

**IN THE HIGH COURT OF TANZANIA  
COMMERCIAL DIVISION  
AT DAR ES SALAAM**

**COMMERCIAL APPLICATION NO.29 OF 2011**

IN THE MATTER OF TRADE AND SERVICES MARKS ACT, CAP 326

IN THE MATTER OF APPLICATION FOR CANCELLATION OF REGISTRATION  
OF TRADE MARK "FLOR" FORMALLY APPLICATION NO.000107 IN CLASS  
33 REGISTERED IN THE NAME OF MOHAN'S OYSTERBAY DRINKS LIMITED

**BETWEEN**

**COMPANIA LICORERA DE CENTROAMERICA, SA.....APPLICANT**

**VERSUS**

**MOHAN'S OYSTERBAY DRINKS LIMITED.....1<sup>ST</sup> RESPONDENT**

**REGISTRAR OF TRADE AND SERVICE MARKS.....2<sup>ND</sup> RESPONDENT**

*Date of final submissions: 16/08/2012*

*Date of last Order: 02/07/2012*

*Date of Ruling: 28/11/2012*

**RULING**

**MAKARAMBA, J.:**

On the 11<sup>th</sup> November 2011, **COMPANIA LICORERA DE CENTROAMERICA, SA**, the Applicant, brought this application in this Court against **MOHAN'S OYSTERBAY DRINKS LIMITED**, the 1<sup>st</sup> Applicant, and The **REGISTRAR OF TRADE AND SERVICE MARKS** the

2<sup>nd</sup> Applicant, for the cancellation of the registration of trademark '**FLOR**' [formally Application No.000107] in Class 33 registered in the name of **Mohan's Oysterbay Drinks Limited**. The application has been preferred under section 36 of the Trade Mark and Service Mark Act, 1986 (Cap.326 of R.E 2002); section 95 of the Civil Procedure Code; and any other enabling provisions of the law. It is supported by the affidavit of **Yande Panya**, the duly appointed attorney in fact of the Applicant. The application is for the following orders, that:

- a) This Hon. Court may be pleased to direct or order the Second Respondent to rectify the register or expunging and/or cancelling the First Respondent's Trade Mark '**FLOR**' (formerly application No.000107) in class 33 from the Register of Trademarks.*
- b) This Honourable Court may be pleased to direct the First Respondent to account for profits earned by him through unauthorized use of the Applicant's trademark "**FLOR**" and similar trademarks and a decree for such amount in favour of the Applicant.*
- c) This Honourable Court may be pleased to direct or order the First Respondent to pay costs of this Application.*
- d) Further or other orders(s) that may be made and/or direction(s) that may be given as this Honourable Court may deem fit and proper.*

The Application with the consent of the learned Counsel for the parties was disposed of by way of written submissions by **Mr. Dindi**, for the Applicant; **Mr. Byamungu**, for the 1<sup>st</sup> Respondent; and **M/s Mhando**, for the 2<sup>nd</sup> Respondent.

On the 19<sup>th</sup> April 2012, the following issues were framed and recorded for the determination of this application, namely:-

- (1) Whether the Applicant's FLOR DE CANA trademark is a well known trademark.*
- (2) Whether FLOR DE CANA is a registered trademark in Tanzania.*
- (3) Whether the 1<sup>st</sup> Respondent's trademark FLOR is confusingly similar to the Applicants trademark FLOR DE CANA.*
- (4) What reliefs are the parties entitled to.*

In the course of his submissions, Mr. Byamungu for the 1<sup>st</sup> Respondent raised a preliminary objection on a point of law that, this application was wrongly initiated by way of Chamber Summons instead of being brought under the Trade and Service Mark Act, Cap.326 R.E. 2002. An affidavit accompanying the Chamber Summons is not evidence for the purposes of removal from the register of the 1<sup>st</sup> Respondent's trademark "FLOR", Mr. Byamungu submitted further. The affidavit is full of hearsay and relies on

photocopies that by any standard cannot be relied upon by the Court to make any fair judgment, Mr. Byamungu further submitted.

