THE PROBLEMATIC NATURE OF UNREGISTERED TRADEMARKS: AN INSIGHT OF ZAMBIAN LAW WITH COMPARATIVE LESSONS FROM THE SOUTH AFRICAN JURISDICTION

RODRICK CHISALA MUKUKA

MKKROD002

FACULTY OF LAW

DEPARTMENT OF COMMERCIAL LAW

SUPERVISOR: PROF. LEE-ANN TONG

University of Cape Town

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Signed: Rodrick Chisala Mukuka

Cape Town, 27th June 2023

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ABSTRACT

Unregistered trademarks are an important aspect of trademark law. Historically, the origins and use of trademarks dates to medieval times and the early developments are particularly obscure. Some legal scholars have however argued that it seems the Courts first began to protect 'marks at the behest of traders in the sixteenth century acknowledging the fact that such signs operated as an indication of source…the Courts then felt that if another trader were allowed to use the same sign, this would allow fraud to be committed on the public. Considering this development, the initial trademark protection was provided by the Common law courts. The rationale then was that if a trader had already used a mark, he deserved some protection. Overtime, it was discovered that trademark protection through common law courts was increasingly becoming inadequate thus paving way to statutory rights and the attendant perceived exclusive rights. It is now apparent that enforcing unregistered marks rights under the dictates of Common law, has for some reason proved to be problematic under modern trademark law, which include but not limited to what is perceived to be inadequate statutory provisions in the local trademark laws and somewhat lack of precise judicial interpretation of the law itself. Both Zambia and South Africa practice a dual legal system, where Common law and statutory rights are recognised and enforced simultaneously. With this Common law commonality between the two countries, it would ordinarily be expected that the legal jurisprudence emanating from the two jurisdictions with regards to unregistered trademarks should be the same but regrettably, that has not been the case.

Undoubtedly, Zambia has a dual legal system that has been modelled after English law and the current provisions under Section 12 of the Zambian Trademark Act specifically provides for the preservation of Common law rights. However, the preservation of these rights, suffered a setback in 2012 when the Zambian Supreme Court held that unregistered mark cannot be accorded protection under the Zambian Trademarks Act. Put simply, the effect of the Zambian decision in the case of DH Brothers (Pty) Limited v Olivine Industries (Pty) Limited Appeal No. 74/2010 is that unregistered trademarks cannot be accorded any form of protection under statutory law, confining

proprietors of unregistered marks to a rather old and expensive remedy that lies in the tort of 'passing off'.

*Whilst Zambia is still grappling with the issue of Common law rights and whether the Supreme Court must indeed consider reversing its decision, the approach that has been taken by South Africa; another SADC state is quite different. The South African Trademarks Act No. 194 of 1993 has similar provisions under its Section 36, which has preserved Common law rights. In line with Section 36 as read together with 10 (12) of the Act, South African Courts h*ave risen to the occasion and interpreted the said provisions correctly. It is therefore *this writer's contention that the South African's legal jurisprudence that has evolved around Sections 36 and 10 (12) of the South African Trademark Act, are dear lessons that the Zambian legal system can embrace. Unregistered trademarks and the attendant Common law rights are still a key component of Intellectual Property Law and for this reason, they must never be alienated from any legal system; Zambia inclusive.*

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CHAPTER ONE

1. INTRODUCTION

1.1 Background to the Study

This study is intended to highlight the importance of unregistered trademarks and the challenges that are occasionally associated with the interpretation and enforcement of the akin rights in the advent of modern commerce. The study will endeavour to show that it has been difficult to enforce unregistered trademark related rights in the Republic of Zambia, and for this reason, a comparative view will be taken with the South African jurisdiction. That notwithstanding, it is in the public domain and undisputed that while unregistered trademarks are coming under increased pressure of alienation and more preference is now being accorded to statutory rights, Common law rights are still valuable in our modern society and must never be delineated to sub-standard rights. By their very nature, Common law rights are historical and a product of evolution of time and their co-existence with statutory rights dates to medieval times. However, the intended co-existence of Common law and statutory rights has not been without difficulties as there have been certain instances when Common law rights have clashed with statutory rights. These intermittent clashes between the two competing rights, have sparked off a plethora of debates from imminent scholars as to who holds superior rights between a registered and unregistered trademark holder. This superiority debate has been getting louder, and whether indeed, one set of rights is superior to another, are some of the concerns that this paper will attempt to explore.

This study will therefore, examine whether a registrant of a trademark, has exclusive and unassailable rights over unregistered trademark holder? How has Zambia and South Africa dealt with this inherent legal issue of superiority of marks? Have the two nations developed a similar legal jurisprudence over unregistered trade vis a vis Common law rights worth taking a comparative view? Many different legal scholars may hold different views over this pertinent legal matter, but this paper intends to interrogate whether Zambia and South Africa, countries with similar trade practices, share a common legal position over this controversial legal issue of superiority of marks. There has not been much literature that has been written about this important topic in Zambia save for

a few commentaries. However, the legal jurisprudence that has emanated from South African jurisdiction on this topic is undaunted as a few South African eminent scholars have written about unregistered trademarks and their problematic nature. In addition to the eminent scholars, the South African Courts too, have risen to the occasion and have been consistent in their pronouncements regarding unregistered trademarks and how they interface with statutory rights.

