

**DECISION OF THE REGISTRAR OF TRADEMARKS IN THE MATTER OF
TRADE MARK APPLICATION No. 521/2017 HI-TET IN CLASS 5 IN THE
NAME OF BAYER INTELLECTUAL PROPERTY GMBH AND OPPOSITION
THERE TO BY MILBORROW ANIMAL HEALTH (ZIMBABWE)(PRIVATE)
LIMITED PURSUANT TO THE TRADE MARKS ACT CHAPTER 401 OF THE
LAWS OF ZAMBIA AND REGULATIONS THEREUNDER**

BETWEEN:

**MILBORROW ANIMAL HEALTH (ZIMBABWE)
(PRIVATE) LIMITED**

AND

BAYER INTELLECTUAL PROPERTY GMBH

APPLICANT



**Coram: Anthony Bwembya, Registrar of Trade Marks, sitting with
Benson Mpalo, Deputy Registrar -IP**

For the Opponent: O.M.M. Banda (Dr.), of OMM Banda and Company

For the Opponent: J. Nambule (Ms.), of HOWARD & MARIETTA, Legal
Practitioners

RULING

CASES REFERRED TO

1. Cadila Healthcare Ltd. Vs. Cadila Pharmaceuticals Ltd(2001) 5 SCC 73
2. EJOT GmbH & Co. KG v Eastcoast Fasteners Pty Limited [2017] ATMO 45
3. GE Trade Mark [1973] RPC 297

4. National Brands Limited vs. Yoyo Foods Limited (2020) [Registrar's Decision]
5. Pirie's Application (1933) R.P.C. 147
6. Parkington & Co Ltd's Application (1946) 63 RPC 171)
7. Trade Mark Application No. B370430, ((1988) AIPC 90-466) ("Bi-Lo")

STATUTE REFERRED TO:

The Trade Marks Act Chapter 401 of the Laws of Zambia



INTRODUCTION

1. This is a ruling in respect of an opposition to the registration of trade mark application no. 521/2017 'HI-TET' in class 5 in the name of Bayer Intellectual Property GmbH of Alfred-Nobel-Str. 10, 40789 Monheim am Rhein, Germany (hereinafter referred to as "the Applicant").
2. The former Registrar of Trade marks Mr. Anthony Bwembya presided over the hearing of this matter while I sat with him in my capacity as Deputy Registrar of Trade Marks. I am therefore delivering this ruling pursuant to section 5(b) of the Trade Marks Act which permits me, as Deputy Registrar, to exercise all the powers conferred by the Act on the Registrar.

BACKGROUND

3. On 4th April 2017, the Applicant applied to register the mark '**HI-TET**' in class 5 of the Nice Classification of Goods in respect "*veterinary preparations*". The Application was provisionally rejected based on conflict with a prior registration no. 1085/2013 in class 5 in the name of Milborrow Animal Health (Zimbabwe) (Private) Limited of Corner Craster/Manchester Road, Southerton Harare, Zimbabwe (hereinafter referred to as "the Opponent"). The examiner relied on Section 17(1) of the Trade marks Act, Cap 401 of the laws of Zambia (herein called the 'Trade Marks Act') for the provisional refusal.
4. On 28th November 2017, the Applicant's agents responded to the Notice of Refusal citing prior use of the mark HITET and argued for co-existence of the marks. Based on the sales invoices that were submitted, the examiner withdrew the provisional refusal and accepted the application for publication on 2nd February 2018. The application was published in the



Industrial Property Journal of 25th June 2018 and on 8th August 2018, the Opponent filed a Notice of Opposition.

GROUND OF OPPOSITION

5. The Grounds of Opposition are as follows

- i. That the Applicant's application No. **521/2017 HI-TET** is likely to deceive or cause confusion with the Opponent's registration No. **1085/2013 HITET**.
- ii. That the Applicant's trademark application No. **521/2017 HI-TET** is classified under goods that are identical with trademark No. **1085/2013 HITET** belonging to the Opponent.

