

IN THE HIGH COURT OF THE UNITED REPUBLIC OF TANZANIA

ARUSHA SUB - REGISTRY

AT ARUSHA

CIVIL CASE NUMBER 18 OF 2023

EASY TRAVEL LTD _____ PLAINTIFF

VERSUS

TECOMATE TOURS & SAFARIS CO. LTD _____ DEFENDANT

JUDGMENT

05/03/2024 & 03/05/2024

BADE, J.

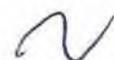
Through an ex parte proof, the Plaintiffs had established its case based on infringement of its copyright and a protected trade and service mark by the Defendant. They seek a judgment and decree against the Defendant jointly and severally by

- i) A declaration that Defendant has infringed the Plaintiff trade and service mark by using a logo that is confusingly similar to the protected trade and service mark.
- ii) A declaratory order against Defendant, that they have infringed the Plaintiff's copyright as well as their trade and service marks rights,

- iii) The Defendants be restrained through a permanent injunction to continue infringing the Plaintiff's rights over the copyright and trade and service marks rights.
- iv) The Defendants be ordered to purge all copyright and trade and service marks infringing contents from their usage online and in the website www.tecomatetours.co.tz which is against the Plaintiff's exclusive protected interests.
- v) general damages to the tune of USD 500,000 (about TZS 1,172,000,000).
- vi) Costs of the suit
- vii) Any other relief as deemed right by the court/

The defendants had neither responded to the Plaintiff's demand notice nor had they entered an appearance in court to defend the case against them, despite service to them. On the closure of the Plaintiff's case, their counsel Mr. John Massangwa, prayed to be allowed to file a final summation, a prayer that I readily grant. I appreciate the effort and industry by the counsel fashioned in addressing the framed issues, thus:

(i) Whether the Plaintiff is the registered owner of the copyright and trademark complained about.



(ii) Whether the Defendant has breached the Plaintiff's right to the protected trademark

(iii) Whether the Defendant has infringed the plaintiff's copyright through the Defendant's website; and

(iv) What relief(s) are the parties entitled to.

On the first issue which seeks to inquire whether Plaintiff is the owner of the copyright and trademark infringed by Defendant, the court has received ample evidence substantiating the fact that Plaintiff registered the copyright and the trademark corresponding to the complaint of infringement, satisfying legal propositions that rights to a trademark can be acquired in one of two ways; first, by being the first to use the mark in commerce; or second, by being the first to register the mark with the Trademark Office.

Through the testimony of PW1, Sayeeda Hassan Hirji, a director and shareholder of the Plaintiff testified that they have been in business as tour operators for over 40 years, and have been using the logo in dispute for over 14 years. She testified further that most of Plaintiff's business is a result of contact with clients in cyberspace or online through their website, adding further that Plaintiff made an application to the Registrar of Trade and Service Marks to register the Plaintiff's trade and service mark. They also

made an application to the Copyright Society of Tanzania ("COSOTA") for copyrighting the Plaintiff's website and presented their trade and service mark certificate number TZ/S/2015/641 registered with effect from 21st September 2015 in class 39, which is registered under Section 28(2) of the Trade and Service Marks Acts [Cap. 326 R. E. 2002] together with Regulation 50 of the Trade and Service Marks Regulations as she read through the document. PW1 also tendered the renewal chit for the Plaintiff's trade and service mark registration done under Regulation 51 of the Trade and Service Marks Regulations from September 2022. In addition, PW1 testified that the Plaintiff's website was registered with COSOTA, presenting a certificate showing that [www. easytravel.co.tz](http://www.easytravel.co.tz) is so registered as a literary work as per registration number G081100, praying and had the same admitted in evidence collectively as exhibit P1.

Exhibit P1, particularly the trade and service mark certificate together with its certificate of renewal evidences that the plaintiff is the proprietor of the artistic concept and colored 'ET easy travel and tours ltd' Logo.