In one of his writings, a South African eminent scholar, Wim Alberts has aptly stated that '*trademark use over trademark registration is naturally problematic and is not something that trademark attorneys should merely gloss over as rights relating to trademarks can exist under the statute or at common law. It has been further argued that for rights to be enforced under the common law context, the use of a mark must be of such an extent that a reputation has been established. The nature and scope of the use of the mark that will qualify for protection are factual questions and varies from case to case and the type of the industry concerned. Under statutory protection however, the general principal is that relief depends on a registration, which will be effective from date of application once a mark is registered and that in an ideal world, the user of a mark will also be its registered proprietor, but this is not always the case.*' [1]

Broadly speaking, the word trademark can either mean registered or unregistered trademark. Unregistered trademarks can further interpose into well-known marks. Well-known marks have their own peculiar legal rights but are not without any enforcement challenges. Zambia and South Africa practice a dual legal system that recognises both Common law and statutory rights. As rightly put by Wims, the rights that relate to trademarks exist both under a statute and or at Common law where the user may be put to a horrendous task of proving reputation. [2]

A dual legal system is the desired model in Zambia and South Africa, but its implementation has not been without difficulties, more particularly to a country like Zambia. Though the dual legal system is working well in the South African jurisdiction in

[1] W. Alberts 'John Wayne or Clint Eastwood? Trademark Use versus Trademark registration' (2005) 13 Juta Business law 160
[2] Ibid

relation to trademark law, there have been some judicial interpretations there too, that legal jurists have criticised. That notwithstanding, the deliberate intent by the South African Courts to preserve Common law rights has been clear for anyone to see.

The debate regarding the preservation of Common law rights in Zambia or the lack of it, emanated from the decision of the Zambian Superior Court where the Court therein stated that unregistered trademark cannot be used in opposition proceedings where an application of a similar mark has been made, even if prior use of that unregistered mark has been proved.

This argument was canvassed by the Zambian Supreme Court in the case of ***DH Brothers Industries (Pty) Limited v Olivine Industries (Pty) Limited***[3] where the Court declined to recognise unregistered trademarks in an opposition proceeding. This decision by the Zambian apex Court was unprecedented and flies in the teeth of Common law principles.

Following this decision by the Zambian Supreme Court where unregistered trademarks received a legal backlash, this study will endeavour to show that Common law rights/unregistered trademarks are an essential and integral part of trademark law which should never be alienated from our statute books. Historically, Common law rights have in the past, been used successfully to defend unregistered trademarks from both imitation and obliteration on a mere account that a similar mark has been registered or awaits some form of registration. Considering this background, the Zambian position regarding Common law rights/unregistered trademarks, should be a serious source of concern to progressive trademark practitioners.

Legally, it has been difficult to comprehend as to why Zambia has taken this route which no other country in the region or in the world has ever taken. However, it is

[3] Appeal No. 74/2010. DH Brothers, a south African based Company opposed a Zimbabwean Company (Olivine) application to register the trademark "Daily: in Zambia on account that it was the true proprietor of the mark and had been using the mark prior to Olive's application to register the same mark. The Registrar of Trademarks ruled against DH Brothers. On appeal, the Appellate Court, in interpreting or misinterpreting Section 16 of the Zambian Trademarks Act, as read with Sections 7 and 8 of the same Act; held inter alia that only a proprietor of a registered trademark can oppose the registration of a similar mark. This decision was strange because section 12 of the Zambian Trademark Act is like Section 36 of the South African Trademark Act.

submitted that one of the factors that could have contributed to this controversial decision being made by the Supreme Court is the underdeveloped trademark case law. The Zambia Trademark Act is the principal enabling trademark act, which was modelled after the UK Act, which invariably introduced Common law rights into Zambia. Though the current Zambian Trademark Act would require substantial amendments to suit the modern trade tenets, the Act however, appears to contain provisions that would be adequate in preserving and enforcing Common law and the akin rights.

Despite the adequacy of the provisions in the Zambian Trademark Act that one would term as 'Common law preservation provisions', the Zambian Courts however, have not risen to the occasion of defending and upholding Common law rights vis a vis unregistered trademarks as have been done by their South African counterparts.

In sum, South Africa, a SADC[4] member state like Zambia, has made progressive strides in enforcing common law rights vis-à-vis unregistered trademarks. The legal position in Zambia, however, looks bleak in the wake of the Supreme Court decision that seemed to have ignored the 'Common law preservation provisions' as contained in the Zambian Trademark Act. In view of the foregoing, this study will show that the decision of the Court in ***DH Brothers Industries (Pty) Ltd v Olivine Industries (Pty) Ltd***[5] was unwarranted, a misapplication of the law in Zambia and an affront to basic tenets of trademark law.

The decision of the Zambian Supreme Court, has invariably altered the landscape of trademark law in Zambia, thereby defying the widely accepted notion that even unregistered trademarks are entitled to some form of protection, just like registered trademarks.

On the other hand, although it is trite that Common law rights are to co-exist along with statutory rights, in there however, lies a potential legal problem of superiority of rights.

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[4] The Southern African Development Community (SADC) was established as a Development Coordinating Conference in 1980 and turned into a Development Community in 1982. It is an inter - governmental organisation that whose goal is to promote sustainable and equitable economic growth and socio - economic development through efficient productive systems, deeper co-operation, and integration among 16 Southern African member states. SADC Website available at: http://www.sadc.int/. [Accessed on 10 October 2020]

[5] Supra (note3)

Again, one of South Africa's eminent scholars, Wim Alberts brings this issue to the fore. In one of his writings, he argues that '*whether a complete mark protection is guaranteed once a mark is registered? The answer is in the negative, although trademark registration through statutory enactments was intended to accord a complete and exclusive trademark protection. Therefore, the relationship between unregistered and registered trademarks tends to be a problematic one and has the potential to bring about undesired legal results. Wim Alberts acknowledges this problem and further argues that the intersection between unregistered and registered trademarks has given different permutations that can arise in this problematic relationship between unregistered and registered trademarks…for example a scenario where one is armed with prior use and the other with prior registration – the question that begs then is; who would have to give in to the other?*'[6] It is therefore an undeniable fact that the law is uncertain on whether registration of a trademark offers exclusive protective rights to such a mark to the extent that once it is registered, such a mark will remain on the statute books indefinitely?

