

**IN THE HIGH COURT OF THE UNITED REPUBLIC OF TANZANIA  
(COMMERCIAL DIVISION)**

**AT DAR ES SALAAM**

**COMMERCIAL CASE NO. 60 OF 2019**

**GODREJ CONSUMER PRODUCTS LIMITED ..... PLAINTIFF**

**VERSUS**

**TARGET INTERNATIONAL (T) LIMITED ..... DEFENDANT**

**JUDGMENT**

*07/11/2023 & 14/11/2023*

**SIMFUKWE, J.**

The plaintiff company Godrej Consumer Products Limited is a company incorporated and existing under the laws of India, Pirojshanagar, Eastern Express Highway, Vikhroli (East), Mumbai 400079. The defendant is also a limited liability company incorporated under the Companies Act, Cap 2012, carrying on its business in Tanzania. The plaintiff claims against the defendant for an order declaring that the defendant's supply in Tanzania market of mosquito and insect repelling spray bearing the Trade Mark

"HIT", including the container shape, colours and labels of the products, which amount to passing off and infringement.

It has been stated in the plaint that, the plaintiff is part of Godrej Group of Companies which are engaged among other things, in the manufacture of a unique and distinctly packaged mosquito and insect repelling spray under its well-known Trade Mark "HIT" (hereinafter referred to as "plaintiff's HIT products"). That, the HIT products consist of a distinctively shaped and packaged spray cans of 275 mls, 400 mls. 600 mls, 720 mls and 750 mls in various colours which connotes the various fragrances of the spray.

It was stated further that, sometimes around April, 2019, the plaintiff's officers discovered counterfeit HIT products in the Tanzanian market, which are an exact copycat of the plaintiff's HIT products which are being imported and distributed by the defendant, and who is passing the said products as though they are the products of the Plaintiff, while they are not.

The Plaintiff outlined the particulars of passing-off as follows:

- a) Defendant's counterfeit products consist of an exact shaped spray can as that of the Plaintiff's Hit products;

- b) The Defendant's counterfeit products bear the word mark "HIT" as do the Plaintiff's Hit products;
- c) The get-up of the Defendant's counterfeit products, i.e the image of the mosquito on the body of the spray can, the rainbow colour combination surrounding the mosquito image is identical to Plaintiff's HIT products;
- d) The colour combination of the spray can is identical in both the Defendant's counterfeit products and the Plaintiff's products. The spray can, has a shiny blue colour with a green cap;
- e) The writing scheme, font, explanations have also been copied by the Defendant.
- f) To demonstrate the resemblance, images of the products are placed side by side.

The images of the Plaintiff's alleged genuine can and Defendant's so called counterfeit can, were shown in the plaint.

In order to demonstrate its right over the HIT trade mark, the Plaintiff averred that, together with its affiliated companies, have been manufacturing and supplying into the Tanzanian market the mosquito spray bearing its well-known "HIT" Trade Mark for over 20 years. The said products have been available in various sizes, fragrances and shapes

spray cans. That, the current authorized distributor is BOPAR ENTERPRISES LIMITED. The said supply and distribution, has been continuous and uninterrupted for the said 20 years.

The plaintiff also mentioned the registration numbers of the "HIT" Trade Mark in Zanzibar and Tanzania Mainland to be: No. ZN/T/2015/219 and TZ/T/2011/147 respectively. Both registrations were in Class 5 in respect of "Mosquito repellents in the form of mats, coils and liquids; insect repelling and destroying substances and preparations; household insecticides, pesticides and disinfectants. It was contended that the noted registrations have at all material times hereof been valid and subsisting on the Trade Mark and Services Marks Register until 25 April 2018 when the Registrar in Tanzania Mainland, upon a mala-fide application by HB WORLDWIDE LIMITED, removed the Trade Mark from the Register on a false allegation based on non-use, and without affording the Plaintiff the right to be heard. The plaintiff has appealed against the said removal, to the High Court and the appeal is still pending.

It was elaborated that the defendant's conduct of using and copying the entire product of the plaintiff is mala-fide and calculated to mislead or cause confusion to the consumers in the market into believing that the products originate from the same manufacturer or that there is connection

in trade between the plaintiff and the defendant. The plaintiff was of the view that the defendant's conduct amounts to infringement and passing off; and has tarnished or likely to tarnish the plaintiff's reputation in the Tanzanian market.