Responding to the submissions by Mr. Byamungu, Mr. Dindi for the Applicant submitted that on the 23<sup>rd</sup> March, 2012 when the matter came for hearing of the preliminary objection Mr. Byamungu raised, this Court *suo motu* concluded that, this application having been initiated by "Chamber Summons" has no effect on the merits of this case. Apart from that, Mr. Dindi added that, preliminary objections should be raised at the preliminary stage of the case and notice should be served to the other party, and not during the closing submissions. In buttressing his point, Mr. Dindi referred this Court to the decision of Kimaro, J. in **Commercial Case No.257 of 2002 BETWEEN SYCAMORE INVESTMENT LTD VERSUS JUMA MGASA** thus:

*"....what I would say is that the submission made by Mrs. Muruke on the competency of the suit as closing submissions after the trial, is a misconception. It is a matter which ought to have been argued as a preliminary objection..."*

The ruling of this Court of 23<sup>rd</sup> March, 2012 related to the preliminary objections the learned Counsel for the 1<sup>st</sup> Respondent had raised by way of Notice which he filed in this Court on the 12<sup>th</sup> December, 2011 as follows:

- 1. The application is incompetent for relying on documents in a language not of the court or that understood by the respondent*



*thereby depriving the respondent a fair hearing on the applicant's claim.*

*2. The application is incompetent for being commenced by an incompetent person purporting to derive powers under the purported power of attorney given by another holder of power of attorney. The purported power of attorney upon which these proceedings have been commenced is against the principal of delegatus non potest delegare.*

*3. The affidavit in support of the chamber summons is incompetent for containing legal arguments, speculations and conclusions.*

Clearly the above mentioned preliminary points of objection are distinguishable from the point of preliminary objection Mr. Byamungu, learned Counsel for the 1<sup>st</sup> Respondent has raised in the course of making his submissions. With due respect to Mr. Dindi, the points of preliminary objection Mr. Byamungu in the course of his submissions were not the subject of the ruling of this Court dated the 23<sup>rd</sup> of March, 2003.

In the course of making his closing submissions, Mr. Byamungu raised a point of preliminary objection that the application has wrongly been initiated. The application the subject of this ruling was preferred under section 36 of the Trade and Service Marks Act, and section 96 of the Civil Procedure Code, Cap.33 R.E. 2002 by way of Chamber Summons

supported by an affidavit. Section 36 of the Trade and Service Marks provides as follows:

*"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 an order for making, expunging or varying the entry as shall be deemed fit."*(Emphasis supplied).

Pursuant to section 36 of the Trade and Service Mark Act, the Trade and Service Marks Regulations were promulgated, Regulation 66 of which stipulates that:

*"(1) An application to the Registrar under either sections 35 or 36 for the making, expunging or varying of any entry in the register **shall be made on Form TM/SM 23** and shall be accompanied by a statement setting out fully the nature of the applicant's interest, the facts upon which he bases his case and the relief which he seeks.*

*(2) Where the application is made by a person who is not the registered proprietor of the mark in question it shall be accompanied by a copy of the application and a copy of the statement, and these*

*copies will be transmitted forthwith by the Registrar to the registered proprietor.*

Regulation 66 of the Trade and Service Mark Regulations is conspicuously silent on how a party can make an application for rectification to the Court. Regulation 66 is confined only to the procedure for applying to the Registrar of the Trade and Service Marks for rectification, which is by the prescribed Form TM/SM 23. Mr. Byamungu himself could not make it clear under which procedure this application could be made in this Court. Under such circumstance in my considered view, in the absence of any other procedures for initiating proceedings in Court under section 36 of the Trade and Service Mark Act, the Applicant's application was properly preferred in this Court by way of Chamber Summons supported by affidavit.

The preliminary objection raised by the Counsel for the 1<sup>st</sup> Respondent that the application has wrongly been initiated stands dismissed.

Mr. Byamungu also raised an objection that, an affidavit in support of the application is not evidence and that the affidavit is full of hearsay and is accompanied by secondary evidence. With due respect to Mr. Byamungu, this objection, is in my considered view, misconceived. The issue whether an affidavit forms part of evidence or not cannot be challenged by way of preliminary objection. It is clear under Order XLIII Rule 2 of the Civil Procedure Code that, an application must be supported by an affidavit. The issue whether an affidavit forms part of evidence or

not can only be ascertained during the full trial. We are yet to cross that bridge. The point of the preliminary objection that an affidavit in support of the application is not evidence also stands dismissed.

