

DIGITAL TRADEMARKS: THE GLOBAL LEGAL REGIME AND INEFFECTIVE TANZANIAN LEGISLATIONS¹

By Innocent P. Kibadu²

Abstract

When digital trademark law had yet to be enacted, infringements of digital trademarks are subjected to traditional trade and service marks and cybercrimes laws. This approach results in considerable conflict. The conflict paves the way for the consensus appealing for legislators to intervene and enact specific digital trade and service marks legislation suiting to confront the online digital trademarks infringement. Many countries in the world responded by enacting new provisions of laws covering digital trademarks and many others are on their way to take similar legislative steps, while others are still reluctant.

The article highlights and addresses the legal concern developing digital trademarks provisions. On the bases of law, the article argues that the penetration of internet and its use in Tanzania requires effective measures to ensure legal framework is inevitable at national level through enactment or amendment of existing laws.

Key words: *Digital Trademark, Confusion, Dilution, Cyber-squatting, Domain names, Trademark Impersonation*

1.0 Introduction

Protection of intellectual property rights in developing global and competitive economy is of paramount importance, taking into account of fast developments in e-commerce. Digital technology brought a number of challenges in intellectual property rights. Other scholars comment on developing digital technology that:

it has become a place to do all sort of activities which are prohibited by the law. The emergence of the Internet as a tool for e-communication and e-commerce has resulted in a complex intellectual property issues.³

In this era of evolution in technology, trademarks are at risk of being infringed perpendicularly with the mushrooming penetration in global Internet usage. This situation other way round risks and give opportunity to the trademarks infringers to infringe them at distance without being depicted. Yet an international legal framework to protect digital trademarks does not exist.⁴ It is pertinent to note that

¹This article was originally presented in a class as a long paper being part of an academic work. The author thanks the lecturer and his fellow students for their invaluable comments and suggestions led to the writing of this article.

²The author of this article is an Assistant Lecturer in Law at Tumaini University Makumira - Mbeya Centre. He holds LL.M-ICTLAW, LL.B.

³ P. Mayuri and S. Saha, 'Trademark Issues in Digital Era', *Journal of Intellectual Property Rights* 13 (2008), at 118.

⁴ A. Mazza, 'Protecting Trademarks on the Internet', *Focus on Intellectual Property Rights*,(2006), at 86.

intellectual property rights are territorial in nature.⁵ Since the designer or owner of a trademark acquires exclusive rights over the created trademark, that, it is in this regard, digital trademarks attract its protection parallel to the traditional trademarks.⁶ This is because Intellectual Property Rights commonly serve as legal devices to promote innovative and creative work in the society.⁷

The main argument of this article centers on the immediate concern of developing trademark laws which addresses protection of digital trademarks. It further looks at the global and national (Tanzanian) legal regimes to address digital trademarks protection and its remedies available. It also reveals the absence of international legal regime and inability of national laws to address the challenges posed by internet use has led to infringements of digital trademarks. It is advocated that Tanzania should amend its trademarks law to include protection of digital trademarks, as opposed to available traditional trade and service marks law and cybercrimes law. A balanced approach that considers the protection of digital trademarks and the need for effective safeguard of rights holders has been mooted. International co-operation between countries is also required to address the global nature of digital trademarks.

1.1 Digital Trademark: An overview

There is no direct or universal definition of digital trademark. However, in order to grasp the meaning of digital trademarks, first it is imperative to understand the meaning of trademark. Different scholars have defined the term trademark but the concern of this article is the element of distinctiveness of a mark. It follows that trademark simply refers to a distinctive sign distinguishing one good from another good.⁸ Another on the other hand, define trademark as a mark used in relation to goods or services so as to indicate a connection in the course of trade between the goods and some person having a right to use the mark.⁹ Trademark serves as a link between the manufacturer or service provider and the customer.¹⁰ Therefore, it is evident that the crucial element of a trademark is its distinctiveness nature which distinguishes one good or services from another trademark of the other.

Trademarks can take the form of a mark, word or phrase and color,¹¹ but for colours, it is ideal to have a combination of colour and not a single colour so as to be

⁵ A. Mambi, *ICT Law Book: A Source Book for Information and Communication Technology and Cyber Law*, (Dar -es- Salaam; Mkukina Nyota, 2010), at 198.

⁶ Traditional trademark refers to offline trademarks as opposed to digital trademarks.

⁷ J. Liegsalz, *The Economics of Intellectual Property Rights in China: Patents, Trade, and Foreign Direct Investment*, (GablerVerlag, 2010), at 10.

⁸ *Ibid*, at 239.

⁹ K. Abbott, *et al*, *Business Law*, 8thedn. (United Kingdom; TJ International, 2007), at 315; *See also*, P. J. Groves, *Sourcebook on Intellectual Property Law*, (London; Cavendish Publishing Limited, 1997), at 511; *see also*, J. S. McKeown, *Canadian Intellectual Property Law and Strategy: Trademarks, Copyright, and Industrial Designs*, (New York; Oxford University Press, 2010), at 12.

¹⁰ F. W. Mostert, and L. E. Apolzon, *From Edison to iPod – Protect Your Ideas and Make Money*, (United States; DK Publishing, Inc., 2007), at 51.

¹¹ Consider Red colour for Vodacom, White and Blue for Tigo, Green for Zantel.

distinctive and attractive. However, currently, there is a debate on invisible (conversional) marks such as smell and sound marks¹² to be considered as trademarks.

On the other hand, the Agreement on Trade-Related Intellectual Property (TRIPS) defined trademark in a broad sense so as to provide a wider meaning referring to as any sign, or combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, to constitute a trademark. The Agreement identifies the signs referred as words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs as eligible for trademark registration. And where the signs cannot distinguish one good to another its registrability should depend on distinctiveness acquired through its uses. However, the Agreement set forth an option to member states to place a condition for registration of trademark to be visible.¹³ *i.e* visually they can be seen. The Tanzanian statute further define trademark *verbatim* as:

any visible sign used or proposed to be used upon, in connection with or in relation to goods or services for the purpose of distinguishing in the course of trade or business the goods or services of a person from those of another.¹⁴

Therefore, though there is no clear and universal definition of digital trademark, it has been associated with innovations and the use of computer technologies in its applications in the rapid communications, social and economic development.¹⁵ The term digital denotes electronic technology that generates, stores, and processes data into two states, namely; positive and non-positive state. Positive state is expressed or represented by the number 1 and non-positive state by number 0 (bits).¹⁶ It means that, digital trademark is merged with technological advancement of using trademarks in an electronic format or technology in making distinctive marks or services for marketing in e-commerce and e-business.