The plaintiff prayed for judgment and decree against the defendant as follows:

- a) An order declaring that the defendant's conduct amounts to passing off and infringement.
- b) A permanent injunction restraining the defendant, whether by its officers, servants, agents or any of them or otherwise from infringing the plaintiff's Trade Mark HIT.
- c) A permanent injunction restraining the defendant, whether by its officers, servants, agents or any of them or otherwise from importing, distributing, selling or advertising for sale any mosquito and insect repelling products in Tanzanian market which are confusingly similar to the plaintiff's products;
- d) An order for the obliteration of the plaintiff's Trade Marks on all boxes, packages, labels and display matter, in respect of any mosquito and insect repelling products which are confusingly similar to the plaintiff's products and are in the defendant's possession,

custody and/or control and any other goods that may still be held or owned by the defendant;

e) General damages;

f) Costs of the suit;

g) Any other or further relief that the Court deems just and equitable to grant.

In the Written Statement of Defense, the defendant vehemently disputed the claims of the plaintiff and stated that, the plaintiff is neither the owner of the Trade Mark nor has any right over the said Trade Mark in Tanzania Mainland. As such, the plaintiff can neither claim for infringement nor passing-off. That, since the plaintiff is not the registered owner of the Trade Mark "HIT" in Tanzania Mainland, the allegations of counterfeit are baseless, unfounded and purely intends to mislead the Court. It was asserted that, the defendant is a sister company and authorized importer, distributor and seller given right by the proprietor of the Trade Mark M/S HB WORLDWIDE LIMITED, a limited liability company registered in Tanzania and owner of HIT Trade Mark under registration number TZ/T/2010/1091. The image of the Mosquito and colours on the body of the can are registered by HB WORLDWIDE LIMITED under certificate registration number TZ/T/2015/1304 in class 5.

Contesting the allegation that the disputed Trade Mark is registered as the property of the plaintiff, the defendant contended that, Trade Mark No. TZ/T/2011/147 was registered in the name of Godrej Household Products Limited and not Godrej Consumer Products Limited the plaintiff in this matter. It was contended further that; the said Trade Mark was expunged on 25<sup>th</sup> April 2018. The Trade Mark with registration No. ZN/T/2015/219 was said to have been registered in the name of Indovest Limited Capital and not the plaintiff's name. In addition, it was alleged that HB WORLDWIDE LIMITED is the proprietor of Trade Mark HIT and its colours, image and logo in Tanzania mainland under certificate No. TZ/T/2010/1091 and TZ/T/2015/1304, both in class 5.

Concerning the alleged pending appeal against the expungement of the Trade Mark, it was stated that, the present case has been filed prematurely prior to determination of the said appeal on merit.

During the hearing of this matter, the plaintiff was represented by Mr. Mohamedzameen Nazarali and Mr. Evarist Kameja, learned counsels while the defendants enjoyed the service of the senior counsel Mr. Mpaya Kamara and Mr. Gulamhussain Yusuf, learned counsel. The following issues were framed as guidance of determination of the matter:

- 1. Whether the plaintiff has locus standi to institute this suit.*

- 2. Whether the plaintiff and its affiliate companies are producers of HIT insecticide for Tanzania.*
- 3. Whether the plaintiff and its affiliate companies have been legally supplying HIT insecticide in Tanzania.*
- 4. Whether it is the plaintiff and its affiliate companies or defendants who own HIT trade mark in Tanzania.*
- 5. Whether HIT insecticide produced and distributed by the plaintiff and its affiliate companies has reputation and good will in Tanzania.*
- 6. Whether HIT products produced and distributed by the defendant are identical to those produced and distributed by the plaintiff and its affiliate companies.*
- 7. Whether distribution of identical HIT products by the defendant amounts to passing off.*
- 8. To what reliefs are the parties entitled.*

Pursuant to **Rule 49 (2) of the High Court (Commercial Division) Procedure (Amendment) Rules, 2019**, parties were ordered to file witness statements. Whereas, the plaintiff called four witnesses and tendered twenty-two (22) physical and documentary exhibits to prove their case. The defendant had two witnesses and 22 exhibits. All witnesses



identified their witness statements which were adopted to form part of their evidence in chief.

The hearing of the matter commenced before my learned brother Hon. A. Mbagwa J. It was reassigned to me in a special clearance session.

**PW1 Mr. Malik Khamis Said** the sales manager of Bopar Enterprises PTE Limited stated inter alia that, Bopar Enterprises PTE Limited is a limited liability company registered in Zanzibar. The company deals with wholesale business of importing and distribution of various products in Tanzania Mainland and Zanzibar. The said products include, cooking oil, milk, cosmetics and insecticides with the logo and trademark "HIT." That, HIT products are imported from Indonesia where they are manufactured by the company called P.T. Megasari Makmur. PW1 produced one HIT spray can (orange), which was admitted as **exhibit P1**. Also, PW1 tendered twenty-two bills of lading in respect of HIT brand mosquito aerosol from Jakarta Indonesia to Zanzibar port and Dar es Salaam, which were admitted as **exhibit P2 collectively**.

