

DECISION OF THE REGISTRAR OF TRADEMARKS IN THE MATTER OF AN APPLICATION FOR REMOVAL OF TRADE MARK REGISTRATION No. 1075/2021 'SANSAMUKENI AND LABEL' IN CLASS 5 IN THE NAME OF DOMICUZ GENERAL DEALERS BY ZAMDEZI FOODS AND BEVERAGES LIMITED PURSUANT TO THE TRADEMARKS ACT CHAPTER 401 OF THE LAWS OF ZAMBIA.

BETWEEN:

ZAMDEZI FOODS AND BEVERAGES LIMITED

APPLICANT

AND

DOMICUZ GENERAL DEALERS

RESPONDENT

Coram: Mr. Benson Mpalo, Registrar of Trade Marks

For the Applicant: Messrs. Mambwe, Siwila & Partners

For the Respondent: Messrs. Mutemwa Chambers Advocates

RULING



Legislation referred to

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

Cases referred to

1. Amerex Fire Equipment Zambia Limited v Universal Fire Fighting Equipment Limited (2018)
2. Apollinaris Company Limited's Application (1891) 8 RPC 137

3. British Sugar Plc V. James Robertson & Sons Ltd (1996) RPC 281
4. Edward Hack's Appn. (1941) 58 RPC 91
5. Lloyd Schufabrik Meyer & Co GMBH v Klijesn Handel BV case C – 342/97 (ECJ)
6. Mettenheimer V Zonquasdrif Vineyards CC (965/12) (2013) ZASCA 152 (19 November 2013)
7. National Brands Limited v Yoyo Foods (2020)
8. OHIM v Shaker C-334/05 P
9. Pharmanova (Zambia) Limited v. King Pharmaceutical Limited (2023)
10. Philip Morris Brands S.A.R.L v. Benson & Hedges (Overseas) Limited
11. Recot, Inc. V. Becton, 214 F.3d 1322, 1329, and 54 U.S.P.Q.2d 1894 1899 (Fed. Cir.2000)
12. Re Rivieres Trade Mark (1884) 26 Ch D 48
13. Sabel BV v. Puma AG (1998) RPC
14. Trade Kings Limited vs. Unilever & Others, SCZ Judgment No. 2 of 2000 ZLR
15. Wright, Crosssley, TM: 1898 (15) RPC 131

Other works referred to

1. Collins English dictionary



INTRODUCTION

1. This is a matter which was filed before the Registrar of Trade Marks pursuant to section 37 of the Trade Marks Act, chapter 401 of the Laws of Zambia (herein called the Trade Marks Act.) I presided over this matter in my capacity then as Deputy Registrar of Trade Marks pursuant to section 5 (b) of the Trade Marks Act.
2. The brief background is that on the 27th of January, 2022, Zamdezi Foods & Beverages Limited of Plot No. 006/07, Kabanana, Lusaka (hereinafter referred to as “the Applicant”) applied for the removal from the Register of trademarks, trade mark registration **No. 1075/2021 ‘SANSAMUKENI AND LABEL’** in class 5 registered in the name of Domicuz General Dealers of plot No. 33320, Kabwata, Lusaka (hereinafter referred to as “the Respondent”).
3. The trade mark registration No. **1075/2021 ‘SANSAMUKENI AND LABEL’** (hereinafter referred to as ‘the Respondent’s trade mark’) is registered in class 5 in respect of *medicinal alcoholic beverages*.

GROUND FOR EXPUNGEMENT

4. The grounds for the application for removal were as follows:
 - i. That the get up of the Respondent’s whole trademark is similar to the Applicant’s
 - ii. That the logo is the same
 - iii. That the font used was similar to the Applicant’s.
 - iv. That the names of the products are similar

COUNTER-STATEMENT

5. On the 1st of April, 2022 the Respondent filed a Counter-statement in response to the Applicant’s application for expungement. The Respondent



stated that the Applicant's goods are registered in class 33 in respect of *alcoholic beverages (except wine)* whilst the Respondent's goods are registered in class 5 in respect of *Medicinal alcoholic beverages*.

