

*- In view of infringement of trademark a
plaintiff must establish that his
trademark is lawfully registered.*

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

COMMERCIAL CASE NO. 262 OF 2001

SOCIETIE BIC.....PLAINTIFF
VERSUS
SAJJAD ALI LIMITED.....1ST DEFENDANT
COMMISSIONER FOR
CUSTOMS AND EXCISE DUTY.....2ND DEFENDANT

JUDGMENT

KIMARO, J.

There is one main issue which requires determination by this court. The issue is whether or not the first defendant (SAJAAD ALI LIMITED) has infringed the plaintiff's (SOCIETE BIC) trademark "BIC" as alleged in paragraph 5 of the plaint. This court framed the issues on 19th June, 2002. By then the conduct of the case was before my brother judge Nsekela, as he then was, before being uplifted to the Court of Appeal. The other issue is ancillary. It is on the relief of the parties to the suit.

In paragraphs 4,5 and 6 of the plaint, the plaintiff has pleaded acts of infringement and passing off by the defendant.

The background information which is not in dispute is that the plaintiff is a foreign company. It is incorporated in France. It has a business place in Tanzania at Dar-Es-Salaam. It registered a trademark in Tanzania In 1976. The Trademark is "BIC" (the word and device). The "Trades mark" falls in class 16 schedule III. A certificate of registration and a renewal were tendered in court and admitted as Exhibit I.

Apparently, the plaintiff has for many years and particularly after registration of the trademark used the trademark exclusively, upon the goods registered under the trademark.

What has given rise to this suit is that sometimes in October 2001 the first defendant imported into Tanzania a consignment of ball points pens bearing the plaintiff's registered trademark. One packet of BIC ball point pens was tendered and admitted in court as exhibit, to substantiate the plaintiff's claim. The packet was admitted as exhibit P4.

There is also evidence on record which supports the fact of the defendant selling ball point pens bearing the trademark. This is a tax invoice receipt/cash sale receipt which was issued by the first defendant to one

of the plaintiff's witnesses who purchased one packet of ball point pens from the first defendant. The tax Invoice/Cash Sale receipt was tendered and admitted in court as exhibit P3. The plaintiffs contention is that the products which were imported and sold by the first defendant were of low quality, much as they bore the plaintiff's trade mark. The observation by the first plaintiff's witness was that they were counterfeit products. This explains the plaintiffs complaint that the action done by the first defendant amounted to an infringement of the plaintiff's trade mark.

Although the defendant admitted importation of the consignment of BIC into the country in 2001 and sale of the products it has disputed the claim of the infringement of trademark and passing off.

It was on the light of the contentions made by the parties that the main issue given above was framed.

The plaintiffs prayers are:

" permanent injunction and damages against the first defendant's acts which the plaintiff describes as tortuous acts of infringing its registered trademark "BIC" by importing and selling counterfeit ball point pens bearing the plaintiff's registered

trade mark and passing off the counterfeit ball point pens."

This court did, on 17/07/2003 order the Advocates (Ms Kasonda, from Mkono & Company for the plaintiff and Mr. Mgonya, from Kiwango and Company, Advocates for the first defendant) to file final written submissions. The time frame was that Mr. Mgonya had 11/08/2003 as the deadline and Ms Kasonda had 25/08/2003 as the deadline for filing the submissions.

For reasons not disclosed to this court, Mr. Mgonya did not file his submissions as ordered by the court.

The submission by Ms Kasonda was that the acts perpetrated by the first defendant amounted to both infringement and passing off. She made reference to the defence raised by the first defendant and remarked that the defence is baseless and is not maintainable. She maintained that the matters raised in the written statement of defence such as the validity of the business licence (para 4), the Importer's from whom the products were purchased (para 6) the packing and labelling of the goods as well as the quantity and value of the goods are of no relevancy to the suit.

