

**CONSOLIDATED PROCEEDINGS UNDER THE TRADE MARKS ACT,  
CHAPTER 401 OF THE LAWS OF ZAMBIA**

**IN THE MATTER OF:**

**AN APPLICATION FOR REMOVAL FROM  
THE REGISTER OF TRADE MARKS  
PURSUANT TO SECTION 31 OF THE  
TRADEMARKS ACT TRADE MARK  
REGISTRATION NUMBERS 4503,  
167/87, 314/94, 734/97 and 806/2006  
'PARLIAMENT' ALL IN CLASS 34  
REGISTERED IN THE NAME OF BENSON  
& HEDGES (OVERSEAS) LIMITED;**

**IN THE MATTER OF:**

**TRADE MARK APPLICATION NUMBER  
1454 'PARLIAMENT' IN CLASS 34 IN  
THE NAME OF BENSON & HEDGES  
(OVERSEAS) LIMITED AND OPPOSITION  
THERE TO BY PHILLIP MORRIS BRANDS  
SARL**

**BETWEEN**

**PHILIP MORRIS BRANDS S.A.R.L**

**APPLICANT/OPPONENT**

**AND**

**BENSON & HEDGES (OVERSEAS) LIMITED**

**RESPONDENT**

**Coram:**

**Anthony Bwembya, Registrar of Trade Marks**

**Benson Mpalo, Deputy Registrar of Trade Marks**

**For the Applicant:**

**Mr. Kanti Patel, Christopher Russell Cook & Co.**

**For the Respondent:**

**Ms. Ireen Nambule , Messrs Howard & Marietta  
Legal Practitioners**

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**RULING**

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*Delivered by Benson Mpalo, Deputy Registrar of Trade Marks pursuant to  
section 5(b) of the Trade Marks Act, Chapter 401 of the Laws of Zambia*



**Statutes referred to:**

The Trademarks Act Chapter 401 of the Laws of Zambia

**Cases referred to:**

1. Amerex Fire Equipment Zambia Limited v Universal Fire Fighting Equipment Limited (2018) ( Decision of the Registrar)
2. Ansul BV v. Ajax Brandbeveiling BV 2003(RPC C-40/01).
3. Apollinaris Company Limited's Application (1891) 8 RPC 137
4. Full Colour Black Limited v Pest Control Office Limited (2020)
5. Gulf Oil Corporation v Rebrandt En Handelaars (EDMS) BPK 1963 (2) SA 10 (T) 27G-H
6. Imperial Group Limited v Philip Morris and Company Limited (1982) FSR 72
7. Maxxus Group GmbH v Globus Holding GmbH C-183/21
8. Powell's T.M (1894) 11 RPC 4
9. Re Arnold D. Palmer [1987] 2 MLJ 681
10. Sant Ambroeus Trade Mark [2010] RPC 28
11. Steven Katuka (Suing as Secretary General of the United Party for National Development), Law Association of Zambia and the Attorney General, Ngosa Simbyakula and 63 Others (Selected Judgement No. 29 of 2016)
12. Wildcat Energy Drink Zambia Limited and Another v. Big Tree Beverages Limited (2021) (Decision of the Registrar)



## INTRODUCTION

1. This is a combined ruling in respect of an application for the expungement of five trade mark registrations and an Opposition to the registration of trade mark application number 1454/2014 in Class 34 all in the name of Benson & Hedges (overseas) limited (herein referred to as 'the Respondent'). The Expungement Application together with the Notice of Opposition were filed by Phillip Morris Brands S.A.R.L (herein referred to as 'the Applicant').
2. The conclusion of these proceedings were delayed following the request by the Respondent's Agent in November, 2019 to suspend the proceedings until the outcome of the settlement negotiations by the parties.

## BACKGROUND

3. On 14th August 2014, the Applicant filed an application under section 31 of The Trademarks Act, Cap 401 of the Laws of Zambia for the removal from the register of trademark registration numbers **4503, 167/87, 314/94, 734/97 and 806/2006** in the name the Respondent. These trade mark are all registered in class 34 in respect of '**cigarettes, tobacco and tobacco products**'.

## GROUNDS FOR EXPUNGEMENT

4. The Application for expungement was premised on the following grounds:
  - (i) That up to the date one month before the date of this application, a continuous period of five years or longer has elapsed during which the trademarks in issue were registered and during which period there was no bona fide use thereof by the Respondent in relation to the goods in respect of which they are registered; and or
  - (ii) That the said registered trade marks were registered without any bona fide intention by the Respondent that they should be used in relation to any of the goods in respect of which they have been registered and up to the one month before the date of this application, there has in fact been no bona





fide use of the registered marks by the Respondent in relation to the goods in respect of which it is registered.

5. In the statement of case accompanying the application, the Applicant outlined the basis for its application. In brief, the Applicant submitted that it is and operates as a subsidiary of Philip Morris International Inc (referred to as PMI) which is the leading international tobacco company with products sold in more than 180 countries. The Applicant further submitted that PARLIAMENT is a brand of cigarettes manufactured, distributed and marketed by subsidiaries and licensees of the PMI group of Companies in many countries.
6. It was further stated that on 17<sup>th</sup> February, 2014 the Applicant lodged an application for the registration of the trade mark PARLIAMENT in respect of the goods in class 34. The Application was assigned an official application number 172/2014 with the filing date of 20<sup>th</sup> February, 2014. That on 16<sup>th</sup> April, the Applicant was informed that its application for registration of the PARLIAMENT mark had been refused by the Registrar on the basis that it is in conflict with one of the Respondent's registered trade marks, namely registration number 806/2006 PARLIAMENT Label.
7. The Applicant stated that it conducted investigations into the use, by the Respondent of the trade mark PARLIAMENT in Zambia in connection with cigarettes or any tobacco product in the past five years. That the investigation revealed that the Respondent is not making use of the said trade mark or any of the Respondent's registered trade marks in relation to tobacco products.
8. It was also contended that the Respondent's registered trade marks will interfere with the use and registration of the Applicant's mark, namely application number 172/2014 PARLIAMENT filed on 20<sup>th</sup> February, 2014.



