

Supreme Court of Zimbabwe

SC 127/01

Philip Morris Products Inc. v Marlboro Shirt Co. (SA) Ltd

Court	:	Supreme Court
Case	:	Criminal
Date of Judgement	:	November 5, 2001
Plaintiff	:	Philip Morris Products Inc
Defendant	:	Marlboro Shirt Co. (SA) Ltd
Concept	:	Trade Mark Owner Legitimate Interest
Statue	:	Section 15(3) Trade Marks Act [Chapter 26:04]; Intellectual Property Tribunal. Act [Chapter 26:08]

Panel of Justices

McNally JA ,Cheda JA and Ziyambi JA

Case Background

Both parties applied to be registered as proprietors of the identical trade mark — a rectangular shape within which appears the word “Marlboro” under a chevron device. Philip Morris applied first on 30 January 1980 and 15 March 1982. Marlboro Shirt lodged its applications on 7 October 1983. There are two applications in each case because they applied for registration in two different classes, both relating to clothing. The Registrar of Trade Marks refused to register the trade marks because they resembled each other, and referred the question of who should succeed to the Tribunal, in terms of s 15(3) of the Trade Marks Act, then Chapter 203, now *Chapter 26:04* (“the Act”). The Tribunal decided in favour of Marlboro Shirt. Hence the appeal.

Procedural History

The Supreme Court gave a ruling on the case.

Issue

Whether Marlboro Shirt has an exclusive right to the use of the name Marlboro.

Rational

The court considered the significance of priority in time of application for registration when competing claims for registration are made by foreign companies with no reputation in the country. Zimbabwe is a first to file not a first to use jurisdiction. Registration is granted to the first to file in cases where the foreign trade mark in question has no reputation in Zimbabwe.

Keywords

Registration of trade marks with goodwill, first to file jurisdiction, passing off, delict, reputation, goodwill