Received: 11 March 2021 | Accepted: 2 October 2021

DOI: 10.1111/jwip.12204

ORIGINAL ARTICLE

THE JOURNAL OF WORLD INTELLECTUAL PROPERTY WILEY

Protection of geographical indications and cross-border trade: A survey of legal and regulatory frameworks in East Africa

Saudin J. Mwakaje

School of Law, University of Dar es Salaam, Dar es Salaam, Tanzania

Correspondence
Saudin J. Mwakaje, School of Law, University of Dar es Salaam, Dar es Salaam 14115, Tanzania.
Email: saudinj@gmail.com

Abstract

Geographical indications (GIs), one of a subset of intellectual property rights (IPR), have recently assumed significant role in regulating variety of sectoral policies and national and regional, and international levels. Its relevance makes it one of the critical agenda in areas such as agriculture and international trade. Internationally, the articulation of GIs under TRIPs Agreement remains unclear and leaves policy and regulatory space for each country to choose their own path. The Continental Strategy for Geographical Indications in Africa—2018–2023 has introduced a new dimension about GIs. Legal instruments governing the East African Community (EAC) proffer a harmonized policy and regulatory framework for IPR as one of the means to attain the regional objectives. However, laws governing GIs in the partner states of EAC vary in terms of the nature and scope of protection and the underlying regulatory structures, resulting into heterogeneity in GIs protection in each country. Amid this regulatory dilemma, this paper examines the GIs laws in EAC by bringing to the fore the obtaining substantive and procedural differences amongst the partner states to EAC. The paper, among others, proposes a centralized regional approach for GIs protection to attain EAC's objective.

KEYWORDS

cross border trade, Eastern Africa perspectives, geographical indications, intellectual property rights

1 | INTRODUCTION

Geographical indications (GIs) refer to a type of intellectual property rights (IPR) that provides a legal framework through which origin of mainly agricultural products can be differentiated based on the special geographical features and climatic attributes of the place of origin. The Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter "TRIPs Agreement") defines GIs as signs which identify goods as originating in a particular territory, or a region or locality, where a given quality, reputation or other characteristic of the goods is essentially attributable to its geographical origin.[1] GIs is a subject that has recently started to attract special interest from many developing countries in view of its allure and role in the development of the agricultural sector and trade generally.[2] The protection of GIs is tailored to achieve, among others, several economic functions including facilitating fair competition and consumer protection through product differentiation based on their geographical origin; which is a critical element in influencing the purchasing decision of consumers.[3] Thus, as an aspect of IPR and in view of the nature of its underlying rights, regulation of GIs may have significant impact on various dimensions of social and economic development in a particular society. No wonder issues of GIs were one of the critical agenda in the negotiations that preceded the adoption of the TRIPS Agreement in 1994. The TRIPs Agreement introduced an elaborate GIs protection framework featuring the enhanced protection for wines and spirits; applicable statutory exception to the protection of GIs; and, has captured several unresolved issues for future negotiations.[4]

Informed by the context and dynamics narrated above, this paper confines its examination on the legal framework for the protection of GIs in the partner states of the East African Community (EAC). It is worth pointing out that all partner states to EAC are also members of the WTO, hence bound by the obligations arising under the TRIPs Agreement. Thus, the dimensions of the protection of GIs discussed in this paper is predicated on the WTO set up, which seem to look at GIs from cross-border trade perspectives. Specifically, the paper assesses potential policy and regulatory implications of the current GIs protection set up on cross border trade within the EAC region. At the outset, the paper lays down the guiding analytical benchmark, followed by an inquiry on the legal basis of treating GIs as a subset of IPR. Then a snapshot on the current GIs protection regimes in the East African region is presented by way of reflecting on the current statutory frameworks and regulatory variances obtaining in the partner states to EAC. The conclusion and recommendations focus on the available policy and regulatory options contextualized in the EAC regional cooperation framework.

2 | CONTEXTUAL SETTING

Africa is one of the rich continents in terms of having climatic and geographical diversities which enables cultivation and production of varieties of agricultural products with distinct taste and characteristics. Cognizant of such potential, in 2018 the African Union (AU) adopted a Continental Strategy for Geographical Indications in Africa aimed at, among other things, strengthening of the GIs regulatory framework with a view of harmonizing the GIs laws to enhance regional trade.[5] This continental and region trend on the emphasis to the protection of GIs is not peculiar to Africa. Across many regional economic blocs, the protection of GIs has become one of the critical agenda and is considered as crucial in enhancing product quality and cross-border trade negotiations.[6]

In the East African region which is comprised of 6 Partner States, the Republics of Burundi, Kenya, Rwanda, South Sudan, the United Republic of Tanzania, and the Republic of Uganda, the quest for protection of GIs emanates from the realization of its rich endowment of diverse geographical conditions which enable, among others, production of agricultural produce with unique qualities and taste.[7] Furthermore, the legal instruments establishing the EAC have provisions aimed at facilitating regional harmonization and cooperation on IPR issues.[8] In a bid to realize this objective, the EAC has initiated the process of developing a model policy and law on IPR, the draft EAC Regional Intellectual Property (IP) Policy was submitted for consultation in the EAC Secretariat in 2018.[9] This paper posits that as dialogues on regional harmonization of IPR regimes continues in EAC; protection of GIs

ought to be one of the key issues occupying a center stage in the regional deliberations in view of its relevance and potential effect to agricultural reforms, trade, and overall economic development within the region.[10]

3 | PROBLEM STATEMENT

As the EAC embarks on enhancing cross border trade by removing trade barriers through synchronizing various legal and regulatory regimes, harmonization of IPR laws and systems remains undecided, hence continuing to be heterogenous amongst the partner states. The legal instruments establishing EAC explicitly calls for harmonization of laws and policies on IPR as one of the crucial initiatives in achieving regional developmental objectives. Yet, there has been insignificant progress in the harmonization of IPR laws and regulatory framework. Regarding the international protection of GIs, none of the partner states to EAC has acceded to the relevant international legal instruments for the protection of GIs, such as the Madrid Agreement which are administered by the World Intellectual Property Organization (WIPO). Amid the ongoing inertia on harmonization of IPR within EAC; a new continental impetus has recently arisen to push for harmonization of policies and legal regimes on IPR in Africa triggered by the GIs continental agenda for Africa. In addition, in the partner states to EAC there are still noteworthy disparities on how GIs are protected in terms of qualifying criteria, scope of rights, and regulatory frameworks.[11] The current set up is potentially problematic in the context of cross border trade by reason that GIs being an aspect of IPR; its protection gives rights which are territorial in nature.[12] Thus, it follows that the exclusive rights granted are confined to the geographical boundaries of a country in which protection has been granted.