6. The Respondent asserted that in view of section 17 (1) of the Trade Marks Act, Chapter 401 of the Laws of Zambia ("the Trade Marks Act"), it is important to determine whether or not the two trademarks nearly resemble each other to cause confusion on the market. The Respondent claimed that although subsection 1 of section 17 does not engage the word 'similar', it is generally understood that the phrase 'so nearly resembles' implies the extent of similarity.
7. The Respondent stated that, according to Collins English dictionary, the verb form of the word resemble means "to possess some similarity to." That the dictionary further explains that "if one thing or person resembles another, they are similar to each other". The Respondent contended that it must be determined whether the two marks possess major similarities which would create a likelihood of confusion in the mind of the public.
8. The Respondent cited case law to buttress its argument that the two trade marks are very distinguishable and are not visually similar to resemble each other. I will not consider the case law in the Respondents counter statement as the Respondent is only required, at this point, to set out the grounds on which it relies to support its trade mark registration in line with Regulation 48 of the Trade Marks Regulations.
9. It was the Respondent's submission that the two trademarks were very distinguishable and were not visually similar and presented the following information as indicating the differences between the two trade marks:



Zamdezi food & beverages limited (TM)	Domicuz General Dealers (TM)
Dominant colour is yellow	Dominant colour is orange
Has a group of people on the middle	Has a glass of wine, ginger and oranges on the left end of the label
The word SANSAMUKENI is on both sides of the label	There is only one word SANSAMUKEN on the label
Has the white colour below	Has the sky blue colour below
Has the word wine	Has the words medicinal wine

10. The Respondent contended that the Applicant has not specified the type of font used on the word SANSAMUKENI and therefore could not dwell on something that is nonexistent. The Respondent further argued that the Applicant's products are different from those of theirs and that the Applicant's products are alcoholic beverages (except) wines; whilst that of the Respondent is a wine drink containing medicinal properties registered for medical alcoholic beverages including wine.
11. The Respondent submitted that the general impression of the two trademarks is distinct and that this can also be deduced from the fact that the Respondent has been selling the medicinal wine for a long time.
12. The Respondent implored the Registrar to invoke section 17(2) of the Trade Marks Act and allow concurrent use of the two trademarks as they have coexisted for some time now selling the two category of products on the same market without confusion to the public.

RESPONSE TO COUNTER-STATEMENT

13. The Applicant filed a response to the Respondent's counter-statement on the 25th of April, 2022. However, since the trade mark regulations do not



provide for a Reply to a counter-statement, I will note reproduce what was contained in that response.

APPLICANT'S EVIDENCE

14. The Applicant filed an Affidavit in Support of its application for expungement on the 1st of June, 2022. The Affidavit was deposed by one William Rubayita, in his capacity as Managing Director of the Applicant company.
15. Mr. Rubayita stated that the Applicant is a company incorporated under the Companies Act No. 10 of 2017 of the laws of Zambia and that it manufactures a drink called Sansamukeni Wine Drink on the Zambian market, whose trade mark is being infringed.
16. Mr. Rubayita deposed that in order to protect the name 'Sansamukeni Wine', the Applicant registered it as a trademark. A certificate of registration was exhibited marked "WR1" in this regard. Mr. Rubayita also exhibited a copy of the Conditional Acceptance and payment receipt respectively marked as "WR2" and "WR3". He further exhibited a copy of the verification of payment for trade mark registration, marked "WR4".
17. He explained that at the time the Sansamukeni trademark was registered, it was doing well in terms of sells but suddenly the sales dropped drastically. He stated that research conducted by the Applicant revealed that there was another drink with the same name and similar appearance that was being sold on the market, called 'Sansamukeni Medicinal Wine', which caused the change in sales.
18. Mr. Rubayita further stated that the trade mark, "Sansamukeni Medicinal Wine" is a product of another company called Domicuz General Dealers and was registered as a trade mark on 15th June, 2021 under



class 5, number 1075/2021. A certificate of registration for the said trademark was exhibited and marked “**WR5**”.