1.2 Global Protection of Digital Trademarks

As noted above that digital technology brought complex challenges in e-economy particularly in the aspect of intellectual property rights, trademarks specifically requires protection in the present digital era in as much as the traditional platform. Basically, trademarks serve two major purposes namely; consumer protection and

¹² Trademarks Law Treaty of 1994 Article 2, excluding sound and holograms marks and invisible marks such as sound marks and olfactory marks.

¹³ The TRIPS Agreement (1994), Article 15 (1).

¹⁴ Trade and Service Mark Act [R: E 2002], section 2; *See also*, S.Wangwe, *et al.* "Case Study on Institutional Capacity in Intellectual Property Policy, Administration And Enforcement - The Case of Tanzania", Dar-es-Salaam; Economic and Social Research Foundation, at 14.

¹⁵ World Intellectual Property Organization, *Intellectual Property Handbook*, 2ndedn., (WIPO Publication, 2008), at 456

¹⁶ <http://whatis.techtarget.com/definition/digital>(accessed on 14 March 2015)

protecting trademark holders from competitors' free riding.¹⁷ Protection of digital trademark can be ensured through the available instruments such as TRIPS Agreement,¹⁸ Berne Convention, Paris Convention,¹⁹ Trademarks Law Treaty,²⁰ Treaties at International, Regional and National laws²¹ level by broadening its interpretation to include digital trademarks. On the other hand, common law can play an important persuasive role in protecting digital trademarks. The emergence of internet posed challenges to trademarks owners²² in the ever growing competitive global e-business and e-commerce. It is in this context the WIPO - Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications avers that:

Issues of intellectual property protection regarding the material available on the Internet are just as important as issues regarding the use of trademarks as vectors of consumer preference in a global marketplace.²³

1.3 Protection of digital trademarks: Tanzania's position

Digital trademark is gaining momentum as e-business and e-commerce are deepening its roots in Tanzania. The developments and growth of e-commerce necessitates creation of digital trademarks in passing, spreading information and advertisements to the general public at large to solicit customers. However, digitised trademarks are not God creatures that they are free from infringements. They are vulnerable to infringement by other person maliciously for gain.

Trademarks under digital age in Tanzania are recognised and protected recently in the newly enacted law relating to cybercrimes. Though its protection is too general and enclosed under the intellectual property rights, yet it provides protection to the trademarks owner. The law defines intellectual property rights among other things to include the rights accrued or related to trade mark and any other related matters.²⁴ The law further criminalizes any person who uses a computer system to infringe digital trademark for both commercial and non-commercial uses.²⁵ The criminalizing provision deserves to be reproduced *ex tenso* hereunder:

¹⁷E. Bakken. "Unauthorized Use of Another's Trademark on the Internet," 2002, at 2, <http://www.lawtechjournal.com> (accessed on 14 March 2015).

¹⁸ Agreement on Trade-Related Aspects of Intellectual Property Rights, 1994

¹⁹ Paris Convention for the Protection of Industrial Property, 1883

²⁰27, October 1994.

²¹ Trade and Service Marks Act [R:E 2002] and The Cybercrimes Act, No. 14 of 2015

²² World Intellectual Property Organisation, *Op cit*, at 455.

²³ World Intellectual Property Organisation, Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications: *Trademarks and the Internet*, (SCT/24/4, 2010), at p 2.

²⁴The Cybercrimes Act, No 14 of 2016, section 3.

²⁵*Ibid*, section 24.

A person shall not use a computer system with intent to violate intellectual property rights protected under any written law.²⁶

It should be noted that however, the new cybercrimes law is furthering the benchmark role of the intellectual property law in regulating the creation, use and exploitation of mental or creative labour works which are connected to development of information technology.²⁷ Notice that Tanzania is radically witnessing huge developments in information technologies relating to intellectual property rights. These developments affect the legal rights of the online trademark owner. Therefore, it is undisputed fact the new cybercrimes law is timely set into motion to protect digital trademarks in our country. However, despite the enactment of the provision protecting intellectual property rights, Tanzania needs to revisit its trade and service marks law to suit the new developing technologies specifically.

2.0 Infringement of digital trademarks

Intellectual property rights in the digital era are subject to infringements. This can be termed as stealing of intellectual property rights.²⁸ However, it should be noted that the sale of trademarks as keywords for internet advertising is regarded as a commercial use even though neither the seller nor the buyer is using the marks to sell the goods for which the trademarks are protected.²⁹ In the circumstances as such, the commercial use of trademarks on the internet accounts to digital infringement of trademarks. Therefore, digital trademarks infringement can synonymously be committed online in as much as offline through similar ways like those committed under traditional ways. The most common ways of digital trademarks infringement are as discussed hereunder.

2.1 Likelihood of Confusion

The trademark owner cannot bring an action for trademark infringement if he cannot show that there is likelihood confusion which exists between the two marks.³⁰ The mark is said to be infringing the existing trademark if there is likelihood confusion between the already existing and registered digital trademarks; or in a prior-filed pending application owned by another party. In such a case, the applicant's mark and the existing mark are similar, or goods of the parties are closely related to the extent that consumers would mistakenly believe that the goods come from the same producer. However, the similarity or relation of goods does not

²⁶ *Ibid*, section 24(1).

²⁷ A. Mambi, *Op cit.* at 226.

²⁸ D. E. Comer, *Computer Networks and Internets*, 5thedn. (Pearson Prentice Hall, 2009), at 509

²⁹ R. C. Dreyfuss, "Reconciling trademark rights and expressive values: how to stop worrying and learn to love ambiguity," in G. Dinwoodie and M. D. Janis (eds), *Trademark Law and Theory: A Handbook of Contemporary Research*. (UK; Edward Elgar Publishing Limited, 2008), at 272-273.

³⁰ M. Patel and S. Saha, *Op. cit.* at 120.

conclusively determine the likelihood confusion until the court so determines after being affirmatively satisfied that the mark is a famous one.³¹

Generally, two identical marks can exist side by side, provided that the goods are not related in terms of geographical area or its uses. For instance, “Apple” for iPhone and computer brand; and on the other hand “Apple” for fruits juice owned by another company. The best test to determine if there is likelihood confusion of a trade mark is through applying a competitors’ unauthorized use of trademarks test.³² Infact, the plaintiff alleging infringement must show that the marks likely mislead or confuses the ordinary purchaser of his or her products. This position was reiterated in the case of *Mobil Oil Corp. v. Pegasus Petroleum Corp.*,³³ where the court held that: a successful plaintiff must show a ‘likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question.’³⁴

In another common law case, conditions for prevention of third party use of a sign were established in the judgment. It was a persuasive judgment that for the proprietor of a registered mark to prevent the use of a sign by a third party which is identical of his mark, four conditions must be met with, namely; (1)that use must be in the course of trade;(2)it must be without the consent of the proprietor of the mark;(3) it must be in respect of goods or services which are identical to those for which the mark is registered, and (4) it must affect or be liable to affect the functions of the trademark, in particular, its essential function of guaranteeing to consumers the origin of the goods or services.³⁵ In the foregoing, the four criteria or conditions to prove infringement of a trademark are sufficiently to establish a *prima facie* case by the plaintiff. Indeed, these conditions can be applied in the digital and traditional trademark infringement *mutatis mutandis*.