Against this back drop, further uncertainties in enforcing trademark rights are likely to be encountered: First, that whilst unregistered trade marks in jurisdictions like South Africa are accorded protection upon meeting conditions precedent, the Zambian approach to this is different, in that you are only guaranteed of protection of your mark, only if that mark is registered with the Zambian Patents and Companies Registration Agency.[7] Outside, the formal trademark registration system, your mark is not guaranteed protection in Zambia. Common law norms dictate that proprietors of unregistered trademarks are entitled to protection founded on prior use and reputation of a mark. It is therefore a misconception of the law and injustice for any Court to hold that you are only entitled to protection, only if that mark in question has undergone some form of statutory registration. In the advent of modern global trade and the values espoused by Common law, would any Court justify the ousting of Common law rights by purporting that

[6] Alberts op cit (note 1) 160.

[7] The Patents and Companies Registration Agency (PACRA) is a statutory body under the Zambian Ministry of Commerce Trade and Industry and is established under the Patents and Companies Registration Act No. 15 of 2010 with the principal mandate of providing business registration and Intellectual Property rights and serves as a legal depository for business registration and Intellectual Property information. PACRA Website available at: http://www.pacra.org.zm/ [Accessed on 1 November 2019]

trademark protection can only be guaranteed by statutory law? And has there been any country in the world practicing Common law that has taken the route that Zambia has? Will there be a time when the Zambian Superior Courts will revisit the decision, they made in the DH Brothers' case?

Whilst it appears that the old Common law remedy of 'passing off' is still available in Zambia, the Courts's holding that unregistered trademarks cannot be accorded protection under the Zambian Trademarks Act was a misapplication of the law and an affront to tenets of Common law doctrines, which are expected to be enforced simultaneously with statutory rights. Some legal scholars have not been happy with the decision of the Supreme Court in Zambia. Spence has argued that the decision by the Zambian Supreme Court is in breach of Zambia's obligations under Article 6 bis of the Paris Convention.[8]

On the other hand, and by way of comparison, South Africa recognises Common law rights but even in that jurisdiction, there are some inherent interfacial trademark challenges that exit between registered and unregistered marks. A debate among scholars has been getting louder about the superiority of rights and, whether the effect and import of Section 36 of the South African Trademark Act has been interpreted correctly by the South African Courts? The concern that needs to be addressed, (whether under the Zambian or South African jurisdiction) is whether statutory rights have or should have a slight protection edge over Common law rights? Would the argument that Common law rights are inferior when pitted against statutory rights be justified under modern trademark law? Certainly, answers to these questions far-fetched, but certainly, will be explored in this paper.

With short comings in the trademark law emanating from Zambia, it is however gratifying to note that the case law/literature is available from the South African jurisdiction that would suffice for this comparative study. With the knowledge gap in terms of administering statutory and Common law rights that exists between the two countries, both found in the same region and engaging in similar international trade practices, it

[8] M. Spence INTABulletin: Zambia: Well-Known But Unregistered Trademarks do not Provide Ground for Opposition. Vol. 67 (2012) 13

should be a source of concern to Zambia's trade partners that there has been a partial abolishment of Common law rights in Zambia. In the end, it is this writer's expectation that this study could, help and persuade the Zambian Supreme Court to revisit and rethink its controversial decision in the DH Brothers' case and realign the law with what is obtaining under the South Africa jurisdiction and trademark international instruments.

1.2 Brief Historical Aspects of Trademark Protection.

The historical foundations of the law of trademark, are anchored in the nature and its evolutionary stages that have taken place over time. But whether viewed from the ancient or modern perspective, the essence and nature of trademark law has always remained the same and that is, trademarks will always be indicators of sources of goods or services. It is also in public domain that before the modern trademark registration system was introduced, trademark proprietors would use their marks without any form of trademark registration and at the time, the only relief available was an action in the tort of 'passing off' which still appears to be available under the Zambian legal system.

That notwithstanding, a trademark still remains the '*badge or symbol that a producer of goods or a supplier of services uses in relation to his goods and services in order to inform the public that he is the source or provider of those goods or services, or conversely, that the goods and services have been supplied by him…the owner of the goods/services conveys that message to the public through that trade mark.'* [9]

Before the advent of industrialization era, '*there were instances when traders deployed marks of various kinds to distinguish their products, with specific English examples being the hallmarks of goldsmiths and silversmiths and the marks of Sheffield cutlers which survived as unique and distinct systems at the time. That notwithstanding, the demand for general legal protection against unfair imitation of marks and names emanated from the Industrial Revolution era that gave rise to factory production and the growth of canals and railway.'* [10] It is therefore undisputed that even in ancient times and before the advent of modern commerce and the subsequent statutory legislation of trade

[9] O Dean & A Dyer Introduction to Intellectual Property Law 1ed (2014) 79
[10] W Cornish, D Llewelyn & T Aplin Intellectual Property: Patents, Copyright, Trademarks and Allied Rights 8ed (2013) 630

mark law was embarked on, traders guarded their unregistered marks from any form of imitation, in order to protect the good will that was associated with those marks.

It has been argued further that *'from the early years of Industrialization, demands were made and acceded to in English law for legal protection against the imitation of marks and names and the courts of equity gave a lead as claimants primarily wanted injunctions…the courts of equity rose to the occasion and intervened in cases where one trader represented to the public that he was selling the goods or carrying on the business of another…though their concern then was primarily domestic and the passing off action was still somehow useful, it was however felt that for claimant to succeed in a passing off action, depended on him proving in each case that he had a trade reputation with the public'.*[11]

From the historical point of view, it is therefore evident that the English legal system accorded protection to unregistered trademark users from the early days and prevented unscrupulous businesses from engaging themselves in imitating the various unregistered trademarks. The idea of availing protection to proprietors of unregistered marks, is quite ancient, which eventually filtered through into customary Common law doctrines. Therefore, the subsequent introduction of the formal trademark registration system was not in any way meant to repeal the ancient common law rights that have existed from time immemorial. Any attempt, therefore, by a court or tribunal to suggest or insinuate in any way that protection of a mark can only be achieved by a formal registration system, is a misconception at law.

