

children and young persons under 16 years by police officers bars releasing those charged with homicide. There is no equivalent section concerning a situation once such suspect (charged with homicide) is brought before the court, but reading that law together with the Civil Procedure Act makes it clear that once charged with murder, notwithstanding the fact that accused is a young person or child, he or she, cannot be released on bail. In the premises the application cannot stand. A B

I should make further observation. In the affidavit in support of the application and during the oral submissions it was established that there was a quarrel between deceased and accused emanating from children jokes which prompted accused to hit deceased with a stone leading to his death. I would advise that investigations be expedited so that the full record be availed to the Director of Public Prosecutions as soon as practicable for his decision as to whether the preferable charge should be murder or manslaughter as circumstances suggestively cover any of the charges. If by any chance the DPP decides on the later charge that would qualify the accused for bail consideration. C D E

Save for the observations made the application is dismissed.

**TANZANIA DISTILLERIES LTD. v. VITAMIN
FOODS (1989) LTD** F

HIGH COURT OF TANZANIA
AT DAR ES SALAAM
(Mackanja, J) G

MISC. CIVIL APPEAL No. 15 ON 1995 H

*Trade Marks – Registration – Procedure in opposing registration of trademark
– rules 46 to 58 of the Trade Mark rules, Government Notice Number 256
of 1958.* I

A *Civil Practice and Procedure – Appeal – Appeal from decision of the Registrar to the High Court – Whether Order XXXIX, rule 1(i) of the Civil Procedure Code 1966, applies.*

B *Civil Practice and Procedure – Appeal – Appeal to the High Court from proceedings before the Registrar on trademark proceedings – Law applicable – Section 116 of the Trade Mark Ordinance and rule 116 of the Trade Mark Rules 1958.*

C *Trade Mark – Oral evidence heard by the Registrar after final submissions by counsel – Whether proper – Section 54 of the Trade Mark Ordinance.*

D *Trade Mark – Proceedings – Counter statement – Contents of a counterstatement – Section 21(4) of the Trade Mark Ordinance and Form TM7 rule and 48 of the Trade Mark Rules 1958.*

Trade Mark – Registration – Evidence as to registrability of a trade mark – Restrictions – Sections 12(1)(e) and 12(2) of the Trade Mark Ordinance.

E The respondent had applied to the Registrar for the registration of a trademark in respect of an alcoholic drink, Giyangi and device. The appellant opposed the application on the ground that it was the registered owner in respect of gin which was Konyagi and device. It was also the contention of the appellant that the application covered same goods or goods of the same description as those of the appellant and the mark sought to be registered was similar to that of the appellant that would be deceptive or confusing to consumers. After the filing of the opposition the respondent filed a counter-statement. Thereafter the appellant filed statutory declaration containing evidence in support of the opposition. The respondent also complied by filing statutory declaration in support of the application. On behalf of the respondent three businessmen who owned restaurants stated that their customers had never been deceived or confused by the two trademarks. These were countered by statutory declarations filed by the appellant which showed the appellant had received numerous complaints from dealers and customers of Konyagi that Giyangi was causing considerable confusion among consumers who confused or mistook Giyangi for Konyagi until they tasted the product and found it smelt like cheap perfume. This was confirmed by affidavits of three consumers. It was argued by the advocate of the appellant before the Registrar that the counter-statement of the respondent failed to give positive factors in its favour to show that the mark was registrable.

The counter-statement contained mere denials of the grounds of opposition which was not enough. He further argued that the respondent had failed to show how he came to adopt the trademark Giyangi and that failure to show whether he invented the word Giyangi was fatal to the application. He therefore urged the Registrar to rule that the counter-statement was incompetent and irrelevant. The advocate further urged the Registrar to reject the statutory declarations as the declarants were mere dealers and not consumers like the declarants of the appellant. The advocate of the respondent replied that the packaging and abeling of the two products were dissimilar; the advocate further argued that the respondent had registered a business name which the respondent wholly owned known as McIntosh International which would blend and market Giyangi. The public would not be deceived as this was not a limited liability company but a mere business name. It would be responsible for the blending, bottling and trading of Giyangi.

It was further submitted that the product was consumed by a large number of people and no one had complained. After counsel had made their submissions the Registrar heard oral evidence for the respondent. In the end the Registrar dismissed the opposition. The appellant appealed to the High Court. The first ground was that the decision was delivered in the absence of the appellant. The second and third grounds related to the wrongful admission of oral evidence after both counsel had made their final submissions. In the fourth ground the appellant complained that the counter – statements did not contain grounds while the fifth ground was that the statutory declarations contained no evidence. The sixth ground was that the counter – statement and statutory declarations did not comply with minimum statutory requirements for the registration of a trade mark thus rendering the opposed mark not registerable.

On his part the advocate of the respondent raised a preliminary objection contending the appeal was incompetent because the decree appealed from was not attached to the Memorandum of Appeal as required by Order XXXIX, rule 1(i) of the Civil Procedure Code 1966. It was argued in reply that section 116 of the Trade Mark Ordinance and rule 116 of the rules made there under provide for the making of appeals to the High Court.

Held: (i) Appeal from the decision of the Registrar is made under the provisions of section 116 of the Trade Marks Ordinance and rule 116 made thereunder wherein

A there is no requirement that a Memorandum of Appeal need to be accompanied by a copy of the decree;

(ii) A counter – statement must take the form of a Written Statement of Defence in a civil suit and if it contains denials and is merely evasive, such counter – statement should meet the same fate as an evasive Written Statement of Defence;

B
C (iii) In the event the Registrar decides to use his discretion to allow a party to adduce oral evidence after final submissions he must do so only if he is satisfied that the evidence sought to be adduced was not available at the time when it ought to have been presented along with the statutory declarations or in addition to it, or *in lieu* and the reasons for taking such a step must appear on the record of proceedings;

D (iv) The persons to be considered in deciding whether the resemblance between the competing marks is likely to deceive are consumers or those who are likely to become purchasers of goods upon which the marks are used and not retail dealers or businessmen owning restaurants;

E (v) Since Konyagi and Giyangi are alcoholic drinks of the type of gin, an ordinary consumer who is not sufficiently literate, is likely to be deceived.

Appeal allowed.

