

**VITAMIN FOODS (1989) LTD v. SCOTCH WHISKY
ASSOCIATION****HIGH COURT OF TANZANIA
AT DAR ES SALAAM****(Chipeta, J.)****MISCELLANEOUS CIVIL APPEAL No. 5 OF 1999**

(From the decision of the Registrar of Trade and Services Marks at Dar es Salaam)

Trade Marks – Application for removal of trademark from the register – Locus standi – Aggrieved party – Section 36 of Trade and Service Mark Act 1986.

Trade Marks – Protection of trademarks – Paris Convention of 20 March 1883, articles 2, 7 bis, 9, 10, 10 bis, 10 ter and 22.2 – United Kingdom and Tanzania are parties.

Trade Marks – Application signed by advocate – Application by body corporate – Acceptance of application by the Registrar.

Trade Marks – Ruling signed by one officer only – Section 4 of the Trade and Service Mark Act 1986 .

An application was made to the tribunal presided over by the Registrar, Senior Assistant Registrar and two Assistant Registrars, for the removal from the register a trademark registered in favour of the appellant for a product the appellant described as “Premium Whisky – A Blend of Finest Selected Imported Old Scotch and Malt Whiskies.” The basis of the application was that the said mark was deceptive and likely to cause confusion between that product and the products of the members of the respondent who distill, blend and merchant Scotch Whisky. The appellant raised two Preliminary Objections: (a) that the respondent had no *locus standi* because it had no registered trade mark of its own in Tanzania or in the United Kingdom, (b) that the application had not been properly signed. Both Preliminary Objections were dismissed. The appellant being aggrieved, appealed to the High Court on the grounds that the Registrar had erred in holding that the respondent had *locus standi*, and in holding that the

A application was not defective. A further ground was that the ruling of the tribunal was defective as it was only signed by the Registrar and had not been read in open court.

B **Held:** (i) The respondent is a lawfully registered company and as one of its arms and objects is to protect and promote the reputation vested in Scotch Whisky throughout the world it was a party aggrieved;

C (ii) The respondent, therefore had *locus standi* to bring the application because the law allows any aggrieved party to apply to the Registrar for the removal of an entry from the Register;

D (iii) The respondent has *locus standi* as provided for by article 7 bis (3) of the Paris Convention of 1883;

E (iv) The Registrar correctly accepted the application signed by the advocate of the respondent.

F (v) The tribunal is a quasi judicial body and therefore the provisions of the Civil Procedure Code do not or need not necessarily apply as such the tribunal's communication of its decision to parties concerned by post was proper.

Appeal dismissed with costs

Cases referred to:

F (1) *William Powell v. Birmingham Vinegar Brewery Company Limited* [1894] AC 8

(2) *Wineworths Group Limited v. Comite Interprofessionel du Vin de Champagne*, 2. NZLR 327

G (3) *Taittinger SA and others v. ALLBEL Limited and another* [1993] ChD 641

Statutory provision referred to:

H (1) Trade and Service Mark Act 1986, sections 4 and 36

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JUDGMENT

(Delivered 1 October 1999)

Chipeta, J.: This is an appeal by the appellant, Vitamin Foods (1989) Limited, against the Ruling of the Registrar of Trade and Service Marks rejecting Preliminary Objections raised by the appellant in the course of hearing an application by the respondent, The Scotch Whisky Association. The said application was made to the said Registrar for the removal from the Register of Trade Mark Registration Number 22065 registered in the name of the appellant in Class 33, Royal Challenge. The product is described as "Premium Whisky – A Blend of the Finest Selected Imported Old Scotch and Malt Whiskies". The basis of the application is that the said mark is deceptive and likely to cause confusion between that product and the products of the respondent's members who distill, blend and merchant Scotch Whisky.

In the tribunal, which was presided over by the Registrar, a Senior Assistant Registrar, and two assistant Registrars, the appellant raised two Preliminary Objections, namely, (a) that the respondent had no *locus standi* in the matter, and (b) that the application had not been properly signed. The Registrar rejected both Preliminary Objections.

The Memorandum of Apperal contains two main grounds. The first is that the registrar erred in holding that the respondent had *locus standi* and that the application was not defective. The second ground is that, the Ruling is not a proper ruling of the tribunal in that it was not written and signed by the Principal Officer, that is, the Registrar, and that it was not read and delivered in the tribunal in open court. By the order of the court, the learned advocates of the parties in this appeal filed written submissions. I am indebted to them for their lucid submissions. I do not intend to reproduce them here but will refer to them on appropriate occasions in the course of this judgement/ruling.

