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

COMMERIAL CASE NO. 12 OF 2005

TANZANIA CIGARETTE CO.LIMITED...PLAINTIFF
VERSUS
IRINGA TOBACCO CO. LIMITED.....DEFEENDANT

R U L I N G

KIMARO, J.

The plaintiff has filed a suit against the defendant seeking for the following prayers:

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(a) *A declaration that the Defendant has registered Trade Marks with registration Nos. 30410 and 30411 which are closely similar and resemble the Plaintiff's registered Trade Marks with registration Nos. 831 and 7799 and have interfered with the distinctiveness of the Plaintiff's Trade Marks.*

(b) *An order to cancel and expunge the Defendant's Trade Marks with Registration Nos.30410 and 30411 from the Register of Trade and Services Marks.*

(c) *A permanent injunction to restrain the Defendant from using its Trade Marks with Registration Nos. 30410 and 30411.*

(d) *An order upon the Defendant to collect all its products with Trade Marks with Registration Nos.30410 and 30411 and deliver them to the Plaintiff for destruction and hand over all boxes, cartons, packets, containers, labels and all advertisement materials bearing the said offending Trade Marks with registration Nos.30410 and 30411.*

(e) *Damages to be assessed by the court.*

(f) *Costs of this suit.*

(g) *Any other relief(s) this court may deem fit to grant."*

Its cause of action is that the defendant is trading in trade marks closely similar and resembling the plaintiff's trade marks thereby interfering with the distinctiveness of the plaintiff's trade marks.

Briefly, the facts are that both the plaintiff and the defendant are involved in production and sale of cigarettes. The major difference between the parties is that the plaintiff

has been in the industry for a longer period. The plaintiff is a registered proprietor of several trades marks including Sportsman and Sweet Menthol brands which form the subject of this suit. The Registration Certificates for the two brands are No.831 in Class 45 and 7799 in Class 34 Schedule III respectively. The Defendant on the other hand manufactures cigarettes which use trade marks Nyati Filters and Nyati Menthol. Their Registration Certificates are No.30410 and 30411 respectively.

Meanwhile, the plaintiff has filed an application seeking for an order for temporary injunction to restrain the defendants from continued use of the Respondents trade Marks with Registration No. 30410 and 30411 pending hearing and final determination of the suit together with costs. The application is supported by an affidavit of Lucy Sawaya Mandara. The main reason given to support the application is that the respondent's trademarks bear great similarity and resemblance in a variety of ways. These include the scheme of colour arrangements, the get-ups and the size of the logo. It is deposed by Lucy Mandara that the continued use of the Respondent's trademarks till final determination of the suit is likely to make the Applicant suffer irreparably. A list of the sufferings given are:

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i) *Injury to the high reputation and good will of the Applicant's Trade Marks,*

ii) *Confusion to the average consumer likely to constitute the clientele for the Applicant to mistake the products for the Respondent for those of the applicant.*

iii) *The respondent's products are likely to cut down the Applicant's sales.*

iv) *The Respondent without colour of right enjoys the Applicant's high publicity, reputation and good will in the market.*

v) *The Respondents trade marks are calculated to override the Applicants identity."*

It is further deponed that the applicant has dominated the cigarette industry for long as a sole manufacturer and domestic distributer, a factor which may make an average customer to easily confuse the respondent's products with those of the applicant.

Lucy Mandara concludes her affidavit by deponing that the Applicant is likely to suffer irreparable loss that cannot be atoned by way of monetary compensation if the respondent will remain in continuous use of its Trade Marks.

The application has been highly resisted by the Respondent. In a counter affidavit sworn by Mike Fliakos it is deponed that the advertisement made prior to the registration of the Trade Mark was a good opportunity for raising an objection to the registration. However, no objection was taken at that time. It is also disputed that the Trade Marks bear resemblance in the colour arrangements, get-ups or the size of the logo.

Mr. Mike Fliakos further disputes that the continued use of the Respondent's Trade Marks will cause any adverse effects on the reputation acquired by the applicant, and that there will be a likelihood of confusion in the products of the applicant with that of the respondent. Mr. Fliakos contends that if the applicants market share is cut down, that would be a result of the Respondent's distinctive and quality brands, which offer choice and value to consumers and not because the Respondent's trademarks are confusingly similar to the Applicants trademarks. He also disputed the likelihood of the applicant suffering losses.

The application was argued by written submissions. The volume of the submissions made by the Advocates reflects the efforts involved in the preparations of the application. However, a close scrutiny of the submissions made by the Advocates for the applicant suggests that a lot of their time was lost in venturing on matters which are not relevant for the time being.

Let me start with the purpose of temporary injunctions. The purpose of a temporary injunction is to maintain the status quo of the parties as they are at the time of filing the suit pending the determination of the main suit. An order for temporary injunction will not be given if its effect tends to finally determine the main suit.

Having made this primary observation let me go to the principles governing the grant of temporary injunctions.