19. It was deposed that an application to have the Sansamukeni Medicinal Wine expunged for infringement of trademark of Sansamukeni Wine was lodged with the Patents and Companies Registration Agency on 27th January, 2022. He reiterated the grounds for expungement and exhibited the application for expungement marked “**WR6**”. Mr. Rubayita’s affidavit further exhibited the Respondent’s counter-statement marked “**WR7**”.

20. In conclusion, Mr. Rubayita submitted that this is a clear case for the Agency to exercise its power to expunge Sansamukeni Medicinal Wine for being so similar to Sansamukeni Wine as to deceive an average person.

RESPONDENT’S EVIDENCE

21. On the 25th of April, 2022 the Respondent submitted a document in the form of a letter addressed to the Registrar of Trademarks purporting to be evidence in support of its case. The Respondent was advised by the Registry via letter dated 3rd May, 2022 to file an Affidavit or Solemn Declaration as prescribed under the Trade Marks Regulations but failed to do so and the matter proceeded to a hearing. However, since I am not bound by the strict rules of evidence I have taken note of the contents of the said document and may consider the same where necessary in my analysis of this matter.

THE HEARING

22. The hearing of the Application for expungement was held on the 29th of September, 2022. Both parties were represented by their respective counsel. Mr. Alpha Sakala of Siwila Lisimba Advocates, appeared for the Applicants, while Mr. Siyumbano of Mutemwa Chambers appeared for the Respondent.



23. Mr. Sakala indicated that the Applicant would rely on the Applicants Affidavits and other documents which were filed in support of the application and will not file any written submissions.

24. Mr. Siyumbano submitted on behalf of the Respondent that he would make brief oral submissions followed by written submissions.

Applicant's Oral Submissions

25. On behalf of the Applicant, Mr. Sakala indicated that their application is premised on the grounds contained in the Applicants Affidavit dated 1st June, 2022 and on the provisions of section 17 of the Trade Marks Act Chapter 401 of the Laws of Zambia.

26. Mr. Sakala submitted that the Applicants relied on Section 37 (1) of the Trade Marks Act and argued that the Respondents application was registered wrongly on the basis that the trade mark is similar to the Applicants trade mark and has the effect of confusing the general public as to the origin of the products. Further, he made reference to a copy of the registration certificate for the Applicant marked 'WR 1' and a copy of the registration certificate for the Respondent marked 'WR 5' and submitted that when the two trademarks are compared, any reasonable person would conclude that the features and the names are likely to cause confusion and thus giving the Registrar the powers to effect or exercise the provisions under section 17 of the Trade Marks Act.

Respondent's Oral Submissions

27. Before I could hear the Respondent's submissions, I reminded the parties of the provisions of Regulation 83 of the Trade Marks Regulations, read together with Regulation 49 and Regulation 50, which requires them to file



their respective evidence by way of Affidavit or Solemn Declaration. At this stage, Mr. Siyumbano applied for an adjournment to allow the Respondent to file its evidence. Having heard the application and the attendant reasons, I refused to grant the Respondent an adjournment and Counsel for the Respondent proceeded with his arguments in support of the Respondent's trade mark registration.

28. In arguing the Respondent's case, Mr. Siyumbano contended that there are striking differences between the Applicant's and Respondent's trade mark. He submitted that the test in terms of the target consumer, is the average customer. He referred to the case of **Trade Kings Limited V Unilever Plc & Others, 2000 ZR, P. 16**. where Ngulube CJ as he then was stated at page 20 – 21 as follows; *it is necessary to consider the nature of the article sold, the class of customers who buy to remember that it is the question of likelihood of deceiving the average customer or the class which buys, neither those too clever, nor fools; neither those over careful, nor those over careless.*

29. Mr. Siyumbano submitted that the average consumer will be able to discern the striking differences between the two trade marks under consideration as the dominant colour in the Applicants trade mark is yellow while the Respondents trade mark has orange. Mr. Siyumbano referred to exhibits 1 and 5 of the Applicants affidavit in support arguing that the Applicant's trade mark has a circle with people on it while the Respondent's trade has a glass of wine. He added that the classes in which the two trademarks are registered are different. That the Applicant's mark is registered in class 33 in respect of alcoholic beverages while the Respondents mark is registered in class 5, a difference that cannot be overlooked.