### **COUNTERSTATEMENT**

9. A counter-statement was filed by the Respondent on 14th September 2015, wherein they contended as follows
- (i) that the Respondent is the lawful registered proprietor in numerous countries in the world of the PARLIAMENT Label trade marks and trade marks incorporating "PARLIAMENT".
  - (ii) that the Respondent's trade marks were adopted by the Respondent for the specific purpose of identifying and distinguishing the Proprietor's goods from those of other traders.
  - (iii) that the Respondent had a bona fide intention to use the PARLIAMENT trade mark when those trade marks were filed and that the Respondent has made and is making bonafide use the PARLIAMENT trade marks in Zambia for the purposes of identifying and distinguishing the Respondent's goods from those of other traders.
10. On account of the foregoing, the Respondent prayed that its impugned registered trade marks should remain on the Register and that the Applicant's application should be dismissed with an order for costs in favour of the Respondent.

### **APPLICANT'S EVIDENCE IN SUPORT OF APPLICATION**

11. The Applicant's evidence consisted of two statutory declarations which were both filed on 18<sup>th</sup> February 2016. The first was deposed by Lisa Ritchie, who is a Senior Counsel, Trade Marks of Philip Morris International Management S.A. an affiliate company of the Applicant.
12. Ms. Lisa Ritchie stated that the Applicant is a company registered in Switzerland and exhibited a copy of the companies registry which was marked





**“PM1”**. She further stated that the Applicant is a subsidiary of Philip Morris International Inc (PMI) and that PMI is a leading international tobacco company with products sold in more than 180 countries. It was stated that PARLIAMENT is a brand of cigarettes manufactured, distributed and marketed by subsidiaries and licensees of the PMI group of companies to which the Applicant belongs. She went on to state that the brand was first introduced in 1931 in the United States of America by the Applicant’s predecessor in business, namely Benson & Hedges Co. and was subsequently launched in other markets around the world. Ms. Ritchie indicated that the Applicant has an international interest in the trade mark PARLIAMENT which it uses in relation to tobacco products sold in approximately 40 markets. She made reference to world volume of PARLIAMENT cigarettes sold by the Applicant in 2012 and 2013 and the market share of the brand in different countries which I have taken note.

13. Ms. Ritchie also exhibited a schedule showing a sample of the Applicant’s trade mark registrations in many countries that include the word PARLIAMENT. This was marked **“PM2”**. She further averred that the Applicant’s PARLIAMENT trade mark has been extensively used and advertised in many countries in the high price segment and the goods sold in connection therewith have earned a reputation of being superior quality and as a result has acquired goodwill. She added that the Applicant’s PARLIAMENT trademark has consequently become well known.

14. Ms. Ritchie further evidence was that the Applicant conducted investigation through the legal advisors in Zambia into the use, by the Respondent and/or any of its affiliated companies in Zambia of the trademark PARLIAMENT in Zambia in connection with cigarettes or any tobacco product in the past five years. Ms. Ritchie added that the investigations revealed neither the Respondent nor any of its affiliated companies were making any use of the trademark PARLIAMENT, nor has it done so in past five years.



15. Ms. Ritchie averred that the Respondent's trademark registrations containing the word PARLIAMENT were lodged in 1954, 1987, 1994, 1997 and 2006, the first of which was filed over 60 years ago, and which has never been used in Zambia. She contended that it is apparent that the Respondent has no intentions of using the marks in Zambia.
16. Ms. Ritchie also referred to the alleged non-use by the Respondent of the PARLIAMENT trade mark and cancellation proceedings in other jurisdictions which, though not relevant to these proceedings, I have nonetheless taken note.
17. In concluding, Ms. Ritchie stated that to the best of the Applicant's knowledge, up to the date of one month before the date of this application, a continuous period of five years or longer has elapsed during which the Respondent registered its trade marks and during which there was no bona fide use thereof by the Respondent in relation to the goods for which they were registered.
18. The second statutory declaration in support of the Applicant's application was deposed by Jatin Patel, who is a legal practitioner in the legal firm of the Applicant's Agent on record. He testified that from time to time, he conducts market surveys and or business inquiries including use investigations on behalf their clients.
19. Mr. Patel stated that on or about 22<sup>nd</sup> April, 2014 he was instructed to conduct investigations to establish the existence or non-existence of tobacco products under the name of PARLIAMENT in the Lusaka market in the last five years. Lusaka was selected as it is the capital and largest city in Zambia. He was also instructed to purchase samples of any tobacco under the name of PARLIAMENT found to be available for sale in the market.
20. Mr. Patel said he accepted the instructions and conducted the said investigation on 25<sup>th</sup> and 26<sup>th</sup> April 2014. During this time, he said he visited an array of outlets in Lusaka which sell cigarettes and other tobacco products. Among the





outlets he visited and enquired from regarding the availability of the tobacco under the name of PARLIAMENT were Shoprite at Manda Hill mall along Great East Road; Pick N Pay at Levy junction Mall on Kabelenga Road, and Trivedi & Co located along kalambo Road, North-end of Lusaka.

21. He testified that in all his visits and enquiries in the stated places, he failed to find or obtain any cigarette or tobacco by the name of PARLIAMENT. He further said when he queried the shopkeepers and/or store owners on whether they have ever sold or seen any PARLIAMENT cigarette or tobacco products, the shopkeepers and/or store owners told him that they have neither seen or heard about the said product. In the ultimate, Mr. Jatin Patel, stated that he failed to find any tobacco products under the name of PARLIAMENT in Lusaka or any evidence that the same have ever been sold in Lusaka.

### **RESPONDENT'S EVIDENCE**

22. On 3<sup>rd</sup> May 2016, the Respondent filed a Statutory Declaration in Opposition to the Application for Expungement which was deposed by one Clyde Elliot Woods, who said he is an authorised Attorney of Benson & Hedges (Overseas) Limited, the Respondent herein. He also said that he is the Deputy Manager of the British American Tobacco (BAT) Group of Companies within which the Respondent falls.