Cases referred to:

- F (1) *Kaisha* 1958 SRCP 112
 (2) *Rolex Chemical Industries* 1976 PLR 37
 (3) *Eastman Photographic Materials Ltd* (1898) 15 RCP 476
 G (4) *Solanki Tailors v. Nagji Harji* Civil Appeal Number 4 of 1995 (unreported)
 (5) *Kotak Limited v. Kooverji* [1967] EA 348
 (6) *Farrab Incorporated v. The Official Receiver and Provisional Liquidator*
 H [1959] EA 5
 (7) *Yusuf Mntambo and others v. Kassim Abdallah Farsi* [1991] T.L.R.
 196
 I (8) *Mariam Abdallah Fundi v. Kassim Abdallah Farsi* [1991] T.L.R 196

- (9) *East African Tobacco Co. Ltd v. De Erven de Wed J. Van Nelle, NV* (1930) 1 T.L.R 575 A
- (10) *Chesebrough – Ponds Inco. v. Gupyaka (1973) Agencises* [1982] T.L.R 111 B
- (11) *Wella AG. v. Halais Rochemie Industries* Miscellaneous Civil Appeal Number 8 of 1992 (unreported) B
- (12) *Tanzania Distilleries Ltd v. The Attorney General* Miscellaneous Civil Cause Number 47 of 1996 C
- (13) *Eastman Photographic Materials Company v. Controller General of Patents Designs and Trade Marks* [1898] AC 571 C
- (14) *In re Joseph Crossfield and Sons Limited* [1910] 1. Ch 130 D
- (15) *Wood v. Butler and Lambert* (1886) 32 Ch 247 D
- (16) *Revenhead Brick Co. Ltd v. Buabon Brick Co. Ltd* (1937) 54 RPC 341 E
- (17) *Parker – Knoll* 1962 RPC 265 E
- (18) *In the matter of an Ld. for Registration of a Trade Mark (The Pianist Case)* 1906 23 RPC 776 E
- Statutory provisions referred to: F
- (i) Civil Procedure Code 1966, Order XXXIX, Order XXI, Order XXXIX, rule 1(i), section 70
- (ii) Trade Marks Rules, rule 155, rule 122, rule 47, rule 48 and Form TM 7, rules 49, 50, 51, 52, 54, 46 and 58, section 12(1)(e), section 116, section 12, section 14, section 2, section 21(4) G
- (iii) Trade Marks Act 1905-1919 and 1938 H
- Mr Uzanda*, for the Appellant
- Mr Majithia*, for the Respondent

JUDGMENT

A

(Delivered 18 February 1999)

B **MACKANJA, J.:** This appeal originates from the decision of the Registrar of trademarks in respect of an application by Messrs. Vitamin Foods (1989) Ltd., for the registration of a trademark of an alcoholic drink to be known as Giyangi That application was opposed by Messrs. C Tanzania Distilleries Ltd who are the registered proprietors of the trademark number B 12919 Konyagi, also in respect of gin. Twelve grounds for opposing the application were given, namely:

- D 1. that the opponents are the registered proprietors of Trade Mark Konyagi and Device registered in Part B of the Register in Tanganyika on the 1 June, 1970 under Registration number B 12919 in class 33 in respect of gin, advertised in the Official Gazette Volume 4, number 34, General Notice Number 1704 dated the 14 August 1970;
- E 2. that the applicant's mark is not registerable under section 12 of the Trade Marks Ordinance;
3. that the applicant's mark is not distinctive;
- F 4. that the applicant's mark so nearly resembles the mark of the opponents as to be likely to deceive or cause confusion;
- G 5. that the applicant's application covers the same goods or goods of the same description as those of the opponent's and are likely to be sold through the same outlets thereby inevitably causing confusion and/or deception;
- H 6. that by reason of the reputation acquired by the mark of the opponents the mark sought to be registered would be deceptive or confusing and so is disentitled to protection in a court of justice in terms of section 14 of the Trade Marks Ordinance;
- I 7. that the applicant's mark is being used by a party other than the applicant which is an act of deception or will inevitably lead to deception and/or confusion;

8. the learned Registrar erred in law and in fact in failing to hold that trademark Giyangi so nearly resembled trademark Konyagi as to be likely to deceive or cause confusion and that the appellant had adduced overwhelming evidence that trademark Giyangi had actually caused deception and confusion; A
9. the learned Registrar erred in law and in fact in failing to hold that trademark Ginyagi was not being used by the respondent and that this was in itself an act of deception which would inevitably lead to further deception and confusion; B
10. the learned Registrar erred in law and in fact in deciding the opposition (*sic*) against the weight of the evidence before him and against established principles of law relating to registration of trade marks; C
11. conducting the proceedings in an arbitrary and chaotic manner in disregard of fundamental rules of procedure; and D
12. in the alternative, that the decision was not made by or under the direction of the Registrar as required by law. E

Before I delve into the evidence and arguments that were adduced and raised, as the case may be, during the hearing of the opposition it has occurred to me that the case will be brought in the right perspective if procedures under which opposition to an application for a trade mark is handled. The procedure is laid down under rules 46 and 58 of the Trade Mark rules, which were published under Government Notice Number 256 of 1958. Rule 46 provides that any person may within sixty days from the date of any advertisement in the *Gazette* of an application for registration of a trade mark give notice on the appropriate form to the Registrar of his opposition to the registration. Requirements which must be complied with at the time of issuing the notice are provided for in rule 47, namely, that the notice shall include a statement of the grounds upon which the opponent objects to the registration. The notice shall be accompanied by a duplicate which the registrar will serve on the applicant. F

Then, according to rule 48, the applicant shall within sixty days from receipt of such duplicate, send to the Registrar a counter-statement G

A on the appropriate form setting out the grounds on which he relies as supporting his application. He will also set out what facts, if any, alleged in the notice of opposition he admits. As is the case with the notice, a counter-statement will also be accompanied by a duplicate
B which the Registrar will serve on the opponent. Rule 49 requires the opponent within sixty days from receipt of the duplicate counter-statement to leave with the Registrar such evidence by way of statutory declaration as he may desire to adduce in support of his opposition
C and he shall deliver copies of such statutory declaration to the applicant. If the opponent leaves no evidence, unless the Registrar directs otherwise, he will be deemed to have abandoned his opposition in terms of rule 50.

