

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

**MISC. CIVIL REFERENCE NO. 14 OF 2005
IN THE MATTER OF THE TRADE AND SERVICE
MARKS ACT 12/86**

AND

**IN THE MATTER OF APPLICATION FOR REMOVAL OF A TRADE
MARK FROM THE REGISTER**

AND

**IN THE MATTER OF TRADE MARK NO.22065 “ROYAL
CHALLENGE MCDOWEL AND/OR MC KINTOSH (WORD
& DEVICE) IN CLASS 33 REGISTERED IN THE NAME
OF VITAMIN FOODS (1986) LIMITED**

BETWEEN

THE SCOTCH WHISK ASSOCIATION.....APPLICANT

AND

VITAMIN FOODS (1986) LIMITED.....RESPONDENT

- Final submissions by counsel: 1 July 2005
- Date of Judgment – 15 July 2005.

Counsel: Mr. Kishebuka for Applicant
Mr. Kesaria for Respondent

J U D G M E N T

Dr. BWANA, J:

Introduction

1. This matter was referred to this court pursuant to the provisions of sections 49 and 55 of the Trade and Service Mark Act No. 12 of 1986. the said section 49 states:-

“ When any matter to be decided by the Registrar under this Act appears to him to involve a point of law or to be of unusual importance or complexity, he may, after giving notice to the parties, refer such matter to the court for a decision and shall thereafter in relation to such matter, act in accordance with the decision of the court”

In addition, section 55 states:

“Where under any of the foregoing provisions of this Act an applicant has an option to make an application either to the court or to the Registrar and such application is made to the Registrar, the Registrar may, at any stage of the proceedings, refer the application to the court or may, after hearing the parties, determine the question between them, subject to appeal to the court.”

2. The Registrar made reference to this court because she considers this matter to be of unusual complexity, especially the three issues raised by the applicant namely-
 - 2.1. The registration of the (new) trade mark was illegal.
 - 2.2. The registered trade mark is descriptive and likely to cause confusion to consumers as to the origin of the products.
 - 2.3. The respondent has no nexus with the mark, instead, McKintosh International limited is neither registered nor is connected to the respondent.

According to the Registrar, issue No.2.1. above is the one that troubles her, leading to this reference.

Facts:

3. To appreciate the matters before both the Registrar and before this Court, it is important to give a summary of the issues and facts before us.

Before the Registrar there is an application to expunge the trade mark originally filed as “Royal Challenge McDOWELL”. That trade mark was later amended to be “ ROYAL CHALLENGE MCKINTOSH”. The present respondent is the proprietor of the mark. It is a limited liability company registered in Tanzania with an address in Dar es Salaam. The applicant is a limited liability company registered in Scotland.

4. The trade mark in question was first registered on 4 June 1992 by the respondent. It was advertised – as required under the law - on 30 October 1992. The applicant showed an intention to oppose it and did so on 11 December 1992 and applied for extension of time up to 1 March 1993. However before the expiry of that period, the Registrar issued a certificate of registration to the respondent, while he had already granted an extension of time to the applicant. Realising the error, the Registrar cancelled the certificate on 15 January 1993, pending the determination of the opposition.
5. As though that error was not enough on the part of the Registrar, another mishap followed. After the cancellation of the earlier certificate, the respondent proposed amendments to the mark in question from Royal Challenge McDowell to Royal Challenge McKintosh. Leave was granted on 22 January 1993 but without advertising. A fresh certificate was issued (!). The applicant filed a

fresh opposition to the issuance of the new certificate and applied for the removal of the application.

6. It appears that both the applicant and respondent argued their case before the Registrar who in the end, decided in favour of the applicant. The respondent unsuccessfully appealed on a point *limine litis*. Eventually the matter was reheard before the Registrar but on *ex parte* basis, as the respondent never entered further appearance.

Determination:

7. The pressing issue for determination seems to be: by registering the offending mark without advertising, did the Registrar act illegally? The applicant has raised the following grounds in support of its arguments:-
 - 7.1. That it was procedurally irregular for the Registrar to issue a new certificate of registration, before the expiry of the extension period (1 March 1993). I do concur with the applicant on this aspect. Section 27 (6) of Act 12/1986 (the Act) clearly stipulates:

“ On appeal from the decision of the Registrar under this section, the court may, after hearing the Registrar, permit the trade or service mark proposed to be registered or to be modified in any manner not substantially affecting the identity thereof but in any such case the trade or service mark as so modified shall be advertised in the prescribed manner before being registered” (emphasis added)

The above mandatory requirement for advertising before registration cannot therefore be avoided. It was not done by the Registrar in this case. This fact is admitted by the respondent. I consider that to be a fatal error and not only contradicting the provisions of section 27 (6) of the Act but also Rules 89, 90 and 91 of the Act – which state:-

“89. Where a person desires to apply under section 38 that his registered trade mark may be added to or altered, he shall make his application in writing on Form TM 24, and shall furnish the Registrar with four copies of the mark as it will appear when so added to or altered.

90. The Registrar shall consider the application and shall, if it appears to him expedient, advertise the application in the Gazette before deciding it. Within one month from the date of such advertisement any person may give notice of opposition to the application, on Form TM 45 accompanied by a duplicate of the notice, and may also send therewith a further statement of his objections in duplicate. The Registrar shall send the duplicate notice, and the duplicate of any further statement of objections, to the applicant, and the provisions of rules 48 to 57 shall apply mutatis mutandis to the further proceedings thereon. In any case of doubt any party may apply to the Registrar for direction.

91. If the Registrar decides to allow the application he shall add to or alter the mark in the register, and if the mark so added to or altered has not been advertised under the last foregoing rule, he shall advertise it in the Gazette and in any case shall insert in the Gazette a notification that the mark has been altered.”

7.2. All the above considered, I do rule that the mark “Royal Challenge Mackintosh” whose proprietor is Vitamin Foods

(1989) Limited, the respondent herein, be expunged from the register for having been registered contrary to procedure provided for by the law.

- 7.3. I do understand that the applicant has raised the issues of registration and issuing of the new certificate without payment of fees or not filling the proper form (Form TM 24). These arguments need evidential proof before I can make my finding. Be that as it may, they do not affect my earlier finding to expunge the mark from the register. Likewise, failing to pay the necessary registration fees, if proven, amounts to the document deemed not to have been filed, as stated under section 12 (1) (c) of the Act:

“ 12. (1) Where under the provisions of this Act- (c) a fee is payable in respect of the lodging of a document, the document shall be deemed not to have been lodged until the fee has been paid”.

8. The Registrar has asked this court – if it finds it proper – to adjudicate on the other two points (supra, 2.2 and 2.3) so as to dispose off the whole case. I find it unnecessary at this stage to go into issues 2.2 and 2.3 since the basic issue which is material to the case has already been determined by considering issue No. 2.1. above. Therefore, since the registration of the mark has been found to be illegal as it offends the procedural requirements provided by the Act, the said mark is expunged from the register. It is accordingly ordered.

Dr. S. J. Bwana
JUDGE
15/7/2005

1,434 words