Likelihood confusion can also be committed on the internet (digital) especially in meta tags.³⁶ This was reiterated in the case of *Playboy Enter., Inc. v Asiafocos International Inc.*,³⁷ where the court found that the use of phrase ‘playmate’ and ‘playboy’ in the universal resource locator (URL), in the text itself and in metatags caused a strong likelihood that the consuming public would believe that the defendants' website was sponsored by or somehow affiliated with PEI, given (1) the strength of PEI's trademarks ‘PLAYBOY’ and ‘PLAYMATE’; (2) the defendants' unauthorized use of the identical marks ‘PLAYBOY’ and ‘PLAYMATE’; (3) the similarity of the goods and services offered by PEI and the defendants; (4) the

³¹ United States Patent and Trademarks Office, *Protecting Your Trademark Enhancing your Rights through Federal Registration: Basic Facts about Trademarks*, at 2.

³² E. Bakken. *Op. cit*, at 4.

³³ 818 F.2d 254 (2d Cir. 1987).

³⁴ E. Bakken. *Op. cit*, at 9.

³⁵ *Céline Sarl v. Céline Sa*, ECJ, 11 September 2007, C-17/06, ECR 2007, I-7041 in p.86

³⁶ This is a coding statement in the Hypertext Markup Language (HTML) that describes some aspects of the content of the webpage; see also, A. Mambi, *Op. cit*, at 240.

³⁷ 1998 U.S. Dist. LEXIS 10359 (E.D. Va. 1998).

evidence of actual confusion; and (5) that the Internet is the exact marketing channel used by both PEI and the defendants. In the event the defendant was held liable for infringement of the trademark online.³⁸

2.2 Similar Confusion

Another instance of trademark infringement underlies on similar confusion of trademarks. This is part and parcel of likelihood confusion. Normally, to establish that there is likelihood confusion one must look into the similarities and differences of the marks in question.³⁹It is shown into two cases as quoted by Michael S. Melfi, and Kulwant Singh Boora, in their article. In the first case of *Brookfield v. W. Coast*,⁴⁰ the court pointed out that, 'the similarity of the marks will always be an important factor.' And in the second case of *Re West Point-Pepperell Inc.*,⁴¹ the court pointed out that, 'similarity of the marks is a hallmark of consumer confusion.'

However, the similarities can be identified phonetically through sounds if they sound alike though they are spelled differently (*Consider Mike T* and *Mic Tee* marks). On the other hand, similarity can be identified physically through visualization resulting to similar translation of the marks in question and cause the public minds to perceive the two marks in the same commercial impression (*Consider, Mike T* and *Mike T marks*). Therefore, if both sound and visual plus meaning are established in affirmative to related goods, then the test for similar confusion is established in affirmative too. That the second mark confuses the public minds by interpreting the two marks commercially. It should be taken into account that however, "in comparing the marks, similarity in any one of the elements of sound, appearance or meaning may be sufficient to find a likelihood of confusion."⁴²Therefore, infringement of the mark is established against the defendant to whom it entitles the plaintiff to receive remedies.

2.3 Trademark Dilution

This is another form of trademark infringement that may be committed under digital age. Dilution may be defined as the 'lessening of the capacity of a famous mark to identify and distinguish goods and services.'⁴³Therefore, for a trademark holder to claim that his or her trademark has been diluted by another person, he or she must sufficiently satisfy the determining authority that his trademark is famous one against the infringing trademark. However, it should be noted that a mark is regarded as famous if it is sufficiently satisfied that it is widely recognized by the general consuming public of a particular locality as a designation of source of the

³⁸ E. Bakken. *Op. cit*, at 8.

³⁹ A. M. Cotter (ed.). *Intellectual Property Law*. (Cavendish Publishing Limited, 2003), at 10

⁴⁰174 F.3d 1036, 1054, 50 U.S.P.Q.2d 1545 (9th Cir. 1999).

⁴¹468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A.1972).

⁴² M. S. Melfi, and K. S. Boora, "Basic Trademark Infringement and Likelihood of Confusion," 2012: <http://www.melfiassociates.com> (accessed 14 March 2015).

⁴³*Supra fn.* 18.

goods or services of the mark's owner.⁴⁴In fact the purpose of dilution is to protect the 'whittling away of the value of a trademark' and a weakening of its commercial magnetism.⁴⁵ It is wise to seek permission for the use of the trademark from the trademark owner under agreed and available legal platforms such as licensing of trademarks.

Basing on the legal authorities from the United States of America, dilution may take two forms, namely; blurring and tarnishment form. The former refers to as an association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.⁴⁶ That the alleged infringing trademark is too associated with the famous mark, to the extent that it impairs its distinctive appearance of the original mark in the eyes of the consumers. While the later, refers to as an association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.⁴⁷ Here the infringing mark is too similar to the famous mark to the extent that the reputation of the famous mark is at jeopardy to the public consumers of the same. That, in both instances, the holder of a famous trademark is entitled to claim judicial protection as against the holder of junior infringing trademark in the commercial marketplace.

2.4 Impersonations of trademarks on social networks

In recent years online social networks became very popular gaining a remarkable rise as a significant and immense communication forum for professionals, politicians and businessmen or commercial purposes. Earmarking on the commercial discourse such as websites, trademark rights owners and its implications under trademark laws is of vital importance to address them, since trademarks are used to promote goods and services on social networks. That business competitor may impersonate the trademark on social network sites by posting false statements and identity. The social network users may solely believe and rely on the imposter. If goods or services promoted on the page are falsely represented to come from the mark holder, customers may mistakenly purchase another company's products, which may be of lower quality. If the imposter posts false or misleading information about the company or its products, this can harm the mark holder and the public if stock prices drop; or if individuals or entities forgo future purchases, employment, partnerships; or other interaction with the company due to the untruthful information.⁴⁸ However, some social networks⁴⁹ attempts to restrict impersonations of others and posting of content which violate the law, including trademark laws.

⁴⁴The *Trademark Dilution Revision Act of 2006*, section 2 (A) of the United States of America.

⁴⁵R. C. Dreyfuss, *Op. Cit*, at 277.

⁴⁶*Ibid*, section 2(B).

⁴⁷*Ibid*, section 2(C).

⁴⁸R. C. Dreyfuss, *Op. cit*, at p. 865.

⁴⁹Facebook, Twitter and MySpace.