One of the rights conferred to the owner of a GIs relates to the exclusive rights on sale, exportation and importation of goods bearing a particular GIs in a country of registration.[13] On this point, it is apparent that the rights conferred under the GIs system have a direct bearing on cross border trade, as it may affect right of importation and exportation as mentioned above. Within East Africa, each Partner States has adopted her own preferred regime on GIs, this could be partly contributed by the fact that GIs may be protected through variety of legal mechanisms such as competition laws, certification marks or sui generis law.[14] It follows that, unless a unified regional legal regime is adopted, GIs will remain one of the potential nontariff barriers thereby inhibiting the underlying objectives of the EAC which is centered on boosting regional trade by facilitating free movement of goods and services across the region. Hence, an assessment of the existing legal and regulatory framework on GIs in EAC is timely and necessary if the regional ideals contemplated under the establishing legal instruments of EAC are to be achieved.

As a preliminary matter, the paper first interrogates a legal question on why GIs are treated as IPR before exploring the national legal set ups for GIs protection obtaining in the EAC region.

4 | LEGAL ESSENCE OF PROTECTING GIs AS IPR

The recognition of GIs as protectable subject matter within the mainstream IPR has not been short of contradictory views and opinions.[15] The contrasting views are based on both a perceived theoretical and construct mismatch of the nature of rights under IPR regime and the subject matter of protection under the GIs system. A conventional view is that the IPR system is based on property rights formulation which arises from intervention of human ingenuity to generate a creative work. In contrast, the context in which GIs are created, and the ensuing protection is slightly different from the conventional intellectual property. As a rule, GIs focuses on the value of a product or service attributable to certain geographical characteristics—which exist naturally.[16] Viewed as such, one may hardly appreciate the contribution of human ingenuity in creating value of the product upon which GI protection is attached to.

Unsurprisingly, in its formative stages, the subject of GIs was largely considered as a European trade concept,[17] primarily applied in wines, cheese and other related products.[18] The formal international protection of GIs is traceable in the legal instruments such as the Paris Convention for the Protection of Industrial Property, 1886 under article 10, the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods, 1891 as amended under article 1, and the Lisbon Agreement for the Protection of Appellation of Origin and their International Registration of 1958 under article 22–24. The Madrid Agreement has prescribed border control measures by imposing an obligation to the contracting States to seize imported goods which bears false indication of the origin of the goods. Article 1(1) of the Agreement states: all goods bearing a false or deceptive indication by which one of the countries to which this Agreement applies, or a place situated therein, is directly or indirectly indicated as being the country or place of origin shall be seized on importation into any of the member countries.

However, a critical global turning point may have arisen when GIs was linked with trade, particularly its inclusion in the TRIPs Agreement.[19] Appreciated from a trade perspective, the focal point for the protection of GIs shifted to a different notion centered on value addition and branding of a product.[20] Therefore, the quality of a final product is usually a combination of in situ geographical attributes and the human ingenuity. It is this human creative intervention as an integral part of a product's quality which makes a product a *produit de terroir* or product of a place—hence, qualifying GIs as a form of IPR.[21]

Notably, the GIs protection regimes may take different approaches. International and Multilateral legal instruments usually set out the minimum levels of protection, leaving space for contracting states to choose their preferred implementation model. For instance, under the TRIPS Agreement contracting states have the option to implement their obligations by protecting GIs under either the unfair competition laws; or within the trademark law regimes as collective marks or certification mark, and in some cases by establishing a sui generis GIs protection system. Echoing the available protection flexibilities and options in key international legal instruments, the legal regimes on GIs in EAC are a reflection of a mixture of varying legal and regulatory approaches.

5 | BIRD'S EYE VIEW OF GIs PROTECTION IN EAST AFRICA

The national regulatory structures, approaches and the scope of protection of GIs within EAC vary significantly. In some countries, protection is through an elaborate legal and regulatory framework while in others the framework is comparatively obscured and, in many respects, inept. In the overall, as the following sections of this paper seek to demonstrate, the subject of GIs has not occupied a prominent role within the general statutory frameworks of protection of IPR in the region.

5.1 | The regulatory framework of GIs in Burundi

The protection of GIs in Burundi is regulated by the Law Relating to Industrial Property.[22] This legislation, as noted from Article 356, is predicated on the spirit of international IPR legal instruments such as the Paris Convention and the TRIPs Agreement. As an example, Article 2 of the GIs legislation of Burundi has adopted the definition of the term "geographical indication" which mirrors the one provided under Article 22 of the TRIPs Agreement. In addition, Article 341 through 352 of the GIs Law of Burundi establishes a regulatory body dealing with registration of GIs with defined mandates and procedural processes on filings and oppositions similar to the procedures applicable to trademarks or patents registration.

Intriguingly, for protection purposes, Article 340 of the GIs law of Burundi allows the Director of Industrial Property to, *suo moto* (*on his own initiative*), request, obtain and enforce the registration of GIs for goods whose producers are yet to be organized as entities hence are unable to lodge a formal request for protection of a particular GIs which they may have interest. This is a striking feature of the GI law of Burundi as the arrangement

deviates from the traditional systems for the protection of IPR which have no provisions for the regulator to assert rights on the subject matter which it regulates. This special permission to the Director of Industrial Property to register a designated GIs may be necessitated by the fact that the level of awareness on matters of GIs amongst the stakeholders (farmers and agri-business companies) is relatively low, hence the need for the government to protect certain designated GIs for broader national interest and may be preventing unscrupulous traders attempting to register such geographical names as private business property.