COUNTER STATEMENT BY APPLICANT

6. The Applicant filed a counter-statement on 12th December, 2018. The Applicant denied the allegations advanced by the Opponent and further refuted claims that its application No. 521/2017 is likely to deceive or cause confusion stating that:

- i. The Applicant is the rightful owner of the trade mark '**HI-TET**'.
- ii. The Applicant has carried on business, inter alia, as a producer of veterinary medicinal preparations on which the '**HI-TET**' trade mark is used.
- iii. The Applicant, or its predecessor in title, has consistently used the trade mark '**HI-TET**' since it was first coined. In Zambia in particular, the Applicant has used the trade mark for a number of years and relies on Section 17(2) of the Trade Marks Act in support of its trade mark application No. 527/2017.



EVIDENCE IN SUPPORT OF OPPOSITION

7. The Opponent filed a statutory declaration dated 15th of April, 2019 deposited by Viresh Naik who is the Director of the Opponent.
8. Mr. Naik stated that the Opponent is a company registered under the laws of Zimbabwe. Copies of a certificate of incorporation and change of name were exhibited and marked “VN 1”. A copy of a trade mark certificate of registration in Zambia for the trade mark ‘MILBORROW’ was also exhibited and marked “VN2”.
9. Mr. Naik added that the Opponent is and operates a well renowned and reputable corporation. The Opponent, either by itself and/or through associated corporations and agents, affiliates and/or licensees, carry on a reputable business from the Republic of Zimbabwe and elsewhere of manufacturing, production, marketing, distribution and sale of highquality animal health products and related products which are registered in Zambia through the Zambia Medicines Regulatory Authority. A copy of a document written ‘marketing authority for veterinary medicine’ and showing the application number and category of distribution was exhibited and marked “VN3”.
10. He went on to state that the Opponent is a leading company in more than eight (8) countries with relevant market share in the country’s market. That the Opponent has an international interest in the Trade Mark ‘**HITET**’ which the Opponent uses in relation to animal health products sold within the Southern African Development Community (SADC) markets, including but not limited to the Republic of Zambia.
11. He also mentioned that the Opponent and its other subsidiaries and licensees have registered the trade mark ‘**HITET**’ and related ‘**HITET**’



trade marks in Zambia and other African countries. He exhibited a copy of the certificate of registration in Zambia which was marked “VN4”.

12. Mr. Naik further averred that the Opponent’s ‘**HITET**’ trade mark has been extensively used and advertised in neighbouring countries, such as Zimbabwe and the goods sold in various markets in connection therewith have earned a reputation of superior quality and goodwill which is of great value to the Opponent. In support of this claim, Mr. Naik exhibited certificates of registrations for ‘**HITET**’ and ‘**MILBORROW**’ in Zimbabwe marked “VN5”.
13. In response to the Applicant’s counterstatement, the Opponent contended that paragraph 1, 2, 3 and 4 therein are not true to the best knowledge of the Opponent and emphasised that the trade mark ‘**HITET**’ would be confused with ‘**HI-TET**’ if the Applicant was allowed to use the same for goods under Class 5, which were identical as evidenced by the submitted letter from ZAMRA, whose copy was exhibited and marked “VN6”.
14. It was also stated that the Applicant cannot not rely on Section 17(2) of the Trade Marks Act in support of its application No. 521/2017 as there was no evidence adduced to show that the said trade mark had been consistently used in the Republic of Zambia by the Applicant or its predecessors. That it was precisely for that reason that the Opponent was objecting.
15. The Opponent also claims that the colours black, white and yellow used by the Applicant are identical to those used by the Opponent, and that the hyphen used by the Applicant belonged to the Opponents other trade mark ‘**HI-**’ registered as No. 2018/2017. A copy of the certificate of registration was exhibited and marked “VN8”.



