing Agency (BRELA).**

BRELA is a Government Executive Agency which deals with the registrations and licensing of Companies, Business Names, Trade/Service Marks and Patents

#### **4:6:1 HOW BRELA WORKS?**

- Functions/ Roles
- Purposes
- Aims
- Objective
- Challenges
- Registration and Licensing Procedures
- Fees

#### **READINGS**

The Trade and Service Marks Act, 1986 Act No. 12 of 1986

Alexander D. and Jacob R, A Guide Book to Intellectual Property: Patents, Trademarks Copyright and Designs, 4<sup>th</sup> edition sweet and Maxwell, London, 1993.

Allison, C. and Jeremy P., Introduction to Intellectual Property Law, 3<sup>rd</sup> edition, Butterworths, London, 1995.

Amanda A., A Practical Guide to Trade marks Sweet and Maxwell, London, 1993.

ARIPO, " "Patents, Marks and Industrial Designs" The Official Journal of ARIPO, VOL XV NO. 3, September, 1998.

Bevely W.P. and Hilliard D.C Trademarks Cases and materials series ,  
Matthew Bender, New York, 1987.

Bifani, P., "Intellectual Property Rights and International Trade", in  
UNCTAD, the Uruguay Round, Paper on Selected Issues, UNCTAD, New  
York, 1989.

Blanco, W.T.A Patents, Trade Marks Copyright and Industrial Designs 2<sup>nd</sup>  
Edition, Sweet and Maxwell, London 1989.

Chadha, O.P, Cases and materials on Trademarks and Allied laws, 1975-  
1998, Delhi, 1999

Cornish W.R., Intellectual Property: Patents, Copyrights Trade Marks and  
Allied Rights, 2<sup>nd</sup> edition, sweet and Maxwell, London 1989.

Cottier, A., "Intellectual Property in International Trade Law and Policy; the  
GATT Connection" 47 Annsenwirtschaft 1992.

Davis M.H. and Miller A.R., Intellectual Property Patents Trademarks and  
Copyright 5<sup>th</sup> edition, West Publishing Co, New York, 1987.

J. Englefield, 'Current Domain Names Issues', Corp. Briefing 17.1 (6)  
(January 2003).

James Mellor, et. Al., Kerly's Law of Trade marks and Trade Names 12<sup>th</sup>  
edition Sweet and Maxwell, 1986.

Kerly D.M., Law of Trade Marks and Trade Names 10<sup>th</sup> edition, Sweet and  
Maxwell, London.

Kihwelo, P.F, "Implications of Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement in the law and Administration of Industrial Property in Tanzania" LL.M Dissertation, UDSM, 2000.

Laurie, G.T., "Intellectual Property Rights and the Interests of Indigenous Peoples', Lesotho Law Journal Vol. 10. No.1 1997, National University of Lesotho.

Lloyd R.G., Kerly on Trade Marks and Trade Names 8<sup>th</sup> edition, Sweet and Maxwell, London 1960.

Liundi, G.B, Tanzania Laws on Patents and Trade marks: A report on a study of the system of Patents and Trademarks as it applies in Tanzania, as of December, 1980. Geneva.

Marco B. The Impact of TRIPS; Intellectual Property Protection in Developing Countries, Common-Market Law Review 31:1 245-8, 1994.

Michaels A., A Practical Guide to Trademarks 2nd edition, Sweet and Maxwell, London, 1996.

Miller A.R and Davis M.H, Intellectual Property: Trademarks Patents and Copyright West Publishing Co. New York. 1987.

R. Burrell and M. Handler, 'Making Sense of Trade Mark Law', IPQ 2003,4,388-410.

Trade-Related Aspects of Intellectual Property Rights Implications for Development Countries. World Trade and Development Report, 1991

Workman J., Trademarks their Creation Psychology and Perception, Longman, London, 1974.

Williams J.F, A Manager's Guide to Patents Trademarks and Copyright 1<sup>st</sup> edition Billing and Sons Ltd., London 1986.

