IN THE HIGH COURT OF TANZANIA

(COMMERCIAL DIVISION)

AT DAR ES SALAAM

COMMERCIAL APPEAL NO. 2 OF 2019

(ARISING FROM THE DECISION OF THE DEPUTY REGISTRAR OF TRADE AND SERVICE MARKS DATED 02/04/2019)

BETWEEN

GODREJ CONSUMER PRODUCTS LIMITED.....APPELLANT

AND

HB WORLDWIDE LIMITED ..... RESPONDENT

Date of Last Order: 23/04/2020.

Date of Ruling: 22/05/2020.

JUDGEMENT IN APPEAL.

MAGOIGA, J.

The appellant, GODREJ CONSUMER PRODUCT LIMITED aggrieved by the decision/ruling of the Deputy Registrar of Trade and Services Marks has preferred the instant appeal armed with the following grounds of appeal, namely:-

1. The Deputy Registrar erred in fact by holding that the appellant failed to serve its statutory declaration in support of its notice of opposition to the respondent.

2. The Deputy Registrar erred in law and fact by holding that Regulation 37 of the Trade and Service Marks Regulations 2000 (herein to be referred to as the Regulations) prescribe a limitation of sixty days within which opponent may serve to the applicant its statutory declaration in support of notice of opposition.
3. The Deputy Registrar erred in holding that the provisions of Oaths and Statutory Declaration Act, [Cap 34 R.E. 2002] and of the Notary Public and Commissioners' for Oaths' Act, [Cap 12 R.E.2002] are applicable under oath which have been subscribed and made in by person residing in foreign countries, in connection with proceedings before the Registrar of Trade and Services Marks in Tanzania.
4. The Deputy Registrar erred in holding that the appellant's statutory declaration in reply ought to have complied with section 5 and 10 of the Oaths and Statutory Declaration Act, [Cap 34 R.E.] and section8 of the Notary Public and Commissioners for Oaths Act, [Cap 12 R.E 2002]
5. The Deputy Registrar erred in failing to consider and making a finding on the interpretation and meaning of Statutory Declaration as provided under section 4 of the Interpretation of Laws Act, [Cap 1

R.E. 2002]; section 10 of the Trade and Services Marks Act, [Cap 326 R.E. 2002] and Regulations 93 and 94 of the Trade and Services Marks Regulations.

6. The Deputy Registrar erred in law and fact by holding that notice of opposition is incurably defective and dismissing the said notice of opposition
7. The Deputy Registrar erred in law by failing to safeguards substantive justice instead yielding to legal technicalities.

On the totality of the above grounds, the appellant prays for the orders that the decision/ruling of the Deputy Registrar be reversed, the matter be returned with an order to be heard on merits, and in the alternative, in case this court uphold the ruling of the Deputy Registrar, the appellant be granted leave to file amended Statutory Declaration in support of its notice of opposition. As usual the appellant prays for costs of this appeal.

The facts as gathered from the record of appeal are that the respondent applied for registration of trade mark "HIT" in class 5 before the Registrar of Trade Marks. The process went on well but when same was published under the Trade and Services Mark Journal on 15/05/2018, the same was met with opposition from the appellant under section 27 of the Trade and

Services Act, [Cap 326 R.E. 2002] read together with Regulation 34 of the Trade and Service Marks Regulation, 2000.

The facts go that before hearing the main substantive opposition, three preliminary objection on points of law were raised by the respondent's learned advocate to the effect that the opponent failed to make service to the respondent the statutory declaration as per requirement of Regulation 37 of the Trade and Services Marks Regulation 2000, the opponent failed to abide by section 10 of the Oaths and Statutory Declaration Act, [Cap 34 R.E. 2002] and that the opponent failed to abide by section 8 of the Notary Public and Commissioners for Oaths Act, [Cap 12 R.E 2002] as amended by section 47 of the Written Laws (Miscellaneous Amendment (No.2) Act, 2016.

The Deputy Registrar upon hearing parties on these three preliminary objections sustained them all and dismissed the notice of opposition with costs. Being aggrieved, the appellant, triggering the instant appeal, hence this judgement in appeal.