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A It has been submitted by learned counsel for the appellant that the respondent has no *locus standi* because the respondent has no registered trademark in its own name either in Tanzania or in the United Kingdom, and so the respondent cannot be “a party aggrieved” within the meaning of that expression in section 36 of the Trade and Service Marks Act 1986, (hereinafter referred to as the Act) nor could the respondent suffer any harm or loss.

C This question, it seems to me, centers on the interpretation of section 36 of the Act. The section reads as follows:

D 36 any person aggrieved by the non-insertion in or omission from the Register of any entry, or by any entry wrongly remaining on the Register, or by any error or defect in any entry in the Register, may apply to the court or at the option of the applicant and subject to the provisions of section 55 of this Act to the Registrar, and the court or the Registrar shall make such order for making, expunging or varying the entry as shall be deemed fit.

E It will be noted that the section talks of “any person”. It does not qualify the person. Who then is “a person aggrieved” who would thus be said to have *locus standi* in such applications. The leading authority on this point, it appears to me, is the case of *William Powell v. Birmingham Vinegar Brewery Company, Limited* (1). In that case, Lord Herschell, L.C. stated, at page 10:

G Wherever it can be shown, as here, that the applicant is in the same trade as the person who has registered the trade-mark, and wherever the trade-mark if remaining on the register would or might limit the legal rights of the applicant so that by reason of the existence of the entry upon the register he could not lawfully do that which but for the appearance of the mark upon the register could lawfully, do, it appears to me that he has a locus standi to be heard as a person aggrieved.

H The House of Lords was, in fact echoing the voices in the Court of Appeal in that case. There Lord Bowen, L.J., stated:

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Persons who are aggrieved are persons who are in some way or other substantially interested in having the mark removed from the register, or persons who would be substantially damaged if the mark is retained.

He added:

To my mind, it is equally true that persons would be aggrieved if they are in the same trade and might reasonably be expected to deal in the same article.

(See: *In Re Powell's Trade-Mark*, (1893) 2 Ch 388, at page 406).

Eminent authors on the subject confirm the foregoing to be the meaning of the expression "person aggrieved". They go on to express the view, which I share, that the expression should be interpreted liberally.

(See **Kerly's Law of Trade Marks and Trade Names**, page 179, 12 ed). This approach was approved by Lord Herschell, LC in the *Powell* case in which he stated, at page 10:

I should be very unwilling unduly to limit the construction to be placed upon these words (persons aggrieved), because, although they were no doubt inserted to prevent officious interference by those who had no interest at all in the register being correct and to exclude a mere common informer, it is undoubtedly of public interest that they should not be unduly limited in as much as it is a public mischief that there should remain upon the register a mark which ought not to be there.

Lord Ashbourne added his voice. He stated, at page 14:

I do not see any reasons of public policy rendering it at all desirable to unduly narrow the definition of this class of "persons aggrieved."

In the instant case, the respondent is a lawfully registered company, and one of its aims and objects is to protect and promote the reputation vested in Scotch Whisky throughout the world. The appellant is said to be dealing in "a blend of the finest selected imported Old Scotch and Malt Whiskies". It, therefore, goes without saying that the two parties are in the same trade, and are in fact dealing in the same article, Scotch Whisky. By the definition of the expression "person aggrieved", it is beyond peradventure that the respondent is "a person