D However, if he does leave evidence, then, within sixty days from the receipt of the declarations, the applicant shall leave with the Registrar such evidence by way of statutory declaration as he desires to adduce in support of his application, copies of which he shall
E deliver to the opponent. Rule 51 gives the applicant the right to reply by statutory declaration to the opponent's statutory declaration. The reply shall be confined to matters strictly in reply. Rule 52 prohibits the adduction additional evidence by either party; additional evidence
F can be called only with leave of the Registrar upon application by either party and if the Registrar thinks fit so to do. What follows will be the hearing of the opposition. The hearing is provided for under rule 54 as follows:

G 54. Upon completion of the evidence the Registrar shall give notice to the parties of a date when he will hear the arguments in the case...
H Within seven days from the receipt of the notice any party who intends to appear shall so notify the Registrar on Form TMS. A party who receives notice as aforesaid and who does not, within seven days from the receipt thereof, so notify the Registrar on Form TM 8, may be treated as not desiring to be heard and the Registrar may act accordingly.

I In the matter before me the applicant and the opponent complied fully with the above procedure. And as it turned out both were represented

by counsel at the hearing. Mr Uzanda of Donaldson and Wood, advocates, acted for the opponent, while Mr Majithia advocated for the Applicant. A

The applicant vide a counter-statement dated 14 September 1997 denied all the above grounds of opposition while emphasizing that the opponent's mark Konyagi and device does not resemble the applicant's trade mark Giyangi and device. B

A statutory declaration made by Mr CA Kayuni, General Manager of Tanzania Distilleries Ltd stated that Konyagi was registered as far back as 1 June 1970 and that since its registration it has been extensively used and that the sales have grown from 122, 445 cartons in 1989 worth TZS. 1 037 225 310-00 to 186 231-00 cartons worth TZS. 3 066 197 670-00 in 1993. It was in the evidence that these sales have been realized after extensive advertisements which, over the last five years only, have cost the appellant from TZS. 5 526 498-00 to TZS. 29 021 000-00 to date and that due to the high quality, the appellant's gin has acquired a high reputation throughout Tanzania which the applicant is trying to appropriate by using a deceptively similar or resembling trade mark Giyangi. C D E

In a statutory declaration in reply, Khuzena Rajabali Mussaji, General Manager for Messrs. Vitamin Foods (1989 Ltd, the applicant contended that the trade mark Giyangi and device is visually and phonetically different from the opponent's trade mark Konyagi and device and that the flavour, colour and packaging have no resemblance to the Konyagi mark. Mr Mussaji also submitted declarations by Ambrose Mushi, Salim Karim and Vallabh Suchak, businessmen who own restaurants. These three people alleged that they and their customers have never been deceived or confused by the two trade marks. These four statutory declaration in reply were countered by Mr CA Kayuni who in his reply stated that he has received numerous complaints from dealers and consumers of Konyagi to the effect that Giyangi is causing considerable confusion amongst consumers who, on first contact with Giyangi invariably mistake it for Konyagi until they taste the product which, they allege, "smell like a cheap perfume" and in other respects is markedly inferior to Konyagi. To prove his F G H I

A point Mr CA Kayuni submitted affidavits of AP Mwatonoka, Beatrice
Makenge and JD Njau which stated that at first contact with Giyangi
they invariably mistook it for Konyagi or thought it was a variation
of Konyagi until they tasted the product and realized that it was a
B different product altogether and that it smelt like perfume.

Mr Uzanda submitted before the Registrar that his client's trade
mark Konyagi and device has acquired a great reputation after intensive
and extensive publicity. He attacked the applicant's counter statements
C saying that they were incompetent because they did not comply with
section 21(4) of the ordinance and rule 48 of the Trade Marks Rules
1958 nor with Trade Mark Form TM7. This means that the applicant
failed to give positive factors in his own favour, for instance that
D the mark is registerable. A counter-statement, in his opinion, should
not consist of mere denials of the grounds of opposition. He requested
the Registrar to rule that the counter-statements were incompetent
and irrelevant. It was the further contention of Mr Uzanda that all
E along the applicant had failed to show how he came to adopt the
trade mark Giyangi i.e. whether the word Giyangi was invented as
required under section 12(1)(e) on registerability of trade marks.
Failure to do so, he submitted, is fatal and the Registrar should have
F concluded that the mark was copied from another reputable trade
mark. He cited the cases of *Kaisha (1)* and *Rolex Chemical Industries (2)*.

In both cases the applicants were not able to satisfy the tribunal
as to how they adopted the trade marks. Their applications were rejected.
G Mr Uzanda later submitted that the statutory declarations of the applicant
are worthless because they do not comply with rule 50 of the Trade
Marks Rules 1958 because, as stated before in the statutory declaration
in reply, it does not give grounds (positive factors) relied upon in
H the applicant's case. It allegedly consists only of denials. In the same
vein he prayed that the Registrar reject the statutory declarations
by A. Mushi. Section Karin and V Suchak should also be rejected
because they are mere dealers of alcohol and other beverages and
I not the ultimate consumers as stated by *Kerly, Law of Trade Marks*
page 451 paragraph 836.

the evidence should be from the ultimate purchaser of the product because dealers often collude with the manufacturers in deceiving the public.

Mr Uzanda argued in detail the grounds of opposition numbers 1 to 7. On the first ground of opposition, that the trade mark is not registerable under section 12(a)-(e) of the ordinance on the ground that is not an invented word, he cited the cases of *Eastman Photographic Materials Ltd* (3) page 476 also quoted by *Kerly* at page 105 where Lord Shand stated:

There must be an invention and not a mere appearance of an invention.

In his introductory remarks Mr Majithia submitted that the advocate for the opponent was deliberately misleading the Registrar by quoting 18th, 19th and early 20th century English cases which have very little relevance to the law, practice and the people of Tanzania. In his opinion the law must take into account the characteristics and behavior of the people it concerns. In his opinion whatever is the position of the law under these old cases the position of the law is clear in Tanzania where section 54 of the Trade Marks Ordinance provides that the Registrar may accept evidence "*viva voce*" in lieu of or in addition to the declarations submitted under rules 49 of the Trade Marks Rules 1958. He then asked the Registrar to consider the oral evidence of Mr Y.M. Maneck, the Managing Director of Vitamin Foods (1989) Ltd. This witness stated that when they decided to produce a gin-based product the question of a trade mark arose. The applicant decided to get public opinion on the trade mark. The company published a notice in the newspaper about a competition on suggesting a suitable trade mark for its gin.