5.2 | The legal framework in Kenya

In Kenya, the protection of IPR is rooted in the constitutional provisions which obligate the state to protect IPR of the people of Kenya.[23] Having in place such an express constitutional reference to IPR offers a solid legal foundation for formulation of requisite national interventions on issues of IPR in Kenya. Despite this seeming advantageous legal foundation for the national protection of IPR, Kenya is yet to enact a specific legislation on GIs.[24] Instead, the protection of GIs is currently governed by the Trade Marks Act under the provisions dealing with certification marks.[25] In a bid to expand the protection coverage, the Act under Section 40D (1) recognizes GIs which are registered under the Banjul Protocol, which is administered by the African Regional Intellectual Property Organization.

Arguably, the registration framework for certification marks is atypical to GIs protection because, as opposed to GIs, under certification marks, there is no requirement of attributing quality of the product to the geographical characteristics of the place of origin.[26] It can, therefore, be contended that, strictly construed, the protection of GIs in Kenya under certification mark lacks proper elements which are traditionally applicable to GIs, hence making it less effective.[27] No wonder there have been concerted national initiatives in Kenya to enact a sui generis legislation on GIs. In 2007, a Geographical Indications Bill was drafted but was never assented to despite receiving comments and support from various stakeholders.[28] Recently, a new proposed Intellectual Property Bill of 2020 with detailed provisions on GIs has been drafted and rolled out for public and stakeholders' scrutiny, commentary and views.[29] It is projected that when the new Bill is eventually passed into law, Kenya will join Uganda in having in place an elaborate legal framework for the protection of GIs in the East African region. Furthermore, such a measure may usher a promising era with significant increase of value in agricultural products from Kenya which in turn may boost their quality and marketability.[30]

5.3 | Protection of GIs in Rwanda

The protection of GIs in Rwanda is governed by the Law on the Protection of Industrial Property of 2009 and is tailored to reflect the ideals of the TRIPs Agreement.[31] Its preamble makes express reference to the international intellectual property legal instruments and the accession of Rwanda to the WTO. There are several aspects under the GIs law of Rwanda which borrows from the TRIPs Agreement such as the definition of GI under section 5(6) which mirrors the definition under 22(1) of the TRIPs Agreement, and the provisions under section 166 on special treatment of GIs for wines and spirits. The right to file an application for a GI is open to any person (natural or juridical). The right to use registered GIs under section 168 and 175 is open to any producer, provided that the applicant is carrying out production activities in a geographical region indicated in the registration. Also, the GIs law in Rwanda has set a clear tone in terms of the overall underlying objectives of GIs protection, which is to, inter alia, prevent and reduce distortions in trade, a subject which has been repeatedly restated in the legislation from different angles. Hence, a microscopic view of the GIs law of Rwanda, specifically article 165, 167, 174, and 176, suggests that it is primarily anchored on the prevention of unfair competition in the market.

In terms of the regulatory set up, Section 170 through 173 provides for an elaborate framework for GIs protection, containing provisions on the examination process, publication of the application, the opposition proceedings and the invalidation procedures of a registered GI. It is also worth mentioning that in Rwanda, infringement of GIs may attract both civil and criminal sanctions, thus expanding the enforcement terrain.

5.4 | Protection of GIs in South Sudan

In the Republic of South Sudan, the law on GIs is currently not in existence; the old legislation is also comparatively not sufficiently elaborate on matters of GIs protection. The ineptness of the legal and regulatory framework on GIs in the Republic of South Sudan can be better appreciated from her historical political context. The Republic of South Sudan seceded and became autonomous from the Republic of Sudan to form a Republic in 2011.[32] Since attaining her full autonomy, there has been little progress in enacting legislation to govern matters of IPR; hence currently there is no law in force on GIs protection in the Republic of South Sudan.[33] At a time when it was part of the Republic of Sudan and immediately after secession, the law applicable on GIs was the Trademark Law of 1969,[34] which was nevertheless not elaborate on GIs issues. However, since 2015 all laws governing IPR were suspended until further notice.[35] Currently, proprietors of IPR are only allowed to reserve trademarks and other forms of intellectual property assets that they may have pending the enactment of relevant legislation. Thus, there is little in terms of GIs protection that can be traced from South Sudan.[36]

5.5 | GIs protection in Tanzania

The United Republic of Tanzania has a unique IPR regulatory system which is based on the dual registration and enforcement system. Tanzania is a union between Tanganyika and Zanzibar under which only matters of the Union are centrally regulated and the rest of the matters are independently dealt with by each side of the Union.[37] Notably, the protection of IPR is not a Union matter; hence, each side of the Union (Tanzania Mainland and Tanzania Zanzibar) has her own legal and regulatory structure.[38] This has resulted into duality of intellectual property legal frameworks with some variations in substantive features, the procedural and regulatory structural set up; hence, it serves to explain the current mismatch of the GIs laws in either side of the Union.

In Tanzania Mainland there is neither a specific legislation nor express provisions on GIs protection.[39] A far-fetched inference can be drawn from the provisions of Trade and Service Marks Act,[40] which under section 19(a) prohibits registration of a mark which is likely to cause confusion as to the nature or geographical or other origin of the goods or services concerned. Admittedly, Section 19 is not a registration provision; rather it is a deterrent prescription on registration of geographical names as trademarks. Therefore, by inference, under the Tanzania Mainland law, a geographical name may be registered as a trademark, not as a GI.

In contrast, there is a defined legal regime on GIs protection in Tanzania Zanzibar, under which registered and unregistered GIs are protected under the Zanzibar Industrial Property Act.[41] The Act is to a greater extent a reminiscent of the framework under the TRIPs Agreement, except on one aspect—the GIs law of Zanzibar does not extend special protection to wines and spirits. The reflection of TRIPs Agreement in the Zanzibar GIs law can be noted from a few provisions including section 2 which deal with the definition of GIs, and its overall protection framework.

Under section 60(3) of the Zanzibar Industrial Property Act, similar to the GIs law of Burundi, the registrar, may request, obtain, and enforce the registration of a GI for goods whose producers are not yet formally organized. Furthermore, under section 59 through 62 there are detailed provisions on substantive and procedural requirements regarding refusal from the registrar and opposition proceedings. In terms of section 63 of the Act, the right to use registered GIs is open to all producers carrying on their activities in the specified geographical area.

