

**IN THE HIGH COURT OF TANZANIA
(DAR ES SALAAM DISTRICT REGISTRY)**

AT DAR ES SALAAM

CIVIL APPEAL NO. 323 OF 2021

*(Arising from the Ruling and Drawn Order of the Deputy Registrar Business
Registration and Licencing Agency dated 26th day of July 2021)*

ABRO INDUSTRIES INC ----- APPELLANT

VERSUS

**ABRI GENERAL TRADERS -----
RESPONDENT**

J U D G M E N T

Date of last order: 30/03/2023

Date of Judgment: 07/06/2023

MGONYA, J.

The Appellant herein filed an Application to the Registrar of Business Registration and Licencing Agency for removal and rectification from the Register of the Respondent's registered **Trade Marks No. TZ/T/2011/323 ABRI** in class 12.

The Application was dismissed by the Deputy Registrar and the Appellant being aggrieved with the same, preferred and appeal to this Court on the following grounds:

1. *That learned trial Deputy Registrar erred in law and fact by holding that there is no danger of confusion for the Appellant's mark and the Respondent's mark to co-exist in Tanzania regardless of non-existence of co-existing agreement;*
2. *That, the learned trial Deputy Registrar further erred in law and fact by holding that the trademarks can co-exist where two different enterprises are at liberty to use honestly a similar or identical trademarks to market a product or service without necessarily interfering with each other's business;*
3. *That, the trial Deputy Registrar erred in law and fact/or otherwise grossly misdirected himself when he failed to consider and make inferences from the provisions of the Trade and Service Marks Act of 1986; and*
4. *That, the Deputy Registrar erred in law and fact by holding that the Appellant's trademark is not a well-known mark despite the fact that the Appellant's mark has existed in the market since ever and the Appellant has been selling her goods in different countries all over the world by its unique distinction.*

Hearing of the Appeal was by way of written submissions whereas the Appellant had full legal services from **Mr. Patrick Sanga**, learned Advocate whereas the Respondent enjoyed the legal services of **Dr. Alex Nguluma**, learned Advocate.

Arguing in support of raised grounds of Appeal, Mr. Patrick Sanga for Appellant submitted by raising two issues. Firstly, as to *whether the Appellant's trademark and Respondents' can co-exist in the trademark register despite at their similarity and confusion*. He answered this issue in negative that two trademarks cannot co-exist in the Trademark Register due to their similarities which are in like hood to cause confusion in the market. He further cited section **20 (1) (2) and (3) of the Trade and Service Marks Act of 1986**.

He further submitted that, Trademark law provides for a Trade mark of an honest and concurrent user to co-exist with another similar mark, and the principles were laid in the case of **JONH FITTON & CO**, where five factors were laid down in order to have success in honest and concurrent user defense to include;

- 1. The extent of use in time and quantity and the area of trade;*
- 2. The degree of confusion likely to ensue from the resemblance of the marks which is to a large extent indicative of the measure of public inconvenience;*
- 3. The honesty of concurrent use;*
- 4. Whether any instances of confusion have in fact been proved, and*
- 5. The relative inconvenience which would because if the mark were registered, subject if necessary to any conditions and limitations.*

It was his further submission that, in regard to the evidence submitted before the Registrar, the Appellant managed to provide sufficient proof that, there is high degree of similarity that causes confusion from the resemblance of the marks, and further the Respondent has registered her mark by imitating the Appellant's mark including its registered word, and mark. Further that the Respondent has gone even further to copy the colors and graphic design of the Appellant's description of goods, which are the same goods produced by the Respondent with ill will to mislead the Public.

On the second issue raised by Counsel for the Appellant was as to *whether the Appellant's mark is similar to Respondent's mark hence the similarities between Appellant's trademark and Respondent's trademark can cause confusion in the market.* It was his submission that, the proprietor's exclusive rights are deemed to be infringed by any person who is not the proprietor of trademark or registered user. Thereof, uses a sign either identical with or so nearly resembling it as to likely to deceive or cause confusion, in the course of trade or business, or identical with or nearly resembling it in the course of trade or business in any manner likely to impair the distinctive character or acquired reputation of the trademark.

