

**IN THE HIGH COURT OF TANZANIA  
(COMMERCIAL DIVISION)  
AT DAR ES SALAAM**

**MISCELLANEOUS CASE NO. 3 OF 2007**

**IN THE MATTER OF THE TRADE AND SERVICE MARKS ACT, 1986**

**AND**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 29733 RANTAC**

**(word)**

**AND**

**IN THE MATTER OF AN APPEAL BY:**

**AND**

**GLAXO GROUP LIMITED ... .. APPELLANT**

**VERSUS**

**J.B. CHEMICALS & PHARMACEUTICALS LTD.....RESPONDENT**

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**JUDGMENT**

**LUANDA, J.**

The facts giving rise to this appeal as contained in the Ruling of the Deputy Registrar of Trade and Service Marks are to the following effect.

On 17/6/2002 the respondent through Abdulmalik and Surendra Patent and Trade Mark Agents applied for registration of RANTAC in class five as a trademark. The same was published in the Official Government Gazette of 9<sup>th</sup> August, 2002. It would appear the appellant were not aware of that application till in October, 2002. On being aware they sought leave for extension of time to file notice of opposition, which they were granted. They then filed the said notice.

In the notice the appellant contended, inter alia, that they are sole lawful proprietors in Tanzania of the trade mark ZANTAC under registration No. 17764 in class five; that the goods specified in the application are similar with theirs, namely pharmaceutical, medicinal and veterinary preparations and products (substance). Since they are lawful owners of ZANTAC selling the above mentioned products, to allow the respondent use RANTAC trade mark will cause confusion to the public, hence the opposition.

The respondent on the other hand countered the prayer. They are maintaining that the registration will not confuse the public. An Indian example was given whereby RANTAC and ZANTAC co-existed. But they added that there was an agreement to that effect. So there was no dispute existed as in this case.

Be that as it may, after going through the "pleadings" the Deputy Registrar framed the following issues, namely:

(i) *Whether the Opponent (Appellant) is the lawful proprietor of trade mark "ZANTAC".*

(ii) *Whether the trade mark "ZANTAC" is a well known mark.*

(iii) *Whether the opposed trade mark "RANTAC" is so similar to "ZANTAC" mark that is likely to deceive and/or cause confusion between the goods of the Applicant (Respondent) and Opponent (Appellant) and the members of the public.*

(iv) *Whether the opposed mark "RANTAC" is not distinctive and its registration would be unlawful under the provisions of the Act.*

With regards to the first and second issues framed, the Deputy Registrar answered them in the affirmative in that the appellant is a lawful owner of ZANTAC trade mark and that the mark is well known. The Deputy Registrar did not end there, she went further and said the mark is valid until 27<sup>th</sup> January, 2010. To put it differently, the appellant renewed the mark. And so the argument raised by the respondent in their written submissions by their counsel Mr. Mapunda and Mr. Malick from Law Associates Advocates that the mark was not renewed does not hold.

As regards the third and fourth issues, the Deputy Registrar answered them in the negative. In referring to issue number three the Deputy Registrar said, I quote:-

*"In looking at the resemblance of the marks and likelihood of deception and confusion, it is important to consider as to who is likely to be confused or deceived. In the case at hand, the goods to which the marks apply are subject of prescription by the Doctors. Taking this into consideration, the likelihood of deception and confusion does not arise."*

And in deciding the fourth issue, the Deputy Registrar said the following, I quote:

*"In deciding whether the mark is distinctive, regard has to be given to the mark as a whole and not in segments. Looking at the mark "RANTAC" as a whole and in relation to the goods for which it is applied to conduct business and identify, I find it distinctive, that it is capable of distinguishing goods with which is or may be connected in the course of business, that is pharmaceutical goods."*

The finding on these issues prompted this appeal.

In the memorandum of appeal, the appellant has raised five grounds. The parties argued their cases by way of written submissions. The advocates for the parties thoroughly researched on the subject. I commend them on the excellent research.

I have read the submissions as well as the Ruling of the Deputy Registrar. Basically the issues for determination and decision is whether the finding of the Deputy Registrar on the third and fourth issues as quoted above are correct.