16. The Opponent also exhibited a copy of the letter from ZAMRA requesting the Opponent to provide proof of trade mark registration which was marked “VN9.” Also exhibited by the Opponent was a copy of a document marked VN10”.

EVIDENCE IN SUPPORT OF APPLICATION

17. The Applicant’s evidence was given through a Statutory Declaration of Dr. Florian Bottenschein, who says he is a senior Counsel of the Applicant company.
18. According the Dr. Bottenschein, the Applicant is a subsidiary of the German multi-national pharmaceutical and life sciences company Bayer AG.
19. He stated that the Applicant is one of the biggest pharmaceutical and life sciences companies in the world. The Applicant was originally founded as long ago as 1863 in Barmen, Germany and has been in business ever since. That the Applicant has been in business for over 150 years and has a long and proud history.
20. He testified that the “HI-TET” trade mark properly belongs to the Applicant who has consistently used it since at least 2017. He said that in Africa, the Applicant is the owner of the “HI-TET” trade mark in South Africa, Botswana, Namibia, Mozambique, Zimbabwe, Nigeria, Madagascar, Rwanda, Uganda and Zanzibar. Copies of certificates of registrations for the Applicant’s “HI-TET” in these countries were exhibited and marked “Annex 1”.
21. It was further stated that, in Zambia in particular, the Applicant has used the “HI-TET” trade mark consistently for some years since at least 2002. That the Applicant’s use of the “HI-TET” trade mark commenced more than a decade before the filing date of the Opponent’s trade mark



registration on which the Opponent founds its case. That the opponents trade mark registration No. 1085/2013 by the Opponent's own admission was only filed on 3 October, 2013.

22. The Applicant exhibited invoices extracted from the records of the Applicant showing sales of "HI-TET" branded goods in Zambia dating back as far as 2002 which were marked "**Anexure 2**". Also marked "**Anexure 3**" was a copy of the Drug Importation Certificate issued by the Department of Veterinary Sciences and Livestock Development for 2010 granting the Applicant authority to import "HI-TET" branded goods into Zambia. According to the Applicant, this shows that the Applicant had been using the trade mark "HI-TET" in Zambia since at least 2002, more than a decade before the Opponent filed trade mark No. 1085/2013.

23. In addition, Dr. Bottenschein averred that the Applicants extent of use of "HI-TET" is significant with an approximate US Dollar value in sales during the period 2014-2018 shown below:

Year	Value in US\$
2014	1,010,111.00
2015	389,352.00
2016	1,607,965.00
2017	1,671,333.00
2018	5,061,540.00



24. It was stated that the facts above demonstrate the Applicant's true ownership of the trade mark "HI-TET" including in Zambia and that this implies that the Applicant has made the case for honest concurrent use.

25. In response to the Opponent's evidence, Dr. Bottenschein deposed that the Applicant is in discussions with ZAMRA regarding the continued importation of its HI-TET product into Zambia. That ZAMRA has no authority to rule in trade mark disputes and whatever ruling it may reach does not affect the decision of the Registrar of Trade marks.

OPPONENT'S EVIDENCE IN REPLY

26. On 12th December 2019, the Opponent filed what was described as a statutory declaration in reply deposed by Dr. Overs Masozi Mufwakawiri Banda, who states that he is the Legal Counsel and Authorised Agent for the Opponent.
27. Dr. Banda stated that the Opponent is the lawful proprietor of the trade mark "**HITET**" in thirty (30) territories and also the trade mark "**HI-**" in thirteen (13) territories. In this regard, copies of the certificates were exhibited and marked "**OMMB 1 to OMMB 43**".
28. He stated further that the Opponent is a lawful holder of four (4) registrations of the mark "**HITET**" in Georgia, Uzbekistan, Ukraine and Kazakhstan in the Opponents' sister companies and that the Opponent is a holder of an import permit of its products bearing the mark "**HITET**" and that in 2014 was granted authorisation by Zambian Medicines Regulatory Authority (ZAMRA).
29. It was also stated that the Applicant failed to register its trade mark "**HITET**" in Mauritius due to the Opponent's opposition. An opposition document filed in Mauritius and the decision were exhibited and marked "**OMMB 44**" and "**OMMB 56**" respectively.



