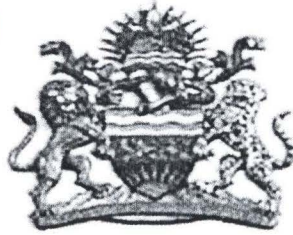


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IN THE HIGH COURT OF MALAWI
CIVIL DIVISION
PRINCIPAL REGISTRY

CIVIL CASE NO. 16 OF 2018

BETWEEN:

CANDLEX LIMITED.....CLAIMANT

-and-

ANCHOR INDUSTRIES LTD.....DEFENDANT

Coram: Hon Justice Jack N'riva, Judge

Mr Chipembere, legal representative for the claimant

Mr F Mbeta, legal representative for the defendant

Ms D Mtegha, Court Official

RULING

This is the defendant's application for me to set aside an order of interlocutory injunction granted that I granted to the claimant on 20th April 2018.

The background of the matter is that the claimant commenced this action against the defendant praying for an order restraining the defendant from using the tagline

'*kuchapa kwaphweka*'. Their argument was that the tagline is for their product *U Fresh* registered under the Trade Marks Act, Cap 49:01.

The claimant's case is that it has been using the tagline since 2004 and registered it on 15th April, 2017. During the last quarter of 2017 it came to their knowledge that the defendant was using the tagline in advertising its *Anka Washing Powder*.

In opposition to application for an order of interlocutory injunction, Mr Tariq Kidy, the Operations Manager of the claimant's company made a sworn statement. He said that sometime in October, 2017, the claimant's General Manager, Fredrick Changaya, contacted him by email in which he alleged that their (the defendant's) use of the tag line '*kuchapa kwaphweka*' on their detergent *Anka* was in breach of the claimant's trademark.

Mr Kidy further states that he requested for the proof of the trade mark registration. Mr Changaya sent him a copy of a certificate which had a tagline '*laundry made simple*' and not '*kuchapa kwaphweka*'. He avers that upon being served with the order of interlocutory injunction he noted that following their conversation with the claimant's General Manager in early October, 2017, the claimant proceeded to re-register the U-fresh trademark with the inclusion of the tagline '*kuchapa kwaphweka*'. That, according to Mr Kidy, was well after the defendant had launched its detergent powder *Anka*.

Mr Kidy further stated that he noticed that the certificate has a clear disclaimer which reads as follows;

'Registration of this trademark shall give no exclusive rights to the use of the words "LAUNDRY MADE SIMPLE" and "KUCHAPA KWAPHWEKA" except as represented'.

The deponent therefore states that in the circumstances, it is clear that the claim by the claimants is frivolous and vexatious. The defendant premises this argument on the aversion that the exclusive right of use of the tagline '*kuchapa kwaphweka*' does not exist because the Registrar of Trademarks excluded the tagline. The further argument is that the said tagline is just part of language and nothing more.

The deponent further states that, even if the said tagline was to be to the exclusive use of the claimant, it was not registered in respect of detergent powder like the

defendant's *Anka*. Therefore, the defence argues that the claimant has no right to protect, and that there is no serious question to go for trial. In that regard the defendant asks me to discharge the order of injunction that I granted.

In reply, the General Manager on behalf of the claimant's company Fredrick Changaya filed a sworn statement. In the statement he said on the conversation with Mr Kidy, he said the claimant has for a long time used the said tagline in connection with U-Fresh, way before the defendant launched its washing powder. He stated that he believed that it did not matter that the claimant lodged their application after their conversation because once the tagline was registered, the claimant started to enjoy trade mark protection over it. He further stated before registering the trade mark, the defendant did not oppose the said application.

On misapplication of the disclaimer, Mr Changaya said the defendant misunderstood the disclaimer. He said the disclaimer was in respect of the words appearing individually and not the phrases "*laundry made simple*" and "*kuchapa kwaphweka*."

Otherwise, he said it would be pointless to apply for trade mark protection if the claimant could not enjoy exclusive usage of what is registered. He said he believed the effect of registering the trademark was that claimant enjoys protection in respect of the phrases "*laundry made simple*" and "*kuchapa kwaphweka*".

Mr Changaya further stated that *U-Fresh* as a soap and *Anka* as a detergent powder fall under the same class in trademarks as they both fall under the same class according to the Patent Journal and Trade Marks Journal, Number 3 dated 12 March, 2014. He further states that U- Fresh, a soap and Anka, a detergent powder fall under "soaps" and "substances for laundry use". He said the products target the same demographic features of the market thereby posing a possibility to confuse current and potential customers.

In all this, Mr Changaya argued that the claimant had an arguable case, a triable issue for determination.

The main issue for the determination of the court in the circumstances of this case is whether or not to set aside the interlocutory order of injunction that I granted to the claimant. The issue is whether the claimant has raised a triable issue or whether the defendant has demonstrated that the claimant has no triable issue.

Mr Mbete submitted that there is no question to go for trial because the registration of U-Fresh Trademark expressly excluded kuchapa kwaphweka from any exclusive use. Besides, the defendant uses the tagline for detergent Anka which is not excluded among the products to which the said U-Fresh Trade Mark relates.

Citing *John Albert v Saonia Thomas (Nee Singh), Sukhdev Singh, Samsher Singh and Hellen Singh* M.S.C.A. Civil Appeal No. 46 of 2006 (unreported) and *American Cyanamid case* counsel argued that the court must be satisfied that the claim is not frivolous or vexatious.

The claimant argued that they began advertising its laundry soap *U Fresh* using the tagline *kuchapa kwaphweka* since 2004. On the strength of the long-time usage of the tagline, the claimant applied for registration of the tagline as a trade mark on 10th October, 2017. Then they noted that the defendant was using the kuchapa kwaphweka in advertising its washing powder, Anka. The argument of the claimant is that the registration of the tagline gives Candlex Limited exclusive use to the tagline.

Section 2 of the Trademarks Act defines a trademark. It is a mark registered and used to indicate a connection between a product and a person, a proprietor or a registered user, with the right to the mark. Sections 9 and 10 confer on a registrant of a trademark the exclusive right to the use of the trademark in relation to those goods. Any person who uses a mark identical with it, or so nearly resembling the mark, infringes the trademark rights. That is especially where a person so acts as to be likely to deceive or cause confusion in the goods in respect of which it is registered.

Therefore, there lies a cause of action for infringement where a competitor uses a registered trademark for the purposes of comparing them with his own goods of the same class-*Bismag Limited v Amblins (Chemists) Limited* [1940] Ch 66.

The claimant asserted that it registered the mark '*kuchapa kwaphweka*' on 10th October 2017 and there is also evidence showing that the claimant company begun its trading operations in Malawi as early as 2004, well before the defendant started using the same tagline.

In the circumstances of this matter, I am of the opinion, that the claimant has exhibited that it has an arguable case. Damages, in my view, may hardly redress the claimant's claim. The loss to the claimant might be difficult to express in monetary

terms. Considering all the circumstances of the case, it would be just to maintain the injunction.

In the circumstances, I dismiss the defendant's prayer to set aside the order of the interlocutory injunction. The order of the injunction will subsist. I dismiss the defendant's application with costs.

DELIVERED at Blantyre this 28th day of September, 2018

A handwritten signature in black ink, appearing to read 'J N'RIVA', written over the printed name.

JUDGE