

DECISION OF THE REGISTRAR OF TRADEMARKS IN THE MATTER OF TRADEMARK APPLICATION NUMBERS 684/2020 'ARMANI IN CLASS 34 IN THE NAME OF J & B LIMITED AND OPPOSITION THERETO BY GIORGIO ARMANI S.P.A PURSUANT TO THE TRADEMARKS ACT CHAPTER 401 OF THE LAWS OF ZAMBIA AND REGULATIONS THEREUNDER.

BETWEEN

GIORGIO ARMANI S.P.A

OPPONENT

AND

J & B LIMITED

APPLICANT

Before Mr. Benson Mpalo, Registrar of Trade Marks

For the Opponent : Mr. Bwalya Mutiti of Dench Intellectual Property Consultant.

For the Respondent : Mr. Wesley Silungwe of Galloway & Company.

RULING

Legislation referred to:

1. Trade Marks Act, Chapter 401 of the Laws of Zambia

International Conventions/ Treaties Referred to:

1. Paris Convention for the Protection of Industrial Property, 1883
2. Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, (2007).



Cases referred to:

1. Attorney General v Roy Clark (2008) AHTLR 259
2. Berlei (UK) Ltd. v Bali Brassier Co. Inc. (1969)
3. British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281 (Pages 296, 297)
4. Chocodafabriken Lindt & Sprungli AG v. Franz Hauswirth GmbH, EU:C:2009:361
5. DH Brothers (Pty) Vs. Olivine Industries (Pty) Limited SCZ JUDGMENT NO. 10/2012)
6. Hotel Cipriani SRL v. Cipriani (Grosvenor Street) Limited (2010) EWHC
7. Jellinek's Appn (1946) 63 RPC 59
8. Johnson & Johnson v Aardash Pharma Limited (2016) HP A025
9. Juvena Produits de Beaule SA v BLP Import and Export (1980) 2 SA 210 (T) at 217H-218H
10. Koton Magazacilik Tekstil Sanayi ve Ticaret v European Union Intellectual Property Office, C-104/18 P, EU:C:2019:724
11. Laboratoire Lachartre SA v Armour – Dial Incorporated (1976) (2) SA 744 (T) at 746H
12. Plascon Evans Paints Limited v. Van Riebeeck Paints Pty Limited (1984) 3 S.A 623
13. Pianotist Application (1906) 23 APC 774
14. Ranbaxy Laboratories Limited V Glaxosmithkline (Appeal No. 15 of 2011)
15. Trade Kings v. Unilever and Others, Supreme Court Judgement No. 2 of 2000
16. Zambia Sugar Plc v. Fellow Nanzaluka, Appeal No. 82 of 2011

Decisions of the Registrar

1. Anhui Liangliang Electronic Technology Co. Limited v. Xu Benxhou (2018)
2. Sigma-Tau Industrie Farmaceutiche Riunite v Amina Limited (2019)
3. Truworths Limited v Guangzhou Zengcheng Guangyin Garment Co., Ltd (2023)



BACKGROUND

1. This is a matter in which J & B Limited (hereinafter called 'the Applicant') of 3rd Floor, Yam Raj Building, Market Square, P.O Box 3175, Road TOWN, TORTOLA, British Virgin Islands, applied to register trademark Application No. 684/2020 "ARMMAN" filed on the 5th of May 2020.
2. The mark was applied for in class 34 in respect of: *Cigarettes; Cigars, Filters (Cigarette-), Pipes (Tobacco, Pouches (Tobacco-), Tobacco jars, Smokers (Lighters for-), Filters (Cigarette-), Cigarettes containing tobacco substitutes, not for medical purposes. Cases (Cigarette-), Herbs for smoking.*
3. After examination, trade mark Application No. 684/2020 was accepted and published in the Zambia Patents and Trade Marks Journal of 25th December 2020.
4. The application filed by the Applicant was opposed by Giorgio Armani S.P.A (hereinafter referred to as 'the Opponent'), of Via Borgnuovo 11, 20121 Milano, Italy. The Notice of Opposition was filed on the 25th February 2021.