Mr. Byamungu argues that the affidavit in support of their Chamber Summons is full of hearsay and is accompanied by secondary evidence. This point of preliminary objection is also misconceived. In my considered view, the question whether an affidavit is full of hearsay cannot be challenged in the manner as suggested by Mr. Byamungu. That could be done by challenging the verification clause. Where the issue is whether statements made in affidavit are hearsay, could be tested by looking at the verification clause which discloses which of the facts as deponed are of the deponent's own knowledge and which are subject to another source of information which must be disclosed. Mr. Byamungu has not raised any objection on the verification clause in that affidavit.

The preliminary objection Mr. Byamungu raised that the affidavit in support of the Chamber Summons is full of hearsay fails. It is accordingly dismissed.

Mr. Byamungu has also raised an objection on a point of law that the affidavit in support of application is accompanied by secondary evidence. This point of preliminary objection like the previous two points is also misconceived on two grounds. First, the preliminary objection has failed to stand the legal test laid down in the famous case of **MUKISA BISCUITS MANUFACTURING COMPANY LIMITED V. WEST END DISTRIBUTORS LIMITED (1969) EA 969** that a preliminary objection must be on a pure point of law. Secondly, the issue whether the

accompanying documents to the affidavit in support of the application are primary or secondary evidence in my view is a matter of facts. It cannot therefore be determined by way of preliminary objection as it calls for the adduction of evidence.

It is for the above reasons that the preliminary objection that the affidavit in support of the application is accompanied by secondary evidence also fails. It is hereby dismissed.

In the whole all of the preliminary points of objection that Mr. Byamungu raised in the course of his submissions fail. They are accordingly all dismissed. This holding essentially paves the way for me to determine the issues as framed and recorded for the determination of the application.

The first issue is *whether the Applicant's FLOR DE CANA trademark is a well known trademark*. In his submissions Mr. Dindi argued that, law in Tanzania in terms of section 19(d) of the Trade & Service Marks Act prohibits registration of well-known marks which belong to third parties. Mr. Dindio submitted further that this prohibition emanates from the Paris Convention for the protection of Industrial Property, 1883, which the United Republic of Tanzania has ratified and incorporated under section 2 of the Trade & Service Marks Act. According to Mr. Dindi, the Paris Convention is administered by the World Intellectual Property Organization (WIPO), to which Tanzania is a member, having ratified the WIPO Treaty on the 30<sup>th</sup> December 1983. Article 2 of the WIPO Joint Recommendations on the Protection of Well-Known Marks (Part 1) provides for a formula for determination of well-known marks that, it is not relevant whether:

- (i) *the mark has been used in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, the Member state, or*
- (ii) *that the mark is well known in, or that the mark has been registered or than an application for registration of the mark is well known in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, any jurisdiction other than the Member state; or*
- (iii) *that the mark is well known by the public at large in the member state.*

According to Mr. Dindi what is relevant here is that, the duration and geographical area of any registrations, and/or any applications for registration, of the mark to the extent that they reflect use or recognition of the mark.

Mr. Dindi submitted further that, it is not disputed that the trade mark "*FLor De Cana*" is registered in 27 countries worldwide, namely, the United States of America, Puerto Rico, Uruguay, Argentine, Chile, Brasil, Belize, Venezuela, Bolivia, Ecuador, Colombia, Panama, Costa Rica, El Salvador, Nicaragua, Guatemala, Australia, South Africa, Spain, Italy, Denmark, Liechtenstein, Slovenia, Czech Republic, Japan and China. According to Mr. Dindi, there is also pending application for registration in

Tanzania Mainland and Zanzibar. The products on which the trademark “*Flor De Cana*” is registered are extensively distributed by agents worldwide and more so are advertised by the Applicant’s at *flordecana.co*, *flordecana.net* and *flordecana.us*, Mr. Dindi further submitted

Mr. Dindi argued further that, the Applicant’s trademark “Flor De Cana” is a well-known mark and therefore this Court may be pleased to direct or order the 2<sup>nd</sup> Respondent to rectify the register or expunging and/or cancelling the 1<sup>st</sup> Respondent’s Trade Mark “FLOR” (formally application No.000107) in Class 33 from the Register of Trademarks.