The appellant in this appeal is enjoying the legal services of Mr. Francis Kamzora, learned advocate from Dar es Salaam legal clinic of Bowmans

Tanzania. On the other hand, the respondent is enjoying the legal services of Mr. Gullamhussain Yusuf Hassam, learned advocate from G.Y.Hassam & Company Advocates.

This appeal was argued by way of written submissions. Let me record my sincere gratitude to the learned counsel for their useful input in their written submissions, which same will assist this court to do justice to this appeal.

Mr. Kamzora in support of this appeal started by giving the history of the opposition and what the Registrar did after sustaining the objections was wrong. The learned counsel submitted that the appellant's attempts to serve the respondent were not possible for failure to locate the offices of the respondent's counsel. Moreover, the learned counsel for appellant argued that respondent was served by the Registrar through a letter dated 30th October 2018 which was accompanied with statutory declaration and notice of opposition and it was that service that enabled the respondent to file counter statement. The learned counsel cited Regulation 38 of the Trade and Services Marks Regulations which provides that the applicant shall file its Statutory Declaration after being served with opponent's Statutory Declaration and went on to cite Regulation 42 which provides that hearing can only start after each party has filed its evidence.

According to the learned counsel for appellant, if the respondent was not served, the remedy was to order that the respondent be served instead of dismissing the notice of opposition. Failure to serve notice of opposition is not fatal, contended Mr. Kamzora. The decision to dismiss the notice of opposition for lack of service is not supported by the Act nor the Regulations nor by any previous practices of the Registrar in opposition proceedings. On that note, Mr. Kamzora implored this court to find merits in this ground.

On the other hand, Mr. Hassam, learned advocate for respondent argued that the appellant failed to show at all how did they serve the said Statutory Declaration to respondent, which fact was admitted by the learned counsel for appellant, by then, Mr. Odinga for failure to serve the Statutory Declaration against Regulation 37, which demands that the appellant was to deliver to the applicant upon leaving the same with Registrar.

According to Mr. Hassam, the appellant failed even to serve via alternative means but neglected and decided not to serve the Statutory Declaration, and as such the Deputy Registrar was entitled to what he decided.

In rejoinder, Mr. Kamzora faulted the arguments of Mr. Hassam that the Regulation 37 has no alternative way of making service possible and the reason advanced were that the service was not possible for failure to locate the office of the counsel for respondent. Further submissions in rejoinder was that going through Regulations 34-40 no way hearing could proceed unless all parties are served and where no service is done, the best practice was to order service be done accordingly to pave way for hearing of the objection.

Having read the ruling and the written submissions of the learned counsel for parties' on this ground, I have noted that the bone of contention is on the interpretation of Regulations 37 of the Trade and Service Marks Regulations, 2000 and the service of the statutory declaration to the respondent. The said Regulation provides:

Regulation 37- Upon receipt of the counter statement and duplicate the Registrar shall forthwith send the duplicate to the opponent and within sixty days from the receipt of the duplicate the opponent shall leave with the Registrar such evidence by way of statutory declaration, as he may desire to adduce in support of his opposition and shall deliver to the applicant copies thereof.

The above Regulation is loud and clear that is all about the presentation of evidence in support of the opposition after receiving the counter statement from the applicant. The Regulation requires the opponent to leave with the Registrar with **such evidence by way of statutory declaration within sixty day from the date the Registrar served him with the counter statement as provided under Regulation 36.** (emphasis mine.)

The next step expected from the opponent under that Regulation is to deliver to the applicant copies thereof. To deliver to my understanding is to give the said documents physically. I have perused the contents of the counter statement and have noted that indeed no way one could deliver such documents to the applicant who did not indicate his physical address of her office to enable the appellant comply with the requirement of the regulation 37. This point was raised by the appellant before the Deputy Registrar but was not given due consideration it deserved. Mr.Gulamhussain Yusuf Hassan just indicated a postal address as P.O. Box 9393 Dar es. Salaam which was not possible to make the physical delivery as envisaged in the Regulation. This court hereby thus directs that future documents to be filed for the use of the parties in the Tribunal should contain proper

physical addresses to enable parties to deliver the necessary documents for proper service and determination of issues before the Deputy Registrar.