In a nutshell, it is argued that the protection of GIs in the United Republic of Tanzania is a reflection of a mixed regulatory set up. This paradoxical legal situation has resulted into a regulatory dilemma and a potential disincentive to producers to pursue GIs protection of products which may have the qualifying features.[42]

5.6 | Protection of GIs in Uganda

Within the EAC, it is only Uganda which has in place a standalone statute for the protection of GIs, enacted in 2013 as a sui generis legislation for the protection of GIs.[43] The Act became operational in 2018 after the promulgation of the Geographical Indications Regulations of 2018 on September 4th, 2018.[44] Furthermore, in 2019 Uganda launched the national policy on intellectual property, which among others seek to foster effective protection of GIs.[45] Surprisingly, the policy is silent on the regional dimensions of IPR within EAC. The Uganda's GIs legislation significantly mirrors the contemplated GIs framework under the TRIPS Agreement both in terms of definitions and overall layout of the GIs regime. The Act contains all the key provisions which are necessary for the protection of GIs ranging from establishing the criteria for registration, the regulatory body, the duration of protection, and remedies for infringement of GIs as traceable from sections 6, 7, and 15 of the Act. In addition, the Act has adopted a procedural registration process which is similar to the procedures applicable to other forms of IPR.

One of the striking features of the GIs legislation of Uganda lies on a carefully delineation of three types of IPR protection, namely, GIs, certification marks, and trademarks. Under the Geographical Indications Act, trademarks and GIs are treated as different subsets of IPR,[46] although a potential hitch is that despite their conceptual differences, it is allowable to convert from one type of protection to the other as per section 19 of the Act.

Regarding the correlation of GIs protection in Uganda and EAC cross border trade, the relevant provisions are those dealing with legal remedies available to owners of GIs which, as per section 25 of the Act, include a right to object importation of infringing goods. Also, within the dictates of section 23 of the Act customs authorities are empowered to restrict importation and exportation of infringing goods on the GIs registered in Uganda.[47] It remains to be seen how the courts will interpret such provisions in view of the previous decision of the High Court of Uganda (Commercial Division) in *Nairobi Java House Ltd. v. Mandela Auto Spares Ltd*.,[48] in which the court established a rule regarding the paramountcy of the regional legal instruments of EAC over the national laws on trademark territoriality. The Court asserted that in interpretation of the national intellectual property laws, regional objectives as found in the various legal instruments under EAC ought to take precedence. Notably, the protection of GIs is also territorial, hence potentially inhibitive to cross border trade.[49] Unless the position of the Court in *Nairobi Java case* is adopted in disputes involving GIs infringement, it is argued that there will be serious cross border trade issues to be resolved based on the current national territoriality in the provisions on GIs protection within EAC.

As revealed in the preceding discussion, the protection of GIs in EAC has remained a matter of national law with little concerted regional initiatives on harmonization and unification of GIs registry system. The current GIs regulatory inertia may be attributable to several hiccups inherently intertwined within the GIs structural setting, as highlighted in the following section.

6 | CHALLENGES IN THE PROTECTION OF GIs IN EAC

Despite tremendous economic potentials of GIs within the region, the establishment of a harmonized GIs regulatory regime in EAC is yet to attract formal dialogues. The lethargic stance may be attributable to various setbacks, including conceptual issues of GIs, variance in national GIs laws, difference in judicial approaches on IPR matters, lack on national IPR policies, and limited awareness on matters of IPR.

6.1 | The mismatch of GIs and IPR

Substantively, GIs has had an uncomfortable sitting within the conventional IPR regime. As a norm, protection of IPR is reserved to works resulting from human creativity. Hence, human intellect is a critical ingredient and must be applied in creating a work to attract IP protection. In contrast, the critical ingredient for GIs protection is the attribution of quality of a product to geographical characteristics of a particular area. Admittedly, human ingenuity cannot be responsible for existence of certain natural geographical conditions. Under exceptional situations whereby collective human initiatives on using creative environmental conservation methods resulting into certain geographical characteristics, then such creativity may only be attributed to a community (not to an individual). Under Section 7(3) of the Geographical Indication Act of Uganda, there is recognition of human factors in giving rise to certain quality of a product for the purposes of GIs registration. The section reads: "In determining whether a geographical indication is registrable, the registrar shall consider quality, reputation or other characteristics attributable to natural factors or human factors or a combination of natural factors and human factors." Thus, the "communal efforts and ownership aspect" of GIs places it on a contradictory doctrinal pathway with the usual setting of IPR protection which is fundamentally structured as a private property right. For instance, Article 349 of the attendant law of Burundi indicates that ownership of GIs vests to producers (not an individual) engaging in production in the designated geographical area. In contrast, ownership of GIs has always maintained a community element, a fact which explains the difficulties in finding a uniform IPR protection model.

6.2 | Variances of national GIs laws

In the framework of the EAC, whose objective is to facilitate cross border trade, it is crucial to have coherence of the laws, particularly those which have inhibitive effect like IPR. In is in this context that Article 7 of the Treaty Establishing the East African Community has set the key operational principles that encourages free movement of goods and services across the borders. Yet, a survey of the GIs laws within EAC testifies that there is a significant degree of variation in each Partner States in terms of comprehensiveness of the GIs laws and the protection approach. Currently, it is only Uganda which has in place a sui generis legislation on GIs; while Burundi, Rwanda, and Tanzania Zanzibar have included detailed provisions dealing with GIs in their mainstream IPR legislation. Kenya and Tanzania Mainland are working towards consolidation of their IP statutes within which issues of GIs will be given more elaborate framework. In the Republic of South Sudan there are uncertainties because of the current suspension of all IPR legislation. The existing heterogeneity of the GIs laws amongst the Partner States of EAC may prove to be a significant stumbling block in creating a harmonized GIs regional regime, henceforth, hindering the agricultural development and free movement of goods and services as advocated by the legal instruments adopted by EAC.

