

THE TRADE MARKS ACT (CAP 401 OF THE LAWS OF ZAMBIA)

1

**IN THE MATTER OF TRADE MARK APPLICATION NO. 292/2001
SUPAKILL BY TRADE KINGS LIMITED AND OPPOSITION
THERE TO BY TWIGA CHEMICAL INDUSTRIES LIMITED.**

**DECISION OF THE REGISTRAR AFTER HEARING BOTH PARTIES
PURSUANT TO REGULATION 54 OF THE TRADE MARK
REGULATIONS OF CAP 401 OF THE LAWS OF ZAMBIA.**

This is an opposition to the Registration of a trade mark, brought under Section 16 of the Trade Mark Act Cap 401 of the Laws of Zambia and the hearing thereto convened by the Registrar under Regulation 54 of the Trade Mark Act, Cap 401 of the Laws of Zambia.

An application for the registration of the trade mark "SUPAKILL" in class 5 was lodged by Trade Kings Limited on 7th May, 2001. On 15th May, the applicant was issued with a Certificate of lodging. After due process by the Trade Mark Office, the applicant was issued with a proof acceptance and the mark was advertised in the Zambia Patents and Trade Marks Journal of 25th December, 2001, Volume XXXVIII No. 12 on Page 351.

On 18th February, 2002, the Patent Office received correspondence from M/s. Christopher Russell Cook & Co, stating that they were acting on behalf of Twiga Chemical Industries Limited who intended to oppose the registration of the mark "SUPAKILL" in class 5 as applied for by Trade Kings Limited.

On 18th March, 2002, M/s. Christopher Russell Cook and Co. in a letter to the applicant's legal representatives indicated that their client's objection to the application was based on Section 16 of the Trade Marks Act.

On 11th June, 2002, a Form TM No. 6, (**Notice of Opposition to Application for Registration of a Trade Mark**) was filed at the Patent Office and attached thereto was a statement of case in support of the opposition by Twiga Chemical Industries Limited. In the statement of case, the grounds of opposition were set out and these were:-

- (a) that there had been prior use of the trade mark "SUPAKILL" in Zambia prior to the application for trade mark No. 292/2001 by Trade Kings Limited.
- (b) that consequently, the mark had acquired a reputation in Zambia in respect of the goods on which the mark appeared.
- (c) that by virtue of the prior use of the identical mark and on goods identical to those covered by the application, the applicant's mark offended against the provisions of Section 16 of the Trade Mark Act in that the use of the mark "SUPAKILL" by the applicant would be likely to deceive or cause confusion, or otherwise would be disentitled to protection in a Court of Justice.

The Registrar was asked to refuse the registration of the mark in the circumstances.

On 21st February, 2003, an affidavit by Mr Kabir Charania, the Finance and Administrative Manager of Twiga Chemical Industries Limited, was lodged. Mr Charania stated that he had been duly authorised to represent Twiga Chemical Industries Limited in the proceedings. This affidavit was in addition to the statement of case filed earlier on behalf of Twiga Chemical Industries Limited by M/s. Christopher Russell Cook and Co. In addition to confirming what had already been stated in the statement of case, Mr Charania indicated that their products were sold internationally and through out Africa under the "Supakill" trade mark.

He further stated that a Zambian Company called Specialised Systems Limited had in 1996 imported into Zambia, a quantity of Insecticides under the trademark " SUPAKILL". This assertion was confirmed by a Mr Chandrasekera in his supplemental affidavit, filed on the same date. He confirmed that his Company had imported, in the latter part of 1996, a quantity of insecticide aerosols under the trade mark "SUPA KILL" from Twiga Chemical Industries Limited.

The quantities consisted of 4,800 cans, namely, 2,400 cans of 200 mls and 400 cans of 325mls. The total value came to US\$4,968.00. He conceded that these insecticides were sold in Zambia over a period of 2 -3 years following their importation in 1996 while bearing the trade mark "Supakill".

Mr Charania further contends that the applicant's application therefore, post dates by nearly five years the first use of his Company's trade mark in Zambia.

Moreover, the application covered goods identical to these in respect of which his company's trade mark had been used in Zambia for some three years since 1996.

He claimed that allowing the registration of the identical mark would result in deception and confusion in that members of the public would believe that the applicant's products originate from his Company or infer a connection between his company and products and the applicant's company or its products.

On 20th February, 2002, M/s. M.G. Johnson-Mwenda & Co, agents for the applicant wrote to the opponent's agent requesting for grounds of the opposition as their earlier letter had not stated this, neither the trade mark number, nor whether it was registered.