Britain heavily colonized Zambia before it attained her independence on 24th October 1964. The introduction of the western culture and values invariably influenced the Zambian legal system as we know it today. The practice of diverse Common law doctrines in other branches of the law, is a widely accepted phenomena and is not alien to the Zambian legal system. The coming of the British in the then North-western/North-eastern Rhodesian was motivated by the search for mostly minerals to support the industrialization that was taking place in Europe then and perhaps the many other

[11] Ibid at 631

conflicts that were taking place in other parts of the world. The coming of the British into Zambia invariably left an indelible mark on its judicial system where the doctrines of Common law have been infused into different branches of the national law; including trademark law. This infusion of the doctrines of Common law doctrines into the Zambian legal system, has seen Common law being administered concurrently with statutory law.

That notwithstanding, Intellectual Property Law has on the other hand developed both legislatively and judicially in the recent past because of the massive developmental trends and as result of this, the business communities are now more inclined to seek protection of their trademarks, either as registered or unregistered marks. It has therefore become more imperative than ever before, that judicial interpretations of the law, should reflect the basic norms of both common and statutory laws.

1.3 The Interface Theories of Registered and Unregistered Trademarks.

Protecting a trademark from imitation or any other form of infringement is one of the core features of the law of trademark. As earlier pointed out, trademark in this context, can either mean unregistered or registered trademark. Unregistered trademarks accrue their protection, through Common law doctrines of prior use and reputation, whilst registering a mark will give rise to statutory rights.

As rightly put by Klopper, '*a trademark can enjoy protection under either the statute or the common law, or under both and the proprietors of trademark can choose whether to register their trademark or not. If a trader chose to register his or her trademark, he or she will enjoy protection under both the statute and the common law, however, if he or he or she chooses not to register the mark, protection will be restricted to the common law.*' [12] This dual system gives rise to two distinct rights referred to as common law and statutory rights. These rights have co-existed for many years and this, has not been unusual for countries like Zambia and South Africa. That notwithstanding, in as much as the law has recognized a dual legal system of trademark protection, what is in issue, however, are the interfacial challenges sitting between unregistered and registered

[12] HB Klopper Law of Intellectual Property 1ed (2011) 75

trademarks. As pointed out earlier, this study will attempt to explore the legal maze that subsists at the intrinsic interface of registered and unregistered trademarks.

Furthermore, in as much as trademark statutory rights have generally been perceived to be unassailable when pitted against Common law rights, it is now in the legal domain that the proprietor of unregistered mark, can cause a similar mark, get expunged from the register, on account of prior and substantial use. Clearly, this can be very unsettling to the proprietor of the registered mark, as certainty of protection cannot be guaranteed even when the registration process of the mark is complete. Additionally, a person who has used his mark without registering it, can effectively use it to defeat a pending registration application of that similar mark. The process leading to the acquisition of either right is not the same and the choice to opt for either, lies with the proprietor of the mark, or the proprietor to be. For the foregoing reasons, the relationship nature of unregistered and registered trademarks remains a problematic one.

1.3.1 Unregistered Trademarks and Passing Off Actions.

The problematic relationship between unregistered and registered trademarks, yet again manifests itself in 'Passing Off' actions. This usually arises when an attempt is made to exert the superiority nature of an unregistered mark over a registered trademark. '*The law of passing off protects a trader's business reputation which forms part of the good will of the business….passing off occurs where a trader misrepresents that its goods or services are in some way associated with another trader, who has developed good will in a particular product or service line and as a result of the misrepresentation, there is a reasonable likelihood that consumers will be confused, leading to damage to the traders good will.*' [13]

The issue that this paper will attempt to examine under this heading is that the action of passing off is founded under common law but tends to undermine the validity of the mark registered under the statute. A party, on account of 'prior use' of a mark, can bring an action of passing off against the proprietor of a registered mark, if the holder of that mark can prove good will and reputation in relation to

[13] Dean op cit (n9) 166

that mark. Ironically, if such an action is brought against the proprietor of the registered mark, the registration of that mark cannot be used as a defence to the action of passing off, whilst on the other hand, in infringement proceedings brought at the instance of the registered mark holder against an unregistered holder, prior use of the unregistered mark can be used as a defence. This too, will be explored by this study.

1.3.2 Unregistered Trademarks Trading as Well-Known Marks

The other legal concern sitting at the interface of unregistered and registered trademarks, and which sits at the core of this paper, are the influences brought about by international instruments regarding well-known marks; which is another category of unregistered trademarks. Intellectual Property Law, now being at the centre modern industrialisation, cannot stand in isolation with the norms of international trade law. Article 6 bis of the Paris Convention on the Protection of Industrial Property and Article 16 of the Agreement on Trade Related Aspects of Intellectual Property have both retaliated the need to recognise and protect unregistered well-known trademarks in the conventional states where the well-known marks may not have been registered.[14] However, despite these guidelines from international instruments being in place, most member states have adopted different approaches of recognising and protecting these well-known marks. The jurisprudence that has emerged from Zambia and South Africa regarding well-known marks, is yet again of concern, sitting at the problematic interface of unregistered and registered marks. As will be seen later in this paper, Zambia has adopted a defensive registration system on well-known marks whilst South Africa's approach is different in the sense that a foreign well-known trademark cannot be expunged for non-use. Therefore, the inconsistencies exhibited by different member states in the application and interpretation of international legal

[14] Klopper op cit (n8) 107 – 110 The Paris Convention for the Protection of Industrial Property was signed in Paris in 1883 and was one of the first Intellectual Property Treaties. It is an international treaty that allows applicants to file a first application in their home country. That application is referred to as a priority document and the date it is filed is called priority date. Similarly, the Trade – Related Aspects of Intellectual Property Rights has been in force since 1995 is to date the most comprehensive multilateral agreement on Intellectual Property as it introduced global minimum standards for protecting and enforcing nearly all forms of Intellectual Property Rights.

instruments has immensely contributed to the uncertainty in the law sitting at the interface of unregistered and registered trademarks.