6.3 | Differences in judicial interpretation of IPR provisions

To harmonize the GIs protection and enforcement systems in EAC, it is crucial for the Courts within the Region to have a common understanding on how issues of IPR are to be interpreted in support of regional trade agenda; much more so when issues of cross-border trade are a subject of judicial contention. Worryingly, recent decided cases point to a significant disparity on how national courts in EAC Partner States are approaching and interpreting IPR laws and principles. Two cases adjudicated in Uganda and Rwanda illustrate the alarming signs which may have major effect on cross border trade and IPR enforcement. Both cases involved trademark disputes which attracted the interpretation of the principle of territoriality. The High Court of Rwanda in *Bakhresa Grain Milling (Rwanda), Ltd. v. Mikoani Traders Ltd.*,[50] maintained that based on the principle of territoriality, the Registrar of trademarks in

Rwanda is not bound by the trademarks registered in other countries within EAC or elsewhere. In contrast, the High Court in Uganda in *Nairobi Java House Ltd. v. Mandela Auto Spares Ltd*.,[51] adopted a different interpretational approach by holding that the principle of territoriality ought to be construed in support of broader objectives of EAC. The Court emphasized that a chosen interpretational path must be the one that advances the ideals of cross border trade and not otherwise. Hence, the Court disregarded the trademark territoriality law by invalidating a trademark registered in Uganda based on the opposition filed by a proprietor of the mark which was earlier registered in Kenya. These two cases demonstrate a jurisprudential disparity in the courts within EAC, a dimension which may affect how GIs law will be applied and enforced across the region.

6.4 | Absence of national intellectual property policies

One of the prerequisites for smooth harmonization of regional IPR system is the existence of necessary national infrastructures for the recognition and promotion of intellectual property, including appropriate and well-articulated national intellectual property policies. As it stands, only Rwanda and Uganda have in place national policies on IPR.[52] The rest of partner states are yet to adopt national policies on IPR. In those countries isolated issues of intellectual property are traceable in scattered policy documents on areas such as education, science and technology, and agriculture. The absence of national policy position on GIs may affect quality of regional dialogues and speed of the regional impetus in embracing an all-around GIs model regime.

6.5 | Limited IP awareness amongst all stakeholders

The level of awareness to policy and law makers in East African region on the strategic role of IPR for sustainable development is generally on the low side. This is vindicated by, as discussed above, the lack of clear national policies and agenda on IPR in most of the partner states, with the exception of Rwanda and Uganda. Coincidentally, both policies of Rwanda and Uganda have identified IPR awareness as one of the key policy action points.[53] Limited awareness on matters of IPR may, in several ways, have negative effect on enforcement of intellectual property and cross border trade. For instance, it may affect the way cross-border agencies handle intellectual property infringing goods that are interchanged within the EAC borders; it may affect how intellectual property disputes are resolved by the judicial bodies within the EAC.[54] Furthermore, it may hinder seeing the necessity of harmonizing GIs laws in EAC from a strategic economic development angle, thus slowing down the adoption of a common regional approach.

7 | POLICY AND REGULATORY OPTIONS

The discussions in the previous sections have revealed that the protection regimes of GIs in Eastern Africa are still evolving and are in dire need of concerted regional harmonization initiatives. The following section suggests some of the possible approaches in addressing the current plight.

7.1 | Adoption of a harmonized regional model policy and law on GIs

One of the objectives of establishing the EAC was to facilitate free trade and general economic and social development within the Eastern Africa region. To achieve this objective, the EAC Treaty has highlighted the need for harmonization and approximation of, among others, national intellectual property policies and laws as one of the

key areas for immediate action to achieve the set regional objectives. The critical role of IPR in cross border trade emanates from the nature of rights created by intellectual property laws which are exclusive rights to sell, import, and export. These rights have a direct bearing on trade, in particular, cross border movement of goods and services.[55] Therefore, to properly regulate GIs within EAC it is advisable to adopt a model law from which national laws may be built on and which clearly delineate specific benchmarks of protection, the scope of protection and enforcement measures.[56] This proposal is feasible in view of the fact that at the regional level, as stated above, the establishing legal instruments of the EAC contains provisions that call for harmonization of the intellectual property laws. Also, at the continental level there are already initiatives for the harmonization and adoption of a model GIs law in Africa.[57] Furthermore, the agenda for developing a common continental approach on IPR protection and enforcement is already on the table under the framework of the Agreement establishing the African Continental Free Trade Area (AfCFTA) whereby there is a proposal for the adoption of specific protocol on IPR under the AfCFTA Agreement.[58]

7.2 | Establishing a centralized regional GIs registry

In the current regulatory set-up in EAC in which each country has its own GIs registry, and in view of the fact that similar geographical conditions cut across the borders, it is very likely that at some point there are may be similar geographical names/indications registered in more than one country.[59] Regarding this, a classic example is on certain geographical names such as Maasai Mara which cut across Kenya and Tanzania, with similar climatic conditions, cultural diversities, and geographical attributes. In such a case, Tanzania has its own interest in the region to use the name Maasai Mara and so is Kenya.[60] Thus, having a centralized GIs registry under the auspices of EAC would create a harmonious registration and regulatory system and may prevent possible trade disputes based on the ownership and right to use GIs registered in the Partner States to EAC, thereby enhancing compliance to the obligations under TRIPs Agreement and other attendant legal instruments administered on intellectual property and international trade.[61] To achieve such a regional objective, it is proffered in this paper that the adoption of the EAC regional model law on IPR from which national laws may be based would open up a requisite platform for creating a harmonized GIs legal framework within EAC. Such a model law should, among others, provided for a centralized registry for the future GIs registration and guidance on how the premodel law GIs should be dealt with by authorities in partner states, such as allowing concurrent use by legitimate proprietors subject to differentiation as to country of origin and the overall packaging. In turn, harmonized frameworks on GIs will created conducive condition for cross border trade and prevent potential legal disputes which may arise on the use of similar GIs by proprietors from different partner States.