It is on record that the respondent intends to sale goods similar to those sold by the appellant namely, pharmaceutical, medicinal and veterinary preparations and products. In terms of International Classification of Goods and Services as spelt out under Nice Agreement which is applicable in Tanzania by virtue of Section 2 of the Trade and Service Mark Act, the said goods falls under class five. According to the current edition, i.e. 9<sup>th</sup> Edition class five includes the following goods, namely -

*Pharmaceutical and veterinary preparations; sanitary preparation for medical purposes; dietetic substances adopted for medical use, food for babies; plasters, materials for designs; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin, fungicides, herbicides.*

It is the appellant's case that by using the trade mark RANTAC which is more or less similar with their well known trade mark ZANTAC and selling similar goods will confuse the public. A number of cases and articles were cited in support of their case. One of such case is a Ugandan case which is in all respect similar with our case under discussion. The Deputy Registrar was not persuaded with that case. The parties in that case were Glaxo

Group Ltd. v. J.B. Chemicals and Pharmaceutical Ltd. Civil Appeal No. 68 of 2002.

In that case Glaxo like in our case, were registered proprietor of the trade mark ZANTAC registered in class five way back in 1979. In 1997 the respondent filed an application to register RANTAC in class five as their trade mark. Glaxo objected the application contended that the intended trade mark would confuse the public with their trade mark.

The Registrar of Trade Mark overruled the objection. Glaxo appealed to the High Court. The appeal was dismissed. Dissatisfied with the decision of the High Court, Glaxo appealed to the Court of Appeal of Uganda. The Ugandan Court of Appeal held, inter alia, I quote:

*"... the words "Zantac" and "Rantac" differ only by one letter "Z" and "R" leaving the remaining syllables identical. It is not disputed that "Zantac" has been in existence for over 15 years and covers the same products as "Rantac".*

The Court then held as follows, I quote:

*"As the evidence stands on record, I agree that the likelihood of causing confusion or deception is strong and on high side."*

The appeal was allowed. Rantac was not registered as a trade mark in Uganda.

In our case the Deputy Registrar held that there was no likelihood of confusion as the goods are subject to prescription by a doctor. But we have seen what kind of goods are in class five. They include plaster, material for dressing, disinfectants to mention a few. Surely the above mentioned goods

do not need doctor's prescription; they are available at the counter. One may buy for use as and when he wishes without the doctor's prescription.

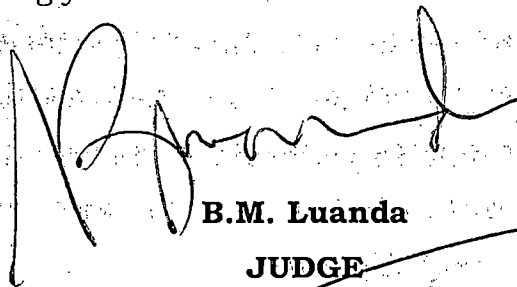
As regards Rantac to have a distinctive mark, I am unable to agree with the Deputy Registrar. Section 1 of the Trade and Service Marks Act, defines what is a "trade mark or service mark". It defines thus:-

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

In our case the only difference between Rantac and Zantac as correctly observed in the Ugandan case which is highly persuasive is by one letter "R" and "Z". The words look very similar. There is no distinct mark so as to distinguish Rantac from Zantac. I subscribe with the holding in Glaxo case from Uganda. With due respect to the Deputy Registrar, she was wrong when she held contrary to the holding of that case. To register Rantac as a trade mark will cause confusion. The appeal is allowed with costs. The decision of the Deputy Registrar is hereby set aside.

The Registrar of Trade Marks is directed not to register "Rantac" as its trademark.

Order accordingly.



**B.M. Luanda**

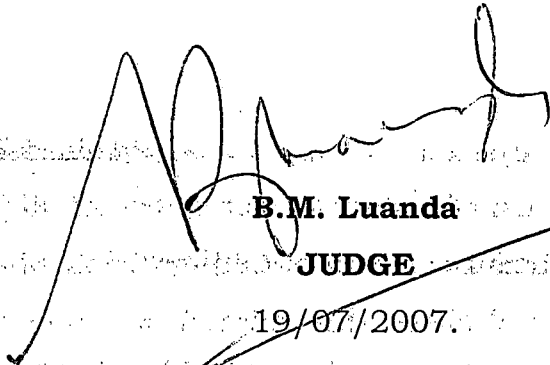
**JUDGE**

18/07/2007.

Judgment delivered.

Brooke Montgomery for the Appellant.

The Respondent absent.



**B.M. Luanda**

**JUDGE**

19/07/2007.

1,450 words.