

DISTRIBUTABLE (110)

Judgment No. SC 130/02
Civil Appeal No. 113/01

ZIMBABWE GELATINE (PRIVATE) LIMITED v
CAIRNS FOODS (PRIVATE) LIMITED

SUPREME COURT OF ZIMBABWE
CHEDA JA, ZIYAMBI JA & GWAUNZA AJA
HARARE, OCTOBER 7, 2002 & MARCH 20, 2003

A P de Bourbon SC, for the appellant

J C Andersen SC, for the respondent

CHEDA JA: Cairns Foods (Private) Limited, the respondent, and Zimbabwe Gelatine (Private) Limited, the appellant, are both manufacturers of dog food. The respondent manufactures Wrights Kibbles Instant Mix, while the appellant manufactures Hwau-Hwau Carnivora Kibbles Dog Food. Both parties pack their products in plastic bags of different sizes and sell to the public through shops and supermarkets throughout the country.

The respondent applied to the High Court for an order in the following terms:

“IT IS ORDERED THAT:

1. The respondent (now the appellant) is hereby interdicted from using the trade mark Kibbles or any other mark, trading name, label or get-up likely to result in the goods and/or business of the respondent being taken to be those or that of the applicant (now the respondent) without

clearly distinguishing such goods and/or business from those or that of the applicant.

2. The respondent is interdicted and restrained from infringing the applicant's trade mark 1566/95 Kibbles or any other words which so nearly resembles 1566/95 Kibbles as to be likely to deceive or cause confusion on or in relation to any of the goods for which the mark is registered.
3. The respondent deliver up to the applicant for obliteration of the mark Kibbles, all packaging, labels, wrapping, advertising matter and other documents in the possession of the respondent bearing the trade mark Kibbles.
4. The cost of this application be borne by the respondent."

The application was granted with costs, but the counter application by the appellant to expunge the trade mark granted to Cairns Foods on 13 August 1996 as number 1566/95 failed and was dismissed. The appellant now appeals against that decision.

It is common cause that both parties make their products for dogs in the form of pellets. These products are often placed close to each other in the shops where they are displayed for sale to the public. The packaging used by the appellant has a predominant white colour on a plastic bag, with a blue picture of a dog. The plastic bag is dominated by red capital letters inside a square of blue smaller letters. On the upper half of the plastic bag are the words "Hwau-Hwau Carnivora", and below the picture of the dog the most prominent words are "Kibbles Dog Food". The word "Kibbles" appears twice on the front of the plastic bag. The reverse side is printed in blue letters only.

The respondent's packaging is also a plastic bag, mainly yellow, red and brown against a white background. The word "Kibbles" is printed in large red letters on the upper part of the bag. Below it are pictures of dogs' heads over a

square of yellow and brown. Below the square are the words “Instant Kibbles” in white. The other side of the bag is blank.

The starting point in this appeal is that the word “Kibbles” is registered as the respondent’s trade mark. It was registered as number 1566/95.

It is common cause that once a trade mark is registered it gives the registered owner of the trade mark an exclusive right to use it concerning the goods for which it is registered. (See Kerly’s *Law of Trade Marks and Trade Names* 12 ed at p 261).

The purpose of registration of a trade mark is that no other party should use the trade mark. Kerly’s *Law of Trade Marks and Trade Names* at p 12 para 2:08 says:

“The function of a trade mark is to give an indication to the purchaser ... of the trade source from which the goods come or the trade hands through which they pass on their way to the market.”

It follows that once a trade mark is registered, persons who purchase goods with the registered trade mark associate those goods with the owner of the trade mark.

For that reason, any use of the trade mark on goods other than those of the owner of the trade mark is an infringement generally referred to as “passing off”. It amounts to a misrepresentation. I quote once more from Kerly’s *Law of Trade Marks and Trade Names* at p 261:

“Section 4(1) gives to the registered proprietor of a valid mark (other than a certification trade mark) the exclusive right to the use of that mark in relation to those goods or services for which it is registered.

In addition, ‘without prejudice to the generality of’ the words in the subsection granting the exclusive right, that right is deemed to be infringed by any person who, not being the proprietor or a registered user, uses a mark identical with or nearly resembling it in the course of trade (or for services ‘in connection with the provision of any services’), in relation to any goods (or services) in respect of which it is registered and in such manner as to render the use of the mark likely to be taken either;

- (a) as being used as a trade (or service) mark or
- (b) (for trade marks) in a case in which the use is use upon goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark or to goods with which such a person as aforesaid is connected in the course of trade.”