30. The Opponent further exhibited certificate of registrations in Zimbabwe, which were described as its historical precedent from 1989 in Zimbabwe. These were marked "**OMMB 45**". In addition, other certificates of registrations from various countries for the trade marks "**HITET**" and "**HI-**" were exhibited and marked "**OMMB 46**" to "**OMB 57**".
31. Dr. Banda also deposed that in the letter dated 8th November, 2017 the Zambia Medicines Regulatory Authority had requested the Opponent to provide registration Certificates for HITET injection in Zambia which was later provided and exhibited the said letter marked "**OMMB 59**". He also exhibited another letter from the Zambia Medicines Regulatory Authority in which the Applicant was directed to amend the name of its products bearing the mark "hi-tet to another suitable name that is not similar in name to any product already on the Zambian market. This letter was marked "**OMMB 60**".

THE HEARING OF THE PROCEEDINGS

32. At the hearing of the matter counsel for the Applicant, Ms. J. Nambule of Howard and Marieta Legal Practitioners expressed the Applicant's desire to respond to the Opponent's evidence in reply. Dr. Overs Masozi M. Banda who appeared on behalf of the Opponent indicated that he had no objection. The Applicant was accordingly allowed to file further evidence. The parties further indicated that the matter should proceed to a ruling following the filing of further evidence and submissions if any.

APPLICANT'S FURTHER EVIDENCE

33. The Applicant's further evidence was tendered through the statutory declaration of Dr. Florian Bottenschein. I note that most of the averments in Dr. Bottenschein's statutory declaration were a denial of the facts in



the Opponent's evidence in reply which they contend went beyond matters in reply. I will therefore not reproduce such evidence to the extent that it constitutes mere denial. Further, I will also avoid reproducing what I consider to be legal arguments.

34. In summary, Dr. Bottenschein stated that the position in the Republic of Zimbabwe is of no relevance to these proceedings and that, in any event, the Opponent failed to disclose that the Applicant was the lawful proprietor of the trade mark HI-TET in Zimbabwe, registered under No. ZW/T/2009/508. That the Opponent further failed to draw attention to the ongoing proceedings at the Trade Mark Office in Zimbabwe, including the fact that the Applicant had sought the cancellation of the Opponent's registration No. 205/1989 HI-TET.
35. He reiterated the fact that the Applicant is the owner of the trade mark HI-TET in numerous jurisdictions as set out in his first statutory declaration. He further drew attention to the fact that the HI-TET trade mark had been consistently used by the Applicant in Zambia since at least 2002 as set out in his first statutory declaration. That the use of this trade mark in Zambia was more than a decade before the Opponent sought registration of the trade mark in Zambia.
36. He further indicated that the decision of the Zambian Medicines Regulation Authority was of no consequence in a trade mark dispute and that the contents of that paragraph are utterly irrelevant and that the Registrar of Trade Marks should decide the matter without the outside influence of third party organisations.



OPPONENT'S FURTHER EVIDENCE IN REPLY

37. The Opponent tendered further evidence in reply in which they disputed the Applicant's further evidence and contended that opposition proceedings are administrative in nature, and do not follow strict rules of procedure. I will not reproduce much of what was said in this part of the evidence for the same reason that it constitutes mainly of legal arguments than facts.

HEADS OF ARGUMENTS

38. The Applicant filed written submissions in which they gave a brief background to the matter and proceeded to argue its case relying on relevant law.

