

**IN THE MATTER OF:**

**TRADE MARK REGISTRATION NUMBER  
1612/2018 'ZAMPIPE' IN CLASS 19 IN  
THE NAME OF ZAMBEZI POLYPAST  
LIMITED**

**IN THE MATTER OF:**

**AN APPLICATION FOR THE  
EXPUNGEMENT FROM THE REGISTER  
OF TRADE MARKS PURSUANT TO  
SECTION 37 OF THE TRADEMARKS ACT  
CHAPTER 401 OF THE LAWS OF  
ZAMBIA.**

**BETWEEN**

**ZAMPIPE LIMITED**

**APPLICANT**

**AND**

**ZAMBEZI POLYPLAST LIMITED**

**RESPONDENT**

For the Opponent : Messrs. Ilunga and Company

For the Applicant : Messrs. Charles and Charles Associates

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## **RULING**

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### **STATUTES**

Trade Marks Act, Chapter 401 of the laws of Zambia

### **INTERNATIONAL CONVENTIONS**

Paris Convention for the Protection of Industrial Property 1883

### **CASE LAW REFERRED TO:**



1. Apollinaris Company Limited's Application (1891) 8 RPC 137
2. Berlei (UK) Ltd. v Bali Brassier Co. Inc.; "BALI" T.M. (1969)
3. DH Brothers (Pty) Limited v. Olivine Industries (Pty) Limited, SCZ Judgement No. 10/2012
4. Olympic Milling V Comite International Olympique Application Nos. 123-125/2017
5. Powell's Trade Mark (1894) 11 RPC 4
6. Wildcat Energy Drink Zambia and Wildcat Energy Drink Limited V. Bigtree Beverages (2021)- Application for removal of trade mark registration No. 1581/2015 'Wildcat Label'



## INTRODUCTION

1. This is a matter in which Zampipe Limited (hereinafter called 'the Applicant') of Plot 4866, Station Road, P.O Box 11801 Heavy Industrial Area, Chingola, Zambia, filed an application for removal from the trade marks register, of trade mark registration **No. 1612/2018 'ZAMPIPE'** in class 19 in the name of Zambezi Polyplast Limited (hereinafter called 'the Respondent') of Plot No. 687 Los Angeles Road, Makeni, Lusaka, in respect of '*Non-metallic rigid pipes*'. The application for removal was filed on the 30<sup>th</sup> of December, 2022.

## GROUND FOR REMOVAL

2. In its application, the Applicant submitted that the trade mark registration No. 1612/2018 'ZAMPIPE' (hereinafter called 'the Respondent's trade mark') constitutes an entry made in the register without sufficient cause and is therefore an entry wrongly remaining on the register on account of the following reasons:

- (i) That it was registered in bad faith in order to free ride on the reputation of the Applicant.
- (ii) That it was registered in contravention of section 13 of the Trade Marks Act, Chapter 401 of the Laws of Zambia.

## STATEMENT OF CASE

3. The application was accompanied by a statement of case where the Applicant submitted that it was relying on **section 37 of the Trade Marks Act** for the application for removal of the Respondent's trade mark.
4. The Applicant explained that it is a duly registered local company incorporated in the Republic of Zambia on 26<sup>th</sup> January, 2016 and carries on its business under the name ZAMPIPE Limited. That since its incorporation, the Applicant has been carrying on its business as a supplier of steel pipes, HDPE pipes and other related products in Zambia



and its main product line being pipes commonly known as 'Zampipes' by customers.

5. The Applicant contends that in an attempt to cause confusion on the market and to take due advantage of the reputation of the Applicant, the Respondent registered a trade mark which is identical to the Applicant's company name in October, 2018. That the Respondent knew or had reason to know that the name ZAMPIPE was the Applicant's company name
6. The Applicant argues that the registration of its trade name by a third party in respect of the same goods in which the Applicant trades in has interfered with the bona fide use of the Applicant's own business name and is contrary to section 13 of the Trade Marks Act and Article 8 of the Paris Convention.
7. Further, the Applicant contends that the registration of the Applicant's trade name as a trade mark by the Respondent has further diminished the possibility of the Applicant securing a trade mark in respect of the goods it trades in.