## CASES

- London and Provincial Law Assurance Society V London and Provincial Stock Life Assurance Co. (1847) 17 L.J Ch 37
  
- Wessex Dairies Ltd. V Smith [1935] 2KB 80
  
- Sabel V Puma [1998] R.P.C. 199
  
- British Diabetic Association V The Diabetic Society [1996] F.S.R 1
  
- Taittinger SA V Allbev Ltd [1994] 4 ALL ER 75
  
- Aristoc V Rysta [1945] A.C 68, HL
  
- Linoleum Manufacturing Co V Nairn [1878] 7 Ch D 834
  
- Rank Films V Video Centre [1980] 1 ALL ER 277
  
- Person's Co. V Christmas 900 F 2d 1565 (Fed City 199)
  
- Aktiebolaget Johkoping – Vulcan Indstricksfa Briksaktiebolag V East Africa Match Company Ltd [1964] EA 62
  
- Morning Star Cooperative Society Ltd V Express Newspaper Ltd [1979] FS R 113.

- York Trailer Holdings Ltd vs. Registrar of Trademarks [1982] 1 ALL ER 257.
- Yorkshire Copper Works Ltd V Registrar of Trademarks [1954] WLR 570.
- Electrix Ltd’s Application for Trade Marks [1958] R.P.C 176.
- Phonis Pharmacies (T) Limited V Phenis Pharmaceuticals N.V Antwerp civil case No. 217 of 1994 Dar Es Salaam High court registry (unreported).
- Chesebrough – Ponds Inc. V Gupyaka Agency (1982) TLR 111.
- Tanzania Breweries Ltd. V Kibo Breweries Ltd. Civil Case No. 34 of 1999 High Court, Dar Es Salaam, main registry (Unreported)
- CPC International Inc. V Zainab Grain Millers ltd Civil Appeal No. 49 of 1995, Court Appeal of Tanzania (Unreported)
- Colgate Palmolive Company V Zakaria Provision Stores and 3 others, High Court Civil case No. 1 of 1997, Dar Es Salaam main registry (Unreported)
- E.R Flour Mills Ltd. V The Registrar of Trade and Service marks and the Attorney General, Miscellaneous Civil Application No. 3 of 1996, Dar Es Salaam High Court main registry (Unreported)

## **MODULE 5**

### **5:1 PATENTS**

This topic looks at the development of patent law in Tanzania; rights which are granted by ownership of a patent; the criteria which must be satisfied in order to obtain a patent: the patent process and ownership of a patent. Patent is an industrial property.

**5:2** Definitions of Patents, TRIPS, Novelty, Obviousness, Nullity, Invention; Inventor; WIPO.

### **5:3 History of Patent Law in Tanzania**

### **5:4: Criteria for Patentability/ Patentable Invention**

- (i) Invention must be new
- (ii) Invention must involve an inventive step
- (iii) The invention must be capable of industrial application

### **5:5 The Patent Legal System in Tanzania**

- (i) Application for a Patent
- (ii) Grant for a Patent
- (iii) Inventors and Joint Inventors
- (iv) Ownership
- (v) Duration for Patent Protection
- (vi) Nullity of Patents
- (vii) Licensing Arrangements

- (viii) Limitation for Patentability
- (ix) Exploitation of Patented Invention
- (x) Revocation
- (xi) Industrial Application
- (xii) Infringing Acts

### **5:6 Types of Patentable Invention**

- (i) Product Inventions
- (ii) Process Inventions

### **5:7 TRIPS/WTO Agreement Exclusive Rights to the Owner (Article 28)**

### **5:8 Non- Patentable Matters**

- (i) Generally- e.g. Discovery (historical places)
- (ii) Abstract- Scientific Theories, Mathematics Methods, Biological Inventions, Methods of Treatment
- (iii) Aesthetic-Literary, Dramatic, Music and Artistic Works
- (iv) Non-technical-e.g. Computer Programme BUT if it makes a technical contribution, that a technical effect is produced so that technical problem is solved, then it can be PATENTABLE.

### **5:9 Modern Patents System**

Patent Information

- New, not obvious and industrially applicable
- Complete and practical
- May be the only publication
- Latest and up to the minute
- Easily accessibly
- Possibility to be exploited

## **READINGS**

The Patents Act 1987, Act No. 1 of 1987.

TRIPS Agreement, Article 27(1) & 28

Alexander D. and Jacob R, A Guide Book to Intellectual Property: Patents, Trademarks Copyright and Designs, 4<sup>th</sup> edition sweet and Maxwell, London, 1993.

Allison, C. and Jeremy P., Introduction to Intellectual Property Law, 3<sup>rd</sup> edition, Butterworths, London, 1995.

Blanco, W.T.A Patents, Trade Marks Copyright and Industrial Designs 2<sup>nd</sup> Edition, Sweet and Maxwell, London 1989.