From the foregoing and after going through the Regulations 33, 34, 35 36 and 37 no way failure delivery to the applicant the statutory declaration though the words used is shall can cause the whole opposition be dismissed. In the case of BAHATI MAKEJA v. THE REPUBLIC, CRIMINAL APPEAL NO.118 OF 2006 (CAT) DSM(Unreported) the full bench of the Court of Appeal held that the word **"shall"** in the Criminal Procedure Act is not imperative as provided by section 53 (2) of Cap 1 but is relative and subjective to section 338 of the CPA.

Guided by the above holding of the Court of Appeal, I am fortified to observe and hold that the use of the word **"shall"** in the regulation 37 on delivering the copies to the applicant, in my considered opinion is not imperative that has to apply strictly and be a point of law that lead to the consequences of dismissing the opposition. The regulation when read in the light provision of Regulation 38 gives the consequences of failure to leave with the Registrar with statutory declaration within sixty days, **that unless the Registrar directs otherwise, the opposition is to be deemed to have been abandoned.** (Emphasis mine)

The phrase **'unless the Registrar otherwise directs'** was meant to my considered opinion to give the Registrar discretionary powers to deal with the matter before him which to my opinion were intended give proper directions or orders to make sure the parties do the necessary to have their issues resolved. In another case of DIRECTOR OF PUBLIC PROSECUTIONS v. FREEMAN MBOWE AND ESTER NICHOLAS MATIKO, CRIMINAL APPEAL NO. 420 OF 2018, the Court of Appeal increasingly insisted that the use of the word 'shall' is not always mandatory but relative and is subjective to section 388 of the CPA and observed that the phrase, **"unless the High Court otherwise directs"** means the High Court has discretion to order otherwise. Even the issue of deeming the opposition abandoned will be decided based on the conduct of the opponent which goes beyond bearing. The position of the law, therefore, clearly shows that the Registrar can give directions despite even expiry of the sixty days and have the parties serve each other to enable the matter determined. The purpose of Regulation 37 in my considered opinion is to allow the applicant to file his evidence or statutory declaration for the matter to proceed and the word used in that regulation is not mandatory but relative and is subject to Regulation 38.

There is no dispute that the Deputy Registrar in this appeal treated the word shall as mandatory requirement and uphold the preliminary objection and went on to dismiss the opposition which was for non-delivery of the evidence or statutory declaration to the respondent. This was wrong. The Deputy Registrar was to use his discretion under Regulation 38 and direct that the respondent be served and be given time to present his evidence. Since, no dispute that the evidence was left to the Registrar within sixty days, then no way he could have hold that the opposition is deemed to have abandoned in the circumstances nor dismiss the opposition in dispute.

In deed upon careful consideration of first limb of preliminary objection, I have no flicker of doubt that same did not even qualifies to be a preliminary objection on point of law to the well known principal on preliminary objection on points of law. See the case of MUKISA BISCUITS v. WEST END DISTRIBUTORS LIMITED (1969) EA 696 at page 702 in which the Court held that:

> **"A preliminary objection is in the nature of what used to be a demurrer. It raises a pure point of law which if argued on the assumption that all the facts pleaded by the other side are**

correct. It cannot be raised if any fact has to be ascertained or if what is sought in the exercise of judicial discretion.

On the above reasons, this court is of the considered opinion that the arguments by the learned counsel for respondent suffers from legal back up and are far from convincing this court to affirm the holding of the Deputy Registrar on ground number one.

In the upshot , this court find merits in ground number one and is my strong finding that the Deputy Registrar erred by holding that a mere failure to deliver the statutory declaration to the respondent was a preliminary objection worthy for consideration and upon misconception of the law wrongly dismissed the opposition. The first ground is merited, allowed and the order of the Deputy Registrar dismissing the opposition is hereby reversed.

