

**THE REPUBLIC OF UGANDA**  
**IN THE HIGH COURT OF UGANDA AT KAMPALA**  
**(COMMERCIAL DIVISION)**  
**CIVIL APPEAL NO. 6 OF 2009**

**META PRODUCTS (U) LTD:.....APPELLANT**

**VERSUS**

**CENTUAR PHARMACEUTICALS PVT LTD:.....RESPONDENT**

**BEFORE HON. LADY JUSTICE HELLEN OBURA**

**JUDGMENT**

On 18<sup>th</sup> April 2007 the appellant applied to the registrar of trademarks to expunge from the register the mark “**COLDAREST**” on the ground that it was infringing the appellant’s trademark known as “**COLDAFEX**”. The application was made under section 34 (1) of the Trademarks Act Cap 217 and rules 82, 83 and 84 of the Trademarks Rules SI 217-1 although it was wrongly cited in the application as SI 5-75.

The appellant is an agent of the registered proprietor, **UNI-MEDIA INDIA** of a trademark known as “**COLDAFEX**”. On 7<sup>th</sup> May 1997 the said trademark was entered on the register of trademarks under Trademark No. 20526 Part A, Class 5 and subsequently renewed for 14 years on the 11<sup>th</sup> August 2005.

On 9<sup>th</sup> November 2006 the respondent applied for a registration of a trademark known as “**COLDAREST**” which was granted on 13<sup>th</sup> February 2007 under registration No. 29320, Part A, Class 5.

The trademarks of the parties are in respect of all goods in class 5 which are basically tablets used for treatment of common cold, fever, influenza, headache, rhinitis and nasal congestion.

The applicant being the first to register its trademark was aggrieved by the respondent's trademark registration contending that it resembled the applicant's and was likely to deceive or cause confusion to the public who are consumers of the medical products.

In reply to the application, the respondent's legal representatives filed Trademark Form Number 26 and a statutory declaration which are stated to have been served on the appellant.

On 11<sup>th</sup> June 2007 the Assistant Registrar of Trademarks wrote to the appellant's legal representative notifying them that the respondent had filed a counter-statement and statutory declaration and reminding them to file a reply to the counter statement within 30 days.

On 16<sup>th</sup> July 2007 the respondent's advocates requested for hearing of the matter to be fixed since the appellants had not filed a counter-statement and the 30 days within which they were supposed to do so had lapsed.

On 25<sup>th</sup> March 2008 the respondent applied for the dismissal of the application on the ground that the appellant had taken no step in pursuing the application.

The application was dismissed with costs which were subsequently taxed. The appellant now appeals to this court. The decision of the registrar that is appealed from in respect of Trademark No. 29320 is set out in the letter dated 14<sup>th</sup> April 2008 addressed to counsel for the respondent, and copied to counsel for the appellant.

The appellant set forth in its Memorandum of Appeal three grounds of appeal but the first two grounds can be summarized that the Registrar of Trademarks erred in law and fact when she dismissed the appellant's application with costs without first hearing the appellant. To my

mind the outcome of this ground of appeal would also take care of the ground on taxation of the bill of costs.

Both counsel filed written submissions and at the hearing of this appeal highlighted the key points they felt needed emphasis. As regards the main ground of appeal, it was submitted for the appellant that the Assistant Registrar while exercising her discretionary power did not follow the standard procedure set out in the Trademark Rules SI 217-1 particularly rules 103,104,105 and106.

Counsel for the respondent submitted that the appellant was duly served with the counter statement and statutory declarations and upon failure by the appellant to prosecute the application, the respondent requested for its dismissal. He argued that Article 28 of the Constitution and Sections 88 and 90 of the Trademarks Act No. 17 of 2010 not only provide for a fair hearing but also a speedy one.

The decision of the Registrar of Trademarks was made in response to a letter dated 25<sup>th</sup> March 2008 by the respondent calling for the dismissal of the application. That letter was not copied to the appellant's counsel. Further to that, the respondent reiterated their request to dismiss the application in another letter dated 9<sup>th</sup> April 2008 to the Assistant Registrar of Trademarks still not copied to counsel for the appellant.

I must observe from the outset that counsel for the appellant based her submissions on the provisions of the Trademarks Act 2010 which was not yet in operation when the application was filed and subsequently dismissed. The law applicable in this case would be the repealed Trademarks Act Cap 217 under which that application was made and the Trademarks Rules SI 217-1. The right of hearing alleged to have been breached would then be that provided for under section 43 of Cap 217 and rule 103 of SI 217-1 among others. For that reason, I will consider this appeal basing on the provisions of the above law that was applicable at the time.

The applicant made the application for expunging the trademark **“COLDAREST”** from the register under section 34 (1) of Cap 217 on the ground that it was infringing the appellant's

trademark known as “**COLDAFEX**”. That section gave the court and the registrar of trademarks power to among other things order expunging of a trademark from the register for a number of reasons that are stated therein.

