IN THE HIGH COURT OF THE UNITED REPUBLIC OF TANZANIA

(DAR-ES-SALAAM DISTRICT REGISTRY)

AT DAR-ES-SALAAM

CIVIL APPEAL NO. 388 OF 2021

TIFFANY AND COMPANY .... APPELLANT

VERSUS

PRISCUS APOLIMARY HILARY T/A

TIFFANY DIAMOND HOTEL .... RESPONDENT

(Arising from the Ruling of the Deputy Registrar of Trade and Service Mark in Trade Mark application No. TZ/T/2017/ No. 63 of 2022 dated 12th October, 2021 delivered by Seka Kasera, Deputy Registrar)

JUDGMENT

29/08/2023 & 22/01/2024

NKWABI, J.:

This appeal jogs my memory about an old adage that goes: "*When one sees an old monkey, one must know that he dodged many arrows.*" It is not disputed that the appellant is a well-known and a leading brand throughout the world marketing in jewellery. Its trade mark has been in use since the year 1837 in New York in the United States of America. The appellant's trade mark namely Tiffany and Company is registered not only in the USA but also in many countries all over the world including Tanzania. The appellant's trade mark is registered in Tanzania under trade Mark No. TZ/S/2017/687 in class 43.

When the trade mark of the respondent reached the desk of the Registrar of Trade and Service Marks on 16th November, 2017 via an application, it was processed and published in the Journal of Patents, Trade and Service Marks on 15th December 2017. The appellant filed a notice of opposition in accordance with the law. There is a letter dated 5th April 2017 *sic* from the counsel for the respondent asking for extension of time for sixty days to file a counter statement.

On 24th May 2018, the Deputy Registrar namely **L. Mhando**, wrote a letter addressing the counsel for the respondent the request for extension of time to file a counter statement out of time was refused for failing to adduce sufficient grounds. It referred to the letter of the counsel for the respondent submitted on 18th April 2018 which was assigned tracking number G180418-9564. That was followed by another dated 9th July 2018

But there is a letter dated 1st June 2018 from the respondent's counsel requesting for extension of time to file a counter-statement. Truly, it was not copied to the appellant's counsel. On 12th June 2018 it appears a counter statement was filed. But according to a letter from the counsel for the respondent, a statutory declaration from the opponent had not been served to them thus, they pressed the Registrar to mark the objection abandoned and the trade mark application be granted.

That is not all, on 9th November, 2018 the counsel for the appellant wrote a letter to the Registrar informing him that the respondent had not filed any evidence and asked the Registrar to treat the application as abandoned for want of evidence.

It is undisputed that the respondent did not lodge his counter-statement in time. The appellant, on 3rd September, 2018 filed a notice of preliminary objection that:

> *"The purported counter statement is incompetent because it was filed out of time."*

On 23rd April, 2020, Seka Kasera, Deputy Registrar of Trade and Service Marks delivered a ruling in respect of exchange of opponent Statutory declaration which was duly served to the respondent in this appeal and that the respondent prayed the opposition be marked abandoned or withdrawn for failure to be served with the opponent statutory declaration. But there was proof that the appellant had served the opponent statutory declaration to the respondent. The respondent was permitted by the Deputy Registrar to make copies from the file at the Registrar's office owing to "flexibilities of Tribunal or organs of similar nature." Then the

opposition lodged by the appellant was ordered to be disposed of by way of written submissions.

From the record, it is unclear, how the counter-statement entered the file of the Registrar while the respondent had been notified that he could not lodge one on the ground that it was time barred and reasons assigned for extension were meritless in the following words:

> *"We regret to inform you that on your prayer for request for extension of time to file Counter Statement out of time you have failed to give the Registrar sufficient grounds to grant the requested extension of time out of time, as such your request for extension of time is hereby refused."*

Kasera, the Deputy Registrar only acknowledged about presence, in the file, of a counter-statement which was lodged in spite of the preliminary objection towards its lodgement raised by the opponent.

