

**DECISION OF THE REGISTRAR IN THE MATTER OF AN APPLICATION BY TRUWORTHS LIMITED FOR THE REMOVAL FROM THE TRADEMARKS REGISTER OF INTERNATIONAL TRADEMARK REGISTRATION NO. MT/0001/1053501 'IWEAR' IN CLASS 25 IN THE NAME OF GUANGZHOU ZENGCHENG GUANGYIN GARMENT CO. LTD PURSUANT TO THE TRADEMARKS ACT CHAPTER 401 OF THE LAWS OF ZAMBIA**

**BETWEEN:**

**TRUWORTHS LIMITED**

**APPLICANT**

**AND**

**GUANGZHOU ZENGCHENG GUANGYIN  
GARMENT CO., LTD**

**RESPONDENT**

**Before Mr. Benson Mpalo, Registrar of Trade Marks**

For the Applicant: Messrs. Fisher Cormack & Botha  
For the Respondent: No Appearance

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## **RULING**

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**STATUTES REFERRED TO**

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

**CASES REFERRED TO:**

Sigma-Tau Industrie Farmaceutiche Riunite v. Amina Limited (2019)



## **BACKGROUND**

1. On the 5<sup>th</sup> of April, 2018, Truworths Limited (hereinafter called the “Applicant”) of No. 1 Mostert Street, Cape Town, South Africa, filed an application for the removal from the trade marks register, of international trade mark registration number **MT/0001/1053501 ‘IWEAR’ in class 25** registered in the name of Guangzhou Zengcheng Guangyin Garment Co., Ltd (hereinafter called the ‘Respondent’) of Shapu Road, Shapu, Zengcheng 511338 Guangzhou, Republic of China.
2. The international registration **MT/0001/1053501 ‘IWEAR’** (hereinafter called ‘the Respondent’s trademark’) designates Zambia with a priority date of 2<sup>nd</sup> August 2010 and is registered in Class 25 in respect of “*Clothing; layette; bathing suits; running shoes; shoes; hats; hosiery; gloves (clothing); neckties; scarfs; girdles; belts (clothing)*”.

## **GROUND OF EXPUNGEMENT**

3. The applicant submitted the following grounds in support of its application:
  - (i) That the Respondent’s trade mark offends against the provisions of sections 31(1)(a) and (b)
  - (ii) That the designation of the Respondent’s international registration is invalid and has no force of law and offends against the provisions of section 16.

## **STATEMENT OF CASE**

4. The Application for removal was accompanied by a statement of case wherein the Applicant stated that it filed an application for the registration of trade mark application no. **56/2015 ‘INWEAR’ in class 25**, in respect of *clothing, footwear, headgear*. That the application was refused on the basis of the existence of the Respondent’s trademark.



5. The Applicant contended that for as long as the Registrar of Trade Marks persists in alleging that the Respondent's trademark is a bar to the registration of the Applicant's application in class 25, the Applicant is an aggrieved person for purposes of sections 31(1)(a) and 31(1)(b) of the Trade Marks Act.
6. The Applicant claimed that the Respondent's trade mark was registered without bona fide intention on the part of the Respondent that it should be used in relation to those goods by the Respondent and that there has in fact been no bona fide use of the trade mark in relation to those goods by the Respondent up to the date one month before the date of the filing of the request for cancellation; or up to the date one month before the date of the application for cancellation, a period of five years or longer had 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.
7. The Applicant further argued that the Respondent's trademark is a local designation of international registration no. 1053501 IWEAR. That although Zambia has acceded to the Madrid Protocol, it has enacted no legislation to give local effect to its obligations assumed in terms of the Madrid Protocol and therefore has no force of law in Zambia. The Applicant claimed that the Respondent's trade mark is thus contrary to section 16 of the Trade Marks.

### **Relief Sought**

8. The Applicant prayed for an order that the register of trade marks be rectified by the removal of the Respondent's trade mark insofar as it extends to goods in class 25. The Applicant further prayed for an order for the Respondent to pay costs and further and/or alternative relief as the Registrar sees fit.



### COUNTER-STATEMENT

9. The Respondent was expected to file a counter-statement within two (2) months of receipt of the application for expungement which was sent to the International Bureau of the World Intellectual Property Organisation (WIPO), through the Madrid Office Portal on 31<sup>st</sup> May 2019 for onward transmission to the Respondent. However, the Zambian office did not receive the counterstatement within the stipulated timeframe. Despite several reminders, the counterstatement was not filed.
10. The Applicant was subsequently advised to proceed to file submissions and evidence in support of its application for expungement in line with Regulation 83 of the Trade Marks Regulations, to enable the Registrar determine the matter.