GROUND OF OPPOSITION

5. The Opponent's Grounds of Opposition can be summarised as follows:
 - (i) The Opponent is an Italian luxury fashion whose line of business is into designs, manufacturing, distribution, retail haute couture, ready-to-wear, leather goods, shoes, watches, jewelry, accessories, eyewear, cosmetics and home interiors. The Opponent markets its products under several labels: Giorgio Armani Prive, Giorgio Armani, Armani Collezioni, Emporio Armani, Armani Jeans, Armani Junior, and Armani Exchange. The Opponent utilizes the association of the



Armani name with high-fashion benefiting from its prestige in the fashion industry.

- (ii) The Opponent is one of the world leaders in production of various products, including goods in class 34, under the trade mark "ARMANI", distributed and sold by the Opponent in commerce. The Opponent has made considerable and extensive use of the said trade mark in several countries, to the extent that the trade mark has become well-known and has gained a favourable reputation all over the world.
- (iii) The Opponent is the proprietor of the trade mark "ARMANI", IR No. 502876 in Zambia in various classes including class 34, registered on June 3, 2012 in respect of "*Tobacco; smokers' articles; matches*"
- (iv) The Applicant has applied to register its "ARMMANI" trade mark in class 34, the description of goods being virtually identical to the goods for which the Opponent has already registered its trade mark "ARMANI" in several parts of the world, including Zambia;
- (v) The Applicant's trade mark "ARMMANI" is phonetically and visually identical to that of the Opponent, save for the additional letter "M" in the Applicant's trade mark. The Applicant's trade mark is highly confusingly similar to that of the Opponent.
- (vi) The Opponent has registered its trade mark "ARMANI", in several countries around the world, including Zambia. The Opponent products have been advertised, promoted and distributed all over the world. It is, therefore, not possible that the Applicant devised its trade mark "ARMMANI" without prior knowledge of the opponent's popular trade mark "ARMANI" and thus, it can be deduced that the Applicant



was fully aware of the opponent's trade mark. The Applicant, thus acted in bad faith when it applied to register its trade mark knowing that the Opponent has original right in the trade mark "ARMANI"; an act contrary to universal trademarks laws and norms of honest and fair commercial practice.

- (vii) The trade mark will be applied to the same products and with the same distribution channels and therefore the use of the Applicants trade mark in the course of trade will deceive the average consumer into believing that the Applicant's goods are sponsored by, affiliated with, approved by or otherwise emanate from the Opponent. This would lead to loss of sales and damage to the Opponent's reputation.
- (viii) Registration of the Applicant's trade mark will be contrary to section 16 and 17 of the Trade marks Act Chapter 401 of the Laws of Zambia.

Relief Sought

- 6. The Opponent thus requests the Registrar to refuse the registration of the trade mark application number 684/2020 with costs.

THE APPLICANT'S COUNTER-STATEMENTS

- 7. In a counter-statement filed on the 4th May 2021, the Applicant stated that:
 - (i) The Opponent has failed to disclose any trade mark registrations or applications in its own name in class 34
 - (ii) The Opponent has failed to provide proof of use of class 34 goods in any country, and that the trade mark has not become well-known. In any event, Zambia has not domesticated international law, and does not recognise well-known marks.
 - (iii) International trade mark registrations hold no value in Zambia



- (iv) There is no basis for this opposition.
8. The Applicant thus requests the Registrar to dismiss the opposition and allow trade mark Application No. 684/2020 "ARMMANI" to proceed to registration.

OPPONENT'S EVIDENCE

9. On 19th August 2021, the Opponent filed its evidence through an Affidavit in Support of Opposition deposited by one Antonio Croce, an Intellectual Property Manager and proxy holder of the Opponent.
10. The evidence adduced by Mr. Antonio Croce in the Affidavit in Support of Opposition can be summarised as follows;
- (i) That the Opponent is the proprietor of more than 7,000 trade marks identical and/or composed of the well-known trade mark "ARMANI" all over the world. The Opponent deposed that the trade mark has come to be well-known in various local magazines worldwide. The Opponent referred me to exhibit marked "AC1".
 - (ii) That the Opponent is the owner of IR No. 502876 in various classes, including class 34 in Zambia.
 - (iii) That the Applicant acted in bad faith when it applied to register its trade mark knowing fully well that the Opponent has prior rights in the trade mark "ARMANI" in several classes, including class 34. That the Applicant only came into existence in 2018 and failed to prove the existence of any rights in the trade mark "ARMMANI" prior to those of the Opponent in its trade mark "ARMANI". The Opponent thus deposed that the Applicant's intention is to ride on the



reputation of the “ARMANI” trade mark, a practice that is contrary to honesty and fair commercial practice.