The second ground of appeal was that the Deputy Registrar erred in law and fact by holding that Regulation 37 of the Trade and Service Marks Regulations, 2000 prescribes a limitation of sixty days within which the opponent may serve to the applicant its statutory declaration in support of the opposition. In support of this ground, Mr. Kamzora after citing

Regulation 37 argued that the sixty days stated in that Regulation refers to the time of filing of the statutory declaration and does not impose a limitation for effecting service to the applicant. On that note, the learned counsel for appellant strongly submitted that no prescribed time for service was stated in that regulation and that the Deputy Registrar misdirected himself in his interpretation of Regulation 37 to that effect.

According to Mr. Kamzora, the proper remedy was to direct that services be effected to the applicant/respondent because dismissal is not provided for nor supported under the Act or the Regulations. On that note, the learned counsel for appellant prayed that this court find merits in this ground as well.

On the other hand, the learned counsel for respondent was brief to the point that the Deputy Registrar did not err in holding that Regulation 37 of the Trade and Services Marks Regulations prescribe a limitation for service to the applicant. According to the learned counsel for respondent, the regulation is very loud and clear that the prescribe time limit to serve the statutory declaration to the applicant is 60 days.

In rejoinder, Mr. Kamzora argued that the sixty days prescribed in the Regulation applies to filing of the statutory declaration and as such no time limit for service of the statutory declaration.

Having carefully considered the rival arguments by the learned advocates for parties' and the holding of the Deputy Registrar on this point and having revisited the provisions of Regulation 37, with due respect to the Deputy Registrar, he was wrong to hold that sixty days prescribed in the Regulation were meant for service to the applicant as well. The sixty days prescribed in the regulation are time limit within which to file the evidence in support of the opposition by way of statutory declaration upon being served with the counter statement filed under regulation 36.

Without much ado, therefore, the argument by the learned counsel for respondent that the Deputy Registrar was right and did not err are far from convincing this court to hold otherwise and are not supported by law in the circumstances. This ground is merited in this appeal and is equally allowed.

This takes this court to ground number three that the Deputy Registrar erred in law in holding that the provisions of the Oaths and Statutory Declarations Act, [Cap 34 R.E.2002] and of the Notaries Public and

Commissioner's for Oaths Act, [Cap 12 R.E.2002] are applicable to Declaration under oath which has been subscribed and made in foreign countries by persons residing in foreign countries in connection with proceedings before the Deputy Registrar of Trade and Services Marks in Tanzania. In support of this ground, Mr. Kamzora started with quoting the provisions of section 10 of the Trade and Service Marks Act and pointed out that the said section does not provide that the provisions of Oaths and Statutory Declaration Act shall be applicable. According to Mr. Kamzora, the applicable law is Statutory Interpretation Act, [Cap 1 R.E 2002]. The phrase 'statutory declaration' according to Mr. Kamzora as used in section 10 is not referring to Caps 12 and 34 of the Laws of Tanzania but to Statutory Interpretation.

The learned counsel for appellant further faulting the findings of the Deputy Registrar quoted section 4 of Cap 1 which defined 'statutory declaration' and pointed out that the section applicable under of Oaths and Statutory. Declaration Act, [Cap 34 R.E.2002] only if the statutory declaration has been made in Tanzania. But where the statutory declaration is made in any Commonwealth country, it means a declaration on oath made before justice

of peace, notary public or other person having authority under any law in force to take or receive a declaration.

On that note, Mr. Kamzora strongly submitted that the Deputy Registrar was wrong to subject the said statutory declaration under Caps 12 and 34, instead of being guided by section 4 of Cap 1 and found out that the said statutory declaration was made in Kenya which is a Commonwealth country and same being made before a notary public in Nairobi was proper. Further the learned counsel pointed out that in the circumstances of this appeal no way the Notaries Public and Commissioner's for Oaths Act apply and neither is the amendment of section 8 by Act No. 2 of 2016, which introduced the requirement of the name, place and date to be indicated in the declaration applicable.

Mr. Kamzora pointed out and argued that even the cases cited by the Deputy Registrar in his decision to justify his holding such as MOTO MATIKO MABANGA v. OPHIR ENERGY PLC (supra) and DPP V FAKURU MSHENGA (supra) are distinguishable and not applicable to the situation they had before the Deputy Registrar.