In his response Mr. Byamungu revisited the basic principles of Public International Law on the monist/dualist concepts arguing that since Tanzania follows the dualist system, any rule of International Law must specifically be incorporated in municipal law to be enforceable by courts of law in the country. Mr. Byamungu submitted further that the Paris Convention and the WIPO Recommendations show that, both Panama and Tanzania have acceded to them, but without ratifying any of them. Mr. Byamungu observed that according to principles of International Law, accession and ratification are two different and distinct steps towards making a certain international instrument part of a law of a certain jurisdiction. According to Mr. Byamungu accession refers to the act of joining a treaty by a party that did not take part in its initial negotiations as defined by Article 15 of the Vienna Convention. Ratification is accomplished by filing instruments of ratification as provided for in the treaty.

Mr. Byamungu submitted further that, in Tanzania there is no any Bill that has ever been passed by the Parliament for the ratification of the

instruments cited by Mr. Dindi. Therefore according to Mr. Byamungu, the same cannot assist this Court in any way and the same should be rejected.

Mr. Byamungu submitted further that, although the Trade & Service Marks Act defines the Convention as the Paris Convention of 20<sup>th</sup> March 1983, but it is not stipulated anywhere in the Act that the Convention is part of the Act as Mr. Dindi contends. Section 22(1) of the Trade and Service Marks Act relates to priority only, and therefore its application cannot be stretched beyond the ambit of that section.

Mr. Byamungu submitted further that, the Applicant's trade mark is assumed to have been registered in Panama and not in Tanzania. It cannot therefore be regarded as a well-known mark in Tanzania. In Tanzania registration of a trademark is territorial, hence only the first proprietor of a registered mark can claim infringement and not otherwise.

In her response M/s Mhando, learned Counsel for the 2<sup>nd</sup> Respondent submitted that, the exclusivity in the protection of a trademark is conferred solely on the first registered proprietor within a territorial jurisdiction as per section 14(1) and 31 of the Trade and Service Marks Act.

M/s Mhando conceded to the submission by Mr. Dindi that, section 19(d) of the Trade and Service Marks Act affords protection for a well-known mark even if the mark is not registered. M/s Mhando added that, the law suggests that a well-known mark is considered so well known if the same is well known in the respective country.

M/s Mhando submitted further that, the Applicant has failed to prove any of the six elements enumerated in Article 2 of the World Intellectual Property Organization (WIPO) 1999, which were adopted by the



Recommendation for determination of well known marks. M/s Mhando submitted further that, the word "**public**" as used under Article 2 of WIPO refers to the country in which the Applicant claims knowledge of the mark. There is no evidence in the Applicant's submissions that the mark "**Flor De Cana**" is well-known to the public of Tanzania. The registration of the trademark in other jurisdiction is not a sole proof that it is well-known mark in Tanzania. According to M/s Mhando, the Applicant has failed to prove if the mark has been promoted in the public of Tanzania to be a well-known mark, since no single evidence of promotional or advertisement materials has been submitted by the Applicant in Court to prove the same. The only evidence annexed to the affidavit of the Applicant shows only that the trademark "**Flor De Cana**" has been registered in several other jurisdictions. M/s Mhando referred this Court to the decision of Masati, J. in the case of **TANZANIA CIGARETTE COMPANY VERSUS MASTERMIND TOBACCO (T) LTD, Commercial Case No. 11 of 2005 (unreported)**, where his Lordship held that:

*"....while there might be some evidence on record that evidence is not sufficient to establish that stint of promotion was enough to make the cigarettes well-known."*

M/s Mhando also cited to this Court another case, that of **GLAXO GROUP LIMITED VERSUS AGRI-VET LIMITED, Commercial Case No.73 of 2002** (Unreported) where Kimaro, J. held that, "*the evidence on record proves that the Cofta product was well-known in Tanzania.*"

In rejoinder, Mr. Dindi submitted that, the Applicant's trademark is protected under the Paris Convention and since the Paris Convention applies in Tanzania, the Applicant's mark is therefore protected in Tanzania.