Mark holders on the other hand, are permitted to file a complaint by the site. Where it is found by the sites that the complaints are valid, the sites may remove or ask the user to remove the infringing contents, and in addition may suspend or even terminate the account of the user. These private notice-and-takedown procedures for resolving trademark disputes are usually quicker and less expensive than trademark litigation. They further help social network sites owners avoid allegations of contributory infringement.⁵⁰ Indeed, the prevailing problem under digital trademark is not categorically clear as to whether and how trademark law applies to certain unauthorized uses of marks on social network sites. Despite the fact that, mark holders may file a lawsuit against social network sites and their users, but, still existence of a statutory law which directly covers issues of infringement under social networks is of paramount importance. In *La Russa v Twitter Inc.*,⁵¹ where the plaintiff was a manager of baseball teams in the United States. An anonymous user created a Twitter account in the plaintiff's name, impersonated him and posted inappropriate comments on the deaths of two of his team's pitchers. The plaintiff claimed, *inter alia*, that Twitter had committed trademark infringement. But in order to succeed on this claim, it would be necessary for Plaintiff to prove that the false account was likely to confuse consumers into thinking he endorsed Twitter. Plaintiff sought to support this claim by alleging that his photo was used in conjunction with the phrases '*Tony La Russa is using Twitter*' and '*Join today to start receiving Tony La Russa's updates*'. However, the plaintiff voluntarily dismissed his claim shortly after filing.

Also in another case of *OneokInc v Twitter Inc*,⁵² a natural gas distributor brought a lawsuit against Twitter for allowing a third party to adopt its trademark ONEOK as a username. The complaint alleged that messages posted by the user were misleading insofar as consumers would believe that they were official statements of the company. This lawsuit was voluntarily dismissed shortly after filing and the Twitter account in question was transferred to the plaintiff. Although in both cases there is no judicial authority as to liabilities of Twitter but the two cases are of vital illustrative of the potential risks to the trademark owners that they may face through the use of social networks. Therefore, protection of trademark on social networks is imperative taking into account of the rapid technological development on the use of internet especially social networks in the global industry of e-commerce and e-business.

2.5 Cyber Squatting

As pointed out earlier that the development in technology especially the use of internet brought challenges in protecting intellectual property rights. In his article

⁵⁰R. C. Dreyfuss, at 867-868.

⁵¹ Case No. CV-09-2503 (N.D.C.A. June 5, 2009). *World Intellectual Property Organisation, Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications: Trademarks and the Internet*, (SCT/24/4; Twenty-Fourth Session, Geneva, 2010), p 17.

⁵²*Ibid*, case No. 4:09-cv-00597 (N.D.O.K. Sep 15, 2009).

Goldman stresses that, “trademark law is wrestling with cyber squatting / domainers.”⁵³ Cyber squatting is when a person goes out to register a domain name which is similar or identical to that of another’s registered trademark, and thereby attempting to sell the domain name to the right holder and figuratively holds the domain names captive until the trademark owners pay ransom amount.⁵⁴ This was witnessed in the case of *Panavision International LP v Toeppan*⁵⁵ as quoted by Mayuri Patel, where the court held that the defendant’s act of registering more than two hundred and forty trademarks as domain names and then later offered them for sell to their rightful owner for sums ranging between \$10, 000 and \$ 15,000, acted as ‘spoiler’ preventing the plaintiff and others from doing business on the Internet under their trademarked names unless they pay his fees and hence, diluted the plaintiff’s registered trademark. However, the cause of actions in this aspect lies into three discourses namely; likelihood confusion (traditional trademark infringement), dilution doctrine and prevention of cyber squatting.⁵⁶

As technology advances, many business owners and their companies are doing their business internationally via internet. These requires registration of their company’s domain name to be registered⁵⁷ as a trade or service mark to obtain protection and be secure both offline and online.⁵⁸ A good example is a major *America On-Line (AOL)*, an internet service provider (ISP). AOL attempted to register as an official trademark a number of its symbols, including the expressions: “*You’ve Got Mail*,” “*Buddy List*,” and “*IM*” (for instant messenger). If the registration of these trademarks could have been granted, then other ISPs who wish to use these expressions could be charged with infringing on AOL’s registered trademarks. The AT&T challenged AOL. However, the court decided that the expressions in question were not unique to AOL, therefore could not qualify for registration as trademarks.⁵⁹ This is a result of the technological development in information technology which in turn led to e-commerce industrial sector and other e-activities. Significantly, “internet domain names are very useful tools for online business transactions.”⁶⁰ Rochelle Cooper Dreyfuss *verbatim* argues that:

Trademarks have also taken on a wholly new role: on the Internet, they are navigation tools, used by consumers to find merchants and by merchants to find consumers. Some shoppers look for goods on the Internet by using the trademark as a domain name. If they enter it correctly, they will likely find the trademark holder’s website, but they

⁵³ E. Goldman, “Online word of mouth and its implications for trademark law,” in G. Dinwoodie and M. D. Janis (eds), *Trademark Law and Theory: A Handbook of Contemporary Research*, (UK; Edward Elgar Publishing Limited, 2008), p. 404.

⁵⁴ M. Patel and S. Saha, *Op cit*, p. 120.

⁵⁵ 141 F 1316 (9th Cir. 1998); See also, A. Mambi, *Op. cit.*, p. 267-268.

⁵⁶ M. Patel and S. Saha, *Op. cit.*, p. 119.

⁵⁷ The registered domain name must be unique to avoid disputes.

⁵⁸ A. Mambi, *Op. cit.*, p. 240.

⁵⁹ R. A. Spinello and H. T. Tavani, “Intellectual Property Rights: From Theory to Practical Implementation,” in *Intellectual Property Rights in a Networked World: Theory and Practice*, eds. R. A. Spinello and H. T. Tavani (Information Science Publishing, 2005), p. 30.

⁶⁰ A. Mambi, *Op. cit.* p. 259.

may also discover that the same mark is used by merchants in remote locations, or incorporated into several Internet addresses.⁶¹

It follows that, the existence of e-activities had blocked down the territorial limits which existed before especially in trademarks as intellectual property. This has increased the risks of trademarks infringement online in the digital age. Alternatively, to avoid confusion and other forms of digital trademark infringement domain names must be unique and registered.