A number of suggestions were made but the company narrowed down the suggestions to Ginyagi and the device of a thumb. The other items added were a flaming torch and the words "Kiburudisho chako" in a black belt. Prize money totaling TZS. 25 000 was given to the successful winners. It was categorically denied that there was copying from Konyagi. Indeed if there was any copying it was done by Tanzanian Distilleries Ltd who merely altered the French word

- A Cognac to Konyagi. It was contended that their product is a high quality gin which has been approved by Tanzania Bureau of Standards which inevitably and by law sets standards of various products manufactured in the country and tests the products before they are issued with certificates of approval.
- B

C It was in the evidence of the applicant that the packages of the two products are different and the background colour in the Ginyagi trade mark is cream while that of Konyagi is yellow. It was claimed that the word Ginyagi is in white letters while Konyagi is in black. Regarding the licencee MacIntosh International rather than Vitamin Foods (1989) Ltd on 18 December 1992 the applicant formed and registered a business name number 95584 Mackintosh International

D which it owns 100%. Thus the public would not be deceived because McIntosh International is not a limited liability company but a mere business name for the blending, bottling and trading of the gin product. The Company has further advertised the product Giyangi extensively

E and the product is consumed by large numbers who have not to date complained on the opinion or smell. Hence the contention that this opposition is base-less, it arose out of sheer business jealousy of a business competitor.

F In the end, and after evaluating the evidence the registrar dismissed the opposition. Hence this appeal. Seven grounds have been advanced, namely that:

- G
1. that the learned Registrar erred in law in failing to pronounce or deliver the ruling (hereinafter called (the decision) in the presence of the appellant;
 2. that the learned Registrar erred in law in admitting oral evidence over the objections of the appellant and in clear breach of the express provisions of the Trade Mark rules;
 3. that the learned Registrar erred in law in admitting oral evidence after the appellant had made its final submissions;
- H
- I

4. that the learned Registrar erred in law in failing to hold that the counter statement filed by the respondent was defective in substance and did not contain the grounds stipulated by the law; A
5. that the learned Registrar erred in law in failing to hold that the statutory declarations filed by the respondent were defective in substance and contained no evidence in support of the respondent's application; B
6. that the learned Registrar erred in law in failing to hold that the counter statement and statutory declarations of the respondent disclosed that the respondent had failed to comply with the minimum statutory requirements for registration of a trade mark and that therefore the opposed mark was not registerable; C
7. that the learned Registrar misdirected himself and failed to perceive that the appellant had opposed the proposed registration of the word *Giyangi* and not both the word and the device; D
8. that the learned Registrar erred in law and in fact in failing to hold that trade mark *Giyangi* so nearly resembled trade mark *KONYAGI* as to be likely to deceive or cause confusion and that the appellant had adduced overwhelming evidence that trade mark *Giyangi* had actually caused deception and confusion; E
9. that the learned Registrar erred in law and in fact in failing to hold that trade mark *Giyangi* was not being used by the respondent and that this was in itself an act of deception which would inevitably lead to further deception and confusion; F
10. that the learned Registrar erred in law and in fact in deciding the opposition against the weight of the evidence before him and against established principles of law relating to registration of trade marks; G
11. conducting the proceedings in an arbitrary and chaotic manner in disregard of fundamental rules of procedure; and H
12. that in the alternative, the decision was not made by or under the direction of the Registrar as required by law. I

A Mr Majithia has raised preliminary objection in the matter. He contends that the appeal is incompetent because the Memorandum of Appeal is not accompanied by a copy of the decree (or order) appealed from as required by Order XXXIX of the Civil Procedure Code, 1966.
B He, therefore, prays that this appeal be dismissed for incompetence.

He relies on decision in the following cases:

1. *Solanki Tailors v. Nagji Harji Kara* (4)
- C 2. *Kotak Limited v. Kooverji* (5)
3. *Farrab Incorporated v. The Official Receiver and Provisional Liquidator* (6)
- D 4. *Yusufu Mntambo and others v. Moez Alidina* (7)
5. *Mariam Abdallah Fundi v. Kassim Abdallah Farsi* (8)

In addition he has referred me to excerpts from the decision of the Registrar which relate to the alleged conduct of Mr Uzanda and comments thereon as follows:
E

It must be noted at this juncture that while the witness was giving his oral evidence the advocate for the opponent, Mr F.H. Uzanda unceremoniously and, without leave of the hearing officers, walked out of the chambers.
F So at the end of the testimony the witness was not cross-examined by the advocate for the opponent.

In Mr Majithia's view that was a gesture of the highest disrespect to the Registrar. It also amounted to Mr Uzanda abandoning or withdrawing from the hearing. By his said behavior he had forfeited/abandoned all his rights. Consequently, he has no right to challenge the decision in the way he has done. In any case, he contends, that decision is unimpeachable.
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H

Mr Uzanda has invited me to dismiss the objections because they are misconceived. He contends that the making of an appeal from the Registrar of Trade Marks to the High Court is not a proceeding before the court and, therefore, it is not governed by the Civil Procedure Code. For this proposition he relies on: *East African Tobacco Co.*
I

Ltd. v. De Erven de Wed J. Van Nelle, NV (9). It is learned counsel's contention that nowhere in the Trade Marks Ordinance, Chapter 394, is there any provision requiring an order or decree to be extracted, and that the Registrar has no power to issue a decree nor to draw up an order. He has cited *Chesebrough – Ponds Inco. v. Gupyaka* (10) and *Wella AG v. Halais Rochemie Industries* (11).

Now according to Mr Majithia appeals from decisions of the Registrar ought to be governed by Order XXXIX, rule 1(i) of the Civil Procedure Code. For ease of reference the relevant part provides thus:

- 1(i) Every appeal shall be preferred in the form of memorandum ... The memorandum shall be accompanied by a copy of the decree appealed from the (unless the court dispenses therewith of the judgment on which it is founded).