As M/s Mhando rightly submitted, there is no any evidence adduced in this Court to prove whether the trade mark "*Flor De Cana*" is a well-known mark in Tanzania. As my learned Brother Massati, J. observed in the case of **TANZANIA CIGARETTE COMPANY VERSUS MASTERMIND TOBACCO (T) LTD, Commercial Case No. 11 of 2005 (unreported)**, (pp. 32 & 33) there are two major conditions in determining whether a mark is well-known in Tanzania. First, *the fame of a trade mark is normally a function of time*. Secondly, *the promotion of the trade mark*, which he said that *"there must enough stint of it to make the trademark well-known."* In the present application, the Applicant did not inform this Court the duration the trademark has been well-known in Tanzania. Secondly, there is no any evidence adduced to show whether the mark was promoted in Tanzania. It was not clearly stated by Mr. Dindi as to how the ***Flor De Cana*** mark as advertised in ***flordecana.com, flordecana.net*** and ***flordecana.us*** was promoted in Tanzania. Apart from that, Mr. Dindi told this Court that, the mark was still pending for registration in Tanzania. It is therefore difficult to believe without evidence that, the mark is well-known in Tanzania.

It is for the foregoing reasons that the first issue, whether the Applicant's "**FLOR DE CANA**" trademark is a well known trademark in Tanzania is to be answered in the negative.

The second issue is *whether Flor De Cana is a registered Trade Mark in Tanzania*. Mr. Dindi argued that, the issue of registration of the trademark in Tanzania is irrelevant because Article 2 of the WIPO Joint Recommendations on the protection of well-known Marks, declares that it is not relevant whether “(i) *the mark has been used in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, the Member state, or (ii) that the mark is well known in, or that the mark has been registered or that an application for registration of the mark is well known in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, any jurisdiction other than the Member state.*”

In his response Mr. Byamungu submitted that, the Applicant has not adduced any proof to establish the fact that the trademark *Flor De Cana* was dully registered in Tanzania. The registration of trade mark in Tanzania is not universal but rather territorial as per section 14(1) & (2) of the Trade and Service Mark Act. Mr. Byamungu submitted further that, section 30 and 31 of the Trade and Service Marks Act provides that exclusive right accrues to the proprietor of the trademark subsequent upon registration. From these provisions a person is not entitled to institute proceedings for infringement of an unregistered trademark.

In his rejoinder, Mr. Dindi submitted that, a country can be a party by signature only. Tanzania did sign the WIPO convention without reservation. Therefore Mr. Byamungu arguments on reservation are irrelevant, Mr. Dindi further submitted. According to Mr. Dindi, the Paris Convention did not require ratification as well. Since Article 12(1) of the

Paris Convention clearly states that, any country outside the union may accede to the Convention and thereby become a member of the union. Tanzania acceded to the Paris Convention in 1963. Mr. Dindi added that, the Paris Convention is mentioned in several sections of the Trade and Service Marks Act of the Laws of Tanzania, including section 2 and 19(d) of the Act. The Paris Convention should therefore be regarded as part of the domestic law of Tanzania.

Mr. Dindi submitted further that, the implementation of the Paris Convention can be done by any means such as enforcement by the Court, tribunals and government authorities. Article 63(3) (d) of the Constitution of the United Republic of Tanzania gives mandate to the Parliament to enact legislations where implementation requires legislation. However, there is no need for having a local legislation for each international treaty.

According to Mr. Dindi a country can become a member or a party to a treaty in a manner provided for under Article 11 of the **Vienna Convention of the Law of Treaties, 1969**, to which Tanzania is a party. Article 11 of the Vienna Treaty reads as follows:

*"The consent of a state to be bound by a treaty may be expressed by signature, exchange of instruments consisting a treaty, ratification, acceptance, approval or accession or by any other means if so agreed."*

Mr. Dindi maintained that, the registration of the Applicant's trademark is not relevant because Sub-Article 2(3)(a)(i) clearly provides

that the registration of a mark in a member state is not a factor required for determining a well known mark at International Level.