These pieces of exhibits find favor with the present law viz Section 14(1) of the Trade and Service Marks Act, [Cap. 326 R. E. 2021 which declares that exclusive ownership shall be acquired by registration of the trade or service

mark. Also, Section 28(2) of the Trade and Service Marks Act Cap 326 RE 2021 is prescriptive as it provides:

"...upon successful application, the Registrar of Trade and Service Mark shall seal and issue to the applicant the certificate of registration showing the proprietor of the trade and service mark."

Further, looking at the certificate from the COSOTA, it is evident that www.easytravel.co.tz is constituted as literary work and is so registered. As it happens, Section 5(1) and 15(4) of the Copyright and Neighbouring Rights Act, 1999 is prescriptive as it embodies the legal proposition that the owner or author of any literary work is entitled to exclusive economic and moral rights of the work for which he has done material deposit which shows the author and implicitly the owner of the literary work that:

"Authors of original literary and artistic shall be entitled to copyright protection for their works under this Act, by the sole fact of the creation of such work. "

On the basis of the foregoing, I am well convinced that Plaintiff is the registered owner of the literary work and trade and service mark constituted in the website presentation. I answer the first issue in the affirmative.

For the next two issues, I propose to address them together, whirling my attention to the questions of whether Defendant has breached Plaintiff's right to the protected trademark, and whether Defendant has infringed Plaintiff's copyright through Defendant's website.

Testifying as PW 2, Musaddiq Ghulamhussein, was elaborate that he was visiting the Defendant's website, www.tecomatetours.co.tz when he noted that there is a mark 'ET' before the words 'Tecomate Tours' which he found to be similar to the Plaintiff's registered trademark 'ET easy travel and tours'. The only disclaimer of non-exclusivity is the word 'travel' and the phrase 'Your Tanzanian Friend' apart from the mark as a whole. Thus the artistic expression of the letters 'ET' distinctively presented set apart the Plaintiff's logo in connection to the Plaintiff's forty years of outstanding service as a tour operator in East and Central Africa and Tanzania in particular. The display of the Defendant's website, which was admitted in evidence as Exhibit P4 displayed the letters 'ET' before Defendant's Company name the arrangement which is identical to the presentation of the Plaintiff's registered trademark. Furthermore, PW 2 made a comparison of Plaintiff's registered trade and service mark against Defendant's

infringing and unregistered trade and service mark. The comparison was collectively admitted in evidence as Exh P5.

Looking at the compared and contrasted pieces of evidence as exhibited in Exh P4 and P5, PW2 analyzed the Plaintiff's registered trade and service mark as appearing on Exh P5, and the Plaintiff's trade and service mark -as appearing on the Plaintiff's website banner, and that of the Defendant's as it appears on their website banner. PW2 further digitally displayed in court the Plaintiff's registered trade and service mark appearing on the Plaintiff's website footer and the Defendant's infringing logo appearing on the Defendant's website footer. Also, PW2 took a shot at the way Plaintiff registered trade and service marks on their Facebook and Instagram profile pages comparing it with Defendant's presentation of the mark in Defendant's own Facebook and Instagram profile pages, comparing and contrasting them. Finally, PW 2 digitally displayed Plaintiff's registered trade and service mark as it appears on Plaintiff's motor vehicle wheel covers against Defendant's display of their logo also appearing on Defendant's Wheel cover.

PW 2 testified further that Plaintiff has been awarded certificates of excellence and recognized as the best travel and tour operator awarded by

a reputable global travel agency "Tripadvisor" for over eleven years continuously and has more than four thousand online reviews by clients subscribing to Plaintiff's services. The testimonies on this were also admitted in court as Exh P2 and the court had the opportunity to scrutinize the same.

In evaluation, PW2's testimony and analysis of the facts pertaining to Plaintiff's registered trade and service mark and that of the Defendant's, Defendant's logo is not only closely related to the registered Plaintiff's trade and service mark but also nearly resembles the Plaintiffs registered trade and service mark and the same is likely to deceive or cause confusion in the cause of trade. It is evident that both Plaintiff and Defendant are tour operators and this is evidenced by PW1 and PW2 uncontroverted testimony. On the other hand, the exhibited P3 which is a search report from Business Registration & Licensing Agency, depicting information on the Defendant's report is evident that among other things, the Defendant's business is tour operator activities.