- A aggrieved” within the meaning of that expression in section 36 of the Act. In the words of Lord Ashbourne in *Powell’s* case (*supra*), if the respondent in this case is not to be classified as “a person aggrieved”, it would be difficult to suggest any one who could be
- B more aptly be so designated. The respondent, therefore has *locus standi* in the application. The fact that the respondent has no trade mark registered in its name in Tanzania or the United Kingdom is irrelevant.
- C On the point that the respondent is a mere association which had not filed a representative suit, let me point out, as was pointed out by learned counsel for the respondent, that in many jurisdictions in the Commonwealth, courts have granted remedies to trade associations
- D for trade malpractices such as passing-off. Such was the case in *Wineworths Group Limited v. Comite Interprofessionel du Vin de Champagne*, (2) in the Court of Appeal of New Zealand, and in the case of *Taittinger SA and Others v. Allbel Limited; and another*,
- E (3). I can see no reason why this court should treat trade associations differently in this day and age. The practical reason for permitting trade associations to file suits is to avoid multiple parties, minimize costs, and save the time for courts.
- F The respondent, I think, has another basis for its *locus standi*, as suggested by learned counsel for the respondent. I have in mind the Paris Convention of 20 March 1883 for the protection of industrial property to which both the United Kingdom and Tanzania are parties.
- G The relevant articles are articles, 2, 7 bis, 9, 10 bis, 10 ter and 22.2. article 7 bis (3) of the Convention states that the protection of trade marks referred to in the Convention :
- H ...shall not be refused to any association the existence of which is not contrary to the law of origin, on the ground that such association is not established in the country where protection is sought or is not constituted according to the law of the latter country.
- I It was next submitted that Ms Kasonda, learned advocate with the respondent’s firm of advocates, that is, Mkono and Company Advocates,

had no authority to sign the application because, it was said, that was a breach of rule 10 of the Trade Marks Rules 1958. In my view, since the respondent is a body corporate, the second part of the rule is relevant. It provides as follows:

A document purporting to be signed for or on behalf of a body corporate shall be signed by a Director or by the secretary or other principal officer of the body corporate, or by any other person who satisfies the Registrar that he is authorized to sign the document.

In this case, it is abundantly clear from the conduct of the Registrar in accepting the respondent's application and dealing with it in the ordinary manner that the Registrar was satisfied that Ms Kasonda was authorized to sign the application being "any other person".

The next ground of appeal was that the "Power of Attorney" granted to Mkono and Company, Advocates, was bad in law in that a power of attorney can be given to an individual, or to a limited liability company, but not to a firm. Learned counsel for the appellant quoted no authority for that proposition. I am not, for my part, aware of any law which prohibits a client from instructing or authorizing a firm of advocates to act on his or its behalf. I can see no better person than a firm of advocates to be given authority or instruction to act in connection with any lawful matter. It might have been a different matter if the complaint had been that Mkono and Company, Advocates had no authority from the respondent to act on its behalf in the matter; or if the complaint had been that by so acting on the authority of the power of attorney, the appellant was materially prejudiced. This ground of appeal, therefore, is equally without merit.

The last ground of appeal was that the Ruling was not a proper ruling of the Registrar because (a) although the application was heard by the Registrar, it was not written, signed, and dated by the Registrar, and (b) it was not delivered in open court. Instead, it is argued, it was written and signed by a person who had no authority to do so. This, it is said, was a breach of Order 20, rule 3 of the Civil Procedure Code.

A To start with, the record of the tribunal reveals that its coram
consisted of the Registrar, a Senior Assistant Registrar, and two Assistant
B Registrars. The Ruling was signed by the Senior Assistant Registrar
and the two Assistant Registrars. As correctly submitted by learned
C counsel for the respondent, under section 4 of the Act the Registrar
and the Assistant Registrars have concurrent jurisdiction or authority
in matters concerning rectification of, or removal of a trademark
from, the Register. That being the position, the Ruling was properly
signed by people with authority to do so.

The complaint that the Ruling was not delivered in open court as
required by the Civil Procedure Code is also without merit. This
was a quasi-judicial tribunal to which the provisions of the Civil
D Procedure Code do not or need not necessarily apply. Besides, it
appears to be the practice in such tribunals for the Registrar or an
official of the tribunal to communicate decisions of the tribunal to
the parties concerned by post, as was done in this case. There is
E nothing in the Trade Marks Rules 1958, compelling the Registrar
to deliver his decisions in open court. Communicating decisions of
such tribunals by post is the procedure followed even in the United
Kingdom and the European Union. In **The Trade Mark Handbook**,
F which is a practitioners guide to trade marks in the United Kingdom
and the European Union (1997) it is stated, in paragraph 9.6.6:

G In cases where a hearing takes place, the Registrar (who is normally
represented by a senior official) will normally reserve his decision. Copies
of the decision are sent to all the parties to the proceedings.

H That was what the Registrar did in this case. I cannot, therefore, see
any irregularity in the manner in which the decision of the tribunal
in this case was communicated to all the parties concerned. For the
foregoing reasons, I am of the settled view that this appeal is devoid
of any merit. The same is accordingly hereby dismissed with costs.