**Relief Sought**

8. The Applicant has therefore prayed for the removal of the Respondent's trade mark from the register and costs.

**COUNTERSTATEMENT**

9. The Respondent was expected to file a counter-statement within two (2) months of receipt of the application for expungement which was served on the Respondent on the 30<sup>th</sup> of March, 2023. However, the record shows that no counterstatement was filed by the Respondent within the required timeframe.



10. On account of Regulation 83 of the Trade Marks Regulations which prohibits the Registrar from rectifying the register or remove a mark from the register merely because the registered proprietor has not filed a counterstatement, the Applicant was requested file supporting evidence and submissions for to enable the Registrar determine the matter on its merits.

### **APPLICANT'S EVIDENCE**

11. The Applicant filed its evidence on 1<sup>st</sup> September, 2023 by way of Affidavit deposed by one Mweene Hachingala, a Director and General Manager in the Applicant company.
12. Mr. Hachingala deposed that the Applicant is a company incorporated in the Republic of Zambia and carries on business as a supplier and distributor of steel pipes, HDPE pipes and other similar products and has acquired goodwill in Zambia and Democratic Republic of Congo. A copy of the company certificate of incorporation was exhibited marked "**MH 1**".
13. Mr. Hachingala stated that the main customers of the Applicant are mining and related companies based in the Copperbelt province of Zambia.
14. That sometime in 2021 while on a business trip in the Democratic Republic of Congo, Mr. Hachingala learnt that there was another Zambian company trading under the Applicant's trade name, 'Zampipe', when some of the Applicant's clients based in that country expressed displeasure at the Applicant's failure or delay to supply orders.
15. That on return from the Democratic Republic of Congo, the deponent conducted investigations which revealed that the Respondent had registered a trade mark name identical to the Applicant's business and trade name 'Zampipe'. Exhibited and marked "**MH2**" was a copy of the trade mark registration certificate.



16. Mr. Hachingala stated that the Respondent's registration of the name ZAMPIPE as a trade mark has caused confusion on the relevant market resulting in significant loss of business by the Applicant. He explained that on different occasions the Applicant has received purchase orders in the name of the Respondent but delivered to the Applicant by the customer under a mistaken belief that the order originated from the Applicant. The deponent exhibited, marked "MH3", a purchase order from Konkola Copper Mines PLC meant for the Respondent but wrongly delivered to the Applicant. Further, the deponent exhibited marked "MH4" a copy of a purchase order from Mimbula Minerals Limited sent wrongly to the Respondent instead of the Applicant.

17. The deponent stated that the confusion highlighted above has in some instances resulted in the cancellation of orders by the client thereby causing the Applicant to suffer loss of business. That having incorporated its company almost years prior to the registration of the trade mark by the Respondent, the applicant believes that the Respondent's registration was in bad faith.

### **APPLICANT'S SUBMISSIONS**

18. The Applicant filed its written submissions on the 1<sup>st</sup> of September, 2023. The Applicant submitted that the Respondent's trademark registration number 1612/2018 is eligible for removal pursuant to section 37(1) of the Trade Marks Act, firstly on the grounds **that the Respondent's trade mark was registered in bad faith in order to free ride on the reputation of the Applicant.** The Applicant contended that Respondent has engaged in dishonest use of its trade mark with the intention to deceive consumers or unfairly compete.



19. The Applicant submitted that it incorporated its company under the name ZAMPIPE Limited on 26<sup>th</sup> January, 2016 while the Respondent applied to register the same name as a trade mark 19<sup>th</sup> October, 2018. That it is reasonable to assume that the Respondent knew or had reason to believe that the Applicant was using the name ZAMPIPE as a business name. The Applicant submits that this assumption is supported by the fact that the Respondent has been using the trade mark ZAMPIPE as a business name to solicit for business from the same clientele that the Applicant conducts business with. The Applicant further contends that the registration of the ZAMPIPE trade mark by the Respondent has caused actual confusion among the public as shown by exhibit 'MH3' and 'MH4' and is therefore contrary to section 16 of the Trade Marks Act.
20. Secondly, **that the Respondent's trade mark was registered in contravention of section 13 of the Trade Marks Act.** The Applicant submitted in relation to section 13 that the registration of the name ZAMPIPE as a trade mark by the Respondent has significantly interfered with the bona fide use by the Applicant of its own name thereby depriving the Applicant of business and the opportunity to register its name as a trade mark in line with section 14(a) of the Trade Marks Act.
21. The Applicant relied on the ***Decision of the Registrar in the matter of an application for removal of trade mark registration no. 1581/2015 'Wildcat label' in class 32 in the name of Big Tree Beverages Limited by Wildcat Energy Drink Zambia and Wildcat Energy Drink Limited*** in which it was opined at paragraph 125 as follows:

*“Without doubt, section 13 is couched in mandatory terms and enjoins the Registrar of Trade marks to ensure that no registration of a trade would interfere with “bona fide use by a person of his own name or the name of his place of business” and secondly with “use by any*



*person of any bona fide description of the character or quality of his goods.”*

22. Reference was also made to another passage in the above cited case, where it explained that one of the purposes of section 13 is to give effect to article 8 of the Paris Convention which provides that “*a trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark.*”

23. In light of the foregoing, the Applicant submitted that had the Registrar of Trade Marks been aware of the existence of the business name ‘ZAMPIPE Limited’, the Respondent’s application for registration of ZAMPIPE as a trade mark would have been rejected on the basis of section 13.

24. It was submitted that the Respondent’s trade mark registration number 1612/2018 is an entry wrongly remaining on the register and must be removed in accordance with section 37(1) of the Trade Marks Act. Lastly, it was submitted that the Registrar makes an order for the removal of the Respondent’s trade mark from the register and the Respondent be further ordered to stop trading under the name ZAMPIPE or using the said name as a trade mark.

### **RESPONDENT’S SUBMISSIONS**

25. Despite its failure to file a counterstatement, the Respondent was allowed to file submissions in support of its trade mark application. The Respondent filed its written submissions on the 31<sup>st</sup> of October, 2023. In its submissions, the Respondent gave a brief background regarding the Respondent company, stating that the Respondent is a manufacturer of Poly pipes or non rigid pipes. Making reference to the Applicant’s submission that it is a supplier and distributor of HDPE Pipes among



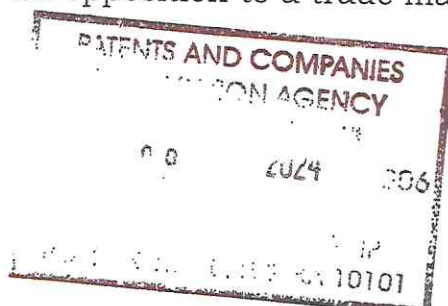


others, the Respondent claims that it has a reasonable assumption that the Applicant is a customer of the Respondent's products.

26. In support of its case, the Respondent relied firstly on section 17(1) of the Trade Marks Act, Chapter 401 of the Laws of Zambia arguing that the Applicant's trade mark is likely to be confused with the Opponent's trade mark and therefore should be prohibited from registration pursuant to section 17(1). The Respondent submitted that according to the said section one of the statutory tests to be applied to determine whether the trade mark is disqualified is whether the trade mark belonging to a different proprietor is **already on the register** of trade marks and whether the goods or products of the applicant are similar to the products or goods of the registered proprietor of similar goods.

27. The Respondent submitted that it is a manufacturer of polypipes which are similar to the HDPE pipes which the Applicant supplies and distributes. That as a manufacturer and producer of polypipes the Respondent has a vested interest in the subject goods and that it can be presumed from the foregoing that the Applicant could be a customer of the Opponent in the chain of business dealings. The Applicant contended that it would therefore be ironic for the distributor to ask for the removal of a registered proprietor who is a manufacturer of the products he supplies. The Respondent submitted that the Applicant's trade name, Zampipe, is not a registered trade mark on the register of trade marks to enjoy protection of the trade mark laws in Zambia.

28. Further, the Respondent submitted that section 17 (1) of the Trade Marks Act was considered and interpreted by the supreme Court in the seminal case of **DH Brothers (Pty) Limited v. Olivine Industries (Pty) Limited, SCZ Judgement No. 10/2012**, arguing that whereas in the said case the opponent lodged an opposition to a trade mark application without a trade



mark application of its own but based on prior use only, the Respondent in this case has its trade mark registered by the Agency. Furthermore, that the case cited is buttressed by the case of **Olympic Milling V Comite International Olympique Application Nos. 123-125/2017** which is instructive on the protection granted to registered trade marks in Zambia regardless of how well known a mark is. It was submitted that the Opponent's trade mark is a registered trade mark in Zambia and therefore enjoys absolute protection of the trade mark laws in Zambia.