PW1 made reference to invoices issued by Bopar for HIT products consignment. Ten invoices attached with their corresponding bills of lading and certificate of authenticity sworn by PW1, were admitted as **exhibit P3 collectively**. He identified HIT products which are distributed

by Bopar. He said that, HIT products are packed in cans of different sizes, various flavours and fragrances.

PW1 mentioned some of their esteemed customers and distributors to be; Abdallah Nasir trading as Bopar Dar, Zahor who has a shop at Kariakoo, Ms Amina who had a shop at Kariakoo and Willy. Proving the distribution of HIT products in Tanzania Mainland, PW1 referred to delivery notes of various products including HIT from Bopar. Forty-seven (47) delivery notes for the years 2010 to 2019 were admitted as **exhibit P4 collectively**.

PW1 stated further that, HIT products are greatly needed in Tanzania to the extent that the stocks vanish quickly in their godown. From 2008, they have been importing the product in Tanzania Mainland and Zanzibar, non-stop to the extent of having a good will.

PW1 concluded by saying that for Tanzania Mainland and Zanzibar, the company authorized to distribute HIT products is Bopar authorized by P.T. Megasari Makmur. Anyone else distributing the product apart from Bopar and P.T. Megasari, infringes their trade mark by intervening their established market in Tanzania.

**PW2 Mr. Faraji Taratibu** gave a testimony to the effect that, he is an advocate of the High Court of Tanzania with Roll No. 5107. His practicing

certificate was admitted as **exhibit P5**. He narrated that in or around 2020, he was instructed by the plaintiff to conduct an investigation in Dar es Salaam market to scout and establish whether the defendant was distributing products under HIT Trademark in respect of which there had been a temporary injunction ordered by this court in Misc. Commercial Application No. 54 of 2019. The purpose of the instruction was to confirm whether or not the defendant was complying with the court order of restraint from trading the products that are subject of litigation in the present proceedings, namely, HIT aerosol products. His investigation was conducted for a period of seven days, from 26<sup>th</sup> to 31<sup>st</sup> October 2020 and 3<sup>rd</sup> November 2020. During his investigation, PW2 discovered that the defendant was engaged in distribution of HIT products at a very large scale around various areas of Dar es Salaam. He found out the location of the warehouse at Ilala Dar es Salaam and took a photograph of it. The photograph together with certificate of authenticity were admitted as **exhibit P6 collectively**.

PW2 narrated further that, on 27/10/2020, he once again went to the said warehouse and found vehicles loading and unloading boxes which had HIT logo on them. He was able to confirm that the premises at Lugoda street that's where the defendant used to keep the HIT products which it

was distributing. He visited the location on 28 and 29 October 2020 but it was closed on account of public holiday. Thereafter, PW2 made follow up of different motor vehicles which were leaving the warehouse to various places including Julius Nyerere International Airport Road, Chang'ombe road, Tandale, Magomeni, Gongolamboto, Kariakoo and Chanika in Dar es Salaam. Along the way, he was able to see the said vehicles distributing products of Rungu and HIT brands. He produced samples of HIT products which he purchased while making follow up of the vehicles bearing the words:

***Imported & distributed by:***

***Target International (T) Limited***

***Lugoda Street, Dar es Salaam, Tanzania.***

One box and twelve cans of HIT spray were admitted and marked as **exhibit P7 collectively.**

**PW3 Irene Akinyi Oduor**, asserted among other things that, she is a Legal Executive of Style Industries Limited, a Kenyan company and subsidiary of Godrej Consumer Products Limited. She said that, the plaintiff was incorporated on 29<sup>th</sup> November 2000. A certificate of Incorporation of Godrej Consumer Products Limited dated 29<sup>th</sup> November,

2000 was produced and admitted as **exhibit P8**. She explained that, the plaintiff is manufacturing, marketing, distributing and supplying personal care products, home care products such as home insecticide, air fresheners and detergents. For that purpose, the plaintiff has established a number of subsidiary companies which together formulate a group of companies of which the plaintiff is the ultimate beneficial owner.