- (iv) That the Applicant’s trade mark will be applied to the same products and with the same distribution channels.
- (v) That use of the Applicant’s trade mark will undoubtedly deceive the average consumer into believing that the Applicant’s goods are sponsored by, affiliated with, approved by or otherwise emanate from the Opponent, which would lead to loss of sales and damage to the Opponents reputation.
- (vi) That the “ARMANI” trade mark is registered in Zambia and registration of the Applicant’s Trade mark “ARMANNI” is likely to cause confusion among consumers who will be deceived into believing that the Applicant’s products belong to the Opponent or somehow connected, because the Applicant’s trade mark: (a) is visually identical to that of the Opponent; (b) is verbally identical to that of the Opponent; and (c) the goods to which the trade marks apply are identical.

APPLICANT’S EVIDENCE

- 11. The Applicant filed a Statutory Declaration which constituted evidence in support of the opposed applications, on 4th May 2021. The Applicant’s Statutory Declaration was filed on an even date as the Counter-Statement. The Statutory Declaration was deposed by one Koula Rashid Murad Albalooshi, the owner of the Applicant company. Without reproducing the legal arguments contained in the said statutory declaration, the Applicant’s evidence can be summarized as follows:



12. It was stated that the Opponent has failed to disclose any trade mark applications or registration for the “ARMANI” trade mark in class 34 in its own name in Zambia.
13. Ms. Albaloooshi averred that she has no knowledge of the Opponent’s IR No. 502876 “ARMANI” in Zambia which allegedly covers various classes, including class 34.
14. That the Applicant has filed the application in question on the basis that it is proposed to be used in relation to cigarettes, foodstuffs, energy drinks and juices. Ms. Albaloooshi deposes that there has been no use in Zambia of the trade mark to date.
15. That although the Opponent claims to have made “considerable and extensive use” of its “ARMANI” trade mark in several countries, it has failed to provide any evidence of the use in any country of the mark in relation to class 34 goods.
16. Ms. Albaloooshi averred that the Opponent has shown no use of its “ARMANI” trade mark in relation to class 34 goods in any country, much less in Zambia. Thus, the Applicant has no knowledge of any prior rights existing in the trade mark “ARMANI” in Zambia in respect of class 34 goods.
17. That that Applicant did not in any way act in contravention of any trade marks laws or norms of honesty and fair commercial practice.

OPPONENT’S EVIDENCE IN REPLY

18. On 17th January 2022, the Opponent filed an Affidavit in Reply wherein one Antonio Croce deposed as follow:



- (i) That the “ARMANI” trade mark has been on several products on the Zambian Market for several years and an average consumer in Zambia would most certainly respond in the affirmative if questioned of their knowledge of the “ARMANI” trade mark.
- (ii) That the Opponent IR No. 502876 is under the Madrid Protocol and the said registration covers class 34 and designates Zambia. The Opponent referred to exhibit “**AC1**” as evidence of registration under WIPO.
- (iii) Mr. Antonio Croce deposed that international registrations (IRs) are recognized in Zambia to the extent that trade mark applications that are confusingly similar to those already registered via WIPO and designates Zambia are rejected on examination. Mr. Antonio Croce, thus deposed that the Opponent has prior rights in its trade mark “ARMANI”, which the Opponent is attempting to register.
- (iv) That the Applicant acted in bad faith when it applied to register its trade mark knowing that the Opponent has prior rights in the trade mark “ARMANI”.
- (v) That the trade marks are confusingly similar in every way and will be applied in the same products and with the same distribution channels.
- (vi) That the use of the Applicant’s trade mark will deceive the average consumer into believing that the Applicant’s goods are sponsored by, affiliated with, approved by or otherwise emanate from the Opponent and this would lead into loss of sales and damage to the Opponent’s reputation.