39. In brief, the Applicant argued that though section 17(1) of the Trade prohibits the registration of a trade mark that is identical to an existing trade mark in respect of goods in the same category, the Applicant, in its Statutory Declaration, has demonstrated the following:

- (i) Having been established in 1893, Applicant is the proprietor of a trade mark known as 'HI-TET' which it has consistently used since at least 2017;
- (ii) In respect of Zambia, the Applicant has established that since 2002, it has used the trade mark HI-TET having been granted an import permit by the Department of Veterinary Sciences and Livestock Development;
- (iii) Between 2014 and 2018 the Applicant made sales of the HI-TET branded products amounting to \$9,740,301.00.



40. The Applicant submitted that the above are some of the special circumstances which should be taken into consideration in arriving at a decision in accordance with Section 17(2) of the Act.
41. The Applicant submitted that the Registrar should allow its application to proceed to the registration because failure to do so would result not only in major loss to the Applicant but also in the Opponent deriving a benefit from the good will enjoyed by the trade mark in the market.
42. It was submitted that whilst the Opponent has obtained registration for the mark HITET in various countries including Zambia, registering the Applicant's trade mark pursuant to Section 17(2) of the Act will, owing to its current honest use, will not cause any confusion in the minds of the general public. The Applicant further claimed that it has from 2002 been marketing HI-TET without causing confusion in the mind of the public. That in fact, confusion was non-existent to the extent that the Opponent only became aware of the existence of HI-TET after the Applicant lodged its application for registration.

DECISION

43. I have considered the grounds of opposition raised by the Opponent as well as the counter-statement filed by the Applicant. I have also considered the evidence adduced by both parties by way of statutory declaration filed in support of their respective cases and the submissions filled on behalf of the Applicant. I now proceed to make a decision in this matter.



44. I will start by addressing the issue raised by the Applicant regarding the Opponent's evidence in reply which, according to the Applicant, went beyond matters in reply and that the same should be excluded.
45. Regulation 51 of the Trade Marks Regulations states as follows regarding evidence in reply-

“Within two months from the receipt by the opponent of the copy of the applicant's affidavit or solemn declaration, the opponent may leave with the Registrar evidence by affidavit or solemn declaration in reply, and shall deliver to the applicant a copy of such evidence. This evidence shall be confined to matters strictly in reply”. (Emphasis Mine)

46. It is clear from the above regulation that evidence in reply must be confined to matters in reply. This is a mandatory requirement which a party submitting evidence in reply must obey. I have perused through the purported evidence in reply filed by the Opponent and I agree with the Applicant that the deponent went beyond matters in reply. The Opponent has on the other hand argued that Opposition proceedings are administrative in nature and do not follow strict rules of procedure.
47. It is true that proceeding before the Registrar are conducted pursuant to the Inquiries Act (Chapter 41 of the laws of Zambia) whereby I am not bound by the rules of evidence. However, where the law expressly provides for a mandatory procedural requirement, the Registrar cannot hide under the guise of 'not being bound by the rules of evidence' and depart from the mandatory procedural requirement.
48. Therefore, this is a proper case in which I am entitled to exclude the Opponent's evidence in reply to the extent that it goes beyond matters in



reply. However, it is on record that the Applicant had expressed its desire to respond to the Opponent's evidence in reply and they accordingly proceeded to file further evidence without any objection by the Opponent. Therefore, since the Opponent had an opportunity to respond to the Applicant's evidence in reply in its entirety, they cannot thereafter turn around and argue that the evidence should not be admitted. The Applicant clearly acquiesced to the evidence in reply by filing further evidence. On this ground, the request to exclude any part of the Opponent's evidence in reply is denied.

49. I will now proceed to consider this matter on the merit.

50. Firstly, it is important to recall that the Applicant's application was initially rejected by the Trade Marks Examiner on the basis of section 17 (1) of the Trade Marks Act. This provision states as follows:

Subject to the provisions of subsection (2), no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion.'

51. It is also on record that the Applicant invoked sub-section (2) of section 17 and upon proof of *prima facie evidence*, the application was allowed to proceed to acceptance and publication. This is what engendered the opposition by the Opponent.