PW3 testified further that, "HIT" is a trademark which was conceived and coined in the year 1991 by Transelektra Domestic Products Limited, an Indian company, and has ever since been used extensively in Asia and some African countries for household insecticides. She gave a series of change of the trademark ownership from Transelektra Domestic Products Limited to Godrej Hicare Limited in 1996, in 1999 Sara Lee Limited acquired the majority shares of the company and in 2010 Godrej Sara Lee Limited changed to Godrej Household Products Limited. On April 2011, Godrej Household Products Limited and the plaintiff entered into and executed a scheme of Amalgamation through which all the assets and liabilities of Godrej Household Products Limited were transferred to the plaintiff. The said scheme was sanctioned by the High Court of India on 28/02/2011 and registered by Registrar of Companies in India on 01 April 2011. Certified copy of court order of the High Court of India at Bombay,

Scheme of Amalgamation and letter dated 31 March 2011 were admitted as **exhibit P9 collectively**.

It was explained further that, "HIT" Trademark has been used in respect of insecticides in African countries of Democratic Republic of Congo, Zambia, Tanzania, Malawi, Ethiopia, Uganda and Nigeria; Middle East: Dubai, Saudi Arabia, Oman, Qatar, Bahrain; Asia: India, Bangladesh, Nepal and Sri Lanka. In all these countries the said Trademark is being used either directly by the plaintiff or by one of its subsidiary companies under a Master Service Agreement. A Master Service Agreement for Godrej Consumer Products Limited was admitted as **exhibit P10**.

PW3 elaborated the organization of the group of companies of which the plaintiff is ultimate beneficial owner. She said, P.T. MEGASARI MAKMUR is 99.95% owned by Godrej Consumer Holdings Netherland BV (GCHN BV) a Netherland Company, GCHN BV is 100% owned by Godrej Consumer Products Dutch Cooperatief UA (GCPDC UA) a Netherland company, GCPDC is 99.999% owned by Godrej Consumer Products Holding (Mauritius) Limited, GCPHML a Mauritius Company is 100% owned by the plaintiff. It was elaborated further that; products of HIT trademark began to enter Tanzania market sometimes in 2008 to 2010 via one Said Nasser Nassor trading as Bopar Enterprises PTE Limited a

Zanzibar company. The products have Kiswahili language on the label of the products and TBS certification to signify that the same is for Tanzanian market.

Certified copies of certificates of registration of HIT trademark in the aforementioned countries vide paragraph 9 of the witness statement of PW3, were admitted as **exhibit P11 collectively**.

PW3 supported evidence of PW2 in respect of importation of HIT products to Tanzania from 2012 to 2020, registration of the trademark in Tanzania Mainland, Zanzibar and other countries. PW3 was of the view that HIT trademark has already acquired goodwill and a favourable reputation in Tanzania Mainland, by virtue of evidence of sales and revenues generated from the Tanzanian market. That, as a result there is a high market demand for HIT products originating from the plaintiff or its subsidiaries and associated companies. The immense goodwill of the Trademark and the products has tempted some local traders in Tanzania to seek to have a free-ride on the goodwill and reputation. That, they have begun copying the plaintiff's Trademark and products and selling the exact replica of the said products, the defendant being one of them. PW3 believed that the goodwill of HIT products is attributed to the plaintiff who is the rightful proprietor of the same by virtue of Master Service Agreement of 2017.

PW3 testified further that on 25 April 2018, the Tanzanian registration No. TZ/T/2011/147 for HIT, despite being successfully renewed for a period of 10 years, was expunged from the Register of Trademarks by the Registrar through *ex-parte* proceedings which were initiated by a company known as HB Worldwide Limited on the false and erroneous allegations that HIT was not being used in Tanzania. Following the *ex-parte* expungement, the plaintiff filed an appeal to challenge the decision of the Registrar of Trade and Service Marks before the High Court of Tanzania (Dar es Salaam District Registry) at Dar es Salaam, in Civil Appeal No. 147 of 2019 which is still pending. PW3 averred that, she understands that although the Trademark was expunged from the Register of Trademarks, the said expungement did not affect the value of the goodwill which is associated with the HIT Trademark. That, the goodwill remained the property of the plaintiff. It was stated further that, subsequent to the expungement, the defendant began to import insecticide products under the brand name HIT, in identical representation in terms of the colours and the entire get-up of the product.