On that note, Mr. Kamzora implored this court to find that the Deputy Registrar misdirected himself for overlooking to the implications of section 10 of the Trade and Services Marks read together with section 4 of the Interpretation of Laws Act, Cap 1 but centered on section 10 of Cap 34 and section 8 of Cap 12 and as such arrived at wrong conclusion. The learned counsel invited this court to find merits in this ground as well.

On the other hand, Hassam in reply submitted that the law as applied by the Deputy Registrar was correct and there is nothing to fault him. According to Mr. Hassam, section 4 of the Interpretations of Laws Act, Cap 1 R. E. 2002] just defined what is a declaration and that for the courts in Tanzania to act on the declaration same must have been made by a person who is qualified to practice in Tanzania as advocate or commissioner for oaths, otherwise, the declarations cannot be acted upon. According to Mr. Hassam, since the disputed declaration was made in Nairobi by a person who is not qualified to practice in Tanzania it could not be acted upon by. the Deputy Registrar. To buttress his point, the learned counsel for respondent cited the case of MILLICON (TANZANIA) N.V. v. JAMES ALAN RUSSEL AND 2 OTHERS, CIVIL APPLICATION NO. 44 OF 2016 CAT (DSM) (Unreported) in which it was held that:

"Reading from section 4 of Cap 12 of the Tanzania Laws much as Mr...is qualified to practice in England as Notary Public and Commissioner for Oaths has no reciprocal rights to practice automatically in that capacity in Tanzania. He has to comply first with the provisions of section 4 (1) of Cap 12 by seeking practicing certificate from the Registrar of the High Court and upon signing the Roll of Advocates and payment of requisite fees. Since there was no compliance with the section, in the context of Tanzania Law, court cannot take judicial notice of the said seal of the Notary Public and Commissioner for Oaths of Mr... as person lawfully entitled to attest the affidavit."

On that note, Mr. Hassam submitted that the declaration that was made in Nairobi before an advocate who is not qualified to practice in Tanzania is relevant and strongly submitted that the Deputy Registrar was right in his findings on this point and erred nothing. The learned counsel urged this court to uphold the findings of the Deputy Registrar and dismiss this appeal.

In rejoinder, Mr Kamzora submitted that the submissions by Mr. Hassam were not backed up by any law. On the case of MILLCON TANZANIA N. V. (supra) it was the strong reply of Mr. Kamzora that is distinguishable and

the circumstances which the case was decided are different in the circumstances we had before the Deputy Registrar. Further rejoinder by Mr. Kamzora was that the learned counsel failed to submit on how he understands section 10 of the Trade and Services Marks Act when read together with section 4 of the Interpretations of Laws Act. Mr. Kamzora urged this court guided by Regulations 93 and 94 of the Trade and Services Marks Regulations on this point.

Having careful considered the written rival submissions of the legal minds of the parties, cases cited therein, the ruling of the Deputy Registrar and after going through the relevant provisions of the law that govern the Deputy Registrar, in particular, the Trade and Services Marks Act read together with its regulations and other laws on the point, I find that the bone of contention is whether the Deputy Registrar properly directed his mind to the law on the issue before him and reached a proper conclusion. Or in other words it can be asked that, what law is applicable in the circumstances we have when it comes to statutory declaration under the Trade and Service Marks Act? In deed and with due respect to the Deputy Registrar, the proper section that was to be applicable in the situation at

hand was section 10 of the Trade and Services Marks Act, [Cap 326 R.E. 2002]. The said section provides as follows:

Section 10- Any person who is required under the provisions of this Act to take any oath or swear to an affidavit shall, in lieu thereof, make conditions of oath and affirmation conform with the provisions of a 'Statutory Declaration' as provided for in the Interpretations of the Laws Act.