23. Mr Woods deposed that BAT is one of the leading business in the United Kingdom with operations in around 180 countries and sells tobacco products under a number of brands throughout the world. He said that the Respondent was acquired by BAT in 1995 and that the Respondent holds and manages several tobacco brands including PARLIAMENT. He reiterated that the PARLIAMENT trademark has been marketed and sold in respect of goods in class 34 in various countries around the world and as a result the PARLIAMENT trademark has acquired fame and reputation in those countries.





24. Mr. Woods averred that the original parent company of the Proprietor, Benson & Hedges Limited was founded in the United Kingdom in the 1870's and that during the 1900's, a branch of Benson & Hedges Limited was opened in the United States which subsequently became independent from the headquarters in the United Kingdom. The United States branch was eventually acquired by the parent company of the Applicant in the 1950's.
25. Mr. Woods further averred that the PARLIAMENT brand was created over 80 years ago in the United States and different entities acquired rights to the brand in different jurisdiction and the brand is now owned by different parties including the Proprietor and the Applicant. He stated that parties respective PARLIAMENT marks have co-existed for a number of years in their respective markets around the world. He also added that the Respondent and the Applicant have developed and used their own designs of cigarettes under the PARLIAMENT brand in their respective jurisdictions and highlighted the different designs used by the parties. He also exhibited copies of the said designs marked as **Annexure A**.
26. His further evidence was that the Respondent has secured registration of its PARLIAMENT trademark in various jurisdictions around the world, including Zambia and exhibited copies of registration and renewal certificates marked as **Annexure B**. He stated that it is evident that the Respondent has enjoyed rights to the PARLIAMENT trademarks for a number of years and has genuine intention to use and to continue to use its trademark registrations in its designated markets, including Zambia. He added that the fact that the Respondent has been maintaining its trademark registrations in its jurisdiction including Zambia demonstrates this intention.
27. Mr. Woods went on to depose that the Respondent had launched the sale of cigarettes under its PARLIAMENT trade mark in Zambia on 27<sup>th</sup> November 2014. He said the first shipment of cigarettes bearing PARLIAMENT trade marks to Zambia took place in December, 2014. A copy of the photographs showing the



packaging of the product under the PARLIAMENT trade mark being offered for sale by informal traders were exhibited and marked as “**Annexure C**”.

28. He also highlighted the Respondent’s monthly sales volumes of cigarettes under the PARLIAMENT trade marks in Zambia since December, 2014 in terms of millions of sticks and In Market Stock. He further produced copies of invoices addressed to Panafrica Distributors Limited in Zambia as proof of sales of cigarettes under the PARLIAMENT trademarks which he exhibited and marked as “**Annexure D**”.
29. Mr. Woods also proceeded to deny the contents of the Applicant’s affidavit and I have taken note of these averment including Mr. Woods’ insistence that the Respondent has used the PARLIAMENT trade marks in Zambia during the last five years and before it had any knowledge of or was served with the Applicant’s application to remove the Respondent’s trademarks forming the basis of these proceedings.
30. In conclusion Mr. Woods prayed that the Applicant’s application to the Registrar for the removal of the Respondent’s trade mark registrations should be dismissed with an order of costs in favour of the Respondent.

#### **APPLICANT’S EVIDENCE IN REPLY**

31. On 21st September, 2016, the Applicant filed a Statutory Declaration in reply which was also deposed by Lisa Ritchie. I have considered this evidence which mainly sought to rebut the Respondent’s evidence. I note in particular that Ms. Ritchie insisted that the Respondent has provided no evidence of genuine use in Zambia during the relevant period, nor has it provided any evidence of worldwide use and reputation in the international market. In relation to evidence of use produced vide **Annexure C**, Ms. Ritchie refuted this evidence stating that there is no evidence of when or where these photographs were taken. She contended further that even if these photographs do in fact relate to the Zambian market,





by the Respondent's own admission, the Respondent only began trading under the PARLIAMENT trade mark in November/December 2014 which is outside the relevant period in these proceedings. She also disputed the evidence contained in **Annexure D** arguing that this too relate to dates outside the relevant period.

### **THE HEARING**

32. The matter came up for a hearing on 4th July, 2019. Mr. Kanti Patel of Christopher Russell, Cook and Co., appeared for the Applicant, while Ms. Ireen Nambule of Howard & Marietta Legal Practitioners appeared for the Opponent. Both Counsel indicated that they would submit viva voce as well as file written submissions to augment their oral submissions.
33. On behalf of the Applicant, Mr. Patel submitted that the first ground supporting the Removal from the register of the Respondent's registered trademark registrations Nos. 4503 PARLIAMENT, 167/87 PARLIAMENT LABEL, 314/94 PARLIAMENT, 734/95 PARLIAMENT LABEL and 806/2006 PARLIAMENT LABEL is based on the fact that up to the date of one month before the date of this application, a continuous period of 5 years or longer has elapsed during which the registered marks were registered and during which there has been no bona fide use or intention by the respondent in relation to the goods in respect of which they are registered.
34. In support of the first ground, Mr. Patel submitted that he was relying on the Statutory Declaration of Lisa Ritchie dated 18th February, 2016 which shows that following the investigations conducted by the Applicant, it was revealed that the Respondent's or its affiliated companies have not used their registered trademark PARLIAMENT in connection with cigarettes or any tobacco products in the past 5 years.
35. Mr. Patel argued that the Respondent have not provided evidence of genuine use in Zambia during the relevant period being the dates between 13<sup>th</sup> July, 2009 until 13<sup>th</sup> July, 2014 being one month prior to the commencement of these



proceedings, the time frame provided for in section 31 of the Trademarks Act, nor has it provided evidence of worldwide use and reputation in the international market.

36. Mr. Patel further submitted that co-existence of the parties respective **PARLIAMENT** trademarks in the Trademark Register does not amount to co-existence on the market place. He argued that the Respondent's maintenance of **PARLIAMENT** registrations in a number of territories does not amount to genuine intention to use especially regarding Zambia.
37. Counsel concluded by stating that the Applicant is on firm grounds in its request for cancellation of the Respondents registered **PARLIAMENT** trademarks based on non-use in Zambia and prayed that the ruling in these proceedings be made in favour of the Applicant.
38. In response, Ms. Ireen Nambule submitted that she would rely on the Statutory Declaration by Mr. Clyde Elliot Woods and emphasized that the allegation by the Applicant that there has been no *bona fide* use of the trademark is not supported by any evidence and urged the Honourable Tribunal to critically consider the evidence contained in the said Statutory Declaration.