30. Mr. Siyambano further argued that the reason for a decline in sales volume that was advanced by the Applicant to justify the confusion in the minds of the consumers regarding the two trademarks has not been substantiated in any way. He submitted that without proof that there has been a likelihood of confusion in the minds of the consumers, the same does not exist. He submitted that the two trademarks have coexisted well for the duration that they have been in operation.
31. In conclusion, Mr. Siyumbano requested that the Applicant's application be dismissed for want of merit and because in the absence of evidence the application is driven by malice.

Applicant's Reply

32. In Response to the Respondent's submissions, Mr. Sakala argued that the proper test is whether consumers are able to differentiate the source of goods regardless of the fact that the markings are different. He relied on the High Court Case of ***Recot, Inc. V. Becton, 214 F.3d 1322, 1329, and 54 U.S.P.Q.2d 1894 1899 (Fed. Cir.2000)*** citing the following:

"Trademarks can be similar in a number of ways. When comparing trademarks, their appearances, sounds connotations and commercial impressions must be evaluated. Such comparisons allow for considerable amount of subjectivity... One of the biggest misconception this area of law is that the test of likelihood of confusion is whether the marks can be distinguished if they compared side by side to each other. This is not proper or appropriate test, instead the test is after a complete consideration of all relevant facts pertaining to the trademarks, appearances, sounds, connotations and commercial impressions. Is there a likelihood of confusion as to the sources of goods or services? in other words will the consumers believe that the



owners of two trademarks are related, affiliated, connected or that the goods or services originate from the same source....”

33. In view of the above, Mr. Sakala submitted that an ordinary consumer will not be able to tell the difference of the source of the products.

DECISION

34. I have carefully considered the issues raised in this application for expungement as contained in the documents filed before the registry, including the Application for Removal of a Trade Mark from the Register, the Counter-statement, and Affidavit evidence filed by the Applicant. I have also considered the submissions made and the authorities cited by both learned Counsel on behalf of the parties.

35. The Applicant seeks the removal of the Respondent's trade mark No. 1075/2021 'SANSAMUKENI AND LABEL' from the official register of trade marks. At the hearing of this matter, Counsel for the Applicant submitted that the Applicant is relying on Section 37 (1) of the Trade Marks Act, Chapter 401 of the laws of Zambia ("the Trade Marks Act"). The said section provides as follows:

Any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the High Court or, at the option of the applicant and subject to the provisions of section sixty-four, to the Registrar, and the High Court or the Registrar may make such order for making, expunging or



varying the entry as the High Court or the Registrar may think fit.

36. The above provision allows any ‘person aggrieved’ to make an application before the Registrar of trademarks or before the High Court of Zambia, for the removal of a registered trademark from the Register. It is a requirement under this provision that an Applicant must show that it is ‘a person aggrieved’ in order to properly invoke this provision.
37. The issue of what constitutes an ‘aggrieved person’ has been discussed in the previous decisions of the Registrar such as the case of *Amerex Fire Equipment Zambia Limited v Universal Fire Fighting Equipment Limited (2018)*; *Pharmanova (Zambia) Limited v. King Pharmaceutical Limited (2023)*; and *Philip Morris Brands S.A.R.L v. Benson & Hedges (Overseas) Limited*
38. In the above cases, the Registrar relied on a number of old cases including the English case of *Apollinaris Company Limited's Application (1891) 8 RPC 137*, where the court, in determining who is a ‘person aggrieved’, 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. (emphasis added)