52. Therefore, this is not an ordinary opposition to the registration of a mark. It is an objection to the concurrent existence of trade marks that are identical or nearly resemble each other in respect of the same goods or



description of goods by different proprietors. In other words, the issue of identity or similarity of marks is not disputed. The question to resolve is whether the Applicant's trade mark and the Opponent's registered trade mark can coexist pursuant to section 17(2) of the Trade Marks Act.

53. For the avoidance of doubt section 17(2) of the Trade Marks Act provides as follows:-

"In the case of honest current use or other special circumstances which, in the opinion of the Registrar, or the High Court in the event of an appeal from a decision of the Registrar, make it proper so to do, the Registrar or the High Court as the case may be, may permit the registration of trade marks that are identical or nearly resemble each other in respect of the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as the Registrar or the High Court may think it right to impose".

54. To begin with, it is important to acknowledge that section 17(2) provides a discretionary route to the registration of a mark despite the provisions of section 17(1) and 16 of the Trade Marks Act. In other words, a mark that has been rejected or refused registration on account of either sections 17(1) or 16 can nonetheless be accepted and proceed to registration under section 17(2). (See Decision of the Registrar in **National Brands Limited vs. Yoyo Foods Limited (2020)**).

55. The development of the concept of honest current or concurrent use was aptly summarised by Lord Diplock in **GE Trade Mark [1973] RPC 297 at 326** when he said:



“.. the interest of the public in **not being deceived** about the origin of goods had and has to be accommodated with the vested right of property of traders in trade marks which they have honestly adopted and which by public use have attracted a valuable goodwill. In the early nineteenth century trade was still largely local; marks which were identical or which closely resembled one another might have been innocently adopted by traders in different localities. In these their respective products were not sold in competition with one another and accordingly no question of deception of the public could then arise. With the rapid improvement in communications, however, in the first half of the nineteenth century markets expanded; products of two traders who used similar marks upon their goods could thus come to be on sale to the same potential purchasers with the consequent risk of their being misled as to the origin of the goods. Furthermore, it was accepted that as an adjunct of the goodwill of the business the right to use a trade mark might be acquired by more than one successor if the goodwill of the business were divided, as it might be, for instance, where the business had formerly been carried on in partnership or from more than one manufactory or shop. To meet this kind of situation the doctrine of honest concurrent user was evolved. Under this doctrine a trade mark remained entitled to protection in cases where the **use of it had not originally been deceptive but a risk of deception had subsequently arisen as a result of events which did not involve any dishonesty or other wrongful conduct** upon the part of the proprietor of the mark. If, however, his own wrongful conduct had played a part in making the use of the mark deceptive, the Court of Chancery would not grant him an injunction against infringement. This was but a particular application of the general equitable doctrine that he who seeks equity must come with clean hands.” (Emphasis mine).

56. Thus, whether a mark should be allowed registration on honest concurrent use depend on a determination of the following questions:



- (i) whether there has been an honest concurrent use of the mark applied for and the earlier mark;
- (ii) if the answer to (i) is in the affirmative, whether after considering all relevant circumstances, including public interest, a discretion should be exercised to accept the application for registration of the mark, despite the fact that the use of the mark in relation to the goods in question is likely to cause confusion on the part of the public.

57. The main matters for consideration were laid down by Lord Tomlin in ***Pirie's Application (1933) R.P.C. 147(H.L.)***. They are:

- (i) the extent of use in time and quantity and the area of trade;
- (ii) the degree of confusion likely to ensue from the resemblance of the marks, which is, to a large extent, indicative of the measure of public inconvenience;
- (iii) the honesty of the concurrent use;
- (iv) whether any instances of confusion have been proved;
- (v) the relative inconvenience which would be caused if the mark in suit was registered, subject if necessary to any conditions and limitations.