The above provision of the law is clear that 'statutory Declarations' made under the Act (referring to Trade and Services Marks Act) has to be read together with the Interpretation of the Law Act and not Caps 12 and 34 as wrongly held by the Deputy Registrar in his ruling. The relevant law applicable here was the Trade and Services Marks Act and the act of the Deputy Registrar entertaining the provisions of Oaths and Statutory Declaration Act, [Cap 34 R.E.2002] and Notaries Public and Commissioner for Oaths Act [Cap 12 R.E 2002] was a serious misdirection on his part, which caused the Deputy Registrar, with due respect to plunge himself into serious legal morase.

Am fortified to say so because where there is a specific law dealing with specific matter, unless there is a lacuna, but that law has to be the parent law that governs that particular matter. In this appeal, the parliament intended that the statutory declaration before the Registrar acting under the Trade and Services Marks Act should be governed as provided under section 10 above. Section 10 of the Trade and Service Marks Act is to be read together with Interpretation of Laws Act and not caps 34 and 12 as decided by the Registrar.

Another reason am fortified to find merits in this ground is that section 4 shows that there are three kind of declarations that are recognizable under our laws; first, statutory declarations made in Tanzania under the Oaths and Statutory Declaration Act, second, declarations made in any other Commonwealth country before justice of peace, notary public or any other person having authority under any law in force to take or receive declaration, and three, declarations made in any other country before a Foreign Service Officer having authority under any written law to administer oaths or any person specified by Minister responsible for legal affairs by an Order in the Gazette.

In the foregoing, no dispute that the impugned statutory declaration was made in Kenya, which is Commonwealth country and it was made before a Notary Public and Commissioner for Oaths.

Going by the proper provision of the law the issue that he practices in Tanzania will not arise and there the case of MILLICOM (T) N.V. (supra) is as correctly argued by the learned counsel for appellant distinguishable in our appeal we have here.

More so, had the Deputy Registrar directed his minds to the provisions of Regulation 93 and 94 of the Regulations as argued by the learned counsel for appellant he would not have reached the decision he made. The questioning of the authority of the administering authority is question that needs evidence and ceases to be a preliminary objection a point of law.

Therefore, the argument by the learned counsel for respondent are devoid of any legal back up and far from convincing this court to do otherwise. The argument that the said declaration was to me made in Tanzania is devoid of legal back up in world of today. The Deputy Registrar as such applied wrong law and in the consequence arrived at wrong conclusion. This ground too has merits and is upheld as prayed.

The holding in ground number 4 above suffices to find merits in ground number 5 which was not even replied by the learned counsel for respondent. That said ground number five is merited too and same is allowed.

Next is ground number six which is couched that the Deputy Registrar erred in law and fact by holding that the notice of opposition is incurably defective and dismissed it. I have considered the arguments by the learned counsel for appellant in respect of this ground but which were not even replied by the learned counsel for respondent for reasons best known to him. This, to me, is clear admission that they are true.

This ground will not detain this court much. Based on reasons given in grounds numbers 3, 4 and 5 above, the whole decision and orders of the Deputy Registrar, I have no flicker of doubt were given in err of law. The issue of competency of the notice though decided but was based on wrong law. That said, this ground is merited and I hereby allow it.

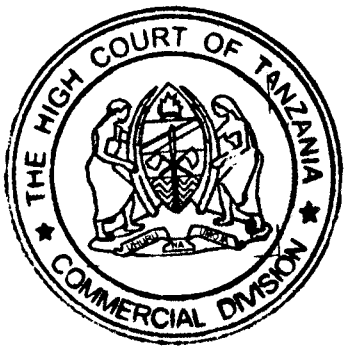
Based on my holding above in all grounds of appeal, ground number seven becomes redundant and same is not hereby discussed.

In view of the aforesaid and what I have endeavoured to discuss above, this appeal is merited. The ruling of the Deputy Registrar is hereby wholly set aside and all orders thereto are reversed as well. The deputy Registrar is hereby ordered and directed to continue with giving directives to enable parties serve each other and be able to determine the real controversy inter parties. The registration done after the ruling of the Deputy Registrar, is invalid and same is hereby declared to be of no effect.

In the vein this appeal is allowed with costs in this court and before the Tribunal below.

It is so ordered.

Dated in Dar es Salaam this 22nd day of May, 2020.



S. M. MAGOIGA

JUDGE

22/05/2020.