- (vii) Mr. Antonio Croce referred me to exhibit “AC2” and deposed that the European Union Intellectual Property Office decided in favour of the Opponent which involved the parties herein.

HEARING OF THE OPPOSITION

19. A hearing of the opposition was set for the 21st June 2022. Both parties were represented by their respective Counsel. Mrs. Bwalya Mutiti of Dench Intellectual Property Consultants appeared for the Opponent, while Mr. Wesley Silungwe of Galloway & Co., appeared for the Applicants.
20. The Learned Counsel for the Opponent submitted that section 17 (1) of the Trade marks Act, Chapter 406 of the Laws of Zambia prohibits registration of marks that are confusingly similar or identical to those already on the register applying to the same goods or similar goods. Counsel relied on the case of **Ranbaxy Laboratories Limited v Glaxosmithkline – Appeal No, 15 of 2011**. Counsel also referred to the case of **Plascon Evans Paints Limited v. Van Riebeeck Paints Pty Limited (1984) 3 S.A 623** and submitted that the comparison for similarity of trade marks must be made with reference to the sense, sound and appearance of the marks. Counsel further referred me to the **Pionotist Company Application (1906) 23 APC 774** and submitted that when assessing similarity of words what must be considered are the look and sound of the trade mark, the goods to which they are to be applied, the nature and kind of customer likely to buy the goods, and what is likely to happen in the course of trade. Counsel submitted that the Applicant’s and Opponent’s trade marks are virtually identical as they sound and look the same and they are also conceptually similar.
21. Counsel for the Opponent further submitted that trade mark application No. 684/2020 was applied for in bad faith. Counsel relied on the decision



of the Registrar in the case of **Anhui Liangliang Electronic Technology Co. Limited v. Xu Benzhou, Decision of the Registrar of Trademarks dated 18th June 2018** and submitted that the applicants conduct of applying for a trade mark that is virtually identical to that of the Opponent which is already on the register is inconsistent with the norms of honest and fair commercial behaviour. Counsel submitted that the Applicant ought to have known that the Opponent possessed prior rights in the “ARMANI” trade marks because it is well-known and appeared on many adverts and television shows. Counsel submitted that considering that the Applicant new about the existence of the Opponent’s rights in the “ARMANI” trade mark, it can be inferred that the Applicant intends to ride on the Opponent’s reputation.

22. I was further referred to the decision **European Union Intellectual Property Office in Opposition No. B3131822** in which it was held that the Applicant’s trade mark was confusingly similar to that of the Opponent in every way and that there is a likelihood of confusion on the part of the public.
23. In concluding, Counsel for the Opponent submitted that the Opponent has the right in Zambia in respect of trade mark “ARMANI” based on the trade mark registered via WIPO designating Zambia and therefore the Applicant’s claim that the Opponent has no right in Zambia has no basis. Counsel for the Opponent, therefore, prayed that the Applicant’s trade mark application No. 684/2020 be refused registration in the Zambian jurisdiction.

OPPONENTS WRITTEN SUBMISSIONS

24. The Opponent filed written submissions on 12th July 2022. The Opponent relied on three main arguments in its submissions.



Likelihood of Confusion due to Similarity of Trade marks

25. Firstly, the Opponent argued that it is the proprietor of international trade mark "ARMANI" in class 34 which is virtually identical to the mark "ARMMANI" which the Applicant seeks to register in respect of the same description of goods. The Opponent relied on section 17 (1) of the Trade marks Act and submitted that the two marks are phonetically and visually identical and thus registration of the Applicant mark is likely to result in consumer deception or confusion. Counsel referred me to the case of **Laboratoire Lachartre SA v Armour – Dial Incorporated (1976) (2) SA 744 (T) at 746H** and to the **Plascon Evans Paints and Pianotist Cases**. Learned Counsel for the Opponent further referred me to the case of **Juvena Produits de Beaulieu SA v BLP Import and Export (1980) 2 SA 210 (T) at 217H-218H** and the **Ranbaxy Laboratories Case** and submitted that the Applicant's trade mark will deceive the average consumer into assuming that there is a connection between the Applicant's and Opponent's goods. In supplementing his argument Counsel submitted that an average consumer will be deceived into believing that the Applicant's goods are sponsored, affiliated with, approved by or otherwise emanate from the Opponent and this would lead to loss of sales and damages to the Opponent's reputation.