PW3 averred that, the defendant is a sister company of HB Worldwide Limited who is a competitor of the plaintiff through its RUNGU products, also an insecticide. HB Worldwide had purported to register HIT in its own



name under Registration No. TZ/T/2010/1091 in class 5. However, the application was opposed by the plaintiff in Opposition proceedings before the Registrar of Trade and Service Marks. The Registrar dismissed the plaintiff's Notice of Opposition on technical grounds, but on appeal to the High Court of Tanzania, in Commercial Appeal No. 2 of 2019, the decision of the Registrar was reversed. The certificate of registration issued by the Registrar of Trade and Services Marks was declared by the Court to be of no legal effect and was invalidated. Ruling and Drawn Order of the Deputy Registrar of Trade and Service Marks dated 2<sup>nd</sup> April 2019 were admitted as **exhibit P13 collectively**. Judgment in Commercial Appeal No. 2/2019, High Court (Commercial Division) and its Decree were admitted as **exhibit P14**. PW3 made further reference to the Official Journal of Patents and Trade/Service Marks for Tanzania Mainland dated 15 August 2019 which shows attempts by HB Worldwide Limited to register the HIT brand, which does not belong to it. The Journal was admitted as **exhibit P19**. The applications which were filed by HB Worldwide Limited were all opposed by the plaintiff through the service of Bowmans Tanzania Limited, under the instructions of the plaintiff. Twenty Notices of Oppositions were collectively admitted as **exhibit P12**. Copies of application to the Registrar for rectification of the register, letter from Gulamhussain Yusuf Hassam to the Registrar of Trade and Service Marks

Tanzania for expungement of HIT trademark from Godrej Household Products Limited dated 4<sup>th</sup> April 2017 and letter from Registrar of Trade and Service Marks to Abdulmalik & Surendra, dated 25 April 2019, were admitted as **exhibit P15 collectively**. Also, PW3 tendered two cans of HIT insecticide, one with yellow colour and another with green colour. The cans were admitted as exhibit **P16 collectively**.

In support of her evidence, PW3 tendered Memorandum of Appeal in Civil Appeal No. 147 of 2019 (supra), which was admitted as **exhibit P17**. The witness also buttressed her evidence at paragraph 40 of her statement by producing in court two RUNGU insecticides, which were admitted as **exhibit P18 collectively**.

In proof that the defendant company and HB Worldwide Limited are owned by the same shareholders and have the same registered address, PW3 produced various documents in respect of incorporation, association, and annual returns of the two companies. The documents were admitted as **exhibit P20 collectively**. The Certificate of Incorporation of Sara Lee Limited was admitted as **exhibit P21**.

PW3 concluded her evidence by stating that, it is apparent that the defendant company is being used to eliminate competition for the benefit of HB Worldwide Limited. That, the defendant and HB Worldwide Limited's

conducts amounts to unfair competition against the plaintiff and passing-off of HIT trademark.

**PW4 Yassin Mustapha** testified that, he is an administrator of the company known as Sigma Hair Industries Limited, a company registered in Tanzania which is part of Godrej Group of Companies. He said that, part of his job is to ensure regulatory compliance of Sigma and all other companies of Godrej Group of Companies, who might need regulatory compliance assistance here in Tanzania. He stated further that, Sigma is part of Godrej Group of Companies which the plaintiff is the ultimate beneficial owner. Also, PW4 informed this court that P.T. MEGASARI MAKMUR an Indonesian entity is one of the subsidiary companies within Godrej Group of Companies of which the plaintiff is 100% owner. PW4 informed the court that P.T. MEGASARI MAKMUR is a manufacturer of HIT products which are being distributed in Tanzania by Bopar Enterprises PTE Limited ("Bopar"). He alleged that, he is responsible to ensure that the distribution of HIT products in Tanzania Mainland, originating from P.T. MEGASARI MAKMUR, have complied with all legal and regulatory requirements. He gave an example of renewal of Tanzania Bureau of Standards (TBS) registrations. He insisted that, he was a custodian of TBS registration and renewal certificates. He produced Tested Products

Certificate No. 0188, dated 25/07/2012. It was admitted as exhibit P22. It was observed that, the said tested product certificate, was issued in favour of PT MEGASARI MAKMUR certifying that the HIT aerosol had been tested and met TBS specifications and standards.

Moreover, PW4 stated that, he was also a custodian of annual renewal receipts confirming that the said HIT products have continued each year from the date of registration, to be certified as TBS compliant. PW4 was also a custodian of Pesticide Registration Certificate for HIT Aerosol, issued by Tropical Pesticides Research Institute. The Pesticide Registration Certificate was issued in the name of Sigma because it was Sigma who applied for the registration as a local entity based in Tanzania and related to P.T. MEGASARI MAKMUR.

PW4 concluded that, the plaintiff and its subsidiaries and affiliated companies have been distributing HIT products in the Tanzanian market since 2008. He said that he was aware that the plaintiff's HIT products have acquired goodwill in the Tanzanian market worth more than ten years.

That was the end of the plaintiff's case.