Although registration of domain name⁶² in certain instance involves the trademark of the company like “startv” or “acer” and adding the top level domain (TLD) such as “.com” designate to “startv.com,” or “acer.com” respectively, etc. then the top level domain “.com” indicates that the domain name owner is a commercial enterprise. Whereas “startv” and “acer” is the second level domain name which identifies the source of goods or services.⁶³Therefore, if another person registers a domain name bearing another’s trademark he can be held liable for trademark infringement. Some companies invested in this kind of trademark have suffered as it is evident into two cases.⁶⁴ In the first case of *Intermatic v Toeppen*,⁶⁵ where the plaintiff was the owner of the well - known trademark ‘intermatic’, which was used in variety of electronic products. Although, the defendant registered the domain name ‘intermatic.com’, he did not offer any goods or services on his site. The plaintiff sued the defendant alleging dilution of its trademark. The District court held that the defendant’s act has diluted Plaintiff’s mark by decreasing the owner’s ability to identify and distinguish its goods on the Internet. The domain name registration system does not permit two entities to use the same domain name unlike marketplace conditions in which similar or identical marks can co - exist; and by decreasing the Plaintiff’s ability to control the association that the public would make its mark. Later, in *Umbro International Inc., v 3263851 Canada Inc.*,⁶⁶the court held that: domain names are property and can be garnished and sold. Infact the infringer must be proved to have registered his domain name parallel to the existing trademark in bad faith intent to profit.⁶⁷

3.0 Infringement of Digital Trademarks in Tanzania

Tanzania does not exist in a planet where technological expansion is totally dormant. Indeed, technological advancement is affecting Tanzania in as much as other

⁶¹ R. C. Dreyfuss, *Op. cit.*, p. 265.

⁶²This is a registered or assigned alphanumeric address by the registrar, domain name registry, or other domain name registration authority as part of an electronic address on the Internet.

⁶³*Supra fn.1.*

⁶⁴*Ibid.*

⁶⁵947 F Supp. 1227 (ND III 1996).

⁶⁶ Civ. No. 174388 1999 WL 117760 (Va. Cir. 12 March 1999)

⁶⁷ L. P. Ramsey, ‘Brand Jacking on Social Networks: Trademark Infringement by Impersonation of Mark holders,’ *Buffalo Law Review*, 58 (2010), at 870; *See also, Supra fn. 26.*

countries are affected particularly in intellectual property rights. Intellectual property rights are endangered by the new digital technology as the rights of rights holders may be infringed online in as much as offline. This part comments on the digital trademarks infringement and the available remedies in Tanzania.

With reference to domain names, there is no specific legislation regulating domain names in Tanzania as well as other East African countries as opposed to the trade and service marks which are regulated under the law.⁶⁸ However, the existing specific trademark law does not cover digital trademark. Indeed, domain names are registered by Tanzania Network Information Centre, (tzNIC),⁶⁹ under administrative arrangements with Tanzania Communication and Regulatory Authority (TCRA). The centre is tasked to perform a number of issues including registration and sensitization of use of domain name.⁷⁰ Further, the centre accredits other companies to be registrar of domain names, whereas currently there are forty two (42) accredited registering companies.⁷¹

Forms of digital trademark infringement such as dilution and confusion in traditional forms of digital trademarks infringement may also take place in Tanzania. Despite the fact that dispute may arise between parties concerning existence of confusing or dilution of domain name or any other digital trademark in Tanzania, the issue that will arise here is that; how can the rights holder be redressed satisfactorily under traditional remedy available? Could they be applied to solve the dispute? Perhaps, the available avenue to claim the infringed rights is unsatisfactory. In the foregoing, although there is no clear, specific and substantive law covering digital trademark, still the rights holder can be protected so far as infringement occurred through the use of a mark by the defendant and such use is in course of trade indicating the origin of the goods or services.⁷² However, depending on the presiding Judge as to whether he is liberal or bold to interpret the existing laws and expertise in the field of intellectual property rights so as to award remedy.

4.0 Remedies for infringed digital trademarks

One of the methods used to protect trademarks from any kind of infringement is registration of a trademark under the law on one hand, and passing off⁷³ on the other hand. However, trademark registration protects the reputation and good will of one's business that he have laboriously built, so that no one is able to use his mark to divert business to them, otherwise would not exist if it were not for his

⁶⁸ The Trade and Service Marks Act, [R: E 2002]; See also; Adam Mambi, *Op.cit*, at 261.

⁶⁹ <http://www.tznic.or.tz/>: 'A limited company (by guarantee) with 2 founding members - TCRA (the regulator) and TISPA (the association of ISPs). It is non-profit Company established and registered in 2006 to administer and manage the operations of the Tanzania country code Top Level Domain (.tzccTLD).'

⁷⁰ N. Abibu, "Empowering Tanzanians in the Management of their Communication Resources: .tz for your identity," p. 135.

⁷¹ <http://www.tznic.or.tz> (accessed on 30/03/2015).

⁷² World Intellectual Property Organization, *The Enforcement of Intellectual Property Rights: A Case Book*, 3rdedn, (LTC Harm, 2012), pp 92-93.

⁷³ Cause of action under tortious liability.

trademark.⁷⁴ It also provides a defence against trademark infringement proceedings brought by other persons claiming to have rights in the trademarks.⁷⁵ The main purpose is to prevent the infringer from gaining out of the infringing trademark since “protection of trademarks is limited to its commercial use.”⁷⁶ Indeed, the remedies should be proportionate to the commercial effect of the use of the trademark on internet.

Similarly, under digital age, goods and services with trademarks require protection under trademark law and passing off as well.⁷⁷ This enables the trademark owner to seek judicial relief by way of seeking damages and any other reliefs from the infringer of his trademark.⁷⁸ However, the remedies available to the exclusive holder of a trademark may be categorized into two aspects, namely; criminal and civil remedies depending on the availability of the law relating to trademarks.

4.1 Criminal remedies

Criminal remedy normally is envisaged under the cybercrimes law.⁷⁹ The law criminalizes any person who violates intellectual property rights⁸⁰ by using computer system.⁸¹ The law requires the offender to pay a fine at a tune of specific amount of money or to serve an imprisonment term for specified period of time or to both fine and imprisonment if the violated intellectual property rights are on non-commercial basis. On the other hand, if the offender has violated the intellectual property right on commercial basis, then the offender will encounter a sanction of payment of fine specified under the law or to serve an imprisonment term for a specified period of time. In addition, the court if deems fit may order the offender to compensate the victim (trademark owner) for the loss sustained from infringement perpetrated by the offender.

4.2 Civil remedies

Apart from criminal remedies available against the infringer, there other various forms of remedies of civil nature worth noting which may be applied to redress the trademark owner for the loss sustained by trademark owner from infringement of his mark by the offender. These remedies include the following:-

4.2.1 Injunction order

⁷⁴M. S. Melfi and K. S. Boora, *Op.cit.*

⁷⁵ P. F. Kihwelo, ‘Remedies for trade mark infringement in Tanzania: Principles and Practice,’ 8 *Journal of Intellectual Property Law & Practice*, 9 (2014), p. 651.

⁷⁶C.Ehlermann and I. Atanasiu, (eds), *European Competition Law Annual 2005: The Interaction between Competition Law and Intellectual Property Law*, (Hart Publishing, 2007), p. 68.