The governing principles were laid down in the case of **Attilio V Mbowe** (1969) HCD 284:

"

i) There must be a serious question to be tried on the facts alleged and a probability that the plaintiff will be entitled to the relief prayed (The prima facie case and overwhelming chances of success).

ii) The courts interference is necessary to protect the plaintiff from the kind of injury which may be irreparable before his legal right is established.

iii) That on the balance of convenience there will be greater hardship and mischief suffered by the plaintiff from the withholding of the injunction than will be suffered by the Defendant from the granting of it."

The question which now comes is whether the Plaintiff/applicant has been able to satisfy this court that the principles are in existence in this case.

On the first principle of establishing a prima facie case, the Advocate for the applicant relied on the cases of **Colgate Palmolive Company Limited vs Zakaria Provisional Stores and Others** Civil Case No. 1 of 1997 (High Court)(DSM Registry) (Unreported) and **Tanzania Breweries Ltd V Kibo Breweries Ltd and Another** (1999) 1 EA 340 which speak of a degree of proof which is required in an application for temporary injunctions. It was submitted that to establish a prima facie case one need not go to the examination of the facts of the case. It is sufficient for the applicant to satisfy the court that the plaintiff has a case for consideration by the

court and there is a likelihood of success. He said to obtain an injunction, the deception/confusion can have either occurred or is likely to occur. The resemblance of marks is established by looking at the marks in totality and their get-ups and the test is that of an average customer of that product. The Advocate looked at the scheme of colour arrangement in the trade marks, the get up and the size of the logo and drew a conclusion that there is a resemblance in the Trade Marks and hence a prima facie case has been established.

The Advocate for the Respondent on the other hand submitted that the applicant failed to establish a prima facie case and has ventured on matters which deserve consideration in the main suit. I will agree with the Respondent's Advocate on this argument. The question of resemblance of the trademarks is one of fact which requires evidence. No evidence has been led on this matter. While I do not have any quarrel at all on what was observed by this court on the cases relied upon by the Advocate for the applicant, I am afraid to say that in this particular application the advocate has relied on matters which are not yet on record and this court can not give them consideration.

A similar conclusion is also drawn in respect of the principles of irreparable loss and balance of convenience. The submission given by the Advocate which touch on matters

which are related to the period of creation of the applicant's good will, confusion in the identification of the applicant's products, quality of the products, expenses involved in publisizing the applicant's trade marks, how the working capital of the respondent was secured and the infancy of the Respondent in the cigarettes industry are all matters of fact which require evidence. Yet the Advocate for the applicant relied on them to support his application. They are not matters which can be submitted to the court from the bar. The submission made by the Advocate for the Applicant would have been more relevant as final submissions after the trial, but not relevant for temporary injunctions. I totally agree with Advocate for the Defendant that a part of the submission made by the Advocate for the Applicant is premature and unacceptable in applications for temporary injunction.

The nature of the case which has been filed by the Plaintiff/Applicant is one which is not suitable for an order of temporary injunction. This is because of the difficulties involved in laying a demarcation line between matters which can be considered in temporary injunctions without touching on the main suit. In cases like this one, I have always shared the views expressed by My Brother Judge Kalegeya in the case of **Glaxo Group Limited Vs Agri-Vet** (Commercial Case No.73 of 2002(Unreported) when he said –

" My view are that in conflict of trademarks and business names, temporary injunctions should very sparingly be sought by parties and granted by Court's because of the intricacy surrounding the first principle of establishment of a prima facie case with probability of success. I am saying so because I fail to see how the Plaintiff/Applicant can establish a prima facie case with a probability of success without going into details of what he alleges to be passing-Offs or infringement and in turn without the Court analyzing what is submitted and being satisfied of those allegations and at the same time escape from what befell the High Court in Zainabu's."

That is why I started by making an emphasis on what temporary injunctions are intended for.

I will in this case reiterate what I said in my previous decision in the case of **Agro Processing And Allied Products Ltd Vs Said Salim Bakhresa & Co. Ltd (**Commercial Case No.31 of 2004) (Unreported). The facts of that case were similar to this case. I rejected an application for temporary injunction on similar grounds as expressed My Brother Judge Kalegeya in **Glaxo Group Limited Vs Agri-Vet** supra.

Given the observation made, I repeat that this is not a suitable case for temporary injunction. I dismiss the application with costs.

N.P.KIMARO,
JUDGE
15/04/2005

Date 15.4.2005
Coram: Hon. N.P.Kimaro, Judge
For Plaintiff/Applicant – Mrs. Moshi.
For the Defendant/Respondent – Mr. Ndyanabo.
CC: R. Mtey.
Court: Ruling delivered today.
Order: The application for temporary injunction is dismissed with costs.

N.P.KIMARO,
JUDGE
15/04/2005

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I Certify that this is a true and correct of the original/order Judgement Ruling
Sign _____
Registrar Commercial Court Dsm.
Date 15/4/05