On 24th July, 2002, the applicant's agent filed a Form TM No. 7, Form of Counter-Statement. In the Counter-Statement, it was indicated that the opponents in the matter had not set out the number of their purported trade mark and the date of the trade mark journal where it appeared for advertising or whether or not it is registered in Zambia. Further, that in the absence of any proof to support its claims of use and exclusive ownership in Zambia, the applicant was not obliged to withdraw its application. It was furthermore, stated that according to law and practice, the use of an unregistered trade mark does not give the owner of that mark exclusive legal rights to that mark against the

owner of a similar mark in the same class as in current circumstances where the applicant has in fact applied to register the said trade mark. Consequently, it was contended that an alleged prior use of an identical mark in this instance cannot be said to offend against the provisions of Section 16 of the Trade Mark Act. It was therefore, submitted that the opposition was without merit and should be dismissed and the trade mark as applied for, should be allowed to proceed to registration.

On 20th May, 2003, they submitted to the Patent Office, an affidavit in support of the application, which was filed by Mr Khalid Mohammed, the Managing Director of Trade Kings Limited, the applicant in this matter. In that affidavit, he basically confirmed what had earlier been stated in the Form of Counter-Statement issued by the agent for the applicant.

He stated that the mere one off importation of the purported mark into Zambia does not mean that the opponents have acquired automatically, a reputation in the said mark in Zambia.

On the 14th June, 2007, after following laid down procedures, the Registrar held a hearing in the Patents and Companies Registration Chambers under Regulation 54 of the Act. Both parties were given an opportunity to make oral submissions over and above what had been presented in their affidavits. Basically both parties relied on the affidavits, and merely reprised the contents of the affidavits orally.

Having had sight of all the documents on file and having heard the oral submissions made by the representatives of the parties in this matter, we wish to state the following:-

- (a) that the grounds of opposition on which Twiga Chemical Industries Limited is relying, namely Section 16 of the Trademark cannot stand to support their claim. This is because they have not adduced evidence of the existence and continued use of their trade mark in Zambia. We tend to agree with the applicant's assertion that a one off importation more than five years prior to the application being lodged is not ground enough to claim reputation. Section 17 of the Act is very clear about prohibition of registration of identical and resembling trade marks. However, this Section pre-supposes the existence of a validly registered mark on the register. It is trite law and practice that use of an unregistered mark does not give the owner exclusive legal rights to that mark. Section 7 of the Trade mark Act clearly provides that there shall be no action for infringement of an unregistered mark. Consequently, our view is that Section 16 cannot be relied upon in this matter as it contains prohibition clauses pertaining to rights enjoyed by the registered proprietor of a trade mark.

Further, to assist in resolving this matter, a market survey was conducted in Lusaka among members of the community who are most likely to use the products in class 5 on which the mark is claimed to have been applied. This was meant to gauge the aspect of reputation and prior use on the Zambian market as claimed. The results revealed that the only product on the market bearing the trademark

"SUPAKILL" was a rodenticide from South Africa and not Twiga Chemical Industries Limited.

- (b) Protection of trade marks is territorial, in that protection of a trade mark will only be recognized in the country of registration. "SUPAKILL" has never been registered in Zambia and therefore, cannot claim legal protection under Zambian legislation.
- (c) It was claimed by the opponents that SUPAKILL is a well known trade mark throughout Africa. Unfortunately, the Trade Mark Act as it exists in Zambia today, does not provide for the protection of well-known unregistered trade marks and therefore, such a claim cannot be sustained. This brings us back to the issue of territoriality in the protection of Industrial Property matters.
- (d) We also looked at the legal issue of whether the application by Trade Kings Limited was done in bad faith after having had prior knowledge of the existence of "SUPAKILL" on the Zambian market. However, this was not proved by the opponents, and we are of the view that a one off importation five years prior to the application is not sufficient to prove bad faith on the part of the applicant.

Based on the facts highlighted in the first instance, our decision on the matter is that since the applicants, Trade Kings Limited applied for the Trademark "SUPAKILL" in the prescribed manner, and a notice of

acceptance issued, and there being no valid registration on the register to warrant opposition under Section 16 of the Trade mark Act, the trade mark application No. 292/2001 " SUPAKILL" in class 5 should proceed to registration.

Further, pursuant to Section 47 of the Trade mark, each party in this matter is directed to bear its own costs in relation to the matter.

In conclusion, should any party be aggrieved by our decision, they have the right to appeal to the High Court under Sections 51 and 55 of the Trade mark Act.


A.M. Banda-Bobo (Mrs)
REGISTRAR