⁷⁷*Supra fn.* 26

⁷⁸P. F. Kihwelo, *supra fn.* 43.

⁷⁹ Cybercrimes Act, No 14 of 2015

⁸⁰Trademarks for the purpose of this paper.

⁸¹ Computer system is defined under section 3 of the Cybercrimes Act, to include any a device or combination of devices, including network, input and output devices capable of being used in conjunction with external files which contain computer programmes, electronic instructions, input data and output data that perform logic, arithmetic data storage and retrieval communication control and other functions.

Injunction is a fundamental remedy which the trademark rights holder may seek and be granted by the court against the defendant in case of infringement of his trademark. The order prevents the trademark infringer from further infringing the rights holder's trademark.⁸² In other words, the "purpose of injunction is to protect the exclusive market position which the right-holder has established for a product or service."⁸³ However, preliminarily the plaintiff can acquire a temporally injunction order pending final determination of the matter. The final order may be declared against the infringing registered trademark under the common law recourse that; registration of a trademark does not confer a right to use the trademark to deceive or confuse the purchasers at public. The effect of injunction order recognizes and protects the exclusive rights of holder of the trademark against the world. This was reflected in the case of *Prince PL v Prince Sportswear Group Inc.*,⁸⁴ as quoted by Adam Mambi, where the dispute involved two companies competing for legitimate rights on "prince.com" domain name in different jurisdictions. The conflict was concerned the words "prince.com" as a domain name for a website. The court in its decision held that:

'The owner of the famous mark shall be entitled ... to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes the dilution of the distinctive quality of the mark.'

In another case of *New York City Triathlon, LLC v. NYC Triathlon Club, Inc.*,⁸⁵ in which the District Court of Southern District of New York issued a preliminary injunction to enjoin the defendant sport equipment store's use of the NYC Triathlon Club, NYC Tri Club and New York City Triathlon Club marks in connection with a race training club. The defendant later sought to challenge the injunction order. In fact, later on the court reaffirmed its injunction order for a number of reasons.⁸⁶

The international regime particularly the TRIPS⁸⁷ do not provide protection for digital trademarks. However, it can be construed to provide remedies for digital trademarks liberally. The Agreement empowers the judicial authorities of the member states to issue an injunction order over infringing goods.⁸⁸ Alternatively, using the traditional approach given to grant remedy the plaintiffs is claiming under

⁸²*Supra* fn 43.

⁸³C. Heath and A. K. Sanders, (eds), *New Frontiers of Intellectual Property Law IP and Cultural Heritage – Geographical Indications – Enforcement – Overprotection*. (Hart Publishing, 2005), p. 292.

⁸⁴(1998) FSR 2.

⁸⁵ 10 CIV.1464 (CM), 2010 WL 808885 (S.D.N.Y. May 4, 2010).

⁸⁶(1) consumers will likely believe (erroneously) that signing up for defendant's club would offer them an advantage in signing up for the New York City Triathlon itself; (2) confusion could undermine the attendant goodwill by making it more difficult for plaintiff to secure sponsors for its 2011 race; (3) defendant's use impeded plaintiff's efforts to control its reputation and the services offered under its name and mark; (4) a highly sophisticated consumer actually did confuse defendant's club with the New York City Triathlon; and (5) substantial confusion has arisen in similar contexts (e.g., the Los Angeles Triathlon and the Los Angeles Triathlon Club). *Id.*, 2010 WL 808885, 32; *See also*, S. V. Wilson, M. E. Sonbaty, and B. LaBarge (June 8, 2010). "IP/Technology: 2010 Midyear Update." Arnold and Porter LLP: <http://www.arnoldporter.com> (accessed on 24 March 2015).

⁸⁷ The Agreement on Trade Related Aspects of Intellectual Property (TRIPS) – 1994, Article 44 (1).

⁸⁸ This could be liberally interpreted to include infringing digital trademarks.

digital trademark, courts have an inherent power to construe⁸⁹ the provisions given to encompass digital trademark infringement as well. This is “necessary because allowing an infringing product to remain on the market will hurt the right-holder’s sales and lead to a risk of market confusion.”⁹⁰ The rights holder needs protection under the available avenues of the law such as passing off rather than leaving someone’s rights being infringed.

4.2.2 Monetary damages

This is the most prominent pecuniary remedy available for trademarks infringement. The calculations of damages normally base on the profit lost or royalty.⁹¹ The trademark rights holder may seek also to be granted specific or general damages such as attorney’s fees from the defendant due to the sufferings sustained by the plaintiff from infringement committed by the infringer’s use of his trademark.⁹² The rule is “damages should be of compensatory and should put the party back where he or she would have been had the infringement not occurred.”⁹³ The court may only order payment for damages on satisfactions of the suit in favour of the plaintiff regardless of whether the infringer knew or ought to know that he was involved in digital trademark infringement.

4.2.3 Punitive damages

In the circumstances that the trademark infringer is proved on balance of probabilities, that his act of infringing the trademark of another person was conducted maliciously, wilfully, fraudulently or deliberately, then the court under its judicial power, may order the infringer to pay a certain sum of money to the rights holder as a punitive or an exemplary damages.⁹⁴ This is a common practice in civil suits. It is a compensation in excess of actual damage sustained,⁹⁵ by the trademark rights holder. Therefore, punitive damages payable aims at deterring the defendant so as he or she can suffer financial loss as a reciprocal pain from his or her evil act of infringing another person’s trademark.

4.2.4 Accounts for profit

The trademark rights holder may also pray to the court to be awarded any profit generated by the defendant accruing from infringement of digital trademark.⁹⁶ This is apart from actual damages suffered by the plaintiff. If the court is satisfied with the suit in favour of the plaintiff, then as it deems fit may order that the profit made

⁸⁹Golden Rule of Interpretation.

⁹⁰C. Heath and A. K. Sanders (edits), *Op. cit*, p. 293.

⁹¹P.F. Kihwelo, *Op.cit*, p. 652.

⁹²The TRIPS, Article 45.

⁹³*General Tire v. Firestone Tyre*[1969] EA 14 as quoted by P. F. Kihwelo, *supra fn.* 50.

⁹⁴*Supra fn.* 43.

⁹⁵C. V Bar and U. Drobnig, *The Interaction of Contract Law and Tort and Property Law in Europe: A Comparative Study*, (Sellier; European Law Publishers, 2004), at 110.

⁹⁶*Supra fn.* 43.

out of the infringing trademark be paid to the rights holder of the original trademark owner. The rationale is to compensate the loss sustained by the plaintiff due to the defendant's use of the infringing trademark in the market which affected commercially the rights holder of the trademark.