**DW1 Mohamed Ramzanali Virani's** testimony was that he is currently working as Manager of Target International (T) Limited, the defendant

herein. As the defendant's Manager, his roles include day to day management and supervision of the defendant's activities, importation of goods on behalf of the defendant, supervising the whole process of selling and distributions of goods, signing various businesses undertaking, negotiations and entering into various contracts. He noted that, the defendant deals with importing, selling and distribution of different kinds of items including mosquito repellents spray and aerosols of different kinds and nature.

As a principal officer of the defendant, DW1 said that he is aware of the instant matter of which the defendant has vigorously denied the plaintiff's claims. He proceeded to give his evidence in response to the raised issued.

On the first issue ***whether the plaintiff has locus standi to institute the present suit against the defendant***, on the outset, DW1 tendered copy of the ruling in this case in respect of the preliminary objection which was raised which is similar to the issue at hand. In the said ruling, the preliminary objection was found not to fall under the ambit of pure point of law as it would require evidence. The said ruling was admitted as **exhibit D1**. DW1 stated that, the plaintiff is not a registered proprietor of the word "HIT" as a Trademark, be in Tanzania Mainland or Zanzibar. He referred to annexure 2 and 3 of the plaint which show that the

registered proprietors of the trademark are **Indovest Limited Capital** and **Godrej Household Products Limited** respectively. DW1 stressed that, HIT as a Trademark and Get-up vide registrations No. TZ/T/2010/1091 and TZ/T/2015/1304 are in the name of HB Worldwide Limited. Whereas, HB Worldwide has permitted its sister company, the defendant herein to use HIT both as a trademark and get-up. DW1 tendered letters dated 17<sup>th</sup> and 30<sup>th</sup> July 2020 with the heading "RE: SEARCH FOR TRADE MARK(S) REGISTERED UNDER THE NAMES OF GODREJ CONSUMER PRODUCTS LIMITED." The two letters were admitted as **exhibit D2 collectively**. Also, The Trade/Service certificate of "MAX" dated 27/10/2016 was admitted as **exhibit D4**. The Pesticide Registration Certificate No. 2027 dated 22/5/2018, was admitted as **exhibit D5**. The Experimental Pesticide Registration No. 1747 dated 18/5/2012 was admitted as **exhibit D6**

DW1 conceded that initially Godrej Household Products was the registered owner of the trademark HIT with registration number TZ/T/2011/147 until on 25<sup>th</sup> April 2018 when it was expunged from the register for non-use. He tendered copy of the letter from the Registrar with reference number MIT/BRELA/TZ/T/2011/147/22 dated 25 April 2018. It was admitted as exhibit D7.

Concerning the complaint of the plaintiff that it was not afforded right to be heard before the registrar's aforesaid decision, and that the decision was made mala-fide, DW1 said that the plaintiff has never been the registered owner of the trademark HIT. Thus, could not have been a party to the proceedings for expungement thereof.

Countering the allegation that the plaintiff amalgamated with Godrej Household Products in 2011, DW1 stated that Godrej Household Products still exists as it continued to file documents on its own names. He referred various matters which were filed in court post 2011 in which Godrej Household Products was a party. He alleged that; the plaintiff is an imposter.

On the second issue, ***whether the plaintiff and its affiliated companies are producers of the HIT insecticides for Tanzania;*** DW1 asserted that the plaintiff does not possess either the registration nor clearance from TPRI/TPHPA to conduct any activity in respect of pesticide in Tanzania. That, if the plaintiff and its affiliates have been manufacturing and supplying mosquito spray bearing HIT trade mark in Tanzania market, they have been so doing illegally and unlawfully.

On the third issue, ***whether the plaintiff or the defendant are owners of HIT trade mark,*** DW1 reiterated his earlier depositions in

respect of the first issue of *locus standi* showing that at no point in time to-date has the plaintiff ever been the registered owner of the word HIT as trade mark or get-up in Tanzania Mainland. That, on the contrary, it is HB that since 2010 and throughout material time is the registered owner of the said HIT in Tanzania Mainland by virtue of Certificate of Registration No. TZ/T/2010/1091 in Class 5 for 10 years issued on 05/04/2019. Trade/Service Mark Certificate dated 05/04/2019 was admitted as **exhibit D3.**

On the rest of the raised issues, DW1 repeated his earlier depositions. He insisted that unlawful business cannot lawfully acquire reputation and goodwill worthy protection by law. It was also averred that; the products of the plaintiff and the defendant are not similar and that no confusion or deception may arise in the market as the logos and get-ups are different. DW1 prayed that this suit be dismissed in its entirety with costs for lack of locus standi and merit.