1.4 Problem Statement

Common law rights have existed from time immemorial and the concern the early traders had, was to prevent imitation of goods. Overtime and with the advent of industrialisation, it was realised that common law rights were not sufficient to adequately address the much-needed mark protection that traders and proprietors of marks, desperately needed. With time, trademark law underwent legislative developments which saw the birth of statutory rights. In as much as statutory rights were meant to accord better mark protection over common law rights, statutory rights were not meant or intended to oust common law rights, but to co-exist.

The intended co-existence of these two ancillary rights, gave rise to a dual legal system of trademark protection, which by its very nature, has been associated with enforcement challenges. Against this backdrop, it has been argued by several eminent scholars that the interface between unregistered and registered trademarks has proved to be problematic and has the potential to remain so at least for the near future. First, and notwithstanding the latest trends in the development of the trademark law, it is not yet clear as to who has better and superior rights, between a proprietor of a registered and an unregistered trademark. This legal uncertainty has frequently been asked by eminent scholars. The issue of superiority of trademark rights, has been keenly debated by Alberts as highlighted in one of his writings referred to earlier.[15] To illustrate this point further, assume you are a trademark attorney and you have been approached by a prospective client to give advice on whether a registering a mark would guarantee one's complete protection from infringement actions and resist any possible expungement actions that maybe instituted. Certainly, this would be a very difficult question for an attorney to answer. However, it would suffice to state that even when a mark is registered, unregistered trademarks can defeat a registered mark in an expungement application, thereby defeating the essence of statutory law.

[15] Alberts op cit (n1) 160

Furthermore, in as much as Common law and statutory rights are meant to co-exist, the Zambian apex Court took a different approach when it decided that unregistered trademarks cannot be accorded protection under the current Zambian Trademark Act, depriving the business community and potential trademark holders of the rights vested in Common law. The Court further guided that a mark holder is only guaranteed of protection, only if that mark is registered pursuant to the provisions of the Zambia Trades Mark Act.[16] The decision of the court in the case of **DH Brothers Industries (Pty) Ltd** [17] surely flies in the teeth of Common law principles and its doctrines. The problem therefore is that the decision of the Supreme Court is bound to mislead attorneys and members of the public that there is a hostile environmental in Zambia regarding trademark law, and that Zambia isn't a good business investment destination. This study, will therefore, highlight some of the potential problems that could flow from this Zambian judgment and the inadequacies obtaining under the Zambian Trademark Act.

1.5 Methodology

This study will adopt a non-empirical but critical approach. The study will cover primary sources; cases from both Zambian and South African jurisdiction, with very minor references made to English law, where Common law originates from. The study will also embrace secondary sources such as textbooks, scholarly articles, and journals from eminent jurists from Zambia and South African. Relevant internet resources will also be referred to intermittently.

1.6 Scope of the Study

This paper is a comparative study between Zambia and South Africa regarding Common and statutory law vis-à-vis the problematic interface between unregistered and registered trademarks. The study will initially focus on how Zambia, having been influenced by English law, has sharply departed from the basic tenets of Intellectual Property law as regards Common law rights vis-à-vis trademark law through judicial misapplication of the law.

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[16] Chapter 401 of the Laws of Zambia.

[17] supra note 4

The study will further integrate a comparative analytical approach with the South African jurisdiction, a state with similar values and geographical orientation, with a functional Common law/dual legal system. The study will further show how the Zambian approach as regards Common law rights is now in error and ought to be corrected. The South African approach with a similar background of Common law values, has maintained a functional dual legal system where both Common law and statutory rights co-exist, with less difficulties. This study will demonstrate that the historical evolution of Common law and the akin rights, have been a pillar of trademark law from time immemorial. For this reason, this study will demonstrate that the value and essence of Common law rights as we know them today, are not in any way lesser than they were then.

1.7 Structure of the Study

This study is made up of the following five chapters broken down as follows:

Chapter One: This chapter discusses the introductory aspects of this study, surrounding Common law rights vis a vis unregistered and registered trademarks. The Chapter will introduce the intrinsic legal challenges sitting at the interface of unregistered and registered trademarks. The Chapter briefly examines the evolution of Common law and its ancillary rights. Problem statement and methodology to be adopted in this study are equally outlined here.

Chapter Two: This Chapter will first deal with the general overview of trademark law in Zambia and later give an account of a historical evolution of the Zambian Trademark Act that was modelled after the UK Act with Common law undertones. The Chapter further explores and examines how Zambia practices a dual legal system and how this system has been underutilised in Zambia in relation to trademark law. The Chapter will further consider brief statutory aspects of trademark protection in Zambia, from both the judicial and international instruments point of view. Additionally, the chapter will consider and examine some trademark application decisions that has been made by the Registrar of Trademarks over the years, in relation to unregistered and registered trademarks. The controversial decision from the Zambian Supreme Court in the DH Brothers’ case will be at the core of this Chapter.

Chapter Three: This chapter will highlight and detail the overall trademark protection under the South African Trademark Act and the relevant provisions of the Act that have preserved Common law rights. This Chapter will further interrogate whether, the judicial pronouncements made by South African Courts, have been in line with Common law values vis a vis unregistered/registered trademark. The Chapter will then take a comparative analytical view with the Zambian legal position as regards Common law rights. In the end, this Chapter will show that there is a deficiency in the law with regards to unregistered trademarks.

Chapter Four: This Chapter will deal with the debate that eminent scholars are embroiled in, and that is whether, unregistered trademarks limit statutory rights? This part of the study will show how, in certain instances, unregistered trademarks can successfully defeat statutory marks, notwithstanding the fact that the registered marks, would have been validly registered. The Chapter will further demonstrate how uncertain the law is, when one set of trademarks rights (unregistered marks) are pitted against the other (registered marks)

Chapter Five: This Chapter will deal with conclusions and comparative aspects (from Zambia and South Africa) of trademark law as regards Common law rights vis a vis unregistered and registered trademarks. The Chapter will further provide some insight to the research questions herein and offer some recommendations.