58. I will start by considering the extent of use of the mark 'HI-TET' by the Applicant. It is trite that the use must be use of the mark as a trade mark in the jurisdiction where registration is sought, in this case, Zambia.

Further, section 2(2) of the Trade Marks Act provides that

"(2) References in this Act to the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark, and references therein to the use of a mark in relation to goods shall be construed as references



to the use thereof upon, or in physical or other relation to, goods”

59. The Applicant has indicated that, in Zambia, it has used the trade mark HI-TET, consistently for some years since at least 2002 and that its use of the HI-TET mark commenced more than a decade before the filing of the Opponent's trade mark registration. To buttress this claim, the Applicant submitted copies of tax invoices. I have critically examined these invoices and note that apart from one copy the rest are dated 01.03.2002 and bear the same invoice no. 90988567. There is some evidence at pages 8 and 18 that products with HI-TET trade mark was delivered to Livestock Services of Lusaka showgrounds in the quantity of 400,000 and 100, 000 with total values of USD 768.00 and USD 739.00 respectively. The rest of the pages of the invoice dated 01.03.2002 have no information on the product bearing the HI-TET trademark and are therefore superfluous.
60. The other invoice is dated 29.03.2006 and shows that the product bearing the trade mark HI-TET was also delivered to Livestock Services of Lusaka showgrounds with a quantity of 120,000 and total value of USD 943,20.
61. My observation from the evidence of the Applicant highlighted above is that, while the Applicant has demonstrated use of the trade mark HI-TET in 2002 and 2006, the quantities and the value of the net sales are, in my view, paltry. Further, the time (period) of use is rather scanty. As argued by the Opponent, there is no evidence to show consistence in use between 2002 and 2006. The Applicant also claims that they have made sales of the HI-TET branded products amounting to \$9,740,301.00 between 2014 and 2018 but no documentary evidence has been produced to substantiate this claim.



62. In addition, the invoices which were submitted in evidence show that the product with the HITET product was only sold or delivered to Livestock Services of Lusaka showgrounds thereby making it difficult to establish the geographical spread of sales in Zambia.
63. Further, the Drugs Importation Certificate tendered by the Applicant does not help its case because not only does it show that it was only issued in 2010 but does not also show that it was issued in respect of HI-TET products. It merely makes reference to “veterinary medicaments” without specification.
64. It is trite that in the case of “triple identity”, as in the present case, the duration, area and volume of use need to be substantial to establish a case under section 17(2) of the Act. (see **EJOT GmbH & Co. KG v Eastcoast Fasteners Pty Limited [2017] ATMO 45**).
65. In the Matter of **Trade Mark Application No. B370430, ((1988) AIPC 90-466) (“Bi-Lo”)** It was held as follows:
“..the applicant's period of use had been very limited: about one month in the first instance and about seven months in the second ... I find it difficult to concede that any amount of use, no matter how great in monetary terms, in such a short period would be sufficient to meet the overall requirement that the use be substantial and of real commercial value.
66. With the foregoing in mind, I do not think the Applicant in the present case has proved substantial use or that its use was of any real commercial value.
67. I have also considered the degree of confusion likely to ensue from the resemblance of the marks. I have taken into account the fact that both



the Applicant and the Opponent's trade marks are pure word marks which are not only identical but also used for the same goods. It is on this premise that the application could not proceed to registration under section 17(1) of the Act. Further, I have also considered exhibit 'VN9' of the Opponent's Statutory Declaration in support. In that exhibit, the Zambia Medicines and Regulatory Authority stated as follows:-

"The presence of products from different manufacturers but bearing similar names makes it difficult for the public to easily differentiate one product from the other. Furthermore this has the potential to hamper the Authority from effectively conducting pharmacovigilance should any issues arise that require redress for the affected products, especially with regards to traceability."