The heading of Order XXXIX clearly shows that the provisions in that part of the Civil Procedure Code (the code) relate to appeals from original decrees from courts that are subordinate to the High Court. Section 70 of the code makes it even clearer. It provides:

- 70(i) Save where it is expressly provided in the body of this code or by any other written law for the time being in force, an appeal shall lie to the High Court from every decree passed by a court of a Resident Magistrate or a District Court exercising original jurisdiction.

By exclusion Order XXXIX does not even apply to appeals originating from primary courts. The cases that have been cited by Mr Majithia are therefore distinguishable from the instant appeal.

There is, however, a procedure by which appeals from the decision of the Registrar of trademarks may be preferred. Section 116 of the Trade Marks Ordinance is clear on the subject. It states:

116. When any person intends to appeal to the court, such appeal shall be made by memorandum in the usual way, and no such appeal shall be entertained unless a Memorandum of Appeal delivered within sixty days from the date of the decision appealed against or within such further time as the Registrar shall allow.

A rule 116 of the Trade Marks Rules repeats word for word the provisions of section 116 which must be applied *in tandem* with the word "prescribed" as defined by section 2 of the ordinance to mean:

B ... in relation to proceedings before the court, prescribed rules of court, and in other cases, prescribed by this Ordinance or the rules.

C In my interpretation this part of the ordinance does not apply to an abstract. It applies to proceedings before the court. The proceedings must first be instituted, and then thereafter rules of court will apply. Proceedings once instituted, will not move forward unless certain steps are taken. First the respondent must be served. A date for hearing the appeal will then be fixed. If any of the parties fails to appear then the consequential action under the Civil Procedure Code will follow.

D The execution of the decree in appeal of the court will have to follow what Order XXI makes provision for. Otherwise no law of procedure other than section 116 of the ordinance and rule 116 of the Trade Mark rules, governs the lodgment of an appeal against the decision of the Registrar. It seems to me that it is by reason of identical legislation that Dalton, C.J., as then was, said this, in *East African Tobacco Co. Ltd. v. De Erven de Wed J. Van Nelle, NV* (9) at page 577:

G It has been urged before me, however, for the Appellants that having regard to the definition of the word "prescribed" in section 2 of the ordinance one must look to rules of court, and not to rules made under the ordinance to ascertain the correct method of making the appeal. If one looks to rules of court for this purpose one must follow the procedure for making appeals laid down in the Civil Procedure Code in an ordinary action, since there are no other rules of court governing the matter.

H The answer to this argument, it seems to me, is that whereas appeals when before the court are governed by rules of court, the making of an appeal is not a proceeding before the court. If that is so an appeal must be made in the manner prescribed by the ordinance or the rules under it. This seems to follow from notes in "**Kerly on Trade Marks**", (4 ed),

page 102 (foot-note 2) and page 685 (note to section 60). It has never been even suggested so far as I can ascertain in any English case that rule 122, a rule made by the Board of Trade and not a rule of court, is *ultra vires* of the act in that it relates to a proceeding before the court when it provides how an appeal shall be made. I can find no suggestion anywhere that the procedure followed in respect of making appeals under section 12 of the Act, i.e. by motion, is incorrect or irregular. In the circumstances set out above Mr Houry's argument must go as far as that, but the unquestioned practice is all against him.

Mr Uzanda has also referred to *Chesebrough Pond's Inc. v. Gupyaka (1973) Agencies* (10) and *Wella AG Hais Prochemie Industries* (11) as supporting the proposition that there is no requirement that a Memorandum of Appeal against the decision of the Registrar need not be accompanied by a copy of the decree. None of these two latter cases decided that point. Nevertheless, and upon the reasons and the observations I have made I hold that the respondent's objections are misconceived. They would fail.

I now turn to consider the appeal on the merits. Let me say right from the outset that only Mr Uzanda has offered in respect introspect of the appeal. Mr Majithia did not. So my approach will be deliberation of the matter as if it were an *ex parte* proceeding.

My examination of the Memorandum of Appeal leads me to the view that the appeal falls under three major parts. Grounds 1, 2, 3, 4, 5, 6, 11 and 12 relate to procedure; grounds 7, 8 and 9 relate to deception and confusion and ground 10 arises from the way the Registrar appreciated the evidence. The appeal will therefore be considered on those lines. And, although Mr Uzanda chose to argue the seventh ground ahead of the rest, I will consider them seriatim.

The conduct of the Registrar has come under sharp criticism. For while this cause was pending the respondents got their trade mark Giyangi registered. In clear condemnation this court, Mapigano, J., called the Registrar's conduct constructive fraud. He later quashed that registration and ordered the certificate of registration be withdrawn

A and called. That decision was made in *Tanzania Distilleries Ltd v. The Attorney General*, (12). The Registrar was exercising quasi-judicial powers, so what is complained of here is judicial bias. What, then would be the effect of the judicial bias, if established?

B Judicial bias is a state of mind; it is a predisposition to decide a cause or matter in a way which does not leave the mind open to reason and logic. And, as the learned authors of **Black's Law Dictionary**, Abridge (6 ed), say, judicial bias is:

C ... Condition of mind which sways judgment and renders judge unable to exercise his functions impartially in particular case. As used in law regarding disqualification of judge, refers to mental attitude or disposition of the judge toward a party to the litigation, and not to any views that he may entertain regarding the subject matter.

D My reading of the ruling in Miscellaneous Civil Cause Number 47 of 1996 shows that the Registrar's mental inclination went beyond mere irrational preference or prejudice against the appellant. What happened was this. Upon dismissal of their opposition to the application to registrar the trade mark Giyangi and Device, the appellants took steps to appeal. In those circumstances section 21 subsections (6) and (7) of the Trade Marks Ordinance has the effect of staying any decision on the application until the High Court has finally determined the appeal. The Registrar proceeded to make the registration while this appeal was still pending. It is in those circumstances that Mapigano, J, said at page 5 of his ruling that:

G It is curious and relevant, I think, that the Registrar acted as he did. He had been duly put on notice that the applicant intended to take his decision to this court on appeal. It is not controverted that his action was unprecedented and I therefore take it to be true. Mr Uzanda has termed the action as one verging on absurdity... But I will content myself calling it curious, overhasty, inordinate and injudicious.