7.3 | Extending the jurisdiction of the east African court of justice

A growing number of IPR related disputes within EAC with varying judicial interpretational path suggest a need for immediate regional action to harmonize intellectual property enforcement system. The absence of a common regional position on intellectual property protection, coupled with different verdicts delivered by the courts within the region creates uncertainties and arguably, may frustrate the intended objective of the EAC.[62] In addressing this legal and enforcement dilemma, it is proposed to vest the requisite "subject matter" jurisdiction over IPR in the East African Court of Justice (EACJ). Currently, the jurisdiction of EACJ is restricted to the interpretation of the Treaty provisions in case there is an alleged breach from a partner state.[63] In a proposed extended mandate of EACJ, provisions should be added to allow appeals or reference from superior national courts on matters relating to IPR disputes. The court should also be given power to provide interpretational guide in cases where there are conflicting court decisions within the EAC on the subject of IPR.

8 | CONCLUSION

The fundamental role and contribution of an effective GIs protection system cannot be overemphasized, particularly in the context of Africa as a whole, a continent which is bestowed with tremendous reservoir of natural resources and variety of climatic and geographic characteristics. Yet, this paper has revealed that there are significant disparities on the laws and regulatory framework on GIs within EAC. In view of the pertinent role that GIs can play in national economic development coupled with its potential effect on cross border trade, it is proffered that it is high time for EAC to embrace and implement the agenda of harmonization of IPR laws within the region. As revealed in the analysis, the foundations for making a breakthrough in the dialogues on the subject of intellectual property are already in place. In some partner states of EAC, such as Kenya, there is constitutional base for the protection of IPR which can serve as a crucial platform in formulating various national interventions including those on matters of GIs. The fact that the EAC regional legal instruments are insistent on the cooperation and harmonization of IPR system within the region is another important starting point in addressing the current shortfalls in the GIs protection within the region. More forcefully, at the continental level, the AU has initiated the process for creating a defined regime that may lead to the harmonization of IPR in Africa predicated on AfCFTA.

A preferred starting point for the partner states to EAC could be to begin with resolute domestic measures by adopting national intellectual property policies which are reflective on issues of GIs protection and the EAC IPR agenda.[64] Having a national policy base is important in setting a national position and direction in regional dialogues and negotiations for the harmonization of GIs protection systems within EAC.

Consequently, EAC stands to benefit by giving requisite attention to the protection of GIs by adopting a model law and a centralized regional GIs registry to achieve its underlying broader developmental objectives.

CONFLICT OF INTERESTS

The authors declare that there are no conflict of interests.

ENDNOTES

[1]Article 22 of the Agreement on Trade-Related Aspects of Intellectual Property Rights, Annex 1C to the Marrakesh Agreement Establishing the World Trade Organization, 1869 U.N.T.S. 299, 33 I.L.M. 1197, (1994), https://www.wto.org/english/docs_e/legal_e/27-trips_01_e.htm, accessed 14th February 2021.

[2]John, I, Lokina, R. and Egelyng, H., 'Small-Scale Producers of Quality Products with Potential of Geographical Indication Protection in Tanzania' [2020] 8(2) IJFAE 193.

[3]Kokthi, E and Kruja, D., 'Consumer Expectations for Geographical Origin: Eliciting Willingness to Pay (WTP) Using the Disconfirmation of Expectation Theory (EDT)" [2017] 23(8) JFPM 873.

[4]Gangjee, D., 'Geographical Indications and Cultural Rights: The Intangible Cultural Heritage Connection?' in CG Christophe (ed), *Research Handbook on Human Rights and Intellectual Property* (Edward Elgar 2015).

[5]African Union, 'Continental Strategy for Geographical Indications in Africa 2018-2023' (2018) <https://au.int/sites/default/files/documents/36127-doc-au_gis_continental_strategy_enng_with-cover-1.pdf> accessed 31 October 2020.

[6]Frankel, S., 'Geographical Indications and Mega-Regional Trade Agreements and Negotiations' in Calboli I. and Wee, L. N. W. (eds). *Geographical Indications at the Crossroads of Trade, Development and Culture: Focus on Asia Pacific* (Cambridge University Press 2017).

[7]John, I, Lokina, R. and Egelyng, H., 'Small-Scale Producers of Quality Products with Potential of Geographical Indication Protection in Tanzania' (2020) 8(2) IJFAE 193, 174; Chinedu, O, Manyise, T and Maruzzo, R., 'Protected Geographical Indications in Sub-Saharan Africa: Issues and Implications' (2017) 1(2) AJIP 79; Ramba, G. M., 'Policy Framework for Promoting GIs in Kenya—What The Law and The Policy Prescribe' Presented at a Training Workshop Organized by the World Intellectual Property Organization for a Branding Project Using Intellectual Property for the Taita Basket, held on 17th to 19th February 2016, Taveta-County, Kenya (2016) <https://www.wipo.int/edocs/mdocs/mdocs/en/wipo_ip_wk_nbo_16/wipo_ip_wk_nbo_16_t_2_b.pdf> accessed 21 December 2020.

[8]Article 103(1)(i) of the *Treaty for the Establishment of the East African Community, 1999* (As amended on 14th December 2006 and 20th August 2007) and Article 43 and 47 of the *Protocol on the Establishment of the East African Community*

Common Market, adopted in Arusha Tanzania in 2009 <https://www.eac.int/documents/category/key-documents> accessed 27 October 2020.

[9]See *World Trade Organization Report on Status on Harmonization of Trade Regimes in East Africa*, (2018) WT/TPR/S/38, para 19. <https://www.wto.org/english/tratop_e/tpr_e/s384_sum_e.pdf> accessed 21 February 2021; EAC, *East African Community (EAC) Regional Intellectual Property Policy on the Utilization of Public Health-Related WTO-TRIPS Flexibilities and the Approximation of National Intellectual Property Legislation, Arusha, East African Community*, (2013) <https://ipaccessmeds.southcentre.int/wp-content/uploads/2019/12/EACTRIPSPolicy.pdf> accessed 21 September 2020.