**DW2 Mr. Seka Kasela** a Deputy Registrar of Trade and Service Mark, stated that he is responsible for registration, post registration and administration of Patents, Trade and Service Marks and other Intellectual Rights matters in Tanzania Mainland. In relation to this matter, Mr. Seka testified that he is aware that an issue of *locus standi* has arisen in this



case just as it was the case in Civil Appeal No. 147 of 2019 which is still pending between Godrej Consumer Products Limited and HB Worldwide Limited and the Registrar of Trade and Service Marks. In the said case, the plaintiff claimed to have amalgamated with Godrej Household Products Limited. He alleged that, in the said case the plaintiff presented documents purported to be records filed with the office of Registrar of Trade and Service Marks, to show that the plaintiff had *locus standi*. The said documents have been filed by the plaintiff in this case vide Volume 3 of the plaintiff's list of Additional Documents filed on 22/11/2022. The documents include:

- a) Receipt No. 00273205, dated 10<sup>th</sup> August 2015, issued to Abenry & Co;*
- b) Letter dated 10<sup>th</sup> August 2015 with reference number TM/26/14/PHK/im*
- c) Power of Attorney issued by Godrej Household Limited;*
- d) Form TM No. 18 (Merger);*
- e) Form TM 26 for certified copy of certificate of registration; and*
- f) Certified copy of the commercial register.*

DW2 made reference to his counter affidavit sworn and filed in Civil Appeal No. 147/2019, revealing that documents comprised in exhibit Godrej 5 filed by the Appellant (now plaintiff) were fraudulent and never existed in the records of office nor were they endorsed by the Registrar of Trade and Service Marks. The said counter affidavit was admitted as **exhibit D22**. Pursuant to the records of the office of Registrar of Trade and Service Marks in Tanzania Mainland, at no point in time to-date has the plaintiff ever been the registered owner of HIT as trade mark. That, HB Worldwide at all material times has been the registered proprietor of the word HIT both as trade mark and get-up.

DW2 clarified that, Trade Mark registration, protection and usage are not union matters. Tanzania Mainland enjoys different territorial jurisdiction under **Trade and Services Marks Act, Cap 326 2002** and its Regulations, while in Zanzibar, enjoys a distinct territorial jurisdiction pursuant to **Zanzibar Industrial Property Act, 2008**.

That marked the end of evidence of both parties. Counsels of both parties filed their final submissions which I intend to refer randomly in the cause of my reasoning.

In consideration to the evidence of both parties, I now endeavour to resolve the framed issues.

Starting with the first issue whether the plaintiff has the *locus standi* to institute the present suit against the defendant; in their final submissions the learned counsels for the plaintiff submitted among other things that **exhibit P10** a Master Service Agreement was tendered showing the relationship between the plaintiff and its affiliated companies PT Megasari Makmur being one of them. That, the plaintiff being the Licensor of the HIT brand to PT Megasari Makmur, who is the manufacturer of the products being distributed by Bopar, the plaintiff has *locus standi* to institute the present suit.

The learned counsels for the defendants stated in their final submission that having examined copies of certificates of registration which the plaintiff annexed to its plaint (Annexures 2 and 3) it became evident that the plaintiff is not a registered proprietor of the word HIT as a Trade Mark both in Tanzania Mainland and Zanzibar. They referred to the search reports dated 17 and 30 July 2020 respectively which were tendered by DW1 to confirm that nowhere in the records of the Register of Trade and Service Marks does the plaintiff feature as owner of the Trade Mark HIT. That, pursuant to exhibit D3, the Trade Mark is registered for HB Worldwide Limited.

Concerning the so called the affiliate company of Godrej Household Products Limited as initial owner of the Trade Mark HIT; it was submitted that the registration existed in the Registry until on 25/4/2018 when it was expunged for none-use, vide exhibit D7.

To buttress their submissions, both parties cited **section 30 of the Trade and Service Marks Act, Cap 326 R.E 2002** which provides that:

*"No person shall be entitled to institute any proceeding to prevent or to recover damages for the infringement of an unregistered trade or service mark, but nothing in this Act shall be deemed to affect rights of action against any person for passing off goods or services as the goods or services of another person, or the remedies in respect thereof."*

In addition, I am inspired by **section 14 (1) of the Trade and Service Marks Act**, (supra) which provides that:

*"14. (1) **The exclusive right to use a trade or service mark as defined in section 32 shall be acquired by registration in accordance with the provisions of this Act.**"*Emphasis added

**Section 31** of the same Act provides that:

*"Subject to the provisions of this Act and any limitation or conditions entered in the register, **the registration of a trade or service mark shall, if valid give or be deemed to have given to the registered proprietor the exclusive right to the use of a trade or service mark** in relation to any goods including sale, importation and offer for sale or importation."*Emphasis added

**Article 6D of the Paris Convention 1883** provides that:

*"D. — No person may benefit from the provisions of this Article **if the mark for which he claims protection is not registered in the country of origin.**"*Emphasis added

In the instant suit, according to the available evidence, the plaintiff is not the registered proprietor of the trade mark "HIT." Hence, it has no exclusive right over the said trade mark, which includes right to sue against infringement of the trade mark (locus standi).