CHAPTER TWO

2. THE GENERAL OVERVIEW OF TRADEMARK LAW IN ZAMBIA

2.1 Brief Historical Aspects of the Zambian Trademark Law

In today's modern trade and commerce, the comfort of getting exclusive rights to trademark protection primarily lies, in invoking the local legislative provisions that provide the akin trademark protective rights. The ***Zambian Trademark Act***[18] is an ancient piece of legislation that came into force in 1958 and since then, the Act has not undergone any form of major amendments; sixty-four years later. Zambia is a former British colony and, the Zambian Trademark Act was modelled after the ***UK Trademark Act 1938***. Although this study is not intended to address the pros and cons of the UK Trademark law, it is however important to trace the origins of the UK Trademark law/Common law, that subsequently gave rise to the enactment of the Zambian Trademark Act. Once these origins have been traced, it will then be easier to understand why Zambia is a dualistic state with the Zambian Trademark Act being couched in the manner it has been.

Whilst it is acknowledged that this study will not discuss the UK Trademark Act/Common law in detail, this paper will however interrogate the nature of Common law and its origins. As a starting point, '*Common law is the unwritten law of England and is solely based on the decisions of the courts as it is pretty much the study of the rules developed by the old common law courts; the courts of exchequer, court of common pleas and the court of kings' bench. Before the Noman conquest in 1066, the common law was applied in England and these rules that were developed were based on customs common throughout England in contest to local custom*.'[19] The UK Trademark Act was, therefore, no exception to these common law influences.

The origins of the UK Trademarks Act, spans from the medieval times when there was an increasing pressure to have a formal trademark registration system which subsequently led to the enactment of the fist statute called ***Trademarks Registration***

[18] Supra note 16

[19] Law Teacher 'English Common Law-Law Essays' November 2013 available at http://www.lawteacher.net/free-law-essays/constitutional-law/english-commonlawessays.php?=1, accessed on 15 November 2021

Act in 1875. [20] This resulted in the opening of the first Trademark Registry in London in 1875 - the first ever trademark registry to be opened in the world.[21]

The ***UK trademark Act 1875*** did not achieve the desired outcome, and this led to its further amendments in 1905 and for the first time, the Act gave a statutory definition of a 'trademark.[22] This later amendment primarily dealt with the stringent requirements in trademark registration but invariably gave better protection remedies, which finally paved way to the enactment of the ***UK Trademark Act 1938***[23]***.*** So, for all intents and purposes, it is beyond the scope of this work to divulge into the historical details of the ***UK Trademark Act*** and its provisions thereof, but it would suffice to state that the **UK 1938 Trademark Act** subsequently gave 'birth' to the current ***Zambian Trademark Act 1958 Chapter 401 of the Laws of Zambia.***

Just like any other British colony, Zambia practices a dual legal system which principally, recognises Common law values. These unwritten legal values are enforced alongside statutory rights, which rights are a creation of a statute. The impact of English law on the Zambian legal system should not be underestimated as it dates to the time when the British South African Company entered Zambia (Northern Rhodesia then) in search of minerals. The British South African Company Charter specifically provided in its article 14 that in the '*administration of justice by the courts set up under it, regard should be paid to African local customs and customary law, especially in circumstances where the application of English law was likely to cause injustice to the litigant.'* [24]

Zambia (formerly Northern Rhodesia) was created in 1911 out of the Barotseland Protectorate 1899 and with the administration of the ***Foreign Jurisdiction Acts of 1843 to 1890*** in the territory and the subsequent passing of the Order in Council, Zambia (Northern Rhodesia) remained a British Protectorate until its independence in October 1964. During the Protectorate days, British law was extended to Zambia (Northern Rhodesia) and therefore, it should not be a surprise that British law is still applicable to

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[20] GM Kanja Intellectual Property Law 1ed (2006) 330
[21] Ibid
[22] Ibid
[23] Ibid
[24] L. Mushota Family Law in Zambia: Cases and Materials 1ed (2005) 2

Zambia.[25] The British were very unequivocal in their quest to apply and extend British law to its Protectorates, including Northern Rhodesia then. The British Colonial Office in answering to a question regarding the extension of British law to Africa responded thus:

> *'I think it is practically a necessity to provide by a local enactment that all civil jurisdictions in the colony shall be exercised upon the principles of or in conformity with the common law of England, the rules of equity the statute law and other law in force in England on the 24th July 1874 (being the date of the colonial charter) except so far the same are shall be inapplicable to the local circumstances of the colony…'* [26]

It is therefore submitted that from the onset, the British had a clear intention to impose British statutes and Common law values in the territories they controlled, except when it was not practical to do so. The detailed historical aspects of British law and the subsequent application of the various statutes to its former colonies is not within the scope of this work and shall not be discussed in detail.

In October 1964 when Zambia attained her independence, the new government still maintained a dual legal system that was influenced by British law and Common law values and in doing so, the two major colonial statutes that were enacted were still maintained by the new post-colonial government. The first Act to pave way for British law into the new Zambia was the ***British Acts Extension Act***[27] which states in its preamble:

> '*An act to provide for the extension or application of certain British Acts to Zambia to provide for amendments to certain British acts in their application to Zambia'.*

The ***British Acts Extension Act*** was followed by another similar Act, ***the English Law (Extent of Application) Act*** [28] and its preamble states thus:

[25] Ibid
[26] Ibid
[27] Chapter 10 of the Laws of Zambia enacted 1923
[28] Chapter 11 of the Laws of Zambia enacted 1963

'An act to declare the extent to which the Law of England applies to the Republic'.