The argument of Mr. Dindi that if a mark is recognized under International Instruments, the same can be said to be automatically registered in Tanzania is misconceived. The question of automatic registration of a trade mark is displaced by section 28(2) of the Trade and Service Marks Act, Cap.326 R.E. 2002 under which proof of registration of trade mark is by means of a Certificate in the prescribed form issued by the Registrar of Trade and Service Marks. A Certificate of registration of a trade mark is therefore the only conclusive evidence of registration of a trade mark, the absence of which a party cannot seek protection under the law. In the present application no any evidence of a Certificate of Registration was adduced by the Applicant to prove registration of the "**Flor De Cana**" mark. In any event as the Applicant readily conceded, the registration of the "*Flor De Cana*" mark in Tanzania was still pending and therefore there could be no such evidence. It is without any shadow of doubt whatsoever that the mark "*Flor De Cana*" has not yet been registered in Tanzania.

It is for the above reasons that the second issue *whether Flor De Cana is a registered Trade Mark in Tanzania* is to be answered in the negative.

The third issue is *whether the 1<sup>st</sup> Respondent's Trademark Flor is confusingly similar to the Applicant's De Cana Mark*. Mr. Dindi argued that, sections 19(d) and 20(1) of the Trade and Service Marks Act of the Laws of Tanzania do not allow the registration of a trademark which is liable to create confusion. Mr. Dindi submitted further that Courts in Tanzania have

established tests for determining the “confusingly similarities” of trademarks.

The first test is *comparison of a trademark as a whole*. Under this test the court has to look on the complete wording of the trademarks. In the case of **TANZANIA BREWERIES LIMITED VERSUS KIBO BREWERIES LTD AND ANOTHER**, Civil Case No.34 of 1999 (unreported), the High Court of Tanzania at Dar es Salaam stated as follows:

*"The Court will have to compare the whole of the Plaintiff's mark and get up with the whole of the defendant's mark and get up to see whether there are similarities which go to create or show the prospect of confusion or actual deception."*

Mr. Dindi submitted further that the second test was also developed in the ***Tanzania Breweries Limited case*** (above) in which a court “wears the shoes of a common man” and to consider what an ordinary man is likely to think about the two trademarks. This test was adopted by this Court in a latter case, in **Commercial Case No.73 of 2002 between GLAXO GROUP LIMITED VERSUS AGRI-VET LIMITED** in which it was held that:

*"The application should show that the two Trade Marks have resemblance which to an eye of common person is capable of deception, making that person to think one product as being of the*

*other. Thus in drawing its conclusion **the Court has to wear the shoes of a common man, spread the two marks before itself and ask itself whether there are resemblance between the two which would make it pick a product which was not intended by but the opposite.***” (Emphasis added).

In his submissions Mr. Dindi alluded to the fact that, the similarities of the two trademarks are that, first, both are made of the dominant name “FLOR.” Second, both are registered in Class 33 for all types of liquors particularly wines and spirits. Third, both trademarks are used in liquor business particularly, and spirits, and that both are in the Tanzanian market. Mr. Dindi submitted further that these resemblances are capable of deception, making any ordinary person to think the owner of one product as being of the other. The 1<sup>st</sup> Respondent’s trademark FLOR is confusingly similar to the Applicant’s FLOR DE CANA trademark. Mr. Dindi referred this Court to the case of **BATA INDIA LTD VERSUS PYARELAL & CO., MEERUT CITY & OTHERS AIR 1985 All. 242**, in which the words “**BATA**” and “**BATAFOAM**” were confusingly similar even if they were not used for similar goods and the Court therefore held that:

*“It is this impression which may ultimately cause damage to the reputation of the Plaintiff. It amounts to an invasion of his right vis-a-vis the name “Bata”...the name “Bata” is neither a fancy name nor paternal name nor in any way connected with the defendant. It is not the name of a flower or fauna. It is a fancy name of a foreigner who*

*has established his business in making shoes and the like products in this country. The name is well known in the market and the user of such a name is likely to cause not only deception in the mind of an ordinary customer but may also cause injury to the Plaintiff-Company. It is notable here that while the Court considered likelihood of confusion and deception by the Defendants mark BATAFOAM as a factor in granting relief to the Plaintiff, it also took into account the "injury" that the Defendants use of their mark might cause to the Plaintiff, whose name was well-known in the market."*