PW2 made it clear to which I am agreeable that the artistic 'ET' appearing in Plaintiff's registered trade and service mark is an essential feature of the mark. The way the Defendant has presented her own logo seems to be

directly related and copied the letters 'ET' before Defendant's name. This in my considered view comes across as random if you compare the two logos by the disputants. I find the Plaintiff's claim to be plausible because the letters depicted on the logo are not only initials for the part of the name of the Plaintiff (Easy Travel) if presented in the long form, but also the Plaintiff has been using it for the better part of its existence in commercial undertakings, as well as has registered it as a mark and copyrighted its presentation as an artistic literary work, both of which are well supported by the law.

In any case, I do not think it is far-reaching to pin the reason for Defendant to want to ride on Plaintiff's fortune or try to ride on the coattails of Plaintiff's success. It is in testimony that Plaintiff has been in the same business for over forty years, and through this time, 11 of which have been impeccably recognized with customers identifying the Plaintiff by the registered trade and service mark "ET easy travel and tours ltd".

I am convinced that the Defendant's copying of the logo is laden with malafide to confuse customers who are the users of the service provided by both of them, that is tour operator service. Since the part that was copied forms an essential part of the registered trade and service mark, it is my

finding that the same amounts to trade and service mark infringement as the part that is similar is confusingly so. And since the actual presentation on the website is a copyrighted work, the same also entails copyright infringement.

The law is also supportive of this position as made clear under sections 32(1) (a) (i), (ii) and (b) of the Trade and Service Marks Act, [Cap. 326 R.E. 2002] as circumstances of infringements are illustrated.

The exclusive right referred to in section 31 shall be deemed to be infringed by any person who, not being the proprietor of a trademark or registered user thereof using by way of the permitted use, uses a sign either

(a) identical or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade or business, in relation to any goods in respect of which it is registered or in relation to closely related goods and in such manner as to render the use of the sign likely to be either;

- i) as being used as a trademark or business or company name, or
- ii) in a case in which the use is upon the goods or in physical relation thereto, or in relation to services, or in an advertising

circular or other advertisement issued public, as importing a reference to some person having the right either as proprietor or as a registered user to use the trademarks or to goods or services with which a person as aforesaid is connected in the course of business or trade; or

b) 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.

Analyzing this legal provision, the commercial division of this court in **Kiwi European Holdings BV vs Sajad Ali Limited** [2005] TLR 434 observed:

"The cumulative effect of sections 31 and 32(1) (a) of the Act is to the effect that the right to exclusive use upon registration cannot be infringed unless it is proved that the offending mark is either (i) identical with the registered trade mark or (ii) it so nearly resembles the registered trade mark as to be likely to deceive or cause confusion in the cause of trade in relation to the goods in respect of which the mark is registered."

In addition, in the case of **Agro-processing and Allied Products Limited vs Said Salim Bakhresa & Co. Limited and Another**, Commercial Case No. 31 of 2004 (Unreported) the court approvingly cited the case of **Saville Perfumery co. Ltd vs June Perfect Ltd and Another** [1991]1 58 R. P. C. 147, H. C, in holding that:

"If the essential feature in the mark has been adopted additional words or devices do not enable the defendants to escape liability for infringement.

Meanwhile the Court of Appeal of Tanzania in **CPC International Inc. vs Zainab Grain Millers Ltd**, Civil Appeal No. 49/1995 (Unreported) has guided that:

"... a prima facie case could well be shown if upon consideration of the close similarity between trade marks complained was on balance such as to cause deception or confusion the part of the customers."

On this aspect, I must agree with the counsel for the Plaintiff when he remarked on his final summation filed in court that deception or confusion to clients must be tested based on a man of average intelligence. This is also the holding in **Kiwi European Holding BWS Case** (supra), that:

"It has often been stated that in deciding the question of similarity between two marks, one has to approach it from the point of view of a man of average intelligence and of imperfect recollection, and that an ordinary purchaser is not gifted with the power of observation of a Sherlock Holmes."