29. Secondly, the Respondent relied on Section 9(1) of the Trade Marks Act. It was submitted that pursuant to section 9(1) of the Trade Marks Act, the Applicant is precluded from infringing on the rights of a registered trade mark without their permission. That the said section gives exclusive use to a proprietor of a registered trade mark in Zambia and that the Applicant's trade mark is not registered in Zambia and therefore does not enjoy exclusive use and protection as envisaged by the law in section 9.
30. The Respondent submitted that the Applicant had an opportunity to file an opposition within the two months following the Respondent's trade mark application appearing in the trade mark journal.
31. The Respondent further submitted that what is in issue in this application is whether under the law and rules in the Trade Mark Act, a proprietor of an unregistered trade mark can prevent the registration of a similar or identical registered mark by expungement from the register. The Respondent contends that the Act is clear in its preamble and the position is buttressed by section 6(3) of the Paris Convention which states that a mark duly registered in a country of the union shall be regarded as independent of marks registered in other countries of the union, including the country of origin.



32. It was submitted that the provisions of section 9 of the Trade Marks Act gives exclusive use of the proprietor of a registered trade mark and when read together with section 7 of the Trade Marks Act, it disentitles a proprietor of an unregistered trade mark from instituting proceedings to prevent or recover damages for infringement of an unregistered trade mark.
33. The Respondent argued that the Applicant has not proved any vested rights in the mark and cannot be accorded the protection it seeks.

### **DECISION**

34. I have carefully considered the issues raised in this Application as contained in all the documents filed before the registry including the Application for removal of a trademark from the register, the Applicant's evidence and submissions, as well as the Respondent's submissions.
35. This is a matter in which the Applicant filed an application for removal of trade mark No. **1612/2018 'ZAMPIPE' in class 19** from the register of trade marks. According to the Applicant's statement of case, the Application was made pursuant to section 37 of the Trade Marks Act, Chapter 401 of the Laws of Zambia (Trade Marks Act) which 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. According to the above section, an Applicant requesting for an order to have a registered mark removed from the register must establish firstly, that the Applicant is a person aggrieved and secondly, the cause of the grievance, being any of the following:

- (i) the non-insertion in or omission from the register of any entry
- (ii) any entry made in the register without sufficient cause
- (iii) the entry wrongly remaining on the register
- (iv) any error or defect in any entry in the register.

37. In line with the foregoing, I must first consider whether the Applicant herein is a person aggrieved. This requirement relates to the question of locus standi, as no application can proceed further unless this prerequisite is met. It has been established in various case law that to be qualify as ‘a person aggrieved’ an Applicant must show that it is in the same trade as the Respondent, or has a trading interest in the goods concerned and that the Applicant will suffer damage if the Respondent’s trade mark remains on the register. (See the ***Apollinaris Company Limited's Application (1891) 8 RPC 137*** (“Apollinaris case”) and ***Powell's Trade Mark (1894) 11 RPC 4*** (“Powell’s case”)

38. In the **Apollinaris case**, the court stated that ***“a man in the same trade and who desires to trade in the article in question is prima facie, an aggrieved person...”***

39. In the **Powell case**, Lord Herschell opined that:-

***“...whenever it can be shown, as here, that the applicant is in the same trade as the person who has registered the***



*trademark and wherever the trademark if remaining on the register, would, or might, limit the legal rights of the applicant, so that by reason of the existence of the entry on the register he could not lawfully do that which, but for the existence of the mark upon the register, he could lawfully do, it appears to me he has a locus standi to be heard as a person aggrieved."*