Further, it the Counsel's was his further submission that, the Respondent's mark is phonetically and conceptually identical to the Appellant's **ABRO** Trademark and, from a visual perspective, so nearly resembles the ABRO Trademark, hence the Appellant's and Respondent's Trademark are similar since at the case at hand the words which differ between Appellant's and Respondent's mark are on "I" and "O" that is to say **ABRI** and **ABRO** but the remaining syllables are identical,

not only that but also the manner how Respondent has designed the colors and appearance of her goods, making them similar to Appellant's goods. He referred this Court to a number of decisions including the case of **GLAXO GROUP LIMITED VS. JB CHEMICALS AND PHARMACEUTICAL LIMITED, CIVIL APPEAL NO. 68 OF 2002 UCA.**

Mr. Sanga further submitted that, the Appellant's trademark is a well-known trademark, in relation to any goods or services to mean a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and person using the mark in relation to the first-mentioned goods or services.

He went on to submit that, the Appellant's "**ABRO**" marks have been used and are used on a broad range of motor vehicles lubricants, motor vehicle transmission fluids, motor vehicle paints, motor vehicle waxes and polishes and motor vehicle parts and accessories,

including but not limited to in Classes 1, 2, 3, 5, 6, 7, 12, 17, 20, 21, 22 and 44, for which the Appellant has prior rights in several countries in the world and the Appellant use the mark ABRO globally since 1970's, and in Tanzania the trademarks are registered on Registration No. 30962 ABRO in Class 1, Registration No. 30961 ABRO in Class 2, Registration No. 30963 ABRO in Class 4, Registration No. 31057 ABRO in Class 16, Registration No. 31059 ABRO in Class 17, Registration No. 31056 ABRO in Class 21 hence, it has many years and been extensively used.

He concluded by saying that the mark registered by the Respondent under Class 12 is deceitful and confusing to the public, hence prayed this appeal be allowed and setting aside and quashing the ruling and order of Deputy Registrar.

In response to the 1st ground of appeal that, *the learned trial Deputy Registrar erred in law and fact by holding that there is no danger of confusion for the Appellant's mark and the Respondent's mark to co-exist in Tanzania*, Dr. Nguluma stated that **ABRI** trademark in dispute is registered under class 12 while the Appellants owns registered trademarks under classes 1, 2, 4, 16, 17,

and 21 different from the line of business of the Respondent. He stated that the Appellant's mark has not yet been registered under Class 12 and thus the likelihood of confusion not to exist. He cited the case of **COMPANIA LICORERA DE CENTROAMERICA, SA VS. MOHAN'S OSTERBAY DRINKS LTD & ANOTHER**, Commercial Application No. 29 of 2011, High Court (Commercial Division) at Dar es Salaam (unreported) to bolster his arguments.

On the 2nd ground of appeal, Dr. Nguluma stated that, under **section 20 (2) of Trade and Service Marks Act**, the law recognizes and permits co-existence of a trademark meaning different enterprises are at liberty to use similar and identical trademark without interfering with each other's business. He stated that, since the trademarks between parties are not registered under same class then they are permissible to co-exist.

In response to the 3rd ground of appeal that, *the trial Deputy Registrar erred in law and fact/or otherwise grossly misdirected himself when he failed to consider and make inferences from the provisions of the Trade and Service Marks Act of 1986*, it was Dr. Nguluma's

submission that, Hon. Deputy Registrar caused parties to plead their case by producing evidence in support of their case. He stated further that Hon. Deputy Registrar cited appropriate provisions which determination and findings are based.

Moreover, Dr. Nguluma stated that the cited cases by the Appellant are distinguishable to the matter at hand and further he pointed out such differences on each and every case cited by the Appellant.

As to the last ground of appeal, it was Dr. Nguluma's submission that the Appellant had to prove two major conditions to establish that her trademark is well-known in Tanzania of which are fame of a trademark and secondly, is the promotion of trademark. He referred the case of **TANZANIA CIGARETTE COMPANY VS. MASTERMIND TOBACCO (T) LIMITED**, Commercial Case No. 11 of 2005, High Court (Commercial Division) at Dar es Salaam (unreported).

In rejoinder submissions, Mr. Sanga reiterated his submission in chief and further stated that, all evidences in support of the application before the Registrar were filed, and the records are before the Court.