In normal simplistic parlance, the above observation underscores the practicality of assessing trademark similarity. While we may not all possess the deductive prowess of the famous detective, our everyday judgments play a crucial role in distinguishing between marks. The average consumer relies on their own faculties to discern similarities or differences in trademarks.

See also **Kenafric Industries Limited vs Lakairo Industries Group Co. Ltd and Four Others**, Commercial Case No. 132 Of 2018 (Unreported) approvingly citing Mellor J, Kerly's Law of Trade Marks and Trade Names, 15th Ed, Sweet & Maxwell, 2011 stating

"It should be emphasized that the Court must determine whether there is a likelihood of confusion. It is not necessary for the claimant to prove actual confusion at all."

These sentiments have also been observed in persuasion by Corbett, JA in **Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd**, 1984 (3)

SA 623 (A) at 640G-641D that:

"In an infringement action the onus is on the plaintiff to show the probability or likelihood of deception or confusion. It is not incumbent upon the plaintiff to show that every person interested or concerned (usually as customer) in the class of goods for which his trade mark has been registered would probably be deceived or confused. It is sufficient if the probabilities establish that a substantial number of such persons will be deceived or confused. The concept of deception or confusion is not limited to inducing in the minds of interested persons the erroneous belief or impression that the goods in relation to which the defendant's mark is used are the goods of the proprietor of the registered mark, ie the plaintiff, or that there is a material connection between the defendant's goods and the proprietor of the registered mark; it is enough for the plaintiff to show that a substantial number of persons will probably be confused as to the origin of the goods or the existence or non-existence of such a connection."

Theoretically and by way of counterargument, even if one could say that the infringed mark in question being descriptive as it is, could give the Plaintiff who is claiming exclusive ownership of the trademark an economic advantage that go beyond their own investment in the sign, and should be kept freely available for competitors on the market particularly because the disputed mark is a descriptive mark that directly describes, the characteristic or quality of the underlying product, that is "easy travel" which is telling something about the quality of the service. This is important since such marks are not inherently distinctive to acquire a status of being protected exclusively to the person claiming ownership, except and only if they have acquired "further secondary meaning."

I am well aware that the court is duty bound to ensure that a descriptive mark is cleared of the requirement of attaining a distinction because otherwise, the wording used as marks are terms that are also useful for describing the underlying product by anyone consumer and competitor alike in normal parlance, and giving a particular user the exclusive right to use the term could confer an unfair advantage.

But as I have analyzed through the evidence of PW2, the Plaintiff has been using the said mark for over 40 years, 11 of which as a registered and

copyrighted user, and as such, in my view, the descriptive mark has now attained the distinction that it does not simply represent the terms in normal parlance, but identifying the Plaintiff in the market when it comes to Tour Operator business. One could argue that the coined terms 'easy travel' could be used by any other person in the tour operator industry, but surely there could also be several other description of the underlying travel concept which could bring different meanings such as faster travel, or fun travel, or better travel or leading travel or wonder travel and many more that can be coined. It is supported in evidence that the coined words did not happen as a coincidence, but rather through specific efforts to brand and achieve such branded description to become a distinctive mark. Moreover, the artistic representation of the alphabets "ET" are particularly pointing to the logo of the Plaintiff. The Plaintiff has also attained the distinction in recognition by the consumers / users since they have been recognized and won awards based on it.

As I have endeavored to discuss above, the standard is "likelihood of confusion." To be more specific, the use of a trademark in connection with the sale of a good constitutes infringement if it is likely to cause consumer confusion as to the source of those goods or as to the sponsorship or

approval of such goods. In deciding whether consumers are likely to be confused, this court had looked on the strength of the mark it being a descriptor mark 'easy tour' that has acquired a different meaning; the proximity of the goods brought to the consumer, that both parties are engaged on the tour operator business; the similarity of the marks and it is easy to see the copying of the ET logo and the way it is being presented by both parties; the similarity of marketing channels used that both parties are using the a website to source customers, and have published it to identify themselves as such including in the wheel covers of the motor vehicles; the degree of caution and how it can be exercised by a typical purchaser that the typical consumer is a man of average intelligence; as well as the Defendant's intent, that it would seem attractive for the defendant to ride on the Plaintiff goodwill since the Plaintiff has been in the market for over 40 years with the same mark and been recognized as a big player in the market. See also **Polaroid Corp. vs Polarad Elect. Corp.**, 287 F.2d 492, 368 U.S. 820 (1961).