Ms Kasonda traversed the evidence given by PW1 on the distinction between genuine "BIC" products and those which were imported by the first defendant through DW1. One packet of ball point pens said to be genuine "BIC" products was tendered and admitted in court as exhibit P2. These were ball point pens manufactured by Haco Industries, Kenya. PW1 – Mr. Antony Ng'ang'a who was the Export Manager of Haco Industries spelt out the distinct features found in the genuine products. When a comparison was made between the genuine products and those described as fake, the features were different.

Another packet of ball point pens said to be counterfeit was also produced and admitted in court as exhibit P4. The testimony of PW1 was that exhibit P4 was purchased from the first defendant. According to Ms Kasonda although exhibit P4 had BIC as its trade mark, the products were not of the same quality as exhibit P2 because the features of the two exhibits were different.

Ms Kasonda's conclusion was that the distinctive features or qualities of genuine BIC products given in respect of exhibit P2 when compared with the features/or qualities found in the products in exhibit P4

is sufficient to prove infringement of the plaintiff's registered trade mark.

On DW1's admission of importation and sale of the imported goods, Ms Kasonda interpreted the same as amounting to catch the first defendant in a factual cob web of its own creation making the answer to the main issue affirmative.

What has been discussed above gives the nature of the plaintiff's case, the evidence and the arguments raised by Miss Kasonda to support the plaintiffs case.

Let me go to the issues. As stated before, the main issue focuses on infringement of trademark and passing off. A question which comes immediately is: What gives a registered owner of a trade mark the right to institute legal proceedings? The answer is found in Section 31 of the Trade and Service Marks Act, 1986. The section reads:

*" Subject to the provisions of this Act and any limitations or conditions entered in the register the **registration of a trade or service mark shall, if valid, give or be deemed to have given the registered proprietor, of exclusive right to the use of trade or service mark** in relation to any*

goods including sales, importation and off for sale or importation."

In her final submission Ms Kasonda said and I quote:
*" The plaintiff is and has at all material times been registered proprietors in Tanzania and throughout the world of the famous Trademark "BIC" (world and device). "The Trademark" in class 16 schedule III and that the said registrations are valid and subsisting **as supported by certificate of registration and renewals** which were tendered and admitted in court as exhibit P1."*

Exhibit P1 is one of the exhibits which were tendered in court It is a certificate of registration of the trade mark. It is evidence of the registration of the trademark. There is an attachment to the Certificate of Registration. It is a notice given under Rule 70 of the relevant law. The Notice is dated 3rd February 1983 and it informed the plaintiff that its registration of trade mark 16374 in class 16 Schedule III was renewed for a period of fourteen years from the date of expiration of the last registration. The date of last registration is indicated to be 16th June, 1983.

While giving his evidence in Court on 10/12/2002, PW1 said:

" The owner of the trademark is Societe BIC, a French Company. It was first registered on the 16.6.1976 in respect of all forms of writing implements as indicated in Exhibit P1. The trade mark was renewed on 16/06/1983."

There was no other document tendered in court in respect of the registration, nor renewal.

The question which arises is: If on 16th June 1983 the registration of the trade mark was extended for a period of fourteen years, can it be said that in October, 2001 when this suit was filed in court, the registration was still valid? The answer to this question is that a period of fourteen years from June 1983 expired in June 1997. Since there was no production of any other document to show that the registration was extended again after the period of fourteen years expired, it means that at the time the suit was filed, the registration of the trademark was no longer valid.

Section 29(1) of the Trade and Service Marks Act, 1986 provides:

" The registration of a trade or service mark shall be for a period of seven years from the date of registration but may be renewed from time to time in accordance with the provisions of this section."

As there is no other renewal, apart from the one which was made on 3rd February, 1983 which was for fourteen years, and the fourteen years expired in June 1997, the plaintiff had no valid registration of the trademark when this suit was filed. As such, it has no basis for complaining of infringement and passing off.

The main issue is answered in the negative. The main issue having been answered in the negative, the plaintiff's suit is dismissed with costs.

N.P.KIMARO,

JUDGE

10/09/2003