H On such a record of performance on the part of the Registrar no one will doubt the force in Mr Uzanda's argument in the first ground. It would succeed.

I

Grounds two and three have been consolidated. They relate to the adduction of evidence. The law relating to the production of evidence has already been discussed. What is at issue here then is whether oral evidence may be adduced in addition to the statutory declarations. It appears to be common ground that section 54 of the Trade Marks Ordinance makes provision for the production of oral evidence. What is at issue is the stage in the proceedings at which such evidence may be adduced. Mr Uzanda contents that such evidence has to be tendered in the same manner as applied to statutory declarations and this must be done before submissions from learned counsel are recorded. In the instant case oral evidence was taken after Mr Uzanda and Mr Majithia had made their submissions.

I take the view, as submitted by Mr Uzanda, that section 54 of the ordinance does not entitle any party to adduce evidence after learned counsel have made their final submissions. For it provides, for ease of reference:

In any proceedings under this ordinance before the Registrar, the evidence shall be given by statutory declaration in the absence of directions to the contrary, but, in any case in which the Registrar thinks it right so to do, he may take evidence *viva voce* in lieu of or in addition to evidence by declaration. Any such statutory declaration may in the case of appeal be used before the court *in lieu* of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

In case any part of the evidence is taken *viva voce*, the Registrar shall, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as a magistrate.

Since the purpose and scope of section 54 is to allow parties to produce evidence before final submissions by counsel, the Registrar was required to give reasons, especially after Mr Uzanda had raised objections to that course of action, why he had decided to take additional evidence from the applicant. In particular, he had to be satisfied, and the record had to show the reasons, that the evidence was not available at the time when it ought to have been presented along

A with the statutory declaration or in addition to it, or *in lieu* of. As
always is the case admission of additional evidence involves an exercise
of discretion. It is now so trite that I need not cite any authority in
B saying that discretion must be exercised judicially on reasonable
grounds which are capable of being clearly stated. I therefore uphold
Mr Uzanda in his argument that the admission of evidence after both
learned counsel had made their final addresses to the Registrar was
not a proper exercise of discretion. It is in that circumstance that I
C now hold that the second and third grounds of appeal would succeed.

The fourth, fifth and the sixth grounds are inter-related. They
will be considered together. It is contended by Mr Uzanda that the
respondent filed a counter statement which was so gravely defective
D in substance that the Registrar should have rejected it.

The requirements that must be met in a counter statement are
provided for in section 21(4), rule 48 and Form TM7 of the Trade
Mark Ordinance. Subsection (4) of section 21 makes it a requirement
E that the applicant shall send to the Registrar, in the prescribed manner,
a counter statement of the grounds on which he relies for his application.
The counter statement has to be prepared in the form of Form TM7.
The applicant must show how, and on what grounds, he lays proprietary
F rights over the trade mark he seeks to register. I have examined the
counter statement. All it contains, as Mr Uzanda argues, are denials
over the contents of the notice of opposition. In some paragraphs
denial followed by amplifications, not grounds upon which the applicant
G would rely. I will reproduce the contents of the counter statement
in respect of paragraphs 2, 3, 4, 5, 6, 7 and 8 to underscore this
point.

They read thus:

- H
1. That proper reasons/grounds are not advanced as to why the applicant's mark is not registerable.
 2. That the allegations contained in this paragraph are denied. That
I the applicant's mark is clearly distinctive.

3. That the allegations contained in this paragraph are denied. That the applicant's mark does not resemble the mark of the opponent and was not likely to deceive or cause confusion. A
4. That the allegations contained in this paragraph are denied. That all allegations in this paragraph are speculative and based on prejudiced assumption. That the application does not cover goods or goods of the same description as those of the opponents. Again they would not be sold through the same outlets. And the matter of causing confusion and/or deception does not arise. B
C
5. That the allegations contained in this paragraph are denied. That the applicant's mark is clearly distinctive. That it would not deceive or confuse. D
6. That the allegations contained in this paragraph are denied. Again they, like others above, are merely speculative and not based on evidence. That the applicant's mark is not being used as an act of deception. Again it will costs." E

It is my considered view that in order to meet the requirements of the law a counter statement must take the form of a Written Statement of Defence in a civil suit. If it contains denials and if it is merely evasive a counter statement should meet the same fate as an evasive Written Statement of Defence. In these circumstances I am not persuaded that the counter statement advances grounds on which a defence to the opposition could be founded. F

It is contended in ground five that the statutory declarations that were filed by the applicant were worthless; they should have been rejected by the Registrar because they do not conform to rule 50 of the Trade Mark rules. According to learned counsel this ought to have been so because those statutory declarations are limited to denying infringement and passing off. I must say that this argument is not tenable. It is one thing to contend that testimony is irrelevant, which Musaji's statutory declaration is, and it is another thing to say that such testimony should be rejected. Evidence will not be rejected on the sole ground that it is not probative of any fact. True G
H
I

A in the instant case the statutory declaration of the said Musaji does not have any probative value. It is evidence of a person who is not the final consumer of Giyangi. The evidence required in this kind of proceeding is as the learned authors of **Kely's Law of Trade**

B **Marks and Trade Names**, (12 ed), say at page 367, that:

the persons to be considered in estimating whether the resemblance between the marks in question is likely to deceive are all of those who are likely to become purchasers of goods upon which the marks are used.

C And at page 347 the learned author states:

It is clearly not enough to show that retail dealers buying goods for resale would not be deceived, since they might themselves fraudulently or carelessly make use of the ambiguous character of the trade mark to deceive their customers, the ultimate purchase or more likely, in these days of self-service, allow customers to deceive themselves. Dealers who buy from the manufacturers in order to sell by retail may be aware of attempt infringement and parties to the fraud.

E I am therefore satisfied that the statutory declarations that were filed by the applicant did not meet statutory requirements.