*Locus standi* is a common law principle which signifies the right of one to file a suit before the court of law or to enter appearance in court. In the case of **Peter Mpalanzi v. Christina Mbaruku, Civil Appeal No. 153 of 2019** [2021] TZCA 510 at page 5 and 6, it was held that:

*"Simply defined, locus standi is the right or legal capacity to bring an action or to appear in court. In **Lujuna Shubi Ballonzi v. Registered Trustees of Chama Cha Mapinduzi [1996] TLR 203**, Samatta, J (as he then was) had the following to say on locus standi:*

*"Locus standi is governed by common law according to which a person bringing a matter to court should be able to show that his right or interest has been breached or interfered with. The High Court has the power to modify the applied common law so as to make it suit local conditions."*

*Locus standi is a rule of equity that a person cannot maintain a suit or action unless he has an interest in the subject matter. **Unless a person stands in a sufficient close relation to the subject matter so as to give a right which requires protection or infringement of which he brings the action, he cannot sue on it-** see **Godbless Lema v. Mussa Hamis Mkanga and 2 Others**, Civil Appeal No. 47 of 2012 (unreported)."Emphasis mine*

I fully subscribe to the detailed definition of *locus standi* as stated by the Court of Appeal of Tanzania in the above cited case. In the case at hand, the subject matter of the suit is the Trade Mark of the insecticide called

HIT. According to the pleadings, adduced evidence and final submissions of the parties, there is no need to speculate on the issue, who is the lawful registered owner of the Trade Mark HIT. At paragraph 10 of the plaint the plaintiff stated that:

*"10. The said Trade Mark registrations have at all material times hereof been valid and subsisting on the Trade and Services Marks Register until 25 April 2018 when the Registrar in Tanzania (mainland), upon a mala-fide application by HB WORLDWIDE LIMITED, removed the Trade Mark from Register of Trade and Service Marks on a false allegation based on none-use, and without affording the Plaintiff the right to be heard. The Plaintiff has appealed against the said removal to the High Court, and the said appeal proceedings are still pending."*

The above quoted paragraph speaks loudly that, the purported registration of the plaintiff as the proprietor of the word HIT as a Trade Mark in Tanzania Mainland vide Registration No. TZ/T/2011/147 was expunged from the Register with effect from 25/04/2018. The facts were deposed by the principal officer of the plaintiff. The same were supported with evidence of PW3 one Irene Oduor who contended that, she understands that although the Trademark was expunged from the

Register of Trademarks, the said expungement did not affect the value of the goodwill which is associated with the HIT Trademark. That, the goodwill remained the property of the plaintiff. She tendered Memorandum of Appeal of Civil Appeal No. 147/2019 (exhibit P17).

DW2 Mr. Seka the Deputy Registrar of Trade Mark and Service Marks from BRELA, confirmed that the plaintiff has never been registered as a proprietor of the trade mark "HIT."

Therefore, currently the plaintiff is not a registered owner of the Trade Mark "HIT" even if she was acting under the umbrella of the registration of the sister company (Godrej Household Products Limited) which was expunged on 25/4/2018. Guided by the above cited case law, it is obvious that the plaintiff has no sufficient close relation to the subject matter (HIT Trade Mark) of which it brings the action against the purported infringement by the defendant. Without proof of valid registration of a Trade Mark, one cannot successfully institute an infringement suit seeking protection, for lack of legal basis (*locus standi*).

Having found as such, I am of settled opinion that since the plaintiff has been found to have no *locus standi*, determination of the rest of the framed issues lacks legal basis. Lack of *locus standi* by the plaintiff, ousts



the jurisdiction of this court to proceed resolving the rest of the framed issues.

Consequently, I have no option other than to dismiss this suit with costs.

It is so ordered.

Dated at Dar es Salaam this 14<sup>th</sup> day of November 2023.



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S. H. SIMFUKWE

JUDGE

Signed by: S. H. SIMFUKWE

**14/11/2023**