4.2.5 Withdrawal of the infringing trademark

Since digital trademark cannot be consumed online, it can be used to find the source of the goods and services or identity of the goods and services by the public consumers. Therefore, if it is found that the trademark is infringing another trademark online, *e.g., domain names*, before the judicial authorities, then the plaintiff may seek an order of the court to remove or shut off the infringing trademark from further infringement online.⁹⁷ This can be done by virtual of the existing instruments at international⁹⁸ and national levels. The infringer is prevented from further using the trademark on the internet which would confuse the consumers as to identity and source of the goods or services.

4.2.6 Destruction of digital materials furthering infringement

The infringing materials⁹⁹ of digital trademarks in possession of the infringer or his agent may by judicial authorities and without compensation be ordered to be surrendered to the rights holder for destruction to prevent him from further harming the rights holder. However, this will be contrary if it will be found that it contravenes the existing constitutional requirements as to its destruction.¹⁰⁰ Things like computer programmes or advertisements used in infringing the digital trademark can be stopped and destroyed preventing its use on internet to avoid further infringement.

5.0 Judicial practices in awarding remedies

Globally, there are few incidents of digital trademark infringement that took place and determined by the courts. This is due to *lacuna* in the existing laws which do not or inadequately address the issue of protection of digital trademark in various jurisdictions worldwide. Though in some jurisdictions by using legal avenues available have managed to entertain matters relating to digital trademark infringement.

One of the world's famous financial services provider *Charles Schwab & Co., Inc.*,¹⁰¹ filed a suit in respect of its intellectual property affairs in mainland China. One financial services company in Shanghai registered the plaintiff's famous service

⁹⁷ It could be an online advertising program or website.

⁹⁸ TRIPS, Article 46; See also, Paulo Kihwelo, *Supra fn* 43.

⁹⁹ Website programmes, *etc.*

¹⁰⁰ *Supra fn*. 43; See also, J. S. McKeown, *Op. cit.*, at 159.

¹⁰¹ Model Case of Trademark and Copyright Litigation and Arbitration handled by Chang Tsi & Partner, in China; <http://www.changtsi.com> (accessed on 13 March 2015).

trademark and trade name (*in Chinese language*) as its trade name and prominently used the same as its own trademark in commercial publicity programs. The plaintiff served the Cease and Desist letter to the target company requiring them to cease the infringement and change its company name. However, the target company did not pay much attention to the plaintiff's desist letter, and refused to stop infringements. Considering the stubborn attitude of the counterpart, after detailed and careful investigation and evidence collection, the plaintiff filed the trademark infringement and unfair competition litigation to Shanghai Pudong People's Court. The plaintiff petitioned the court to order the defendant to immediately cease the use of the trademark (*in Chinese language*), including but not limited to the use on services, name cards, promotional materials and the *company website* (*Emphasis supplied*); to order the defendant to immediately stop using (*in Chinese language*) as its trade name, and change its company name accordingly; to order the defendant to compensate the economic loss of RMB 200,000, covering the expenses of the plaintiff for the investigation and deterrence of the infringements. In the litigation, the plaintiff not only submitted a large quantity of evidence to prove the bad faith of the counterpart and their ongoing infringements, but also clearly stated the adverse effect the infringing acts of the counterpart had made on the plaintiff. All plaintiffs' claims were completely supported by the Court. The Court ordered the defendant to stop the ongoing infringement, change its company name, and compensate the economic loss of the plaintiff of RMB 150, 000.

In the above referred case the defendant registered the service mark and used it as a trademark on the website. This indicates that infringement of a digital trademark of the rights holder *i.e.*, unauthorised use of the mark is taking place online.

In another case regarding "*identical*" or "*similarity*" of goods or services, the European Court of Justice (ECJ) developed two conditions for the infringer to be held liable for digital or online trademark infringement. In *L'Oréal SA v. eBay International AG*,¹⁰² eBay used keywords corresponding to L'Oréal trade marks to promote its own service of making an online marketplace available to sellers and buyers of products, that use was not made in relation to either (i) goods or services 'identical with those for which the trade mark is registered' or (ii) goods or services similar to those for which the trade mark is registered. In view of the foregoing, the court decided that the operator of an online marketplace did not 'use' it for the purposes of Article 5 of Directive 89/104 or Article 9 of Regulation No 40/94. That, the signs identical with or similar to trade marks which appear in offers for sale displayed on its site.

¹⁰²ECJ, 12 July 2011, C-324/09.

In contrast using a sign identical with a trademark as a keyword in the context of an internet referencing service falls within the concept of use “in relation to goods or services” within the meaning of Article 5(1)(a) of the Trademark Directive.¹⁰³

Selling to another person a registered trademark as keyword by the internet providers may be sufficient to establish digital infringement of the trademark on the internet resulting to damage and consequently damages to the right holders. This is illustrated in the Chinese case¹⁰⁴ as quoted by WIPO Standing Committee on Trademark, Industrial Designs and Geographical Indications, where the plaintiff’s registered trademark NEDFON was sold by Google as a keyword to a competitor. The court ruled that the competitor in question had committed trademark infringement. Infact, Google itself was not held jointly liable for trademark infringement for the reason that neither had ability to check or control the information submitted by the competitor, nor did it have an obligation to examine the legality of that information.

6.0 Remedies available: Tanzania’s position

The remedies available to the rights holder of a trademark in Tanzania are categorized into two categories, namely; criminal and civil remedies as discussed hereunder:-

6.1 Criminal remedies

This kind of remedy is envisaged under the new enacted cybercrimes law. The law as noted earlier has criminalized any person who violates intellectual property rights by using computer system. The law requires the offender to pay a fine of not less than five million shillings or to serve in jail for a term of not less than three years or both fine and imprisonment if he violated the intellectual property rights in non-commercial basis.¹⁰⁵ On the other hand, if the offender has violated the intellectual property right on commercial basis, then he will encounter a sanction of paying a fine of not less than twenty million or to serve an imprisonment term for not less than five years; and in the court if deems fit may order the offender to compensate the victim (trademark owner) for the loss he has sustained as a result of his infringement.¹⁰⁶ The penalties given under the law are severe aimed at deterring the offender and potential offenders.

6.2 Civil remedies

¹⁰³*Google France SARL v. Louis Vuitton Malletier SA* (C-236/08, C-237/08 & C-238/08) [2010].

¹⁰⁴*Google v. Guangdong Ganyi Electrical Appliance Co Ltd* as quoted in World Intellectual Property Organisation. Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications: Trademarks and the Internet, (SCT/24/4; Twenty-Fourth Session, Geneva, 2010), p. 10.

¹⁰⁵The Cybercrimes Act, No 14 of 2015, section 24 (2) (a).

¹⁰⁶The Cybercrimes Act, No 14 of 2015, section 24 (2) (b).