F As to ground six it is learned counsel's submissions that the provisions of section 21(4), rule 48 and Form TM 7 of the Trade Marks Ordinance were not complied with in some other respects. The alleged shortcoming arises from the contention that the applicant did not state the grounds on which he relies as supporting his application. What the applicant did, it is submitted, was to put up a defence when the law did not require him to do so. In other words, he should have demonstrated that his application complied with section 12(1) of the Trade Marks Ordinance. It provides thus:

H (1) In order for a trade mark (other than a certification trade mark) to be registerable in Part A of the register, it must contain or consist of at least one of the following essential particulars:

I (a) the name of company, individual, or firm, represented in a special or particular manner;

- (b) the signature of the applicant for registration or some predecessor in his business; A
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname; B
- (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c) and (d), shall not be registerable under the provisions of this paragraph except upon evidence of its distinctiveness. C
- (2) For the purposes of this section "distinctive" means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, whether the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration. D
- (3) In determining whether a trade mark is adapted to distinguish as aforesaid the court or the Registrar may have regard to the extent to which: E
- (a) the trade mark is inherently adapted to distinguish as aforesaid; and G
- (b) by reason of the use of the trade mark of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid: H
- Provided always that any mark which has been registered as a distinctive mark in Part A of the Register kept in the United Kingdom under the Trade Marks Act, 1905 – 1919 and the Trade Mark Act, 1938, shall be deemed to be a distinctive mark for the purposes of this Ordinance. I

- A Learned counsel views the provisions of section 12(1) as being absolutely mandatory provisions which lay down in no uncertain terms that no application can be accepted and registered unless its provisions have been complied with. He may be right. For surely, as it seems to me,
- B the word Giyangi does not appear to be invented. It is a coinage from two words from which Gin and yagi have been derived. Mr Uzanda submits that the word yangi is derived from Konyagi. The prefix, Gin is an alcoholic drink. I am persuaded that he is right.
- C And, according to English case law which is relevant to this subject, the mere combination of two English words, or Kiswahili words for that matter, does not constitute an invention of a trade mark. This is what was held in *Eastman Photographic Materials Company v. Controller General of Patents Designs and Trade Marks*, (1898) AC 5781 and 581 where Lord Herschell said:
- D

E I do not think that combination of two English words is an invented word, even although the combination may not have been in use before; nor do I think that a mere variation of the orthography or termination of a word would be sufficient to constitute an invented word.

And Lord Shand was of the same opinion when he said at page 585 that:

- F There must be invention, and not the appearance of invention only. It is not possible to define the extent of invention required, but the words, I think, should be clearly and substantially different from any word in ordinary and common use. The employment of a word in such use, with a diminutive or a short and meaningless syllable added to it, or a mere, combination of two known words, would not be an "invented" word.
- G

H Another restriction that has been created by section 12 is that the trade mark must be distinctive. It must not admit of any deception. Section 12(i)(e) of the ordinance requires also that in order a trade mark to be registerable, it must contain or consist, in addition of the other statutory requirements, of the following:

- I (e) any other distinctive mark, but a name, signature, or word as words, other than such as fall within the descriptions in the foregoing paragraphs

(a), (b), (c) and (d) shall not be registerable under the provisions of this paragraph except upon evidence of its distinctiveness. A

Subsection (2) provides further that for the purposes of section 12:

... "distinctive" means adapted, in relation to the goods in respect of which a trade mark is registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered subject to limitations, in relation to use within the extent of the registration. B C

Section 12(i)(e) traces its origin from section 9(5) of the English Trade Marks Act 1905. These provisions came under scrutiny in the cases of *In Re Joseph Crossfield and Sons Limited (14)*, where it was held, *per Fletcher Moulton, L.J.* that: D

... It is for the applicant to prove that words *prima facie* unsuitable for registration have acquired distinctiveness, and the extent to which the court will require the proof this acquired distinctiveness to go will depend upon the character of the word. In determining whether a word *prima facie* descriptive ought to be admitted to registration as a trade mark the court ought to consider whether the registration will cause substantial difficulty or confusion in view of the provision of section 44 that no registration shall interfere with the use by any person of any *bona fide* description of the character or quality of his goods ... E F

I propose to apply the above observations in the determination of this appeal. I may here add that the word "distinctive" when used in the law of trade marks is synonymous with the word "descriptive". So a word used as a trade mark must not only be distinctive, it must also be descriptive of the goods or manufacture in respect of which that word is registered. Thus where a word has not completely come to be identified with the goods of some person the use of it by any other trader as a trade mark for an apparently identical product must be deceptive. It will be in the public interest if an application for registration of a such a trade mark by the latter trader be rejected. G H I

A Now what is a distinctive trade mark? Mr Uzanda has referred me to the English case of *Wood v. Buttler and Lambert* (15). In that case Lindley, L.J. Said:

B A distinctive Trade Mark must mean some mark which distinguishes the goods to which it is attached as those made or sold by the person who used the mark.

And Lopes, L.J. in the same case said:

C It ought to be a special and distinctive mark, not only recognizable by the trade, but also recognisable by the consumer as connecting the article with the manufacturer.

D I will adapt and apply the observations of Lords Lindsey and Lopes on this matter. The issue which flows from the foregoing observations is whether the word Giyangi meets the conditions in *Wood v. Buttler and Lambert*? Of course the onus of proof lies on the applicant to prove that there will be no reasonable probability of deception if his trade mark is registered. In this connection Mr Uzanda has submitted that the trade marks Konyagi and Giyangi have a strong phonetic similarity and resemblance which was not brought about by coincidence. To him what the respondent did was to remove "KO" from Konyagi and substituted it with "Gi". And that phonetic resemblance is accentuated by the fact that "Konyagi" is Swahili word and therefore the emphasis is on the second and third syllables. The second and third syllables are therefore the essential features of the trade mark "Konyagi". He contends that in trade mark law close resemblance is established when the essential features of any two marks are the same. For instance, this principle was applied in "*Revenhead Brick Co. Ltd v. Buabon Brick Co. Ltd*" (16) "**KERLY**" (9 ed), page 454 where it was held that SANRUS closely resembled RUS.

H Another is the *Parker-knoll* case (17) where it was held that the essential feature of "*Parker-knoll* was *Knoll* and that therefore there was a close resemblance between *Parker-Knoll* and *Knoll International*..