[10]Bramley, C., 'A Review of the Socio-Economic Impact of Geographical Indications: Considerations for the Developing World.' Presented at the WIPO Worldwide Symposium on Geographical Indications, Lima (22–25 November 2011) <http://193.5.93.81/edocs/mdocs/geoind/en/wipo_geo_lim_11/wipo_geo_lim_11_9.pdf> accessed 14 September 2020; Bramley, C, Marie-Vivien, D and Biénabe, E., 'Considerations in Designing an Appropriate Legal Framework for GIs in Southern Countries,' *Developing Geographical Indications in the South*. (Springer 2013).

[11]Kenya Association of Manufacturers (KAM), 'A Study on Intellectual Property Rights Regimes within the East African Community—Enhancing Regional Protection of IPR as a Key Driver to Industrialization,' Nairobi, KAM, 62. (2017) <https://issuu.com/kamkenya/docs/kam_ipr_report_final-2> accessed 13 September 2020.

[12]Bakibinga, D. J., and Kakungulu, R. M., *Intellectual Property Law in East Africa* (LawAfrica Publishing (U), (2016) 78.

[13]Section 25 of the *Geographical Indications Act (Uganda)*, Act No. 8 of 2013.

[14]Sihanya, B., 'Intellectual Property and Innovation Law in Kenya and Africa: Transferring Technology for Sustainable Development' Nairobi, Mentoring and Innovative Lawyering (2016) 406.

[15]Calboli, I., 'Of Markets, Culture and Terroir: The Unique Economic and Culture Related Benefits of Geographical Indications of Origin' in Gervais, D. (Ed). *International Intellectual Property: A Handbook of Contemporary Research* (Edward Elgar 2015); Gangjee, D., 'Geographical Indications and Cultural Rights: The Intangible Cultural Heritage Connection?' in Christophe, C. G. (ed), *Research Handbook on Human Rights and Intellectual Property* (Edward Elgar 2015).

[16]Blakeney, M., 'Geographical Indications: What Do They Indicate?' (2014) 6(50) WIPOJ 53.

[17]Frankel, S., 'Some Consequences of Misinterpreting the TRIPs Agreement' (2009) 1(35–42) WIPOJ, 35.

[18]Blakeney, M., 'Geographical Indications: What Do They Indicate?' (2014) 6(50) WIPOJ 53.

[19]Raustiala, K and Munzer, S., 'The Global Struggle over Geographical Indications' (2007) 18 EJIL 337, 344; Zahur, M., 'An Old Issue of Protecting GIs for Culture: A New Insight from the Experience of India and Bangladesh,' (2017) 43(2) CLB 179, 187.

[20]Agostino, M., and Trivieri, F., 'Geographical Indication and Wine Exports. An Empirical Investigation Considering the Major European Producers' (2014) 46 FP 22, 23.

[21]Gangjee, D., *Relocating the Law of Geographical Indications* (Cambridge University Press 2012) 179.

[22]See the *Industrial Property Law*, Law No 1/13 of Burundi <http://wipolex.wipo.int/en/legislation/details/8324> accessed 13 January 2021.

[23]Article 40 (5) of the Constitution of Kenya, 27th August 2010, Nairobi, Republic of Kenya.

[24]Sihanya, B., 'Intellectual Property and Innovation Law in Kenya and Africa: Transferring Technology for Sustainable Development' Nairobi, Mentoring and Innovative Lawyering (2016) 406, 412; Kameri-Mbote, P., *Intellectual Property Protection in Africa: An Assessment of the Status of Laws, Research and Policy Analysis on Intellectual Property Rights in Kenya*, (International Environmental Law Research Centre (IELRC) Working Paper (2005) p. 21 <http://ielrc.org/Content/w0502.pdf> accessed 21 October 2020.

[25]Section 40(1) of Trade *Marks Act (Kenya), Cap 506*; see also Ramba, G. M., 'Policy Framework for Promoting GIs in Kenya—What The Law and The Policy Prescribe' Presented at a Training Workshop Organized by the World Intellectual Property Organization for a Branding Project Using Intellectual Property for the Taita Basket, held on 17th to 19th February 2016, Taveta-County, Kenya (2016) Note 6 <https://www.wipo.int/edocs/mdocs/mdocs/en/wipo_ip_wk_nbo_16/wipo_ip_wk_nbo_16_t_2_b.pdf> accessed 21 December 2020.

[26]Gangjee D., *Relocating the Law of Geographical Indications* (Cambridge University Press 2012) 179.

[27]See *Agricultural and Processed Food Products Export Development Authority (APEDA) v Krish Commodities Limited, Civil Appeal No. 338 of 2013* (The High Court of Kenya).

[28]INTA, 2018. *International Trademark Association (INTA), Comments on the Kenya Draft Bill on Geographical Indications* <https://www.inta.org/wp-content/uploads/public-files/advocacy/testimony-submissions/COMMENTS-ON-THE-KENYA-DRAFT-BILL-GI-April-2018.pdf>, accessed 14 October 2020.

[29]Kenya, (2020). *Intellectual Property Bill of 2020*, available at the website of the Kenya Industrial Property Institute (KIPI) <http://www.kipi.go.ke/images/docs/IPOK%20Bill%202020.pdf> accessed 14 October 2020.

[30]Sihanya, B., 'Intellectual Property and Innovation Law in Kenya and Africa: Transferring Technology for Sustainable Development' Nairobi, Mentoring and Innovative Lawyering (2016) 406, 412.

[31]See *Law on the Protection of Intellectual Property (Rwanda)*, Law No. 31/2009 of 26/10/2009.

[32]United Nations, (2011). *UN Security Council Resolution 1996 (2011)*, adopted by the United Nations Security Council at its 6576th meeting on 8 July 2011. <https://peacekeeping.un.org/sites/default/files/past/unmis/documents/sres1996_2011.pdf> accessed on 30 December 2020.

[33]Kenya Association of Manufacturers, 'A Study on Intellectual Property Rights Regimes within the East African Community—Enhancing Regional Protection of IPR as a Key Driver to Industrialization,' Nairobi, KAM, 45. (2017) <https://issuu.com/kamkenya/docs/kam_ipr_report_final-2> accessed 13 September 2020.

[34]Law No. 8 of 1969 <https://wipolex.wipo.int/en/legislation/details/11283> accessed 28 December 2020.