After hearing the parties on the merits of the application for registration of a service mark, howbeit by way of written submissions, the Deputy Registrar ruled that:

> *"I wish to state that since the Opponent has failed to prove their case no relief can be granted. As the opponent*

has failed to establish the case on the balance of probabilities the application for removal is hereby dismissed with costs and Application No. TZ/S/2017/838 Tiffany Diamond Hotel (Word And Device) is to proceed for registration."

Irritated by the decision of the Deputy Registrar, the appellant has come to this Court in aspiration for a reversal of the decision of the Deputy Registrar. For reasons that will be apparent shortly, I will only mention one vindication of the appeal which is thus:

> *That the Honourable Registrar erred in law by failing to hear and determine on merits the appellant's notice of preliminary objection on point of law on time limitation against the respondent's counter statement.*

The appeal is disposed of by written submissions. The appellant is represented by Mr. August N. Mrema, learned advocate while the respondent is represented by Mr. Khalid Mzee, also learned advocate. I feel beholden to the counsel of both parties for their eloquent submissions.

Arguing the 1st, 3rd and 5th grounds together, the counsel for the appellant maintained that the respondent failed to comply with the mandatory

provisions of the law which is regulation 36 of the Trade and Service Mark Regulations which is couched in mandatory terms. He was of the view that the Registrar ought to have marked the trade mark application abandoned. On top of that, the registrar did not determine the preliminary objection.

It is also submitted by the counsel for the appellant that since the Registrar refused and rejected the respondent's request for extension of time to file a counter statement, then the Registrar was functus officio and could not legally turn around and grant an extension of time. I was referred to the case of **Bibi Kisoko Medard v. Minister for Lands, Housing and Urban Settlement** [1983] TLR 250 where it was held that:

> *"... that on matters of judicial proceedings once a decision has been reached and made known to the parties, the adjudicating tribunal thereby becomes functus officio ..."*

It is based on those submissions whilst in summary, the counsel for the appellant prayed this Court to allow the appeal.

The respondent's counsel responded. In the response, he maintained that the preliminary objection was resolved by the Deputy Registrar on 9th April 2020 when parties were called for necessary orders. He explained that it was resolved through overlooking certain omissions for purpose of

meeting justice on the matter, by applying the overriding objective principle.

With profound respect to the counsel for the respondent, the submissions are downright misleading. In the first place, as correctly stated by the counsel for the appellant, the overriding objective principle cannot be applied to overrun mandatory provisions of procedural law which go to the root of the matter. See **Night Support (T) Ltd v. Benedict Komba,** Civil Revision No. 254 of 2008 CAT (unreported), where it was stated that:

> *"That limitation is material point in the speedy administration of justice. Limitation is there to ensure that* ***a party does not come to court as when he chooses.****" [Emphasis mine]*

Even the laziest person at law could yet appreciate the significance of limitation as stated in **Yussuf Khamis Hamza v. Juma Ali Abdallah**, Civil Appeal No. 25 of 2020 CAT it was stated as follows:

> *"... of course, we are alive with the settled position of the law that time limitation goes to the jurisdiction issue of the court and that it can be raised at any time, even at the appellate state by the court ..."*

When the Deputy Registrar had ruled that there could be no any extension of time within which to file a counter-statement, there was no way the Deputy Registrar could go back and override his own decision. Even if the respondent would have come with strong reason other than that were assigned earlier, that would amount to accepting an afterthought.

The counsel for the respondent suggests that there was a tag of war about service of pleadings and were ordered to exchange pleadings. With respect, this is vicious concoction, this is because, the counsel for the respondent was ordered to get copies from the file of the Registrar after the Deputy Registrar found that the respondent had been duly served. I further accept the argument of the counsel for the appellant that Regulation 67 and regulation 43 cannot be called to assist the respondent because rule 67 applies where the trade mark has already been registered while the respondent's application for service mark had not been registered (it was still being processed). As for Regulation 43, that does not help the respondent because extension had already been refused.