Cornish W.R., Intellectual Property: Patents, Copyrights Trade Marks and Allied Rights, 2nd edition, sweet and Maxwell, London 1989.

Davis M.H. and Miller A.R., Intellectual Property Patents Trade marks and Copyright 5<sup>th</sup> edition, West Publishing Co, New York, 1987.

Grundam H.E., "Foreign Patent Monopolies in Development Countries: An Empirical Analysis" 132 Journal of Development Studies 1967.

Jeremy P. (ed.), Butterwolths Intellectual Property Law Handbook, Butterworths, London, 1990.

Jones, R.J. Terrel on Patents, 8<sup>th</sup> edition, Sweet and Maxwell, London, 1934.

Jussawalla M., A study of Intellectual Property in a World without Frontiers: A Study of Computer Software, Greenwood Press, New York, 1992.

Keayla, B.K., Patent Regime at a Glance: National Working Group on Patent Laws, Delhi (India) 1992.

Kihwelo, P.F, "Implications of Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement in the law and Administration of Industrial Property in Tanzania" LL.M Dissertation, UDSM, 2000.

Laurie, G.T., "Intellectual Property Rights and the Interests of Indigenous Peoples', Lesotho Law Journal Vol. 10. No.1 1997, National University of Lesotho.

Liundi, G.B, Tanzania Laws on Patents and Trade marks: A report on a study of the system of Patents and Trademarks as it applies in Tanzania, as of December, 1980. Geneva.

Minnesota Small Business Assistance Office, A Guide to Intellectual Property Protection, 2<sup>nd</sup> edition, Minnesota, 1987.

Miller A.R and Davis M.H, Intellectual Property: Trademarks Patents and Copyright West Publishing Co. New York. 1987.

Wangwe J.M Industrial Property Protection and Technological Innovation: A case Study of the United Republic of Tanzania UNCTAD/TEC 1991.

Wellington, O.J., 'Patents and other Forms Related in Transferring Technology to Developing Countries with emphasis to Tanzania, LL.M Dissertation, UDSM, 1974/75

Williams J.F, A Manager's Guide to Patents Trademarks and Copyright 1<sup>st</sup> edition Billing and Sons Ltd., London 1986.

## **CASES**

- British Leyland Motor Corporation Ltd. V Armstrong Patents Ltd. [1986] AC 577
- Re LockWood, Atherton V Brooke [1958] Ch 231
- Chiron Corp V Murex Diagnostics Ltd [1996] FSR 567
- Beecham Group Ltd's (Amoxycillin) Application [1982] FSR 181, CA (NZ)
- Johns-Manville's Patent [1967] RPC 479
- Formento V Mentmore [1956] RPC 87

- General Tire V Firestone [1972] RPC 457, CA
- Catnic Components V C. Evans & Co [1983] FSR 401
- Windsurfing International [1986] E.C.R 611
- PLG Research V Ardon International [1995] FSR 116
- Glaverbel V British Coal [1995] FSR 254
- Smith Kline & French V Harbottle [1980] RPC 363, Pat. Ct
- Kalman V PCL Packaging [1982] FSR 406, Pat. Cat
- Merrill Lynch's Application [1989] RPC 561
- Vicom [1987] EPOR 74
- Lux Traffic Controls V Pike Signals [1993] RPC 107
- Sevcon Ltd. V Lucas CAV Ltd. [1986] 2 ALL ER 104

## **MODULE 6**

### **6:1 INDUSTRIAL DESIGN LAW**

This topic looks at the law surrounding protection of designs at common law, including the differences between Registered Design Right and Unregistered Design Right. The legal systems on industrial design rights in Tanzania will be examined.

6:2 Definitions of Design, Industrial Design, Unregistered Design, Registered Design, Novelty.

### **6:3 Design Rights Law in England**

### **6:4 Legal Systems on Industrial Design in Tanzania**

#### **6:4:1 Relevant Statutes**

- (i) Protection Ordinance of 1936, Cap 216 in the Laws of Tanzania Mainland.
- (ii) The Patents Act No 1. Of 1987 as Amended by Acts No. 13 and 18 of 1991.
- (iii) The Standards Act of 1975
- (iv) The Tanzania Commission for Science and Technology Act 1986
- (v) New Legislation in progress
- (vi) United Kingdom Designs (Protection) Decree Cap 158.(27 of 1937) in the Laws of Zanzibar (Zanzibar)
- (vii) The Harare Protocol 1983
- (viii) Copyrights and Neighbouring Rights Act 1999 (only for Registered /Protected Copyrights).