Our own Trade Marks Act [*Chapter 26:04*] (“the Act”) provides as follows in s 6:

“6. No action for infringement of unregistered trade mark

No person shall be entitled to institute any proceedings to prevent, or to recover damages for, the infringement of an unregistered trade mark.

Provided that nothing in this Act shall affect the right of any person, at common law, to bring an action against any other person for passing off goods or services as the goods or services of another.”

This section means that a person who believes his rights have been infringed can either proceed in terms of the Act if he has a registered trade mark, or at common law in an action for passing off. In this case the respondent complained of both passing off and infringement of a registered trade mark.

As far as the trade mark in question is concerned, the appellant’s packaging displays the word “Kibbles” in large and distinct red capital letters, just as

the respondent does on its packaging. The word “Kibbles” is repeated on the reverse side of the appellant’s packaging in blue letters. It is therefore easy for a customer to mistake the appellant’s product as being either the same, or related to, or from, the same source as that of the respondent’s product.

The main elements of passing off are misrepresentation, damage and goodwill. All the three were sufficiently dealt with by the court *a quo*. Figures were given on the sales and the amount spent on advertising the respondent’s products. Evidence was led of a customer who was looking for the respondent’s product but ended up buying the appellant’s product, and then complaining to the respondent about what she had purchased. The above shows that the respondent has established a certain amount of goodwill regarding its products, and that people are confusing the appellant’s product with that of the respondent’s. The elements of both passing off and infringement of a trade mark were proved.

It was argued by the appellant that the delict of passing off is not intended to stifle competition but unfair competition based on representing one’s goods as being those of another. I agree. Competition in the manufacture of similar or almost similar dog food would be no problem in my view. What is wrong in this case is for the appellant to manufacture a similar product and then give it the same name as that of the respondent’s product. No reason was given for the appellant’s use of the name “Kibbles”. Even if the products were the same, as they are both dog food in the form of pellets, the appellant could have used a different name for its product.

It was also argued that the word “kibbles” is descriptive and no one person should have the sole right to the use of that word. In the dictionary the meaning given as “to crush into fine pieces” is not the only one. The word has several other meanings related, for example, to a drum and rope used in mining. It is not strictly descriptive of the dog food manufactured by the parties.

The argument by the appellant that the respondent’s product is more expensive compared to that of the appellant does not assist or change the position. The effect will still be the same if some customers are led to believe that there is also a cheaper type of Kibbles on the market and turn to buy those. That does not mean to them that the cheaper Kibbles are from a different manufacturer.

The appellant conceded that the term “kibbles” describes the process rather than the end product. The fact that the appellant has been using the word since October 1995 is no excuse to continue the unlawful use of a registered trade mark.

The appellant also argued that there should have been a disclaimer in the registration of the trade mark. That was rejected by the Registrar of Trade Marks.

Section 17 of the Act reads as follows:

“17 **Registration subject to a disclaimer**

- (1) Subject to subsection (2) if a trade mark –
 - (a) ...
 - (b) contains matter common to the trade or otherwise of a non-distinctive character the Registrar, in deciding whether the

trade mark shall be entered or shall remain in the Register, may require, as a condition of its being on the Register, that –

- (1) the proprietor shall disclaim any right to exclusive use of any part of the trade mark or to the exclusive use of all or any portion of such trade mark as aforesaid, to the exclusive use of which the Registrar holds him not to be entitled; or
- (2) the proprietor shall make such other disclaimer as the Registrar may consider necessary for the purposes of defining his rights under the registration.”

While dog pellets may be common to the trade of manufacturing dog food, the word “kibbles” cannot be said to be. Not only is it not common to dog food but it is also not descriptive of the end result that is marketed.

In my view, there was therefore no basis for the expungement of the trade mark “Kibbles”. The word “kibbles” does not describe the shape or contents of the dog pellets produced by the respondent.

In the result, I am satisfied that the appeal cannot succeed and it is dismissed with costs.

ZIYAMBI JA: I agree.

GWAUNZA AJA: I agree.

Dube, Manikai & Hwacha, appellant's legal practitioners

Gill, Godlonton & Gerrans, respondent's legal practitioners