39. The court went further and opined that ***“if the effect produced, or likely to be produced, by the wrongful trade mark, is not the exclusion, but the hampering of a rival trader; that rival trader again, is in our opinion, a person aggrieved. A man in the same trade as the one who has wrongfully registered a trade mark and who desires to deal in the article in question' is prima facie an "aggrieved person.”***
40. In the case of **Wright, Crosssley, TM: 1898 (15) RPC 131**, it was held that apart from merely being in the same trade as the registered owner, ***“an Applicant must show that in some possible way he may be damaged or injured if the trade mark is allowed to stand; and by possible I mean possible in a practical sense and not merely a fantastic view...”***
41. Further, in the case of **Re Rivières Trade Mark (1884) 26 Ch D 48** it was stated that ***“the meaning of the word "aggrieved" is not to be limited in any particular way. There must be a legal grievance. The question is one of fact to be determined on the evidence, not a priori as a matter of law.”***
42. Extending the principles enunciated in the cases cited above to the case in *casu*, I must satisfy myself that the Applicant had a real legal grievance as espoused in the cases cited above. Accordingly, the Applicant must show that it may, in some possible way, be damaged or injured if the Respondent’s trade mark remains on the register.



43. I have considered the Applicant's affidavit evidence filed on the 1st of June 2022, deposed by William Rubayita who explained that the Applicant is a manufacturer of a drink called 'Sansamukeni Wine Drink' which is currently on the Zambian Market. I have considered, in particular, the Applicant's assertion that the sales for its product went down due to the Respondent's product. This claim was not challenged by the Respondent. This, in my view is evidence of damage or loss that the Applicant has suffered as a result of the Respondent's registration. In addition, I have also considered the Respondent's own assertion in the counter-statement that "the two companies have coexisted for some time now selling the two category of products on the same market...". This is evidence to the effect that the two entities are engaged in the same trade. In view of the foregoing, I find that the Applicant is a 'person aggrieved' and has locus standi to make this application for removal of the Respondent's trade mark from the register.
44. I will now turn to consider the application on its merit, that is to say, whether the Applicant has presented sufficient grounds to justify the removal of the Respondent's trade mark from the register. Pursuant to Section 37(1) of the Trade Marks Act, a registered trade mark can be removed from the register by reason of "***the non-insertion in or omission from the register of any entry, or any entry made in the register without sufficient cause, or any entry wrongly remaining on the register, or any error or defect in any entry in the register.***"
45. According to the Applicant, the application for removal was made on the grounds that the Respondent's trade trademark is similar to the Applicant's earlier registered trade mark in respect of: the get up of the whole trade mark, the logo, the font used and the name of the product. In his oral submissions at the hearing, Counsel representing the Applicant submitted that the Respondents application was registered wrongly on the



basis that the Respondent's trade mark is similar to the Applicant's trade mark and has the effect of confusing the general public as to the origin of the products, thus giving the Registrar the powers to effect or exercise the provisions under section 17 of the Trade Marks Act.

46. It is important to note at the outset that under section 18 of the Trade Marks Act, a trade mark that has been registered in Part A of the register for seven years is deemed valid and protected for purposes of an application under section 37 except in cases where the registration was obtained by fraud or where the trade mark offends against the provisions of section sixteen. For the avoidance of doubt, this provision states as follows: -

***“18. (1) In all legal proceedings relating to a trade mark registered in Part A of the register (including applications under section thirty-seven), the original registration in Part A of the register of the trade mark shall, after the expiration of seven years from the date of that registration, be taken to be valid in all respects, unless- (a) that registration was obtained by fraud; or (b) the trade mark offends against the provisions of section sixteen.*”**

47. In light of the foregoing, I ask myself whether the Respondent's trademark enjoys protection under the above provision. The Applicant has presented evidence (exhibit **“WR5”**) which shows that the Respondent's 'Sansamukeni' trade mark was registered on 15th June, 2021. Clearly, having been registered in 2021, the Respondent's trade mark cannot enjoy protection under section 18 since seven years has not lapsed from the date of registration to the date when the application for removal was lodged. This means that the impugned trade mark is vulnerable to removal under section 37 including on the basis of section 17 (1) of the Act relied upon by the Applicant. This is because a trade mark that was registered in contravention of section 17(1) is deemed to be an entry made in the



register without sufficient cause, or an entry wrongly remaining on the register.