On the other hand, it is also my finding that Plaintiff's copyrighted work is infringed. I say so because it is evident through PWI testimony and the exhibited content of Exh P1, presenting in court the Plaintiffs website that

is www.easytravel.co.tz and the registration certificate number C0832316 of 21st July 2016. Section 4 of the Copyright and Neighbouring Rights Act, 1999 defines the word copyright to mean:

“the sole legal right to print, publish, perform, film or record a
literally or artistic or musical work”

Against this legal backdrop, It is implicit that Defendant has published literary work which is copyrighted work from Plaintiff's website www.easytravel.co.tz onto their own website www.tecomatetours.co.tz using it as their own and to their commercial advantage.

Section 14(1) of the Copyright and Neighbouring Rights Act, 1999 entitles a registered owner with exclusivity in economic and moral rights for a lifetime of the author or the owner and fifty years after the death of the author or owner while section 44(1) (iv) of the same law enumerates some acts as unlawful and are assimilated to infringements of the rights protected. These acts include:

"distribution, import for distribution, broadcasting communication to the public, or making available to the public without authority, of works, performances, sound recordings or broadcasts, knowing or

having reason to know that electronic rights management information has been removed or altered without authority"

Addressing the last issue on the reliefs that the parties are entitled to, I think the same is predicated on whether the issues have been answered in the affirmative favoring the Plaintiff, and the remedy that is available under the law while balancing the court's discretion.

In an article published in the **Journal of Intellectual Property Law & Practice** titled *Remedies for trademark infringement in Tanzania: Principles and practice*, Volume 9, Issue 8, August 2014, [Pages 650–655, <https://doi.org/10.1093/jiplp/jpu097>] Justice of Appeal Kihwelo has enumerated the remedies available under the law including injunction which is the principal remedy that one can seek to prevent the other party from continuing to use the infringing mark, account of profit in which case the rights holder rather than seeking actual damages seek the profits made by the other party as a result of its use of the infringing mark, withdrawal of goods bearing the infringing trademark from the market and disposal outside the channels of commerce in such a manner as to avoid any harm to the rights holder and punitive damages which is payable where it is

proved on the balance of probabilities that the infringement was done maliciously, willfully, fraudulently or deliberately.

Section 36(1) (a-b) of the Copyright and Neighbouring Rights Act, 1999 provides that:

Any person whose rights under this Act are in imminent danger of being infringed or have been infringed, may institute proceedings in the United Republic of Tanzania for:

- (a) an injunction to prevent the infringement or to prohibit the continuation of the infringement;
- (b) payment of any damages suffered in consequence of infringement, including any profits enjoyed by the infringing person that are attributable to the infringement. If the infringement is found to have been prejudicial to the reputation of the person whose rights were infringed, the court may at its discretion, award exemplary damages.

In my mind, the issue that begs an answer is how would one attributes malice and willfulness to the infringement of the right. In any case, I think the comparison and similarities must be viewed with reference to the sense, sound and appearance of the marks that are being contested. The marks must be viewed as they would be encountered in the market place website or cyberspace, and against the background of relevant surrounding circumstances as both businesses are on the same field of industry, i.e tour operators. The marks must not only be considered side by side, but also separately. Any time that one would visit the cyberspace marketplace, the algorithms are created in such that both businesses might come through. It must be borne in mind that the ordinary purchaser may encounter the invitation to the service on tour operator, bearing the Defendant's mark, with an imperfect recollection of the registered mark of the Plaintiff's. I am convinced due allowance must be made for this normal happening in the cyberspace market place. If each of the marks contains a main or dominant feature or idea the likely impact made by this on the mind of the customer must be taken into account.