Well-known Status of the Opponent's Trade mark.

26. The Opponent submitted that the trade mark "ARMANI" is registered in several countries all over the world, including Zambia via WIPO and has gained sufficient reputation as a well-known trade mark in the countries where it is present. To support his argument, Counsel referred me to **Article 6bis of the Paris Convention** and to the case of **Johnson & Johnson v Aardash Pharma Limited (2016) HP A025**. In concluding this argument, Counsel submitted that the Opponent's trade mark is



protected as a well-known mark as it is an international registration under WIPO, designating Zambia.

Bad Faith Application by the Applicant

27. Learned Counsel for the Opponent referred me to the **Anhui Liangliang Case** and argued that the Applicant does not deny that the Opponents trade mark “ARMANI” is well-known, but the Applicant merely states that the Opponent’s well-known name cannot be protected in Zambia. The Opponent asserts that the Applicant was fully aware that the Opponent holds prior rights in the “ARMANI” trade mark and therefore, the Opponent infers that the Applicant acted in bad faith and fell short of standard of acceptable commercial behaviour when it applied for the registration of the “ARMMANI” trade mark.

APPLICANT’S SUBMISSIONS

28. The Applicants filed their submissions on 22nd August 2022. The submissions can be summarized as follows:

Madrid Protocol has no Legal Force in Zambia

29. Learned Counsel for the Applicant submitted that the Opponent is the proprietor of international trade mark No. 502876 “ARMANI” in class 34. He argued that international registrations have not been incorporated into the Zambia national trade mark legislation and therefore hold no value in the Zambian jurisdiction. Counsel referred me to the case of **Attorney General v Roy Clark (2008) AHTLR 259** and **Zambia Sugar Plc v. Fellow Nanzaluka, Appeal No. 82 of 2011** and submitted that international agreements that have been ratified but not domesticated have no legal force in Zambia but are only of persuasive value. Counsel submitted that ratification of the Madrid Protocol does not give the Protocol a force of law



in Zambia and therefore the Opponent has no legal basis to bring opposition proceedings against the Applicant.

“ARMMANI” trade mark is not Confusingly Similar to “ARMANI” trade mark

30. Counsel referred me to section 17(1) of the Trade marks Act and submitted that when a comparison is being made for purposes of determining likelihood of confusion, the test is an objective one that takes into consideration all factors. Counsel referred me to the case of **Trade kings Limited v Unilever PLC and Others, SCZ Judgment No. 2 of 2000** and the **Anhui Liangliang Case** and submitted that the standard which the potential confusion should be gauged is that of an average consumer of the goods; whether the ordinary sensible Zambian consumer or general public would be confused by the use of the two marks. Counsel for the Applicant submitted that the Opponent has not provided evidence of use of its trade mark in Zambia with respect to class 34. The Applicant submits that the Opponent has merely exhibited images of smokers’ accessory, but there is no visual representation of the “ARMANI” trade mark

Application for Registration of “ARMMANI” Trade mark not made in Bad Faith

31. Learned Counsel for the Applicant submitted that the Applicant’s application was not made in bad faith and the Opponent did not show any evidence to support the Opponent’s allegation. Counsel referred me to the case of **Koton Magazacilik Tekstil Sanayi ve Ticaret v European Union Intellectual Property Office, C-104/18 P, EU:C:2019:724**; the case of **Chocoladefabriken Lindt & Sprungli AG v. Franz Hauswirth GmbH, EU:C:2009:361**; and the case of **Hotel Cipriani SRL v. Cipriani (Grosvenor Street) Limited (2010) EWHC**. Counsel dispelled the allegation that the Applicant’s application was made in bad faith and that



no conclusive evidence has been provided to show any dishonest intention on the part of the Applicant.

RULING

32. I have considered the grounds of opposition raised by the Opponent in respect of the application in issue, as well as the counterstatement filed by the Applicant. I have also considered the evidence adduced by both parties and the submissions made in support of their respective cases. I now proceed to make a decision.

33. Having perused through the Notice of opposition and the grounds therein, it is clear to me that this opposition is premised on two specific grounds. The first ground is anchored on section 16 and 17 of the Trade Marks Act. The second ground is that of bad faith. I will deal with these grounds in that order.