Apart from criminal remedies available against the infringer in Tanzania, the gist of civil remedies are the same as they are discussed in the foregoing part above. However, for an injunction order to be acquired or obtained, the applicant must satisfy the court that the requirements which are stipulated in the case of *Atilio v. Mbowe*¹⁰⁷ are met with merit. The *first* requirement is that there must be a serious triable issue between parties with a probability that it may be decided in the applicant's favour. *Secondly*, circumstances should be such that if the court does not issue the order, the applicant would suffer irreparable loss even if he subsequently succeeds in the action. *Thirdly*, on a balance of convenience, the applicant stands to suffer more if the injunction is refused than what the respondent would suffer if the injunction is granted.¹⁰⁸ These conditions may be applied under digital infringement of trademark *mutatis mutandis*. However, since the laws available does not specifically provide protection of digital trademarks, it is an ideal that the claim be brought under passing off for unregistered trademark especially domain names; and for registered one claim may be filed under the registrar's procedure of dispute resolution set therewith.

Therefore, trademark use under digital age attracts protection in Tanzania in as much as in other jurisdictions, and should there be any infringement of a trademark in question must be protected under the legal platform available since the traditional trademarks and the new cybercrimes law paved the way to protection of digital trademarks from infringement.

7.0 Conclusion

In the present world, the most fundamental problem the world faces is the pre-occupation of improper sphere, or catch up of intellectual property rights over digital environment and the expanded networked global communities. The global nature of computer technology presents a challenge to nations to address protection of digital trademarks.¹⁰⁹ The available laws and courts may tend to under-protect or overprotect the intellectual property rights.¹¹⁰ This is another dilemma on the other hand. Traditionally, trademarks are essentially meant to serve the consumers to make the right choice of which goods and services should they buy from the market. On the other hand, creation and availability of duplicate trademarks in the market, places consumers at risk or hinders them from making the right decision on which goods and services should they buy. Therefore, for trademarks to perform its function properly it must not be duplicated.¹¹¹ It is from this fact that, trademark law

¹⁰⁷(1969) HCD 284.

¹⁰⁸P. F. Kihwelo, "The Commercial Division of the High Court and the Milestones reached in Intellectual Property Law matters," (Commercial Court Roundtable, 8th October 2009), p. 15.

¹⁰⁹F. Cassim, 'Formulating Specialised Legislation to address the Growing Spectre of Cybercrime: A Comparative Study,' *PER* 2009(12)4, p. 66.

¹¹⁰R. A. Spinello and H. T. Tavani, *Op. cit.*, at 55.

¹¹¹W. M. Landes and R. A. Posner, *The Economic Structure of Intellectual Property Law*, (Harvard University Press, 2003), at 167.

should come into play to interfere as a mechanism to protect the rights holders of the mark from infringement of its exclusive rights of the trademark owner by another.

The global utility of digital technology especially the use of internet had deployed involvement of trademarks in the digital world in search of market for their goods and services. Individuals now can get information concerning a particular goods and services bearing a certain trademark online in as much as reducing the costs and time searching the same offline.¹¹² However, this technological development has caused legal challenges in protection of intellectual property rights as discussed above. The legal regime available does not adequately address the issue of protection of digital trademark. Mortensen quoting Flate in his article *verbatim* argues that:

Technology will play a major role in preserving territoriality,... Technology is progressing at an astonishing rate and it is virtually impossible for the law to keep up. This will in turn leave ...holders in 'search of their own solutions' as Internet technology continues to outpace intellectual property law. The law must adjust to the rapidly advancing technology and attempt to keep up with this new technological age. However, technology will not slow down to allow the law to "catch up" and cutting edge technology requires cutting edge lawmaking.¹¹³

Flate above suggests that, the existing legislation will not stop to allow lawmaking to outpace technology; instead technology will keep on advancing leaving the law behind. Picking the leaf from Flate, it is pertinent to note that the legal platform available should be liberally revisited to provide adequate legal protection and remedies against infringements of digital trademarks at length. However, protection of trademark does not mean that exclusive monopoly over the public use *per se*; rather it is a cardinal principle of law that trademark right it is not a right to own or to control all uses, but a right to exclude others from certain uses.¹¹⁴ Indeed, the right to exclude others is often practically derived from the right to use the trademark.

Hence, fully protection of intellectual property rights cultivates the culture of innovations and creativity in the society. Protection further serves to promote competition of trademarks brands which will in turn ensure there is high quality of goods and services in the marketplace; ensures accurate information of the goods and services and consequently foster consumer confidence and high quality of industrial development in producing goods and services.

¹¹²*Ibid*, at 168.

¹¹³ M. J. Mortensen, 'Would Be Pirates: Webcasters, Intellectual Property, and Ethics,' in *Intellectual Property Rights in a Networked World: Theory and Practice*, eds. R. A. Spinello and H. T. Tavani, (Information Science Publishing, 2005), p. 259.

¹¹⁴S. Frankel, 'Trademarks and Traditional Knowledge and Cultural Intellectual Property,' in *Trademark Law and Theory: A Handbook of Contemporary Research*, eds. G. Dinwoodie and M. D. Janis, (UK; Edward Elgar Publishing Limited, 2008), p. 435.

In ensuring adequate and efficient protection of digital trademarks in Tanzania, sound legislative intervention is needed. To produce sound and successful legislation, two major issues should be adequately addressed; first, the scope of legislative intervention and second, the nature of digital trademark legislation to be enacted. Regarding the first question, new digital trademarks provisions are needed only to cover those infringements that are unique to computers themselves, other infringements in which a computer is used simply as an instrument for perpetration are either covered by existing trademarks or cybercrimes provisions or can be covered by simple amendments of said provisions. Another step that should be taken by legislators is the amendment of existing trade and service marks law with an aim to cover some special cases such as the cases in which the computer is used as an instrument for committing known traditional trademark infringement, making the infringement of such trademarks easier or resulting in more dangerous consequences compared to their more traditional forms and cases in which intangible digitized property like domain names comes under threat from other users.

While many countries in the world have soundly and adequately dealt with digital trademarks infringements legislatively, others have failed to do so like Tanzania. Tanzania on the other hand, through legislators has generally criminalized any electronic violation of intellectual property rights (digital trademarks infringement inclusive) that have recently been so through the new enacted cybercrimes law. However, this creates conflict between criminalizing provisions under the new cybercrimes law and civil provisions under the long standing trade and service marks law, hence posing problems to rights holders and prosecutors.

Regarding the nature of digital trademark legislation, the legislator is presented with two options. The first option is the inclusion of the aforementioned criminal provisions in one separate code as one specific digital trademarks statute. The second is inserting substantive civil provisions related to digital trademarks into the existing trade and service marks law of the country. While the first method preserves the unity of substantive criminal law of the country in one code and prevents the dispersion of criminal provisions into many separate laws, the second one would, by contrast, create much-needed public awareness of digital trademark protection.