



Industrial Designs Protection in Uganda: A Comprehensive Guide

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KAA HOUSE,
Plot 41 Nakasero Road
P.O. Box 9566, Kampala.
Tel: +256 312 244 100
Fax: +256 414 349 954
info@kaa.co.ug

Introduction

Industrial designs, also known as design patents, protect the aesthetic and decorative features of a product that make it visually distinctive and marketable.

Unlike patents that cover functional aspects, industrial designs focus on appearance and are governed under Section 71 of the Industrial Properties Act (IPA) in Uganda. This guide explains eligibility criteria, the registration process, rights of design holders, infringement tests, and available legal remedies.



What is an Industrial Design?

An industrial design protects the visual appeal of a product rather than its functionality. According to Section 71 of the IPA, the design must enhance the product's appeal without being dictated by technical functions.

Novelty Requirement (Section 73 IPA)

For an industrial design to be registered, it must:

- Be new, original, or distinctive.
- Exhibit a substantial difference from existing designs.
- Not be a mere variation of a pre-existing design.

This principle was upheld in Migoo Industrial and Trading Company (U) Limited Vs. Rida International Industry (U) Limited (Civil Suit 359 of 2019), where the court ruled that an industrial design must be original and sufficiently different from prior designs.

Public Disclosure Restrictions

To qualify for registration, an industrial design must not have been publicly disclosed before filing. This means the design:

- Must not have been published or exhibited.
- Should not have been used in trade.
- Should not have been disclosed in business dealings.

Morality and Public Order Compliance

Designs that are contrary to public morality or order are excluded from protection. The nature and perception of the design will determine its eligibility.

Procedure for Registering an Industrial Design in Uganda

Step 1: File an Application

Under Section 74 of the IPA and Regulation 46, an applicant must:

- Submit Form 28.
- File separate applications for each design (Regulation 46(3)).
- Provide graphic representations of the design (Regulation 46(4)).
- Include the applicant's name and details (Regulation 46(5)).
- Obtain consent if the design incorporates registered arms, emblems, names, or portraits.
- Pay the prescribed fee.

Step 2: Examination & Approval

- The Registrar examines compliance with Sections 72, 73, and 74.
- If compliant, the design is registered, a certificate is issued, and the registration is published (Section 74(9)).

Priority in Registration

If two or more applicants independently file the same design, priority is given to the earlier application.

Rights of Industrial Design Holders

- Industrial designs are valid for an initial period of 5 years.
- Renewable for two consecutive periods of 5 years (total of 15 years).
- The owner has exclusive rights to manufacture, import, sell, or offer for sale products embodying the design (Section 79 IPA, Article 26(a) TRIPS Agreement).
- Protection only extends to industrial or commercial activities.
- Designs registered with ARIPO (African Regional Intellectual Property Organization) have the same effect in Uganda as locally registered designs unless otherwise stated.

Licensing of Industrial Designs in Uganda

Design holders can license their designs through exclusive or non-exclusive agreements. Key considerations:

- No restrictions on time, territory (Uganda), or specific fields of use unless specified in the contract.
- Sub-licensing is prohibited unless explicitly permitted in the licensing contract.
- All licensing agreements must be registered with the Registrar of Patents.

Test for Infringement

In Migoo Industrial and Trading Company (U) Limited Vs Rida International Industry (U) Limited, Justice Mubiru established that industrial design infringement is assessed using the 'imperfect recollection test'. This involves:

- Comparing the overall visual appearance of the allegedly infringing product against the registered design.
- Assessing whether a reasonable consumer would confuse one product for another due to similarities in design.

Key factors considered in infringement cases include:

- The **nature and intended purpose** of the goods.
- The **method of use**.
- Whether the goods are **complementary or competitive**.
- The **distribution channels**.
- The **degree of freedom** in design development.
- The **consumer perception** of the origin of goods.

Legal Remedies for Industrial Design Infringement

Under a design holder may seek:

1. Injunctions Section 93 of the IPA,

- Permanent or temporary injunctions to prevent further infringement.
- Anton Piller Orders, which allow search and seizure of evidence (e.g., infringing products, records, or electronic data).

2. Damages

- Special damages: Must be specifically pleaded and proved (e.g., loss of sales due to infringing activity).
- General damages: Based on lost profits, infringer's earnings, or lost royalties.
- In Migoo Industrial and Trading Company (U) Limited v Rida International Industry (U) Limited, the plaintiff was awarded UGX 6,589,795,284 in special damages due to price reductions forced by market competition from the infringing product.

3. Additional Remedies

- Interest compensation (Section 26(1), Civil Procedure Act).
- Legal costs reimbursement (Section 27(2), Civil Procedure Act).

Conclusion

Industrial design protection is crucial in Uganda's innovation ecosystem, providing legal safeguards for aesthetic and commercial value. By securing exclusive rights, businesses and inventors can prevent unauthorized use, enhance market competitiveness, and stimulate economic growth. Understanding the Industrial Properties Act and TRIPS Agreement ensures effective intellectual property management.

For legal support in industrial design registration or infringement cases, consult a trusted intellectual property lawyer in Uganda.

Authors



Augustine Obilil Idoot
Partner
aidoot@kaa.co.ug



Rahil Savani
Trainee Attorney
rsavani@kaa.co.ug

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