The Act further states that 'subject to the provisions of the Constitution of Zambia and to any other written law

a. the common law; and
b. the doctrine of equity, and
c. the statutes which were in force in England on the 17th August 1911 (being the commencement of the Northern Rhodesia Order in Council 1911) and
d. any statute of later date than that mentioned in paragraph (c) in force in England, now applied to the Republic, or which hereafter shall be applied thereto by any Act or otherwise' [29]

This work will not divulge into the historical details of these British influenced Acts as that is not relevant to this work, but it should suffice to state that from the two Zambian statutory enactments, it is undoubted that British law and Common law values are the bedrock of the Zambian legal system. Therefore, it was for such reasons that, the ***Zambian Trademark Act 1958 Chapter 401 of the Laws of Zambia*** was modelled after the ***UK Trademark Act 1938*** justifying the arguments that the Zambian Trademark Law is British influenced but disguised in a local piece of legislation. From the foregoing, it can therefore be safely contended that trademark protection in Zambia (be it registered or unregistered) cannot principally deviate from British canons of trademark protection. Additionally, and in a bid to ensure that British law was further entrenched in the Zambian legal system, the Courts guided that where local legislative provisions have inadvertently omitted to address any specific legal issue under Zambian law, the Courts directed that Common law of England should be applied in such cases. In the case of ***Mileta Pakou and Others v Rudnap Zambia Limited***[30] the Supreme Court held inter alia that the law that applies in Zambia in default of any statute is the Common law of England. [31] It should

[29] Ibid section 2
[30] Mileta Pakou and Others v Rudnap Zambia Limited (1998) ZR 233
[31] Ibid

therefore not be disputed that Common law, was by deliberate design, meant and intended to be part of the Zambian legal system.

2.2 Theoretical Aspects of Zambian Trademark Law.

The rationale of any trademark piece of legislation is to ensure that trademarks; whether registered or unregistered are accorded full protection from any form of infringement, whether actual or threatened. The minimum trademark protection threshold that any law can accord, lies in the substantiative provisions of that trademark act. Thus far, it has been established in this study that the Zambian Trademark Act is an ancient piece of British legislation which has not been amended in the last sixty-four years. Notwithstanding the fact that Zambia is still grappling with an aging piece of legislation, it is however correct to state that it does, at the very minimum extend some protective rights both to registered and unregistered trademarks.

In view of the foregoing, it must always be borne in mind that the justification to enact the Trademark law in Zambia (modelled after British law) spans from the enforcement difficulties that were encountered under English law then and those difficulties were primarily because of the inadequacies of the Common law. As rightly argued by Webster and Page, '*one of the difficulties [among many others] that arose was that the right of property in a trademark which was adjunct of and inseparable from the good will of the business, could only be acquired by the adoption and public use of the trademark …meaning that in any action brought by the proprietor he had to prove his title to the mark afresh by adducing evidence of his use and the reputation acquired thereby : a long and expensive process the costs of which the plaintiff were often unable to recover from the unsuccessful defendant.*' [32]

Though Common law values were very useful before the legislation era, they were however not without inadequacies. Webster and Page have further argued that '*the other justification for the need to legislate trademark rights in England was that there was no easy way for a trader wishing to use a particular mark to ascertain whether he would*

[32] GC Webster & NS Page. South African Law of Trademarks, Unlawful Competition, Company Names and Trading Styles. 3ed (1986) 3

thereby encroaching upon proprietary rights in that already vested in another by virtue of his public use of it, which made it difficult, with passing of time that reliance on common law principles alone could not accord total protection to trademark holders as they had to undergo a lengthy costly process of proving mark ownership when their mark was infringed, giving rise to the new set of rights – statutory rights.' [33]

Therefore, the extent to which the current Zambian Trademark Act accords protection to both registered, unregistered trademarks and Common law rights in general, will be examined fully, against the backdrop of English law, with a more inclined approach towards Common law rights/unregistered marks that appear to be at the brink of extinction under the Zambian legal system.

2.3 Brief Aspects of Statutory Rights Under the Zambian Trademark Act.

Trademark protection in Zambia is principally governed by the Trademarks Act Cap 401 of the Laws of Zambia, which as earlier stated in this study, is modelled after the United Kingdom Trademark Act 1938. The current Zambian Trademark Act came into force on 1st April 1958 and has twice undergone minor amendments. The Trademark Act is further supplemented by Trademark Regulations 1994 and the Merchandise Act Cap 468 of the Laws of Zambia which assists with criminal sanctions against any individual or corporation that forges any registered trademarks.

The statutory rights provided for under the Zambian Trademark Act and the akin rights will not be discussed in detail as these are not in issue in this study, but it would suffice to state first, that the preamble of the Zambian Trademark Act explicitly provides that it is an Act to make provisions relating to the registration of trademarks and for other purposes incidental thereto.[34] From the reading of the preamble of the Zambian Trademark Act, it appears that the Act has put the registration of trademarks at its core, more than anything else. On other hand and by way of comparison, the South African Act has similar provisions in its preamble save to state that the South African Trademark Act, apart from registration of trademarks, further provides for registration of certification and

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[33] Ibid

[34] Preamble of the Trademark act Cap 401 of the Laws of Zambia.

collective marks.[35] If the preambles of the two Acts are principally the same, it is to be expected that the legal jurisprudence evolving from the two Acts ought to be the same or at the very least, similar.