In response Mr. Byamungu submitted that, the Applicant is given protection over subsequent applications in event of similarity. This position was well stated in the case of **TANZANIA CIGARETTE COMPANY LTD VERSUS MASTERMIND TOBACCO (T) LTD [2006] T.L.R. 144** where it was held that:

*"Although the Plaintiff procured the registration of "Safari" Trademark earlier before that of the Defendant, the Defendant nevertheless had prior rights over the "Master" trademark by virtue of making the application first."*

Mr. Byamungu submitted further that, section 20(1) of the Trade and Service Marks Act prohibits registration of a subsequent trademark resembling that which already exists in the Register. The Applicant is not entitled to make any claim over the 1<sup>st</sup> Respondent's trademark. According



to Mr. Byamungu, the use of the Applicant's trademark in Tanzania is illegal.

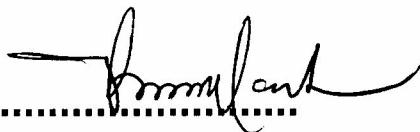
In her response, M/s Mhando submitted that, the only mark on the Register of the Trade Mark in respect of wine and spirits Class 33 is **"FLOR."** The Applicant's mark **"Flor De Cana"** is not yet registered; therefore the likelihood of confusion here does not arise. A mere name which does not enjoy consumption is not a subject of confusion to consumers since there is no comparison in the market. M/s Mhando submitted further that, the Applicant has also failed to prove on whether consumers of the products have been confused by the existence of the two marks.

In my considered opinion, the words **"FLOR"** and **"FLOR DE CANA"** in are not similar and cannot therefore cause any confusion. These two words are separate and independent. The word **"FLOR"** is an English word which according to ***Oxford Dictionary*** 10<sup>th</sup> Edition means *"yeast allowed to develop in a whitish film on the surface of dry (fino) cherries during fermentation."* The word **"FLOR DE CANA"** on the other hand is a Spanish word which stands for *"sugarcane flower."* In my considered opinion one cannot pronounce a Spanish word **"FLOR"** without **"DE CANA"** because it can distort the whole meaning of the mark. The word **"FLOR"** which relates to the fermentation process for yeast cannot therefore be said to be similar to the word **"FLOR DE CANA"**, which means "sugarcane", unless someone wants to shorten **"FLOR"** in respect of **"FLOR DE CANA"**, which in my view will make no sense. In this application this Court has not been told if ordinary or common people

would use "**FLOR**" to connote "**FLOR DE CANA.**" Also, as M/s Mhando rightly submitted, the Applicant has failed to prove whether the two marks ever brought any confusion to any person. The fact that the Applicant's mark is pending for registration in Tanzania and therefore not yet registered should also be taken into consideration in addressing the question whether there is similarity in the two words which is likely to cause confusion among the consumers of products for which the two words represent on the Tanzanian market. As I have already determined in this application, the Applicant's mark is not a well known mark in Tanzania. It cannot therefore cause confusion among the common or ordinary people. In the absence of a registered trademark in "**Flor de Cana**", the Applicant has failed to establish that the two Trade Marks have resemblance which to an eye of common person is capable of deception, making that person to think one product as being of the other.

It is for the above reasons that the third issue *whether the 1<sup>st</sup> Respondent's Trademark Flor is confusingly similar to the Applicant's Flor De Cana Mark* is to be answered in the negative.

In the whole and for the above reasons the Application fails. It is hereby dismissed with costs. Order accordingly.

  
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**R.V. MAKARAMBA**

**JUDGE**

**28/11/2012**

Ruling delivered this 28<sup>th</sup> day of November, 2012 in the presence of  
Mr. Nkuba, Advocate for the Applicant, Mr. Godson Nyange, Advocate  
for the 1<sup>st</sup> Respondent and Mr. Kasera for 2<sup>nd</sup> Respondent

A handwritten signature in black ink, appearing to read 'R.V. Makaramba', is written over a horizontal dotted line.

**R.V. MAKARAMBA**

**JUDGE**

**28/11/2012**

Words, 5,371