## **6:5 Criteria for Registration of Designs**

- Process
- Requirements

## **6:6 Designs Protection**

- (i) Rights Protected
- (ii) Duration of Protection
- (iii) Maintenance Fees
- (iv) Exceptions
- (v) Non-Protectable Designs
- (vi) Refusal for Design Protection

## **6:7 Grounds for Protection of Industrial Design**

## **MODULE 7**

### **7:1 RELATIONSHIP BETWEEN INTELLECTUAL PROPERTY AND COMPETITION LAW.**

This topic looks at the relationship between IP and competition law. The relationship will mainly focus on patents, trade marks and copyrights.

#### **7:2 Theory of Competition**

7:2:1 Definitions of Competition; Competitor; Dominant Position in a market; Market; Mergers and Acquisitions.

7:2:2 Definition of Anti-competitive Practices; Restrictive trade Practices; Market Power; Abuse of Market Power.

7:2:3 Sources and Functions of Competition Law

7:2:4 History of Competition Law in England and US.

#### **7:3 The Competition Legal System in Tanzania: An Overview.**

##### **7:3:1 History of Competition Law in Tanzania**

- The Fair Trade Practices Act of 1994

- The Fair Competition Act 2003

-Functions (Roles) and Purposes of the 2003 Act

##### **7:3:2 The Competition Commission Enforcement Authorities**

-The Fair Competition Commission

-The Fair Competition Tribunal

## **7:4 Competition and IPRs Policy**

### **7:4:1 PATENTS**

(i) Mergers

(ii) Licensing

- Compulsory Licensing
- Cross-Licensing
- Patent Tools

### **7:4:2 TRADE MARKS**

### **7:4:3 COPYRIGHTS**

## **READINGS:**

Allison C, Intellectual Property Law, 1<sup>st</sup> edition Longman, London, 1992.

Bainbridge, Intellectual Property, 5<sup>th</sup> edition, 2002

Bently & Sherman, Intellectual Property Law, 2<sup>nd</sup> edition, 2004

Cornish, Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights, Sweet & Maxwell, 4<sup>th</sup> ED, 1999.

Furse M, Competition Law of the EC & UK, 5<sup>TH</sup> ED, Oxford University Press, 2006.

Ghidini G, Intellectual Property and Competition Law: The Innovation Nexus, Edward E Publishing, 2006.

Jeremy P. (ed.), Butterwoths Intellectual Property Law Handbook, Butterworths, London, 1990

Jones A & Sufrin B, EC Competition Law, 2<sup>ND</sup> ED, Oxford University Press, 2004

Whish R, Competition Law, 5<sup>th</sup> ED, Butterworths, 2003

## **CASES**

- Coditel SA V Cine-Vog Films SA: 262/81 [1982] ECR 3381, [1983] 1CMLR, ECJ
- Volvo AB V Erik Veng (UK) Ltd: 338/87 [1988] ECR 6211,ECJ.
- Independent Television Publications Ltd V Time Out Ltd [1984] FSR 64
- Nungesser V Commission 258/78 [1982] ECR 2015, 1 CMLR 278
- BAT V Commission [1985] ECR 363.
- Musik-Vetrieb Membran GmbH V GEMA 55/80 [1981] ECR 147.
- Centrafarm BV v Sterling Drug 15/74 [1974] ECR 1147, 2 CMLR
- Keurkoop BV v Nancy Kean Gifts BV 144/81 [1982] ECR 2853

## **MODULE 8**

### **INTERNATIONAL AND REGIONAL SYSTEMS TO INTELLECTUAL PROPERTY RIGHTS (IP PROTECTION)**

#### **8:1 INTELLECTUAL PROPERTY RIGHTS (GENERALLY)**

- WIPO(World Intellectual Property Organization)
- WTO and TRIPS Agreement

#### **8:2 PATENTS**

- PATENT COOPERATION TREATY (PCT)
- ARIPO( African Regional Industrial Property Organization)
- BRELA
- OAPI
- PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY
- UPOV (INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS)
- EPO (EUROPEAN PATENT OFFICE)