34. In the first ground, the Opponent alleges that registration of the Applicant's ARMMANI trade mark would be contrary to section 16 and 17 of the Act.

35. Section 16 provides as follows:-

“It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice or would be contrary to law or morality, or any scandalous design”

36. Section 17(1) on the other hand provides that:-

“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”

37. It is trite that section 16 of the Act is wider in scope and covers grounds not applicable under section 17(1). In explaining this distinction between the two provisions, Lord Wilberforce in **Berlei (UK) Ltd. v Bali Brassier Co. Inc. (1969)** stated as follows:-

“There are two points of difficulty in section 11. The first concerns the relation of the section to section 12(1). It is certainly the case that section 11 extends to matters not comprehended in section 12(1); this is obvious when it refers to matter which is contrary to law or morality and to scandalous designs. Even as to the linguistically common criterion that a mark is likely to deceive or cause confusion, one can see that section 11 has wider scope than section 12(1), for whereas the later section is concerned with a comparison between two marks, relating to the same goods or description of goods, of which one is already on the register. Section 11 is not so limited. It extends to cases where the public is likely to be deceived or confused merely by the mark in question per se.”

38. In this matter, the Opponent claims that the Applicant has applied to register a mark which is identical to its ‘ARMANI’ trade mark in respect of the description of goods which are “virtually identical”. Therefore, this opposition is based on a likelihood of the public being deceived or confused solely by the resemblance of the marks and goods in question. In this instance and in line with the Supreme Court’s decision in **DH Brothers (Pty) Vs. Olivine Industries (Pty) Limited SCZ JUDGMENT NO.**

10/2012), the two provisions, that is, sections 16 and 17(1) must be read together.

39. For an opposition to be sustained under section 17(1), the opponent must show that it is the proprietor of an identical or similar trademark already on the register and secondly that the new trade mark application relates to the same goods or description of goods.
40. In relation to the first element of section 17(1), I have to consider firstly whether the Opponent's mark ARMANI is identical or similar to the Applicant's mark "ARMMANI" and secondly, whether the Opponent's mark is a mark already on the register. I note that the Applicant has not contested the Opponent's claim that the two marks are identical or similar. It is not in dispute that both marks are word marks. The principle relating the comparison of word marks is that the visual comparison is based on an analysis of the number and sequence of the letters or characters, the position of the coinciding letters or characters, the number of words and the structure of the mark. However, the average consumer normally perceives a sign as a whole and does not proceed to analyse its various details. Therefore, small differences in the number of letters such as in the present case, are often not sufficient to exclude a finding of visual similarity. In this regard, I find that the presence of an additional letter 'M' in the Applicant's mark is not sufficient to offset a finding of visual similarity between the two marks.
41. The issue which the Applicant appears to contest relates to the question whether the Opponent's trade mark is a mark already on the register. In support of its opposition, the Opponent adduced into evidence exhibit "AC4" which is a copy of the designations under the Madrid Protocol in respect of International Registration number 502876. I have examined this evidence and note that Zambia is indeed one of the designated countries



and the expected expiration date of this registration, according to exhibit “AC4” is 1st May, 2026. The issue I must address is whether this registration is a valid registration which, for purposes of section 17(1) of the Trade Marks Act, can be considered as an “already registered trade mark.” I must hasten to state that this issue raised by the Applicant, regarding the validity of international registration under the Madrid Protocol, is one which has been considered and determined by this Registry and had the Applicant’s legal representatives done their research, they would not be relying on this matter to defend its application from this opposition.

42. For the avoidance of doubt, the Registrar in the case of **Sigma - Tau Industrie Farmaceutiche Riunite v Amina Limited (2019)**, we held that international registrations under the Madrid Protocol designating Zambia, are valid registrations under the Zambian trade marks register. This position has been reiterated in other subsequent decisions of the registry. [see Decision of Registrar in **Truworths Limited v Guangzhou Zengcheng Guangyin Garment Co., Ltd (2023)**].
43. In that decision, it was opined as follows regarding international registrations under the Madrid Protocol.