### APPLICANT'S EVIDENCE AND WRITTEN SUBMISSIONS

11. The Applicant's evidence consisted of a Statutory Declaration filed on 31<sup>st</sup> January 2022 declared by Catherine Nicole Kirkman who stated that she was a divisional Director, Merchandise Planning of the Respondent's company.
12. Ms. Kirkman made declarations in support of the Applicant's case mainly demonstrating the Applicant's use of the INWEAR trade mark across Africa, including Zambia. She further exhibited an investigation report on the findings of an investigation conducted into the use of the Respondent's trademark on the Zambian market. It was stated that the report revealed that a total number of 88 stores were visited and none of them carried any "IWEAR" branded clothing or other "IWEAR" branded goods.
13. The Applicant subsequently filed its written submissions on 15<sup>th</sup> December, 2022. The Applicant stated that the application for expungement was



supported by the statutory Declaration of Catherine Nicole Kirkman and is anchored on section 31(1)(a) and 31(1)(b). In summary, the Applicant submitted that it had established that there had been no bona fide or genuine use of the registered trade mark "IWEAR" in class 25 in respect of Clothing; layette; bathing suits; running shoes; shoes; hats; hosiery; gloves (clothing); neckties; scarfs; girdles; belts (clothing) and that this was a proper and fit case for expungement of the trade mark from the register of trade marks.

14. The Applicant further submitted that the Respondent has not responded to the application for expungement, demonstrating a clear lack of interest in the mark and betraying any bona fide intent to actually use the mark and that if the mark had been used and garnered goodwill in the market, one would expect the proprietor to defend it.

### **DECISION**

15. This is an application for the removal of international trade mark registration number **MT/0001/1053501 'IWEAR' in class 25** from the trademarks register. The application was made pursuant to **Section 31 (1) (a) and (b)** of the Trade Marks Act, Chapter 401 of the Laws of Zambia ("the Trade Marks Act"). For the avoidance of doubt, section 13 (1) provides as follows:

*Subject to the provisions of section thirty-two, a registered trade mark 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 and subject to the provisions of section sixty-four, to the Registrar, on the ground either-*

- (a) *that the trade mark was registered without any bona fide intention on the part of the applicant for*



*registration that it should be used in relation to those goods by him and that there has in fact been no bona fide use of the trade mark 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 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:*

16. Section 31 (1) of the Trade Marks Act essentially provides for the removal of a registered trade mark from the register on application to the Registrar by any person aggrieved on the grounds of non-use.
17. The records before me show that the Applicant filed in support of this application, a Statement of Case, a Statutory Declaration and Written Submissions. As stated earlier in the summary of the facts, the Respondent did not file a counterstatement or any other documents to support its trademark registration. Regulation 83 read together with Regulation 48 of the Trade Marks Regulations requires the Respondent to file a counterstatement within two months from the date of receipt of the application for removal, setting out the grounds on which the Applicant relies to support its trademark registration.
18. Regulation 83 of the Trade Marks Regulations also provides guidance with regards to failure by a registered proprietor to file a counterstatement in expungement proceedings. It provides that:  
*“upon such application being made, and copy thereof transmitted to the registered proprietor, if necessary, the provisions of the*



regulations 48 and 57 shall apply *mutatis mutandis* to the further proceedings thereon; **but the Registrar shall not rectify the register or remove the mark from the register merely because the registered proprietor has not filed a counterstatement.** In any case of doubt any party may apply to the Registrar for directions’.

19. In view of the foregoing provision, the Applicant was directed to proceed to file submissions and evidence in support of its application to enable me assess the application on its merit.
20. Before delving further into merit of the application, I wish to clarify the issue of the status of international registrations designating Zambia under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (‘the Madrid Protocol’). In its second ground of expungement, the Applicant argued that *“the designation of the Respondent’s international registration is invalid and has no force of law and offends against the provisions of section 16.”* This issue was dealt with in the Registrar’s decision in the matter of **Sigma-Tau Industrie Farmaceutiche Riunite v. Amina Limited (2019)**. It was settled in the said case that international registrations under the Madrid Protocol designating Zambia, are valid registrations under the Zambian trade marks register. It was opined in that matter that *“though the filing of an international application is done elsewhere, an international application is for all intents and purposes no different from an application filed locally....all designated applications are subject to the same substantive examination criteria enshrined in the Trade Marks Act.”*
21. In light of the foregoing, the registration of the impugned trade mark cannot be faulted merely because it was an international registration made under the Madrid Protocol.



22. However, a further inspection of the registry records revealed that the Respondent's impugned trademark is no longer a valid trademark on the Zambian trade mark register having expired for non-renewal. Article 7 (1) of the Madrid Protocol provides for the renewal of International Registrations as follows:
- Any international registration may be renewed for a period of ten years from the expiry of the preceding period, by the mere payment of the basic fee and, subject to Article 8(7), of the supplementary and complementary fees provided for in Article 8(2).*
23. The Respondent's trade mark was due for renewal on 2<sup>nd</sup> August, 2020. According to the WIPO Madrid Monitor, the Respondent's trademark was not renewed in respect of its designation to Zambia and is therefore marked as expired.
24. It would therefore be an academic exercise for me to deal with the Applicant's first ground of expungement or to consider the Applicant's evidence and submissions as the Respondent's trade mark which is the subject of this application has since expired and is no longer 'a registered trade mark' for purposes of an application under section 31 (1) (a) and (b) of the Trade Marks Act.
25. In light of the foregoing, I order that the Applicant's trade mark application number 56/2016 'INWEAR' in class 5 which was refused on the basis of the existence of the Respondent's trademark, be re-examined in light of the resulting change on the register of trade marks.





26. Considering that the Respondent did not oppose this application, I shall order no costs against them.

Dated this 11<sup>th</sup> day of October 2023



BENSON MPALO

**REGISTRAR OF TRADEMARKS**