The counsel for the respondent too called into assistance the decision of this Court in **Aida Makukura & 23 Others v Mahidi Hadi** (as Legal Representative of Mohamed Mahfoodh Mbaraka), Land Appeal No. 228 of 2020. I bear in my mind the decision of the Court of Appeal cited therein

in respect of discretionary powers of a court, however, it is also true that there cannot be discretionary power while a court of law or a tribunal is functus officio. Thus, the cited case of **Aida Makukura** (supra) is irrelevant to the case at hand.

There is a disapproval by the counsel for the respondent who slams the remark by the counsel for the appellant that the Deputy Registrar entertaining the application on merit was functus officio. The counsel for the respondent asserted that the claim is a misconception of the law and should not be entertained by the Court. It is added by the counsel for the respondent that the respondent complained about non-service, the respondent was given opportunity of being heard and in resolving the issue of service the registrar allowed the hearing to proceed by way of written submission. He prayed the appeal be dismissed with costs.

I am not impressed by the argument of the counsel for the respondent about his complaint to the Registrar about non-service. As I have indicated above, the Deputy Registrar categorically ruled that the service had been effected to the respondent and would not order the appellant to reserve but rather ordered the respondent to get a copy from the file of the Registrar. In the premises, the alleged complaint was a hoax manufactured by the counsel for the respondent to hide his failure to lodge

the counter-statement in time. Further, there was a mere wanton disregard of the fact that extension of time to file a counter-statement had already been refused and communicated to the respondent. The act of the Deputy Registrar who purported to disregard the refusal to extend time to file a counter-statement was legally unacceptable. When the extension was refused, the application that was lodged by the respondent ought to have been marked abandoned and the application thus to have failed. The above deliberation disposes the appeal in favour of the appellant.

But as if for academic purposes, even if the counter-statement of the respondent were filed within the prescribed time, or extension of time within which to file one were granted, in essence, based on the record, I regard the respondent's (trade) service mark was forged to exploit the good will of the trade mark of the appellant. He took the name TIFFANY which has no any bearing to him like any one of his names. He also sought to exploit the good will of Tiffany and Company by using the name of one of its jewelleries to benefit him by attracting customers. Though the respondent was notified by the Deputy Registrar that he could not have exclusive right to the word HOTEL, it should verily be borne in mind that the appellant's trade mark is registered in Tanzania under class 43 which includes clearly **hotel** business. Thus, in all intents and purposes, the

respondent's trade mark which is sought by the respondent to be registered by the Registrar of Trade and Service Marks is a counterfeit trade/service mark intended to deceive clients that that hotel business is linked with the appellant, while in fact it is not. That, cannot be allowed, having regard to the principle stipulated in **Tanzania Breweries Ltd v. Kibo Breweries and Kenya Breweries,** Civil Case No. 34 of 1999 where it was underlined that:

> *"... court has to wear the shoes of a common man, **spread the marks** before it and ask itself whether there are resemblances between the two which would make it pick a product which was not intended but the opposite."*
>
> [Emphasise mine]

I totally subscribe to the submissions of the counsel for the appellant that the Deputy Registrar, in the circumstances of this case ought to have used both the "First Syllable Rule" and the "Anti-dissection Rule".

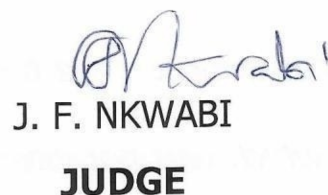
Thusly, the suggestion by the counsel of the respondent that there is no one in this country who has already registered the intended trade mark of the respondent is erroneous. As there is evidence just as I have illustrated above the cited case of **Tanzania Distilleries Ltd v. Vitamin Foods (1989) Ltd,** [2000] TLR 15 is distinguishable. Further the attempt by the

counsel of the respondent to distinguish the authorities cited by the counsel for the appellant as could be seen in the 15th and 16th pages of the reply submission is futile.

At long last, I allow the appeal with costs. The ruling of the Deputy Registrar is hereby quashed. The Deputy Registrar's order that the trade mark proceed for registration is set aside.

It is so ordered.

DATED at **KIGOMA** this 22nd day of January 2024.



J. F. NKWABI

JUDGE