Quoting from Corbett, JA in the **Plascon-Evans Paints Ltd** case (supra)

"As it has been put, marks are remembered rather by general impressions or by some significant or striking feature than by a photographic recollection of the whole consideration must be given to the manner in which the marks are likely to be employed as, for example, the use of name marks in conjunction with a generic description of the goods."

This is not to say that I have not looked at the similarities presented on the logo of the Defendants as it exists. The similarities between the two logos "ET" are not so marked that they cannot be explained, except on the basis of copying, and one can not say the similarities happened as a matter that is attributable to common ideas and concepts, since the mark is a descriptive one, depicting the service offered (easy travel) and which is to be found generally in the tour industry, but not necessarily as a concept or brand. I think the infringement was willful and with malice riding on the success of the one who has had the goodwill in the business for quite some time as testified by PW2.

On the basis of the foregoing, I order the following reliefs:

1. It is declared that the Defendant has infringed the Plaintiff's trademark styled as 'ET' "easy travel and tour" with registration number

TZ/S/2015/641 which entitled Plaintiff to exclusive use of the ET EASY TRAVEL logo, in terms of Section 14(1) of the Trade and Service Marks Act, Cap 326 by an illegal use of the ET logo on the infringing marks), in the course of trade in relation to tour operators business for which the infringed trade mark is registered, as contemplated in Section 31(1) of the Trade and Service Marks Act, [Cap. 326 R.E. 2002.

2. The Defendant is restrained, in terms of Section 32(1) of the Trade and Service Marks Act, [Cap. 326 R.E. 2002, from infringing the Plaintiff's rights acquired by the registered trade mark, by using in the course of trade in relation to the service for which the infringed trade mark is registered, the infringing marks or any other mark so nearly resembling the registered trade mark as to be likely to deceive or cause confusion.
3. It is declared that the Defendant has infringed the Plaintiff's copyright on artworks registered as works with Certificate No C0832349 for the website, in terms of Section 15 (1&4) of the Copyright and Neighbouring Rights Act, 1999, as defined in the founding affidavit (the original works), by reproducing or causing to be reproduced, or publishing in any way the original works and/or by using and

reproducing the artwork in their own devices of whatsoever including the motor vehicle wheel covers and any other trading devices or products in the infringing presentation as in the website www.easytravel.co.tz

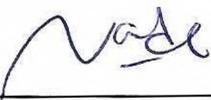
4. The Defendant is interdicted and permanently restrained, in terms of Sections 5(1) and 8 Of the Copyright and Neighbouring Rights Act, 1999, from infringing the Plaintiff's copyright in the original works by reproducing or causing to be reproduced, whether directly or indirectly, the original works and/or by reproducing, publishing, distributing or offering for sale, the products and services depicting the infringing works.
5. Defendant is ordered to remove the infringing marks from all matter in its possession or under its control including but not limited to signage, advertisement, and publishing to the public of the infringing logo via Defendant's website, which has contents that infringe the copyright and trade and service marks from their usage online and in the website www.tecomatetours.co.tz which is against the Plaintiff's exclusive protected interests, Facebook profile, and pages, Instagram

profile, and any other cyber presence, as well as motor vehicle wheel covers, stationery, packages, labels, uniforms, advertising.

6. Where the infringing marks and representations cannot be removed or if Defendant will not heed, Plaintiff to cause the purging of all materials in cyberspace and online bearing the infringing marks and representations using an IT expert.
7. The Defendant is directed to pay the Plaintiff damages to the tune of USD 100,000 or its equivalent in TZS.
8. The Defendant is directed to pay the Plaintiff's costs of the suit.

It is so ordered.

DATED at ARUSHA this 03rd day of May 2024



A. Z. Bade
Judge
03/05/2024

Judgment delivered in the presence of the Parties / representatives in chambers on the **03rd** day of **May 2024**.



ade
A. Z. BADE
JUDGE
03/05/2024