### **8:3 COPYRIGHTS**

- THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY & ARTISTIC WORKS
- THE UNIVERSAL COPYRIGHT CONVENTION 1952
- ROME CONVENTION 1961
- GENEVA CONVENTION 1971
- COSOTA- Copyright Society of Tanzania

### **8:4 TRADE MARKS**

- MADRID PROTOCOL
- NICE AGREEMENT
- PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY

### **8:5 INDUSTRIAL DESIGNS**

- PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY
- ARIPO( African Regional Industrial Property Organization)
- OAPI
- HARARE PROTOCOL 1982

## **MODULE 9:**

### **9:1 LITIGATION (INFRINGEMENTS, REMEDIES AND DEFENCES)**

#### **9:2 TRADE MARKS**

The Laws relating to Trade marks provides for remedies for infringement of trade marks. Penal provisions for counterfeit of trademarks are provided for under the Penal Code cap 16. Hence the aggrieved party has three courses of actions of his trade mark right these are Infringement, Passing off action and Criminal action.

##### **(a) INFRINGEMENT ACTIONS**

- The relief obtainable in an action for infringement

Includes:

- (i) Injunction to restrain the threatened use or the continuance of an existing use.
- (ii) Damages
- (iii) Account of profits together with or without any order for the delivery of infringing labels or marks destruction or erasure. Of the above injunction is the

most effective remedy as it is the specific order of the Court directing the defendant to refrain from an act of infringement or the continuance of infringement.

(b) PASSING OFF ACTION

The Registered user of the trademark can proceed against an infringer for passing off. The reliefs in suits for passing off are the same as in the suits for infringement.

(c) CRIMINAL ACTION

Criminal action can be taken against the one who infringes trademark of another. The purpose of penal action here is to serve as a deterrent.

CASES

- Tanzania Breweries Ltd. V Kibo Breweries Ltd. Civil case No. 34 of 1999 High Court, Dar Es Salaam main registry (Unreported)
- CPC International Inc V Zainab Grain Millers Ltd. Civil Appeal No 49 of 1995, Court of Appeal of Tanzania (Unreported)
- Colgate Palmolive Company V Zakaria Provision Stores and 3others, High Court Civil Case No. 1 of 1997, Dar Es Salaam main registry (Unreported)

- E.R Flour Mills Ltd. V The Registrar of Trade and service Marks and the Attorney General Miscellaneous Civil Application No. 3 of 1996, Dar Es Salaam High Court main registry (Unreported)

### **9:3 PATENTS**

The Patents is a sort of property, the specification being the site-plan which delimits the property-owner's borders; anyone doing any act which falls within the scope of the patentee's legitimate claims is a trespasser, who must be driven off. His patent is virtually sovereign domain. It is an infringement to 'make, use, exercise or vent' a patented product, or a product made by means of a patented process, without the authorisation of the rights holder.

#### **TYPES OF INFRINGEMENTS**

The following acts constitute an infringement if done by a person other than the owner of the patent and without the authorization of the owner of the Patent.

- (i) Making, importing, offering for sale, selling and using the product,
- (ii) Stocking such product for the purpose of offering for sale, selling or using.
- (iii) Using the process when the patent has been granted in respect of a process.

### 9:3:1 REMEDIES FOR INFRINGEMENT

On the request of the owner of the Patent; the Court may order the following reliefs:-

- (i) Injunction to prevent infringement where infringement is imminent or to prohibit the continuation of the infringement, once infringement has started;
- (ii) Damages by paying a sum of money in reparation for the injury occasioned to the patent holder;
- (iii) In addition to the above remedies the court may award any other remedy provided for in the civil law.

### CASES

- CBS Song Ltd. V Amstrad [1988] AC 1013
- Manufactures de Glaces SA V Tilghman's Patent Sand Blast Co [1883] 25 Ch D1
- Sevcon ltd. V Lucas CAV Ltd. [1986] 2 ALL ER 104
- Salomon V Salomon Co. Ltd. [1897] AC 22
- Re Lockwood, Atherton V Brooke [1958] Ch 231

## 9:4 COPYRIGHTS

Unlike Patent infringement, Copyright infringement knows no concept of the claim. Each work, upon and by virtue of its creation, determines the extent of the monopoly which its copyright owner will enjoy, subject to the principle of the restricted act: so far as each type of copyright work is concerned. This part will highlight some of the major issues arising from the following species of infringement:

- (i) Making a Copy
  - Reproduction: a matter of form or content.
- (ii) Issuing copies to the public
  - Rental
  - Selling
- (iii) Performing
- (iv) Broadcasting and cabling.
- (v) Making and adoption
- (vi) Infringement must be intentional
- (vii) Complete and partial infringements.