### **APPLICANT'S WRITTEN SUBMISSIONS**

39. On 31<sup>st</sup> July, 2019, the Applicants filed its written submission. There were three points raised in the Applicant's written submissions. Firstly, the Applicant argued that it has satisfied the statutory requirements of section 31(1) of the Trade Marks Act in proving that the Respondent has not made use of its registered trade marks in Zambia in relation to the goods in which the Respondent's trade marks were registered. In arguing this ground, the Applicant endeavored to show firstly that it has satisfied the statutory requirement of being a "*person aggrieved*" within the meaning of section 31 by referring to its international interest in the mark, the registrations and substantial use in other





countries of the trade mark PARLIAMENT. Secondly, the Applicant sought to demonstrate that the Respondent has not made use of its registered trademarks in Zambia for a continuous period of past five (5) years and had no bona fide intention to use the trade marks in relation to the goods registered. To buttress this argument, the Applicant referred to various components of the Applicant's Statutory declarations relating to its investigation which revealed that there was no use. The Applicant also went on to attack the relevance and credibility of the evidence adduced by the Respondent regarding its purported use of the trade mark PARLIAMENT in Zambia.

40. In the second leg of its arguments, the Applicant argued that the Respondent's argument that the time period stipulated in section 31 of the Trade marks Act is calculated from the date of service to the Respondent of the Application for Expungement is not supported by law. In support of this argument, the Applicant cited the Constitutional Court decision in the case of **Steven Katuka (Suing as Secretary General of the United Party for National Development), Law Association of Zambia and the Attorney General, Ngosa Simbyakula and 63 Others (Selected Judgement No. 29 of 2016)** on the effect of applying the literal rule of statutory interpretation unless that approach leads to absurdity. It was argued on the basis of this authority that section 31 (1) is clear in that the period to determine non-use is from the date of application and not from the date of service of the application as contended by the Respondent.

41. In the third point of its argument, it was submitted that the Respondents alleged use of its registered trademarks in Zambia was not *bona fide* and its conduct in repeatedly registering the PARLIAMENT trade mark in Zambia reveals that it has no intention of using the marks in Zambia which conduct is contrary to law. In support of this argument, the Applicant sought to define the words '*bona fide*' by referring to two cases, namely **Gulf Oil Corporation v Rebrandt En Handelaars (EDMS) BPK 1963 (2) SA 10 (T) 27G-H** and the case of **Ansul BV v. Ajax Brandbeveiling BV 2003/RPC C-40/01**. It was argued in this



connection that the Respondent's evidence relating to use is in any case insignificant in the industry and does not warrant a finding that there has been a *bona fide* use of the mark in Zambia.

### **RESPONDENT'S WRITTEN SUBMISSIONS**

42. The Respondent's filed its written submissions on 11<sup>th</sup> November, 2019. Firstly, the Respondent submitted that its trade mark registrations were in use in Zambia prior to the date of one month before the date of Application for expungement. The Respondent raised four questions and proceeded to argue its case on basis of those questions.
43. The first question raised was whether the Applicant is properly qualified as an *aggrieved person*? In addressing this question, the Respondent observed that the Applicant's interest in this matter is that its application for registration of the trade mark PARLIAMENT was rejected by the Registrar. In this regard the Applicant contended that this interest per se cannot qualify the Applicant as an "aggrieved person" who is not a *bona fide* proprietor of the trade mark PARLIAMENT in Zambia.
44. The second question raised was whether it can be said that the Respondent's trademark registrations were made without any *bona fide* intention to use those trademark in relation to the goods covered under those trade marks? It was submitted in relation to this question that the burden to prove that the Respondent registered its trade mark registrations without *bona fide* intention to use in relation to the specified goods rests with the Applicants who have failed to do so. It was submitted that the Respondent has demonstrated by way of annexures A,C and D of its statutory declaration that it has made use of its trade mark registrations in Zambia which demonstrates that the Respondent had a *bona fide* intention to use its registered trade marks.





45. In the third question, the Respondent addressed the question of whether there has been *bona fide* use of the Respondent's trademark registrations in relation to those goods up to the date one month before the date of the application. It was submitted that the onus to prove *bona fide* use as stated lies with the Applicant. It was submitted further that the evidence advanced by the Applicant in its allegation on non-use through the statutory declaration of Jatin Patel is a geographically limited and is not sufficient to warrant the expungement of the Respondent's trademark registration. In addition, the Respondent submitted that the date of the Applicant's application for expungement is the date of service of the application on the Respondent which in this case is 22<sup>nd</sup> July 2015 and the date one month before that date is 22<sup>nd</sup> June 2015. In this regard, the Respondent argued that it had made *bona fide* use of its trade mark registrations prior to 22<sup>nd</sup> June, 2015 as shown in the statutory declaration of Clyde Elliot Woods.
46. The fourth question raised was whether up to the date of one month before the date of the application for expungement a continuous period of five years or longer has elapsed without *bona fide* use of the Respondent's trademark registrations. It was argued in relation to this question that the Applicant's contention to the effect that the Respondent's calculation of the time periods is incorrect is unjustified. The case of ***Imperial Group Limited v Philip Morris and Company Limited (1982) FSR 72*** was cited to buttress this argument. The Respondent argued that in this case it was found that, it was properly and fully established that the mark 'NERIT' had been registered in the absence of *bona fide* intention to use from the time of registration to the time of notification of the application of expungement.