48. I will therefore proceed to determine whether the Respondents trade mark was registered in contravention of section 17(1) in view of the Applicant's earlier registered trade mark. Section 17 of the Trade Marks Act provides that:-

(1) 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.



49. To offend against the provision of section 17(1) of the Trade Marks Act, two elements must be present; firstly that the later mark is identical or similar to an earlier registered trademark and secondly, that the trade marks are in respect of the same goods or description of goods.

50. I will proceed to consider whether these two elements existed at the time the Respondent's application was being examined.

Comparison of the trade marks

51. The question is whether the Applicant's trade mark is identical or so nearly resembles the Respondents trademark. For purposes of comparison the trade marks involved are shown below:



Applicant's Trade Mark Registration Nos. 627/2020	Respondent's Trade Mark Registration Nos. 1075/2021
	

52. In the case of **Sadas SA V. OHMI-LTJ DIFFUSION (Arthur et Felicie)**

Judgement of 24. 11.2005-Case T-346/04, the court observed that:-

“a sign is identical with a trademark where it reproduces, without any modification or addition, all elements constituting the trademark or where, viewed as a whole, it contains differences so insignificant that that they may go unnoticed by an average consumer”

53. Although the two marks share the word ‘SANSAMUKENI’, it cannot be said that these marks are identical in view of the other elements comprising each mark. I will therefore focus on the resemblance or similarity between the two marks.

54. Case law has provided comprehensive guidance on the principles which must be applied when assessing the similarities of marks. Notably, the case of ***Sabel BV v. Puma AG (1998) RPC, paragraph 23*** established that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. Thus, according to this settled authority, an assessment of similarity between two marks must be based on three considerations namely visual, phonetic or conceptual. Each of these considerations (visual, phonetic and conceptual) will lead to a decision as to whether the marks are similar.



55. It is also necessary to add that when considering the similarity of marks at each of the three levels, attention must be paid to the distinctive and dominant components. This does not, however, mean taking just one component of a composite trade mark and comparing it with another. The courts have guided that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. (*see SABEL, paragraph 23; Lloyd Schuhfabrik Meyer paragraph 25*);). Therefore, the comparison must be made by examining each of the marks in question as a whole even though, in certain circumstances, the overall impression conveyed to the relevant public by a composite trade mark may be dominated by one or more of its components. (See *OHIM v Shaker C-334/05 P*).

56. In the present case both marks are composite marks comprising the word 'SANSAMUKENI' and other word elements, devices and specific colour components. I have noted that at the time of application for the registration of its trade mark, the Respondent had provided a translation of the word 'SANSAMUKENI' as a Bemba word which means "to be joyful." I have also taken note of the nature of goods in respect of each trade mark and the effect the word 'SANSAMUKENI' is likely to have on an average consumer. In *OHIM v Shaker (Para 20)*, the Court observed that "*As regards alcoholic drinks the average consumer gives greater attention to the word component, insofar as it deals with a category of goods usually identified by the name of the product, rather than graphic elements printed on the label.*"

57. In view of the foregoing I find that the average consumer in Zambia is likely to give attention to the word 'SANSAMUKENI' when confronted by either of the products in view of its meaning and product associated with



it, being “wine” whether medicated or otherwise. I therefore find that the word element ‘SANSAMUKENI’ in both marks is the dominant element.

58. Having found that the word ‘SANSAMUKENI’ is the dominant element, the question is whether the other elements in both marks should be disregarded when assessing the similarity between two marks. In ***OHIM v Shaker (Para 42)*** the Court guided that “it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element.”