How the registrar exercises the discretionary or other power given to him/her under the Act was provided for under section 43 of Cap 217 which basically alluded to the right of the parties to be heard. Similarly, rule 103 of SI 217-1 provides that:

***“Before exercising adversely to any person any discretionary power given to the registrar by the Act or these Rules, the registrar shall, if so required, hear such person thereon”.***

Rule 82 of SI 217-1 provides that application to rectify or remove a trademark from the register shall be made on Form TM 25 and shall be accompanied by a statement setting out fully the nature of the applicant’s interest, the facts upon which he or she bases his or her case and the relief which he or she seeks.

Rule 83 provides for further procedure to be followed in handling the application. Rules 48 to 57 are to apply *mutatis mutandis* (with the necessary changes) to the further proceedings of the application. It should be noted that the procedure laid down in those provisions were specifically made in respect of application for registration of a trademark and opposition thereto and that is why those rules are said to apply *mutatis mutandis* in applications to rectify or remove a trademark from the register.

Rule 48 deals with the filing of the counterstatement. While in an application for registration of a trademark it is the applicant who files a counterstatement upon receipt of notice of opposition to his/her application, in an application to rectify or remove a trademark like in the appellant’s case, it is the respondent who files a counterstatement. Under rule 49 it is the duty of the registrar to immediately send the duplicate copy of the counterstatement to the opponent which in this case was the appellant.

In the instant case, the issue is whether the registrar indeed sent a copy of the counterstatement to the applicant (appellant in this case). It was argued for the appellant that no counterstatement and statutory declaration were ever served on the appellant. On the other hand it was contended that the same was served and a letter from the registrar forwarding copies of those documents to the appellant's counsel were attached as proof of service. The copy on the court record does not bear any signature or stamp to show that the same was received by counsel for the appellant.

Upon perusal of the record of appeal and documents relied upon by the respondent, I did not find any affidavit of service of the counterstatement and the statutory declaration on the appellant. Perusal of the counter statement and the statutory declaration also does not indicate that receipt of the two documents was ever acknowledged by the appellant.

Proof of service of a document is normally done by affidavit of service to which a copy of the document that bears the received stamp and signature is attached. It should be curiously noted that in this case an affidavit of service of the taxation notice was filed to prove service and yet affidavit of service of other documents were never filed.

In the case of **Edison Kanyabwera v Pastori Tumwebaze Supreme Court Civil Appeal No. 6 of 2004**; Oder JSC observed that the absence of an affidavit of service on the record led to the inevitable conclusion that the defendant was not properly served with the hearing notice before the suit was heard in his absence.

In the instant case, the absence of an affidavit of service and/or acknowledgment of receipt of the documents only leads to the logical conclusion that service was not effectively made to the appellant. The registrar should have first ascertained that service was made before taking any action that would be prejudicial to the applicant/appellant. She did not do so thereby rendering her decision to dismiss the application unfair and unjust.

In the absence of proof of service I am inclined to conclude that the appellant was not served with the counterstatement and statutory declaration and so it could not have filed evidence in accordance with the provisions of rule 50 of SI 217-1.

For the above reasons, I find that the registrar erred in law and fact in dismissing the appellant's application without first satisfying herself that the appellant was indeed served with the counter statement and the statutory declaration. The assumption, which I believe was based on the provisions of rule 50 of SI 217-1, that the applicant/appellant had abandoned the application was made in disregard of the registrar's duty to effect service on the applicant under rule 49. Proof of service needed to be confirmed first before it could be deemed that the application had been abandoned.

Due to my finding that service was not effected, ground one of the appeal must succeed. This finding also disposes of the last ground of appeal on costs whose order cannot stand alone.

I also wish to observe that the registrar even without the appellant filing a reply to the counterclaim and the statutory declaration by way of evidence could have still given a hearing notice to the parties in accordance with rule 54 (1) of SI 217-1. This is in view of rule 103 of SI 217-1 and the fact that on 16<sup>th</sup> July 2007 the respondent's advocates requested for hearing of the matter to be fixed since the appellants had not filed a counter-statement and the 30 days within which they were supposed to do so had lapsed.

In any event, the application of rules 48 to 57 of SI 217-1 to applications for rectifying or removing a trademark from the register, as I noted earlier in this ruling, are supposed to be with the necessary modifications. In the circumstances, the registrar should not have strictly followed rule 50 by insisting that the appellant should have filed its evidence as stipulated under that rule. If the registrar had been mindful of this fact she would not have deemed that the application had been abandoned and taken the course she did thereby causing injustice to the appellant.

In the result, this appeal is allowed with costs to the appellant. I order that the registrar's order dismissing the application with costs be set aside and the appellant's application be reinstated and heard by the registrar in accordance with the procedure laid down under the Trademarks Rules.

Dated this 21<sup>st</sup> day of September 2012.

Hellen Obura

**JUDGE**

Delivered in chambers at 4.00 pm in the presence of Mr. Ndyagambaki Raymond who was holding brief for Ms. Deepa Virma for the appellant and Mr. Jordan Asodio who was holding brief for Mr. Fred Gadala for the respondent.

**JUDGE**

21/09/12