## **DECISION**

47. The above outlines the summary of the facts, evidence and the arguments by parties in relation to the application for expungement of the Respondent's registered trade marks. I will now proceed to render a decision regarding this matter.
48. The Application is premised on section 31 (1) of the Trade Marks Act, which provides as follows:

***“Subject to the provisions of section thirty-two, a registered trademark may be taken off the register in respect of any of the goods in respect of which it is registered on application by any person aggrieved to the High court or, at the option of the applicant subject to the provisions of section sixty-four, to the Registrar, on the ground either-***

***(a) that the trademark was registered without the bona fide intention on the part of the applicant for registration that it should be used in relation to the goods by him and that there has in fact been no bona fide use of the trademark in relation to those goods by any proprietor thereof for the time being up to the date one month before the date of the application; or***

***(b) that up to the date one month before the date of the application a continuous period of five years or longer elapsed during which the trademark was a registered trade mark and during which there was no bona fide use thereof in relation to those goods by any proprietor thereof for the time being***. (emphasis mine)

49. One of the critical issues of determination in an application such as this one and as rightly observed by the Respondent, is whether the Applicant qualifies as the “**person aggrieved**”. Section 31(1) of the Trade Marks Act clearly states that “a





registered trademark may be taken off the register in respect of any of the goods in respect of which it is registered **on application by any person aggrieved.**” (Emphasis mine)

50. The Applicant has submitted that it has satisfied the statutory requirement of 31(1) of proving *inter alia* that it is a “person aggrieved.” The Respondent on the other hand contends that this requirement has not been met. I will therefore start by dealing with this issue which is essentially an issue of *locus standi*.

51. The question of who is the “person aggrieved” has been dealt and discussed in a number of cases before the Registrar of Trade Marks. In the decision of the Registrar in **Amerex Fire Equipment Zambia Limited v Universal Fire Fighting Equipment Limited (2018)**, it was held that for an applicant to be an aggrieved person “***they must show that they have a trading interest in the goods concerned and would therefore suffer damage by the existence of a conflicting trade mark on the register.***” Further in the decision of the Registrar in **Wildcat Energy Drink Zambia Limited and Another v. Big Tree Beverages Limited (2021)**, the Registrar of Trade Marks dealt with this question and cited several historical precedents on who is the person aggrieved for purposes of an application for removal of a registered trade mark. In particular, the case of **Apollinaris Company Limited's Application (1891)** was cited wherein the Court made the following pronouncement: -

***“Are the Vichy Company persons aggrieved? Now we approach this question on the assumption, which is necessary of course to answer this question, that the trade mark was wrongly on the register, and further, with these two observations: in the first place, that the question is merely one of locus standi ; and in the second, that the words “person aggrieved” appear to us to have been introduced into the statute to prevent “the action of common informers or of persons interfering from merely sentimental notions, but that they must not***



*be so read as to make evidence of great and serious damage 'a condition precedent to the right to apply.'*

52. In *Powell's T.M ( 1894)*, Lord Watson said that the fact that a trader deals in the same class of goods, and could use the mark, was prima facie sufficient evidence of his being aggrieved. In the decision of the High Court of Singapore in *Re Arnold D. Palmer [1987] 2 MLJ 681* it was held that:

*“The registration of a trade mark in the name of a proprietor, once effected, ought not to be disturbed by persons who have no trading interest in the goods concerned. If an applicant for rectification has no such interest to begin with, and therefore cannot suffer any damage at all by the existence of a conflicting trade mark on the register, it cannot be right, in principle, that the mere filing of his application can confer the necessary locus standi on the application for the purpose of rectifying proceedings. Otherwise, the test of grievance propounded in *Powell's Trade Mark (1984) 11 RPC 7; [1984] A.C. 8* would be completely nullified by resorting to the simple expediency of applying to register the very mark the applicant seeks to expunge.”*

53. The Federal Court of that country has explained that *Re Arnold D. Palmer* lays down the principle that a person aggrieved is a person who has used his mark as a trade mark – or who has genuine and present intention to use his mark as a trade mark – in the course of a trade which is the same as or similar to the trade of the owner of the registered trade mark that the person wants to have removed from the Register.

54. I have considered the circumstances of this application and the evidence brought by the Applicant regarding its interest in the trade mark PARLIAMENT. Whilst acknowledging the guidance in *Re Arnold D. Palmer* that a mere filling of a





trade mark per se cannot confer the necessary locus standi on the applicant for an application for expungement, I am also mindful of the caution espoused in *Apollinaris* to the effect that the provision should not be interpreted in such a way as to make evidence of great and serious damage a condition precedent to the right to apply. In this matter, the Applicant has shown by evidence that the trade mark 'PARLIAMENT' is one of its brand of cigarettes which is manufactured, distributed and marketed by subsidiaries and licensees of the PMI group of companies to which the Applicant belongs. The Applicant has further shown that it has secured trade mark registrations for the mark PARLIAMENT in other many countries. In my view, this evidence clearly shows that the Applicant has a trading interest in the goods in which the Respondent's trade mark is registered. In other words, it is my considered view that there is sufficient evidence on the record showing that the Applicant has used the trade mark PARLIAMENT and has a genuine and present intention to use this trade mark in the course of trade in Zambia. Therefore, apart from the mere fact that the Applicant lodged an application for the registration of the PARLIAMENT trade mark, there is sufficient evidence tending to show that the Applicant has trading interest in the goods concerned and thus qualifies as a person aggrieved.

55. Having found that the Applicant qualifies as a person aggrieved and therefore has locus standi to move the Registrar for the purpose of these expungement proceedings, I will now turn to consider the application on the merit, that is

- (a) whether the Respondent's PARLIAMENT trade mark was registered without the bona fide intention on the part of the Respondent that it would be used in relation to the relevant goods and that there has in fact been no bona fide use of the trademark in relation to those goods by the Respondent for the time being up to the date one month before the date of the application? Or
- (b) that up to the date of one month before the date of this application a continuous period of five years or longer had elapsed during which the



trademark PARLIAMENT was registered and during which there was no bona fide use thereof in relation to those goods by any proprietor thereof for the time being.