I have dispassionately gone through the parties' splendid and contending submissions, the record of proceedings before the Deputy Registrar and legal position as it currently obtains. The main issue for consideration by this Court now is whether the appeal has merit.

I will embark on the disposal journey by combining and tackling ground one and two of the appeal that are centered on the issue that the trademarks can co-exist without necessarily interfering with each other's business. It was Mr. Sanga's submission that, the two trademarks cannot co-exist in the trademark register due to their similarities which are likely to cause confusion in the market. Dr. Nguluma opposed this ground and stated that, the trademarks are not registered under the same class hence no confusion can arise.

To start with, I point out the test for determining whether one mark is deceptively similar to another as was laid down by the Supreme Court of India in the case of **PIANOTIST CO. LTD'S CASE (1906) 23 RPC 774** as follows:

*"You must take the two words, **you must judge of 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/ and you must further consider what is likely to happen if each of those trademarks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion-that is to so not necessarily that one man will be injured and the other will gain illicit benefit but that there will be a confusion in the mind of the public which lead to confusion in the goods/ then you may refuse the registration or rather you must refuse the registration in that case."*

[Emphasis added].

What is to note on the above case is that, similarity is a question of overall impression rather than element by element comparison of the two marks, the focus being on

the buyer who might be deceived by the similarity. In the case at hand the matter in dispute is the two trademarks “**ABRI**” that is registered in class 12 and “**ABRO**” which is registered in classes 1, 2, 4, 16, 17, and 21. Going to element by element comparison of the two marks you will find the same are differing only on the last letter. Moreover, their businesses are differing in line of business.

Moreover, since it is a rule that likelihood of confusion is determined by nature of the commodity, the class of its purchasers, and the mode of purchase and surrounding circumstances, it is therefore, my considered opinion that the two marks are not similar and cannot cause any confusion. As rightly held by the Deputy Registrar, “**ABRI**” that is registered in class 12 for about 10 years and “**ABRO**” is not registered in the same class and despite co-existence, no damages or confusion as ever been proved. I insist this because if the Appellant claimed the trademark “**ABRI**” causes confusion then, he was supposed to prove if the same has ever brought any confusion. ***I therefore, find the 1st and 2nd ground of appeal not to be merited.***

Moving to the 3rd ground that, *the trial Deputy Registrar erred in law and fact/or otherwise grossly misdirected himself when he failed to consider and make inferences from the provisions of the Trade and Service Marks Act of 1986*, it is my considered view that since the Deputy Registrar came to his conclusion basing on the facts that, “**ABRI**” is registered in class 12 for about 10 years and “**ABRO**” has never been registered on the said class. Moreover, on the issue of co-existence, he referred the provisions of **section 20 (2) of Trade and Service Marks Act**, the recognizes and permits co-existence of a trademark meaning different enterprises are at liberty to use similar and identical trademark without interfering with each other’s business. ***I also find this ground to have no merit.***

In respect to the last ground of appeal, *that, the Deputy Registrar erred in law and fact by holding that the Appellant’s trademark is not a well-known mark despite the fact that the Appellant’s mark has existed in the market since ever and the Appellant has been selling her goods in different countries all over the world by its unique distinction*, it is undisputed that, the Appellant’s “**ABRO**” marks have been used worldwide including but

not limited to in Classes 1, 2, 3, 5, 6, 7, 12, 17, 20, 21, 22 and 44, and in Tanzania the marks are limited to class 1, 2, 4, 16, 17 and 21 and not in class 12 as that of “**ABRI**”. The justification to a well-known trademark in Tanzania was not clearly proved by the Appellant hence, I find no reason to interfere with the finding of the Deputy Registrar. ***In the upshot this ground also fails.***

Overall, I am convinced that the Appellant has not presented a case that can be said to be cogent enough to persuade me that the Deputy Registrar strayed into any errors which would result in the annulment of the decision that favored the Respondent.

Consequently, I dismiss the appeal and uphold the Ruling and Drawn Order of the Deputy Registrar. The Respondent is to have the costs of this appeal.

It is ordered accordingly.

Right of Appeal Explained.





L. E. MGONYA

JUDGE

07/06/2023

ORIGINAL