I That since there is a close resemblance in the present opposition

between Konyagi and Giyangi, the application ought to have been refused registration. A

I am satisfied, after taking due account of Mr Uzanda's arguments, that he may be right, particularly after considering what was said regarding a similar issue in the English case of *In the matter of an Ld for the Registration of a Trade Mark (The Pianist Case)*, (18) at page 775 where Parker, K, observed, in a case such as the one before me, that: B

You must take the two words. You must judge them, both by their look and by their sound. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; any you must further consider what is likely to happen if each of those trade marks is used in a normal way as a mark for the goods of the respective owners of the marks. C D

Since Konyagi and Giyangi are alcoholic drinks of the type of gin, an ordinary consumer who is not sufficiently literate, is likely to be deceived. I would therefore allow the sixth and the eight grounds. E

Ground ten is very cognate to ground eight. It is submitted by Mr Uzanda that the Registrar misdirected himself in holding that the first syllable is a word mark is in all circumstances the most important in determining whether there is resemblance in any two marks. I agree. For as the learned authors of *Kerly*, (12 ed) say at page 445 say: F

It has been accepted in several reported cases that the first syllable of a word mark is generally the most important. It has been observed in many cases that there is a 'tendency of persons using the English language to slur the termination's of words. G

Accordingly, the tenth ground would also succeed. H

The basis of the appeal in the ninth ground is this. On the label of the product Giyangi there are these words: Blended and Distilled by *McIntosh International*. It thus seems that some other firm distils and blends the gin other than the applicant. It is in that context I I

A understand Mr Uzanda to argue that the respondent does not use the trade mark Giyangi. He cites **Kerly** at page 171 as authority for his arguments. The learned authors of that book observe:

B A mark may be disentitled to protection on the ground that it is confusing or deceptive as to the trade origin of the goods.

C The learned authors cited *Wood v. Lambert and Buttler*, (15). In *Wood v. Lambert and Buttler* Messrs Wood were makers of a variety of cigarette. Evidence established that in the late 1880's customers lost taste with English Cigarettes. In order to compete with popular brands from Russia and other parts of Europe Messrs Wood made cigarettes for Messrs Lambert and Buttler: *Constantinople, Jancal Tachta Cigarettes*. There was nothing on those cigarettes about Wood or Lambert and Buttler. As Lord Lindsey said at page 260:

E For the purpose of enabling Lambert and Butler to sell these goods, Messrs. Wood's goods, as something which is distinctly not Messrs Wood's. Persons in the trade, persons knowing the secrets of the trade, may not be deceived, but any buyer would be deceived by this. It would be perfectly impossible for any purchasers of cigarettes not in the secrets of the trade to understand these words to mean Messrs. Wood's cigarettes.

F There was also evidence that Messrs Wood, who were manufacturers of a blend of cigarettes known as Eton undertook to sell those cigarettes under the brand Mavrogordato as having been a product of St. Petersburg, presumably a city in Russia. The word Eton also appeared on the cigarette. After considering the evidence Fry, LJ, made the following observations at page 263:

H How is it possible for the plaintiffs to say that the label with the word "Eton" upon it is distinctive of their manufacture when they themselves have represented that the "Eton" cigarettes are made by people in St. Petersburg? Precisely similar observations apply to the other case, namely, the "Jancal Tachta": label. There the plaintiffs themselves designed for the defendants a label which represents the cigarettes contained in the box as being the product of a Constantinople firm; and I repeat the question, I how is it possible for the plaintiffs to say that the word "Eton" is distinctive

of their manufacture when they for a second time have represented it as being the manufacture of another person? In my judgment where a person uses a name and represents that name to be applicable to the product of a manufacturer or manufacturers other than himself, so as to produce the belief that the goods are the manufacture of that third person or persons, he cannot say that the word is distinctive of his own manufacture. Nor do I think that principle applies the less because the plaintiffs may be false in the assertion that there is any such firm or firms as the manufacturer represents. He who has made the goods has taken upon himself to represent two things: in the first place, that they are not his manufacture but somebody else's in the second place, that a firm exists which does not exist at all. It appears to me that the plaintiffs have by that conduct entirely precluded themselves from contending in this case that the word is a distinctive word or words.

English case law that I have quoted clearly shows that a manufacturer will be guilty of deception if he undertakes to market his products under a trade mark to which he does not have an apparent connection. He will deceive the consumers that the products on sale are manufactured by a third party. I would add that such conduct amounts to fraud as well. Indeed, such conduct would be sufficient ground upon which to refuse an application for registration of a trade mark which does not have an apparent relationship with the applicant. It is in that context that I can see no relationship between the respondent and Messrs. McIntosh International under which Giyangi is intended to be marketed. So not only is the respondent guilty of deception in this case, the trade mark he seeks to have registered has not passed the required test of distinctiveness.

When considering this issue the Registrar observed that according to the Certificate of Registration of the business name McIntosh International the sole proprietor of this business name is Vitamin Food (1989) Ltd who owns 100% of the business. McIntosh International is not, therefore, a legal entity so there is no deception or confusion of the identity of the owner of the business Vitamin Foods (1989) Ltd. That the name may appear to be connected with Scotland but

- A this is beside the point and to date there has been no complaint on
appellation of origin. The position of Messrs. McIntosh International
may as well be so, but how would one expect an ordinary person, an
ordinary buyer of Giyangi to know that Messrs. McIntosh International
B is a wholly owned subsidiary of the respondent? A person interested
in that drink would not go beyond what the label on the bottle says.
By that name buyers would be misled to believe that Giyangi is
distilled and blended by a foreign company or by a company other
C than the respondent. So the label carries a lie about itself. Upon
these observations, therefore, the ninth ground would succeed.

The eleventh and twelfth grounds have been abandoned. Upon
the reasons and grounds contained in this judgment, the appeal succeeds.

- D Appeal allowed with costs.

E **GEORGE LUGGA MALIYAMKONO v. PRINCIPAL
SECRETARY OF THE MINISTRY OF SCIENCE,
TECHNOLOGY AND HIGHER EDUCATION AND
F TWO OTHERS**

HIGH COURT OF TANZANIA
AT DAR ES SALAAM

G (Chipeta, J.)

MISC. CIVIL CAUSE No. 29 OF 1998

- H *Judicial Review – Grounds for Judicial Review of an administrative decision –
Power to terminate an employee vested in the Permanent Secretary –
Decision to terminate made on the basis of a report submitted by a committee
set up to enquire into the allegations made against the applicant – Whether
I the decision was intra vires.*