56. The above stated grounds of removal of a registered trade mark under subsection (1) of section 31 are disjunctive which means they are essentially alternatives though it is perfectly fine for an applicant to invoke both grounds. I have looked at the Application filed by the Applicant herein and observed that reliance was placed on both grounds albeit in reverse order. The Applicant has argued that the Respondent has not made any use of the PARLIAMENT trade marks for a continuous period of five years and that the non-use by the Respondent of its registered PARLIAMENT trade marks indicates that the Respondent has no *bona fide* intention to use the trade marks in relations to the goods registered.
57. I will start by addressing the ground of removal under sub-section 1(a). To succeed under this ground one has to prove firstly that at the time the registered trade marks were applied for, the applicant had no *bona fide* intention that the trade mark would be used in relation to the goods covered under it and secondly that there has in fact been no bona fide use of the trade mark in relation to those goods for the time being up to the date one month before the date of the application for removal. The first aspect of this ground requires evidence that at the time of filing the applications for the registration of the PARLIAMENT trade marks, the Respondent herein had no *bona fide* intention to use the said trade marks in relation to the goods specified there under. The burden to prove absence of a *bona fide* intention to use lies with the Applicant for cancellation.
58. Before I can consider whether the Applicant in this matter has discharged the burden of proving the absence of an intent to use the impugned PARLIAMENT trade marks, let me first clarify further on what constitutes lack of bona fine intention to use. Where an application is filed without bona fide intention to use the trade mark it implies that the application was filed in bad faith. It means that the application was filed for different reasons other than those of a trade





mark, namely indicating the origin of goods. The Cancellation Division of the European Union Intellectual Property Office (EUIPO) in case of **Full Colour Black Limited v Pest Control Office Limited (2020)**, stated as follows regarding bad faith applications:-

*“For a finding of bad faith there must be, first, some action by the EUTM proprietor which clearly reflects a dishonest intention and, second, an objective standard against which such action can be measured and subsequently qualified as constituting bad faith. There is bad faith when the conduct of the applicant for a European Union trade mark departs from accepted principles of ethical behaviour or honest commercial and business practices, which can be identified by assessing the objective facts of each case against the standards.*

59. The Division went further and opined that:-

*The ground of bad faith applies where it is apparent from relevant and consistent indicia that the proprietor of an EU trade mark filed its application for registration without any intention of using the contested EUTM, or without the aim of engaging fairly in competition, but with the intention of undermining the interests of third parties, in a manner inconsistent with honest practices, or with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, in particular the essential function of indicating origin*

60. The above dicta demonstrates that a finding of bad faith or indeed the lack of a *bona fide* intent to use a trade mark should be made only where there is evidence of a dishonest intention or state of mind, such that the trade mark applicant's conduct is inconsistent with honest practices or acceptable commercial



behavior. Therefore, good faith on the part of the Applicant is presumed until the opposite is proven.

61. I have examined the evidence submitted by the Applicant in this matter and note that much of the evidence and arguments by the Applicant relate to the ground of removal under sub-section (1)(b) of section 31. In relation to the ground of bad faith, the Applicant's main evidence is that the Respondent has repeatedly and at regular intervals been filing for registration the PARLIAMENT trade mark in the same class and in respect of the same goods. It was argued that if the Respondent genuinely intended to use PARLIAMENT as a trade mark to distinguish their goods from those of others, they would not be filing new applications for the same trade mark. The question I must address is whether the conduct by the Respondent of filings new applications at regular intervals of the same trade mark in the same class can be considered to be inconsistent with honest practices or acceptable commercial behavior to infer dishonest intention or state of mind on the party of the Respondent at the time of filing.
62. Firstly, it is important to point out that the practice of filing different versions of the same trade mark in the same class of goods or services is quite common. For example, it is not strange to see a trade mark owner file a new trademark application for a similar mark that was previously registered but with differences in color, shades of color or the whole get-up. In some instance a previously registered mark might have been a word mark and the proprietor later wants to protect the design aspect of that mark or a combination of the word plus design. I do not consider this practice to be intended to undermine the interests of third parties or to be inconsistent with honest practices. To the contrary, I find this practice to be very ordinary and an acceptable commercial behavior.
63. In view of the foregoing I find that the evidence brought by the Applicant in relation to section 31(1) (a) is not sufficient to for me to hold that the Respondent's PARLIAMENT trade marks in issue were filed without any bona





fide intention to use the said trade marks in relation to the goods covered under those trade marks. In the absence of such evidence bona fide intention on the part of the Respondent is presumed. Since the first aspect of the ground in sub-section 1(a) has failed, it is not necessary for me to consider the second aspect which is that there has in fact been no bona fide use of the trade mark in relation to those goods by for the time being up to the date one month before the date of the application for removal. This is because the two components of this ground must be interpreted conjunctively.

64. I will now turn to consider the ground based on sub-section 1(b) of the section 31 of the Act. In this ground, the Applicant has alleged non-use of the Respondent's PARLIAMENT trade marks for a continuous period of years or longer. In support of this claim, the Applicant has submitted evidence vide a statutory declaration of Jatin Patel who deposed that he conducted investigation on the availability of tobacco products under the name of PARLIAMENT in Lusaka but found no evidence of such products or that they have ever been sold in Lusaka. The Respondent on the other hand submitted various pieces of evidence of use of its PARLIAMENT including Annexure C, a photograph showing the packaging of the product under the PARLIAMENT trade mark being offered for sale by informal traders.

65. Let me start by addressing the issue of burden of proof on this aspect of the ground of non-use. In a recent ruling of the Court of Justice of the European Union ("CJEU") in Maxxus Group GmbH v Globus Holding GmbH C-183/21, the court held as follows regarding the burden of proof in non-use proceedings:-

***“the principle under which it is for the proprietor of the mark to prove genuine use of that mark is in reality merely an application of common sense and of a basic requirement of procedural efficacy. It is the proprietor of the mark at issue which is best placed to***



***adduce evidence in support of the assertion that its mark has been put to genuine use”***

66. The Court went further and observed as follows:-

***It is true that the fact that the applicant, in a given procedure, does not have to bear the burden of proof does not necessarily release that party from the obligation to provide, in its application, a full statement of the facts upon which it bases its claims.”***

***“However, it is clear from Article 19 of Directive 2015/2436 that an application for revocation of a trade mark on the basis of that provision is founded on the claim that the mark has not been put to genuine use by its proprietor. Such a claim, by its nature, does not lend itself to a more detailed statement.”***