“In Zambia, once an international application designating Zambia is notified, the Patents and Companies Registration Office (PACRA) carries out an examination in accordance with the Trade Marks Act, Cap 401 and its Regulations. If the application does not conflict with any prior rights it is accepted and published in the Zambia Industrial Property Journal and if no opposition is filed within two months a Statement of Grant of Protection is issued.”



44. It was further stated as follows: –

“The Madrid System in essence merely facilitates the filing of a trade mark application in a number of countries. The registration of that application (i.e., protection) is always subject to domestic legislation. It is for this reason that the International Bureau at WTO examines such applications only for formalities and not on absolute or relative grounds on matters.....this is left to national offices each of which processes the international registration according to its own law and practice.

45. Having explained the procedure and practice for the registration of international registrations, the Registrar proceeded to hold that “international registrations under the Madrid Protocol designating Zambia are valid registrations under the Zambian trade mark register and for purposes of section 17 of the trademarks Act are considered as marks already on the register.”

46. This is the precedent the Zambian Trade Marks Registry has set and until it is reversed by the superior courts of Zambia, the registry is unlikely to vacate from this position. Having said that, the argument by the Applicant in this regard cannot stand and it is accordingly dismissed. This means that the Opponent has established that it is a proprietor of an identical or similar trademark which is already on the register.

Comparison of goods

47. I now turn to consider whether the goods under the respective trade marks are of the same description. According to exhibit “AC4”, the Opponent’s international registration no. 502876 is registered in different classes



including class 34. In relation to class 34, the trade mark ARMANI is registered respect of “*tobacco; smokers’ articles; matches.*”

48. On the other hand, the Applicant’s application number 684/2020 is also sought to be registered in class 34 in respect of ‘*Cigarettes; Cigars, Filters (Cigarettes-) Pipes (Tobacco, Pouches (Tobacco-), Tobacco Jars, Smokers (Lighters for-), Filters (Cigarettes-), Cigarettes containing tobacco substitutes, not for medical purposes. Cases (Cigarettes-), Herbs for smoking.*’
49. Generally speaking, two items are defined as being similar when they have some characteristics in common. The comparison of goods has been addressed by case-law. In ***Jellinek’s Appn (1946) 63 RPC 59*** , Romer J. outlined the factors which must be considered. These factors include the nature of the goods, the uses thereof, and the trade channels through which they are bought and sold. In ***British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281 (Pages 296, 297)*** Jacob J., outlined the following factors as being relevant:
- (a) The respective uses of the respective goods or services;
 - (b) The respective users of the respective goods or services;
 - (c) The physical nature of the goods or acts of services;
 - (d) The respective trade channels through which the goods or services reach the market;
 - (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
 - (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act



for industry, put the goods or services in the same or different sectors.”

50. The above cases illustrate that in assessing the similarity of goods all the relevant factors relating to those goods themselves should be taken into account. I have therefore considered the nature of goods under the respective trade marks in this matter. I have also considered the respective uses and users of the goods at issue and come to the conclusion that the goods under the Applicant’s trade mark application and those under the Opponent’s international registration are of the same description.
51. Therefore, in addressing the question of whether a likelihood of confusion exist in this matter, I have taken into account the degree of recognition of Opponent’s mark on the market, the degree of similarity between this mark and the mark sought to be registered by the Applicant as well as the similarity between respective goods. With this in mind, I have no doubt that a significant part of the relevant public of the goods at issue may be confused as to the origin of the goods under the Applicant’s trade mark. I therefore find that the registration of the trade mark ‘ARMMANI’ in class 34 is not tenable in view of the provisions in both sections 16 and 17(1) of the Trade Marks Act.
52. Having found that that the first ground has succeeded, it is otiose for me to proceed to consider the ground of bad faith or other extraneous matter which were advance in the submissions.

CONCLUSION

53. In conclusion, I find that the Opposition to the registration of trade mark Application No. 684/2020 “ARMMANI”, in class 34 has merit and



accordingly succeeds. The application to register the said trade mark is therefore refused.

54. Leave to appeal to the High Court if dissatisfied with this decision is hereby granted. Each party shall bear its own costs incidental to this Opposition.

Dated this _____ day of _____ 2023.



BENSON MPALO
REGISTRAR OF TRADEMARKS