40. In the present case, the Applicant has stated in its statement of case that it carries on business under the company name ZAMPIPE Limited and its main product line are pipes commonly known as 'Zampipes'. In its affidavit evidence, the Applicant has averred that it carries on business as a supplier and distributor of steel pipes, HDPE pipes and other similar products in Zambia and Democratic Republic of Congo. I have considered the Applicant's certificate of incorporation effective 26<sup>th</sup> January, 2016 which is exhibited marked "MH1" in the said Affidavit.
41. It is not in dispute that the Respondent deals in similar goods to the Applicant, under the name 'ZAMPIPE' which has been duly registered as a trade mark by the Respondent. The Respondent in its submissions confirmed that it is a manufacturer of Poly pipes or non rigid pipes. It is therefore clear that the Applicant is in the same trade as the Respondent and therefore has a trading interest in the goods concerned.
42. Further, I have considered the Applicant's argument that the registration of its trade name by a third party in respect of the same goods in which the Applicant trades has interfered with the bona fide use of the Applicant's own business name. The Applicant has shown in its affidavit evidence that it has received purchase orders in the name of the Respondent under a mistaken belief that the order originated from the Applicant and vis versa. I have, in this regard, considered the exhibits marked "MH3" and "MH4"



being the said purchase orders from Konkola Copper Mines and Mimbula Minerals Limited respectively. I have further considered the Applicant's submission that the registration of the trade mark ZAMPIPE by the Respondent has caused actual confusion on the relevant market resulting in significant loss of business.

43. From the foregoing, I am of the considered view that the Applicant has provided evidence that tends to show that it has or is likely to suffer damage by the existence of the Respondent's trade mark on the register and am therefore satisfied that the Applicant has locus standi to be heard as a person aggrieved.

44. I will now turn to consider the reason for the Applicant's grievance, that is, the substantive grounds presented by the Applicant for the removal of the Respondent's trade mark from the register. The Applicant is seeking to remove the Respondent's trade mark from the register on the basis that it was registered in bad faith in order to free ride on the reputation of the Applicant and that it was registered in contravention of section 13 of the Trade Marks Act. In this regard, the Respondent has submitted that the Respondent's trade mark is an entry wrongly remaining on the register and must be removed in accordance with section 37(1) of the Trade Marks Act.

45. I will first consider the Applicant's first ground for removal, that the Respondent's trade mark was registered in bad faith in order to free ride on the reputation of the Applicant. The Applicant argues that it is reasonable to assume that the Respondent knew or had reasons to believe that the Applicant was using the name ZAMPIPE as a business name having incorporated its company on 26<sup>th</sup> January 2016 while the Respondent applied to register the same name as a trade mark on 19<sup>th</sup> October, 2018. The Applicant contends that the Respondent has been using the trade mark ZAMPIPE as a business name to solicit business from the same clientele



that the Applicant conducts business with. The Applicant has submitted that the registration of the ZAMPIPE trade mark by the Respondent has caused actual confusion among the public as shown by exhibit 'MH3' and 'MH4' and is therefore contrary to section 16 of the Trade Marks Act.

46. Section 16 of the Trade Marks Act which the Applicant relied on above, provides as follows:

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

47. In view of the above provision, the question I ask myself is whether the above provision could have prevented the registration of the Respondent's trade mark. In UK case of ***Berlei (UK) Ltd. v Bali Brassier Co. Inc.; “BALI” T.M. (1969) Lord Upjohn at p495*** observed as follows in relation to section 11 of UK Trade Marks Act, 1938 which is identical with our section 16 of our Trade Marks Act:

***“Section 11 and its forebears were designed not so much for the protection of other traders in the use of their marks or their reputation but for the protection of the public.”***

48. Further, **Lord Wilberforce** in the same case at pp 499-500 stated as follows about the same provision in relation to section 12 of the UK Trade Marks Act, 1938, identical to section 17(1) of Cap 401 of the Laws of Zambia.

***“Section 11 is not so limited. It extends to cases where the public is likely to be deceived or confused merely by the mark in question per se.”***



49. The above dicta by their Lordships of the House of Lords are very instructive on the import of section 16. It is clear to me that section 16 can be invoked by any person other than a proprietor of an existing trade mark. For example, where a mark is 'contrary to law' or comprises a 'scandalous design' it is logical that any person can invoke section 16 to prevent a registration or cause an already registered mark to be removed from the register.
50. In the present case the Applicant has sought to invoke 16 on the ground that the Respondent registered trade mark has actual caused actual confusion among the public as shown by exhibit 'MH3' and 'MH4'. The confusion has been attributed to the similarity between the Respondent's registered trade mark and the Applicant's registered trade name. In my view the first ground upon which this application is anchored is closely connected to the second ground and therefore before I can make my determination in ground one I will first proceed to consider ground two of this application.
51. In ground two the Applicant has argued that the Respondent's trade mark was registered in contravention of section 13 of the Trade Marks Act. Section 13 of the Trade Marks Act provides as follows:

***"No registration of a trade mark shall interfere with***

***(a) Any bonafide use by a person of his own name or the name of his place of business, or of the name of the place of business of any of his predecessors in business.***

***(b) The use by any person of any bona fide description of the character or quality of his goods, not being a description that would be likely to be taken as importing any such reference as***





***is mentioned in paragraph (b) of subsection (1) of section nine or in paragraph (b) of subsection (3) of section forty-two.”***

52. I have observed from the Applicant’s written submissions that the Applicant is relying specifically on section 13(a) arguing that the registration of the name ZAMPIPE as a trade mark by the Respondent has significantly interfered with the bona fide use by the Applicant of its own name thereby depriving the Applicant of business and the opportunity to register its name as a trade mark in line with section 14(a) of the Trade Marks Act.

53. As aptly cited by the Applicant, in the Decision of the Registrar in the matter of **Wildcat Energy Drink Zambia and Wildcat Energy Drink Limited V. Bigtree Beverages (2021)** (application for removal of trade mark registration No. 1581/2015 ‘Wildcat Label’), it was held as follows:

*“the purpose of section 13(a) is twofold, firstly, to give effect to Article 8 of the Paris Convention which provides as follows:*

*“a trade name shall be protected in all the countries of the union without the obligation of filing or registration, whether or not it forms part of a trademark.”*

*...the other objective of section 13(a) is to restrain the registration of names by third parties if the registration will result in the interference with bona fide use of a person’s own name or place of business.*

54. In the case in casu, the Applicant has submitted that had the Registrar been aware of the existence of the business name ZAMPIPE Limited, the Respondent’s application for registration of Zampipe as a trade mark would have been rejected on the basis of section 13. I agree with the Applicant’s submissions and further reiterate that the Respondent’s trade mark application for ZAMPIPE would not have escaped the provisions of section 13(a) had it be known at the time that the word ‘ZAMPIPE’ was a registered



trade name of a third party. In addition, the evidence brought by the Applicant regarding actual confusion by the unsuspecting members of the public as shown by exhibit 'MH3' and 'MH4' of the Applicant's affidavit clearly demonstrates that the registration of the Respondent's trade mark has interfered with the bona fide use of Applicant's own 'trade name. I therefore find that ground two of the application for expungement has merit and accordingly succeeds.

55. Turning back to ground one of this application, as already indicated the applicant relied on section 16 and argued that the Respondent's trade should not have been registered because it is similar to the Applicant's trade name. According to section 16 of the Trade Marks Act, it is unlawful to register as a trade mark, inter alia, 'any matter the use of which would be contrary to law'. Section 13 (a) on the other hand prohibits registration of a trade mark which interferes with a bonafide use by a person of his own name or the name of his place of business.

56. Therefore, having found that registration of the Respondent's trade mark interfered with the Applicant's use of its trade name ZAMPIPE Limited in terms of section 13, it follows that the use of the use of the Respondent's trade mark is contrary to law and therefore its registration was unlawful and contrary to section 16 of the Trade having regard to the existing trade name of the Applicant which is protected not only by section 13 of the Trade Marks Act but also by Article 8 of the Paris Convention. The offshoot of this is that ground one of the application for expungement has also succeeded.

57. Thus, both ground one and two having succeeded, I find that the Respondent's trade mark number 1612/2018 'ZAMPIPE' in class 19, is an entry wrongly remaining on the register and in accordance with section 37(1) of the Trade Marks Act I order for its expungement from the register. The effect of this is that the Respondent cannot longer use the word



'ZAMPIPE' as a trade mark or any manner suggesting as if the same is a registered trade name.

58. Leave to appeal is hereby granted if dissatisfied with this decision.

Dated the 9<sup>th</sup> day of February 2024



BENSON MPALO

**REGISTRAR OF TRADE MARKS**