67. The above case clarified that an Applicant for a trademark revocation action on the grounds of non-use is not required to provide evidence of market research concerning possible use of the trademark in question. This ruling was however based on a specific provision of the EU Directive which expressly places the burden of proof on the proprietor. To my knowledge, our Trade Marks Act, 1952 does not have any express provision that places the burden of proof on either the Applicant or the proprietor. However, two provisions may render assistance on how this issue may be interpreted. The first one is the proviso to sub-section (1) of section 31 which states as follows:

*Provided that (except where the applicant has been permitted under subsection (2) of section seventeen to register an identical or nearly resembling trade mark in respect of the goods in question or where the High Court or the Registrar, as the case may be, is of opinion that he might properly be permitted so to register such a trade mark), the High Court or the Registrar may refuse an application made under paragraph (a) or (b) in relation to any goods, if it is shown that there has been, before the*





*relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by any proprietor* thereof for the time being in relation to goods of the same description, being goods in respect of which the trade mark is registered. (emphasis mine)

68. The above provision suggests that if evidence of *bona fide use* during the relevant period is available, an application for removal may fail and logically it is the trade mark proprietor who is best placed to procure evidence that a mark was in fact validly used. Furthermore, Regulation 82 of the Trade Marks Regulation provides as follows:-

*“An application to the Registrar under any of the sections thirty-one, thirty-two, thirty-seven or thirty-eight for the making, expunging or varying of any entry in the register shall be made on Form T.M. No. 27, and **shall be accompanied by a statement setting out fully the nature of the applicant's interest, the facts upon which he bases his case and the relief which he seeks...**”*

69. The above provision is consistent with the opinion of the Court of Justice of the European Union in the case above to the effect that an Applicant has an obligation atleast **“to provide, in its application, a full statement of the facts upon which it bases its claims.**

70. In view of the foregoing, my view therefore is that once an Applicant has disclosed its interest and submitted a statement of facts upon which it bases its claim of non-use, the burden of proving bona fide use shifts to the proprietor. In the this regard, I find that through the statement contained in its application and the statutory declaration of Jatin Patel, the Applicant has discharged its obligation of setting out the facts upon which it bases its claim.



71. I must consider now whether the Respondent herein has discharged its burden to prove bona fide use of its PARLIAMENT trade marks. In terms of the proviso to section 31(1) of the Act, if the Respondent can show that there has been, before the relevant date or during the relevant period, bona fide use of its PARLIAMENT trade marks, I may exercise my discretion under this provision to refuse the Applicant's application.

72. There are two critical factors to consider when it comes to proof of use. Firstly, the proprietor must show not only that the trade mark has been put to use in the course of trade but also that that the use was bona fide. Secondly, the proprietor must show by evidence that the use was done within the relevant period. Therefore, in examining whether this application must be refused in accordance with the proviso to section 31(1), I will focus on these two factors.

### ***Bona fide use***

73. The question I must resolve at this juncture is what constitutes bona fide use of a trade mark? According ***Black Law Dictionary; 8<sup>th</sup> Edition at page 186***, the word 'bona fide' is defined to mean *'in good faith. 1 made in good faith; without fraud or deceit 2 sincere; genuine.'* This is also the interpretation given in the case law from many other jurisdictions. For example, in the EU landmark case of ***Ansul BV v Ajax Brandbeveiliging BV, C-40/01***, the mark 'MINIMAX' was registered for fire extinguishers and associated products, however, the owner of the mark had stopped producing and selling fire extinguishers. Ansul only continued to supply components and maintenance services to their customers who had already purchased MINIMAX extinguishers. The Court of Justice of European Union ruled that a mark's use is genuine if it is being used by the proprietor of the mark or a third party with authority to use the mark. The Court also held that "the use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration."





74. In the case of **SANT AMBROEUS Trade Mark [2010] RPC 28 at [42]** the jurisprudence of what constitutes genuine use for purposes of revocation or expungement proceedings was summarized as follows:

- (i) “The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin;
- (ii) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market;
- (iii) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide;
- (iv) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor.”

75. In this matter, evidence of use submitted by the Respondent, who as I said earlier bears the burden of proof, appears at paragraph 16 and 17 of the statutory



declaration of Clyde Elliot Woods. In those two paragraphs, Mr. Woods averred that the Respondent launched the sale of its cigarettes under its PARLIAMENT trade marks in Zambia on 27<sup>th</sup> November, 2014. To buttress his claim, Mr. Woods exhibited a photograph (Annexure C) which according to him shows the packaging of the product sold under the trade PARLIAMENT trade marks in Zambia as well as photographs of the products being offered for sale by informal traders in Zambia. Further, Mr. Woods submitted figures in terms of monthly sales volumes of cigarettes under the PARLIAMENT trade marks in Zambia since December, 2014. Also submitted as Annexure D were copies of invoices addressed to PanaAfrica Distributors Limited.

76. I have considered the Respondents evidence highlighted above and note that though the Applicant has raised issues regarding period of use, the credibility of this evidence of use per se has not seriously been impeached. Generally, evidence of the sale of the registered trade mark goods in form of copies of invoices for the sale of the goods as well as images, such as photographs, showing the trademark applied to the goods, or specimens of packaging, tags or other labels bearing the trademark is good proof of use. Therefore, there being no compelling reasons to disregard the Respondent's evidence of use submitted before this Tribunal, I accept the Respondence's evidence and accordingly find that the Respondent has proved on the balance of probabilities use of its PARLIAMENT trade mark in Zambia. Furthermore, bearing in mind the authorities cited above, I also find that the use of the Respondent's PARLIAMENT trademark was bona fide.