68. In view of the foregoing, I have found that degree of confusion and the public inconvenience that is likely to ensue from the resemblance of the Applicant and the Opponent's trade marks is very high.
69. On the question of the honesty of the concurrent use, it is important to point out that the onus for establishing honesty rests with the Applicant. In ***Parkington & Co Ltd's Application (1946) 63 RPC 171*** it was held that "*honesty of the applicant's use may be doubted where his mark was copied from the earlier mark, or where it was adopted with the knowledge that it was identical or very similar to the earlier mark, and the applicant does not satisfactorily explain why he adopted his mark.*"
70. In the present case although the Applicant has shown that it has registrations in other countries for the trade mark HI-TET, they have not given details of how the HI-TET trade mark was adopted or coined. Without some reference to the reasons for adopting the trade mark HITET



in the face of the pre-existing registration, it is difficult for me to find that the use by the Applicant was honest. Furthermore, having failed to establish substantial use, there cannot be concurrent use or indeed the honesty of the use.

71. In terms of whether there are instances of confusion that have in fact occurred, the closest evidence that has been tendered is exhibit ‘VN9’, the letter from the Zambia Medicines and Regulatory Authority (ZAMRA). It is clear from that letter, that the Zambia Medicines and Regulatory Authority was expressing concern over the presence of products from different manufacturers bearing the similar names which was making it difficult for the public to easily differentiate one product from the other. I take judicial notice of the fact that ZAMRA is the regulator of the products or goods covered by both the Applicant and the Opponent’s trademarks, and has a statutory responsibility to protect the interests of consumers. I therefore accept this evidence as representing instances of proven confusion.
72. In terms of the relative inconvenience to the parties, given the short period of trade of the Applicant in Zambia and also considering the fact that in 2018 ZAMRA through exhibit “OMMB 60” had asked the Applicant to “amend the name of its products bearing the trade mark hi-tet to another suitable name” and “to ensure that all products bearing the brand name hi-tet are no longer on the market”, I find that there would be no real inconvenience to the Applicant if its trade mark application does not proceed to registration.
73. On the other hand, there certainly would be enormous inconvenience to the Opponent if a conflicting identical trade mark which is likely to cause confusion on the public as to the source of the products was to be allowed to proceed to registration. I have also considered the public interest in



view of the nature of goods involved and find that it would not be prudent on my part to allow the co-existence of marks that are likely to cause members of the public to be confused as to the source of the product. In the case of **Cadila Healthcare Ltd. Vs. Cadila Pharmaceuticals Ltd(2001) 5 SCC 73**, the Supreme Court of India observed as follows:

“Public interest would support lesser degree of proof showing confusing similarity in the case of trade mark in respect of medicinal product as against other non-medicinal products. Drugs are poisons, not sweets. Confusion between medicinal products may, therefore, be life threatening, not merely inconvenient. Noting the frailty of human nature and the pressures placed by society on doctors, there should be as many clear indicators as possible to distinguish two medicinal products from each other...”

74. In view of the foregoing, it is clear to me that the Applicant has failed to establish a strong case for co-existence of identical marks under section 17(2). For the avoidance of doubt, I find that the Applicant has failed to establish that there has been an honest concurrent use of the trade mark applied for and the Opponent’s registered HITET trademark. Furthermore, while I acknowledge that the factors I have considered as espoused in the *Pirie’s* case, may not be exhaustive, I have generally considered the evidence adduced by both parties in this matter and I find no special circumstances that would compel me to exercise the discretion under section 17(2) of the Act to allow the Applicant’s application to proceed to registration.
75. Consequently, the application for registration of trade mark application no. 521/2017 ‘HI-TET’ in class 5 in the name of Bayer Intellectual



Property GmbH is hereby refused and I order that the register be marked accordingly.

76. Costs of this opposition are awarded to the Opponent, to be taxed in default of agreement.

77. Leave to appeal is granted.

DELIVERED THIS 12th DAY OF October 2022

[Handwritten Signature]

DEPUTY REGISTRAR OF TRADEMARKS