59. Having carefully examined both the Applicant and the Respondent’s mark, I find that there is nothing distinctive in the Respondent’s trade mark which significantly distinguishes it from the Applicant’s trade mark. On the other hand, I find that there are more common than distinguishing features that exist between the two marks. In general, the more commonalities that exist between marks, the higher the degree of similarity. In terms of overall impression produced by the marks, I find that the word SANSAMUKENI is much likely to have significant impact in the mind of a consumer, taking into account the fact that an average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect recollection.

60. In view of the foregoing and bearing in mind the dominant elements of the two marks, I find that there is a high degree of visual, aural and conceptual similarities between the marks in issue.

Comparison of goods

61. It is trite law that a likelihood of confusion under section 17 may occur not only where two trademarks are identical or similar but also where the



goods in respect of which they are registered or sought to be registered are the same or of the same description.

62. In this matter, the Applicant's trade mark is registered in class 33 of the Nice Classification of goods in respect of '*alcoholic beverages (except wine)*' while the Respondents trademark is registered in class 5 in respect of '*Medicinal alcoholic beverages*'. The Respondent has argued that the products of the Applicant are very different from that of the Respondent.
63. It is clear that the trade marks in issue are registered in different classes of the classification of goods. However, it is important to appreciate that classification is not always the determining factor in considering the similarity of goods. The specific goods under both trade marks must be critically examined. Thus, in comparing the goods, I am guided by the historic case of ***British Sugar Plc V. James Robertson & Sons Ltd (1996) RPC 281***, where Jacob, J summed up the factors to be taken into consideration when determining whether or not there is similarity in goods or services. These factors he stated are: "*the uses; users; physical nature of the respective goods; the trade channels through which the goods are marketed; the respective locations where it is sold in the supermarket; and whether the goods concerned are rivals in the same market.*" This principal was applied with approval by the Supreme Court in the case of ***Trade Kings Limited vs. Unilever & Others, SCZ Judgment No. 2 of 2000 ZLR.***
64. There is no evidence that was presented by either party regarding the use for medicated wine or who the users are. While I am at liberty to take judicial notice of general use of wine, I am not able, in absence of evidence, to comprehend or state with absolute certainty the use or purpose of "medicated wine". I have however considered the physical nature of goods involved and in particular, the Applicant's assertion that the products are



sold on the same market, an assertion which has been corroborated by the Respondent in its counter-statement as earlier highlighted.

65. Though I cannot state that the goods are entirely the same or of the same description, I am convinced that there is a certain level of similarity in these goods. In the case of **Mettenheimer V Zonquasdrif Vineyards CC (965/12) (2013) ZASCA 152 (19 November 2013)** it was held that “*where there is a high degree of similarity between two marks, a lesser degree of similarity between the relevant goods is required for a likelihood of confusion to arise.*”
66. Furthermore, in the case of **Edward Hack’s Appn. (1941) 58 RPC 91** an application for registration of “Black Magic” in class 3 in respect of “*medicated preparations in solid form for human use as laxatives*” was opposed by the proprietors of “Black Magic” in class 42 in respect of “*chocolate*”. On appeal, the opposition was successful on the basis that there was a risk of confusion in that some persons would be likely to think that the two “Black Magic” preparations were made by the same manufacturers and others to wonder if this might be the case.
67. Applying the above reasoning to the case in *casu*, I find that the Respondent’s goods are likely to cause confusion as consumers are likely to think that the Respondent’s ‘medicinal alcoholic beverages’ and the Applicant’s ‘alcoholic beverages’ are products of the same manufacturer. In other words, consumers may perceive the goods as having the same trade origin.
68. In view of the foregoing, I find that the Respondent’s trade mark registration was registered in contravention of section 17(1) of the Trade Marks Act.



CONCLUSION

69. Having found that the Respondent's trade mark registration number 1075/2021 was registered in contravention of section 17(1) of the Act, it follows that it is an entry wrongly remaining on register and qualifies for removal pursuant to section 37 (1) of the Act. I therefore order that the same be removed from the register of trade marks.

70. 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^{5th} DAY OF^{September}..... 2023



Benson Mpalo

REGISTRAR OF TRADEMARKS