***Period of Use***

77. I will now move to consider whether the use of the Respondent's PARLIAMENT trade mark was within the relevant period. According to section 31(1) (b), the relevant period in which the registered trade mark must have been genuinely used is at least five years from the date the registered trade mark was registered to up to the date one month before the date of the application for removal. For purposes of calculating the relevant period, it is important to distinguish between





the date of registration and the date when the trade mark was actually entered on the register. For the avoidance of doubt, section 31(1)(b) states as follows:

*“that up to the date one month before the date of the application a continuous period of five years or longer elapsed **during which the trade mark was a registered trade mark** and during which there was no bona fide use thereof in relation to those goods by any proprietor thereof for the time being.”*

78. Generally, a trade mark becomes a registered trade mark on the date the certificate is issued. In this regard, for purposes of removal of a registered trade mark pursuant to section 31, the five year period begins to run from the date the trade mark was actually registered rather than the date of application. Therefore, the relevant period which I must consider is the period between the date each of the Respondent’s trade mark was actually entered on the register and the date one month before the date of application, that is, 14<sup>th</sup> August, 2014. The date one month before 14<sup>th</sup> August, 2014 is 13<sup>th</sup> July, 2014. The question therefore is whether between these two dates, i.e., date of actual registration of each trade mark and 13<sup>th</sup> July, 2014 a continuous period of five years or longer has lapsed without use of the Respondent’s PARLIAMENT trade marks. In order to answer this question, the date of actual registration of each impugned trade mark must be ascertained.

79. There are five registered trade marks which the Applicant seeks to remove from the register. These are trade mark registrations number (i) 4503, (ii) 167/87, (iii) 314/94, (iv) 734/97 and (v) 806/2006. There is no evidence that was placed on the record by either party regarding the date of actual registration of each of these trade marks. However, being the custodian of the register of trade marks, this information is readily available before me and to the extent that neither party is prejudiced, I am entitled, in my view, to consider this information and take judicial notice of the same when faced with a situation such as this one. Thus, a perusal of the registry records shows that the first registration, i.e., no. 4503



was registered in 1954. The date of actual registration cannot however be ascertained probably because this is a pre independence registration. On the other hand, copies of the certificate of registrations, shows that Trade mark number 167/87 was entered on the register on 5<sup>th</sup> May, 1988 while the third and fourth, namely no.s 314/94 and 734/97 were entered on 1<sup>st</sup> February, 1997 and 21<sup>st</sup> October, 1998 respectively. Therefore, even though the actual date trade mark number 4503 was entered on the register cannot be ascertained, I have no doubt, that the five years and longer had lapsed by 13<sup>th</sup> July, 2014, when the Applicant lodged this application for removal. There is no evidence that the Respondent's PARLIAMENT trade mark was in use during that period. According to the Respondent's evidence, "the first shipment of cigarettes bearing PARLIAMENT trade mark to Zambia took place in December, 2014." This evidence cannot protect these registrations as it came way after five years from the date these registrations were put on the register in Zambia and thus fell outside the relevant period prescribed under section 31(1)(b) of the Act. Consequently, I find that the Respondent has failed to prove use of these specific trade mark registrations one month before these proceedings were filed and accordingly order their removal from the register.

80. A fairly young registration in respect of the Respondent's PARLIAMENT trade mark is number 806/2006. According to the copy of the certificate of registration, this trade mark was actually entered on the register on 23<sup>rd</sup> March, 2009. This means that at the time the Respondent was putting its trade mark into use in December, 2014, five years had already lapsed. However, from 23<sup>rd</sup> March, 2009 up to the date one month before the application for expungement, i.e., 13<sup>th</sup> July, 2014, which is the relevant period in these proceedings, five years had not yet lapsed. Therefore, in respect of this registration, the application for expungement was launched prematurely. In this regard, the application for removal of Trade mark registration 806/2006 fails and it is accordingly dismissed.





81. I will now turn to consider the Opposition filed by the Applicant in respect of trade mark application number 1454/2014 PARLIAMENT in class 34 in respect of cigarettes; tobacco products; lighters; matches; smokers' articles. This Application was filed by the Respondent on 22<sup>nd</sup> October, 2014. The Respondent claimed priority date of 30<sup>th</sup> April, 2014 in respect of a UK application number UK00003053764.

82. The Respondent's trade mark application number 1454/2014 was opposed by the Applicant herein( as the Opponent). The Opposition was based on sections 16 and 17(1) of the Trade marks Act.

83. In its written submission in support of its opposition, the Applicant stated as follows at paragraph 5:

*"The Opponent's opposition is related to the expungement Application as detailed below, and also relies on the below mentioned ground:*

*5.1. Ground 1- In the event the Honorable Registrar finds in favour of the Opponent in its Expungement Application, the Applicant will not have any valid trade mark registrations in Zambia related to 'PARLIAMENT' in class 34. The Registrar's basis for refusal of the Opponent's Mark will no longer apply and the Opponent's Mark shall be entitled to proceed to registration. The Opponent's Mark will pre-date (February 20, 2014) the Applicant's Offending Mark (April 30, 2014) which is likely to cause confusion with the Opponent's mark pursuant to Section 17(1) and (2) of the Trade Marks Act.*

*5.2 Ground 2- The Applicant's Offending Mark is also prohibited from regrantion pursuant to section 16 of the Trade Marks Act as it is likely to cause confusion with the Opponent's Mark. In addition, the Offending Mark was applied for in bad faith and for this reason is disentitled to protection in a court of justice, the Offending Mark's application is an attempt to thwart the non-use provisions of section 31 of the Trade Marks Act, which the Opponent has relied upon in its Expungement Application."*



84. It is clear from the above submissions that the Opposition was anchored on the success of the expungement application.

85. Further, it is important to point out that for an opposition to succeed under Sections 17 or 16 of the Trade Marks Act, the Opponent has to show that it is the proprietor of an earlier mark which in terms of section 17 (1) must be a mark already on the register. In this case, the Applicant's earlier mark on which the opposition was premised is Application number 172/2014 PARLIAMENT. This application was however rejected by the examiner. Considering therefore that the Applicant's earlier trade mark was rejected and taking into account the outcome of the expungement proceedings wherein the application has failed in respect of trade mark registration number 806/2006, the opposition cannot stand either pursuant to section 16 or 17(1) of the Trade Marks Act.

86. In view of the foregoing, I accordingly dismiss the opposition filed by the Applicant with costs to the Respondent to be taxed in default of agreement by the parties.

87. Leave to appeal to the High Court if dissatisfied with this ruling is hereby granted.

**Dated this 29<sup>th</sup> day of May, 2023**



.....  
**Benson Mpalo**  
**DEPUTY REGISTRAR OF TRADE MARKS.**