## 9:4:1 REMEDIES FOR INFRINGEMENT

### (a) Injunction

An injunction is a court order, directed at a named person or group of persons, which demands that a particular course of action be undone (if completed) be stopped (if incomplete); or that it should not, be started.

### (b) Damages

A person who is held liable for copyright infringement can expect to face the consequences by being made to pay a sum of money in reparation for the harm which he/she has inflicted upon the economic interests of the copyright holder.

### (c) Account of profits

The law offers the injured plaintiff the chance of claiming as his own the profits made by the defendant.

## CASES

- Joy Music Ltd. V Sunday Pictorial Newspapers [1920] Ltd. [1960] 2 QB 60.
  
- Warwick Film Productions ltd. V Eisinger [1969] 1 Ch 508

- Interlego V Tyco Industries [1989] AC 217
- CBS Inc V Arnes [1982] Ch 91
- Duck V Bates [1884] 13 QBD 843
- Jennings V Stephens [1936] Ch 167
- Turner V PRs [1943] Ch 167
- Hanfstaengl V Empire Palace [1894]
- University of London Press V University Tutorial Press [1916] 2 Ch 601

## **READINGS**

Alexander D. and Jacob R, A Guide Book to Intellectual Property Patents, Trademarks Copyright and Designs, 4<sup>th</sup> edition sweet and Maxwell, London, 1993.

Allison, C. and Jeremy P., Introduction to Intellectual Property Law, 3<sup>rd</sup> edition, Butterworths, London, 1995.

Amanda A., A Practical Guide to Trademarks Sweet and Maxwell, London, 1993.

Beverly W.P. and Hilliard D.C. Trademarks Cases and materials series , Matthew Bender, New York, 1987.

Blanco, W.T.A Patents, Trade Marks Copyright and Industrial Designs 2<sup>nd</sup> Edition, Sweet and Maxwell, London 1989.

Cornish W.R., Intellectual Property: Patents, Copyrights Trade Marks and Allied Rights, 2<sup>nd</sup> edition, sweet and Maxwell, London 1989.

Davis M.H. and Miller A.R., Intellectual Property Patents Trademarks and Copyright 5<sup>th</sup> edition, West Publishing Co, New York, 1987.

James Mellor, et. Al., Kerly's Law of Trademarks and Trade Names 12<sup>th</sup> edition Sweet and Maxwell, 1986.

Jones, R.J., Terrel on Patents, 8<sup>th</sup> edition, Sweet and Maxwell, London, 1934.

Keayla, B.K., Patent Regime at a Glance: National Working Group on Patent Laws, Delhi (India) 1992.

Kerly D.M., Law of Trade Marks and Trade Names 10<sup>th</sup> edition, Sweet and Maxwell, London.

Lloyd R.G., Kerly on Trade Marks and Trade Names 8<sup>th</sup> edition, Sweet and Maxwell, London 1960.

Michaels A., A Practical Guide to Trademarks 2nd edition, Sweet and Maxwell, London, 1996.

Micheal, F. Flint, A user's Guide to copyright 4<sup>th</sup> edition, Butterworths, London, 1997.

Minnesota Small Business Assistance Office, A Guide to Intellectual Property Protection, 2<sup>nd</sup> edition, Minnesota, 1987.

Miller A.R and Davis M.H, Intellectual Property: Trademarks Patents and Copyright West Publishing Co. New York. 1987.

Nguluma A.T., The Role of Law in the Development of Science and Technology: Related Policies and Strategies in Post Independence Tanzania, PhD, UDSM (1991).

Trade-Related Aspects of Intellectual Property Rights Implications for Development Countries. World Trade and Development Report, 1991.

Kihwelo, P.F., “Implications of Trade – Related Aspects of Intellectual Property Rights (TRIPS) Agreement in the Copyrights and Neighbouring Rights Act 1999: General Commentary The Tanzania Lawyer, April – September 2001 issue. Samzug, A.S. and B. Shabaan, “Implications of Copyright Protection to Distance Education in Tanzania: An Appraisal of the Copyright and Neighbouring Rights Act 1999 Huria Journal of the Open University of Tanzania Volume II No. 2 September, 2001.