[35]Nzwili, F., 'As South Sudan Joins East African Community, Some Experts Worry over Its IP Laws,' *IP Watch* (2016) <https://www.ip-watch.org/2016/03/08/as-south-sudan-joins-east-african-community-some-experts-worry-over-its-ip-laws/> accessed 26 October 2020.

[36]Chetty, N., and Pillay, U., *Trade Mark Reservation in South Sudan* (2012) <https://www.adams.africa/intellectual-property/south-sudan-tm-reservation-possible-now/> accessed 24 November 2020.

[37]See *Union of Tanganyika and Zanzibar Act*, Chapter 557 [R.E. 2002] of the Laws of Tanzania].

[38]Mwakaje, S. J., 'Accession by Tanzania to the Marrakesh Treaty on Access to Publications for Visually Impaired Persons: Policy and Legal Implications' (2021) 48 TAR, 215, 224. DOI:10.1163/1821889X-12340033

[39]John, I., Lokina, R. and Egelyng, H., 'Small-Scale Producers of Quality Products with Potential of Geographical Indication Protection in Tanzania' (2020) 8(2) IJFAE 193, 194.

[40]Chapter 326 [R.E. 2002] of the Laws of Tanzania.

[41]Act No. 4 of 2008; see also John, I., 'The Potential of Marketing Zanzibar Cloves with Geographical Indication Labeling' [2017] 2(1) TAJIP 71.

[42]John, I., Lokina, R. and Egelyng, H., 'Small-Scale Producers of Quality Products with Potential of Geographical Indication Protection in Tanzania' (2020) 8(2) IJFAE 193, 194.

[43]*The Geographical Indications Act (Uganda)*, Act No. 8 of 2013.

[44]Bakibinga, D. J., and Kakungulu, R.M., *Intellectual Property Law in East Africa* (2nd Edition, LawAfrica Publishing (U) 2020).

[45]See the *National Intellectual Property Policy of 2013 (Uganda)* <https://ursb.go.ug/wp-content/uploads/2019/09/National-IP-Policy-Uganda-May-2019.pdf> accessed 17 January 2021.

[46]Gangjee, D., 'Trade Marks and Allied Rights' in Dreyfuss, R and Pila, J., eds., *The Oxford Handbook of Intellectual Property Law* (Oxford University Press 2018).

[47]Bakibinga, D. J., and Kakungulu, R. M., Intellectual Property Law in East Africa (LawAfrica Publishing (U), (2016) 78, Note 43.

[48]Civil Appeal No 13 of 2015, High Court of Uganda.

[49]Kisuule, Y., 'Least Developed Countries and Geographical Indications: How can Uganda Position itself to Benefit from Geographical Indications?' Master of Laws (LL. M) Dissertation (University of Cape Town 2015).

[50]Case No. RCOMA 00276/2016/CHC/HCC (High Court of Rwanda) <https://www.judiciary.gov.rw/index.php?id=23&subcat=2365> accessed 13 January 2021.

[51]Civil Appeal No 13 of 2015, High Court of Uganda.

[52]See the *National Policy on Intellectual Property Rights in Rwanda* <https://www.wipo.int/edocs/lexdocs/laws/en/rw/rw003en.pdf> accessed 17 December 2020; *National Intellectual Property Policy of Uganda* <https://ursb.go.ug/wp-content/uploads/2019/09/National-IP-Policy-Uganda-May-2019.pdf> accessed 17 January 2021.

[53]Section 2(5)(3) of the *National Intellectual Property Policy* of Uganda.

[54]Kakooza, A. C.K., 'Can "The Is" and "The Ought" be Married? Creating a Sustainable Legal Framework for Intangible Property in the East African Community' (2018) 45(2) TAR 1, 14.

[55]Addor, F, Thumm, N and Grazioli, A., 'Geographical Indications: Important Issues for Industrialized and Developing Countries' The IPTS (Institute for Prospective Technological) (2003).

[56]Chabrol, D, Mariani, M and Sautier, D., 'Establishing Geographical Indications without State Involvement? Learning from Case Studies in Central and West Africa' [2015] 98 WD 68 <https://doi.org/10.1016/j.worlddev.2015.11.023> accessed 16 November 2020.

[57]African Union, 'Continental Strategy for Geographical Indications in Africa 2018-2023' (2018) Note. 4 <https://au.int/sites/default/files/documents/36127-doc-au_gis_continental_strategy_enng_with-cover-1.pdf> accessed 31 October 2020.

[58]Du Plessis, A., 'The Proposed AfCFTA Protocol on Intellectual Property Rights' (2019) <https://www.tralac.org/blog/article/14066-the-proposed-afcfta-protocol-on-intellectual-property-rights.html> accessed 20th January 2021.

[59]Marrie-Vivien, D., and Bienabe, E., 'Multifaceted Role of State in the Protection of Geographical Indications: A Worldwide Review' [2017] 10 WD 3.

[60]Panzone, L., Di Vita, G., Borla, S., and D' Amico, M., 'When Consumers and Products Come from the Same Place: Preferences and WTP for Geographical Indication Differ across Regional Identity Groups' (2016) 28(3) JIFAM 313, 287.

[61]WTO, 'Doha WTO Ministerial 2001: Ministerial Declaration, WT/MIN (01)/DEC/' (2001) <https://www.wto.org/english/thewto_e/minist_e/min01_e/mindecl_e.htm#trips> accessed 13 December 2020.

[62] Lemley, M., 'The Regulatory Turn in Intellectual Property' (2012) 36(1) HJLPP 109.

[63]Article 27 of the *Treaty for the Establishment of the East African Community* (As amended on 14th December 2006 and 20th August 2007).

[64]Mwakaje, S. J., 'Fair Use under Copyright Law: Theoretical Basis and Enforcement Approaches in Selected East Africa States' (2018) 45 (2) EALR 1, 32.

How to cite this article: Mwakaje, S. J. (2022). Protection of geographical indications and cross-border trade: A survey of legal and regulatory frameworks in East Africa. *The Journal of World Intellectual Property*, 25, 31–44. https://doi.org/10.1111/jwip.12204