The Zambian Trademark Act has defined a mark to mean a mark used or proposed to be used in relation to goods for the purpose of indicating or to indicate a connection during trade between the goods and some person having the right either as proprietor or as registered user to use the mark whether with or without any indication of the identity of that person…[36]

The process of acquiring statutory rights under the Zambian Trademark Act is outlined under Parts IV and V of the Act which deals with registrability requirements, procedure, and registration duration. It is not within the scope of this work to outline in detail the trademark registration requirements and procedures under the Zambian Trademark Act but suffice to say that registration under the Act confers an exclusive (personal) property right in the trademark entitling the mark holder to remedies for infringing use.[37]

Unlike unregistered trademarks where one needs to prove 'prior use' and reputation before an action for passing off can be instituted, rights vested in a trademark by virtue of registration under Part IV and V of the Zambian Trademark Act is effective form the date of registration and action for infringement can be taken out any time thereafter. However, one of the pitfalls of the Zambian Trademark Act is that is that the Act has not specified remedies that are available against a person who has infringed a registered trademark, but it would be a reasonable assumption to make that common law remedies such as damages and injunctive reliefs would be available to any aggrieved persons. It is therefore this writer's contention that even though statutory rights are highly celebrated under the Zambian Trademark Act, common law values will forever remain useful alongside statutory rights,

[35] Preamble of the South African Trademark Act No. 194 of 1993.
[36] Trademark Act Cap 401 of the Laws of Zambian Definition Section
[37] Ibid Section 9

In conclusion, despite the Zambian Trademark Act being an archaic and ancient piece of law, it is this writer's view that the Act is sufficiently couched to cater for basic statutory rights, with minimal statutory enforcement challenges. That notwithstanding, Common law rights ought to be part of the Zambian legal system, but the challenge has been that the expected legal co-existence of statutory and Common law rights in Zambia has been problematic, and this has been exacerbated further by the incorrect interpretation of the Zambian Trademark Act by the Zambian Courts. The incorrect interpretation of the Zambian Trademark Act by the Courts has a potential to ignite a debate on whether Common law rights are on the brink of extinction in Zambia.

2.4. Salient Considerations: Unregistered Trademarks vis a vis the Zambian Trademark Act.

In this study, it has so far been established that statutory trademark rights are a creation of the Zambian Trademark Act. Statutory rights are exclusive and personal in nature to the proprietor of the mark. Additionally, this study has also shown that the justification for enacting trademark statutory law, was because of the inadequacies in the Common law values and principles that could either not accord full trademark protection or were simply costly ventures for the plaintiff to pursue. Considering this, the question that begs is; does the Zambian Trademark Act recognise Common law values and principles? If so, have these provisions been given the correct interpretation by the Zambian Courts or is there a deficiency in the law?

As earlier pointed out, Zambian practices a dual legal system. This system recognises, both statutory and Common law values. Statutory rights under the Zambian Trademark Act are contained under Part IV and V of the Act which provides for registrability, procedure and registration duration of any trademark. However, the same Act recognises Common law and states as follows:

‘

> *"Nothing in this Act shall entitle the proprietor or a registered user of a registered user of a trademark to interfere with or restrain the use by any person of a trademark identical with or nearly resembling it, in relation*

to goods, in relation to which that person or predecessor in title of his has continuously used that trademark from a date anterior:

(a) to the use of the first-mentioned trademark in relation to those goods by the proprietor or a predecessor in title of his; or

(b) to the registration of the first-mentioned trademark in respect of those goods in the name of the proprietor or a predecessor in title of his; whichever is the earlier or to object (on such use being proved) to that person being put on the register for that identical or nearly resembling trademark in respect of those goods under subsection (2) of section seventeen." [38]

Therefore, Section 12 of the Zambian Trademark Act, highlighted above, has been couched in very clear terms. The import and effect of this section is that the proprietor of a registered trademark cannot interfere with the person who has continuously used a mark prior to the registration of that mark. If then one argues that Section 12 is not intended to preserve Common law rights under the Zambian Trademark Act, what then would? Put simply, a registered trademark holder under the Zambian Act cannot extinguish the rights that have vested in the unregistered trademark and these rights accrue in principle, by virtue of continuous and bona fide use of that mark. Zambia and England have a common legal heritage and so is South Africa. Section 12 of the Zambian Trademark Act simply fortifies the legal position that Zambia has a dualistic legal system that recognises both statutory and Common law rights. The South African Trademark Act (which shall be tackled later in this study) has a similar legislative provision under its Section 36 which has preserved Common law rights in that jurisdiction.

As regards any dual legal system that recognises both statutory rights, Webster and Page have argued that 'the legislation of trademark law is originally aimed at creating a registration system that is open to the public and that records existing rights and facilitate their enforcement which in the real sense, has led to the creation of substantive rights…' [39] The protection that is accorded by a statute is not in any intended to replace

[38] Supra note 35, Section 12

[39] Webster and Page op cit (note 31) 1

those accorded by Common law but that the two sets of rights were meant to complement each other and co-exist without any form of superiority claims.

With regards to the justification of dual protection of trademarks, Webster and Page have argued that although the legislation of trademark law is originally aimed at creating a registration system to record existing rights and to facilitate their enforcement, legislative innovations have in many ways developed into a system of substantive law, creating rights which exist independently of the Common law. [40]

Therefore, it is trite that statutory and Common law rights have evolved from different sources, but that notwithstanding, both rights were intended to offer trademark protection with minimal enforcement challenges. Klopper has also added his voice to the dual protection system and has argued that '*a trademark can enjoy protection under either the statute or the Common law or under both and the proprietors of trademarks have a choice, whether to register their trademark or not and if a trader chooses to register his or her mark, he or she will enjoy protection under both the statute and the common law, however, if he or she chooses to not register the mark, protection will be restricted to the common law.'* [41] It is therefore apparent that whatever arguments one may advance that tend to downplay the relevance and importance of Common law rights, these rights cannot be ousted by legislative enactments.

In sum, Common law principles are a unique set of values and principles that are recognised by Section 12 of the Zambian Trademark Act. As earlier stated, these principles and values are wider and diverse in nature, when compared with statutory rights. It is for this reason that Common law rights cannot be alienated from the Zambian legal system. The decision of Lord Diplock in the case of ***GE Trademark***[42] is also quite instructive on this point. The House of Lords made a bold pronouncement regarding a provision that dealt with the preservation of Common law rights which should be

[40] GC Webster & NS Page. South African Law of Trademarks: Unlaw Competition, Company Names and Trading Styles 3ed (1986) 3
[41] H.B. Klopper, Law of Intellectual Property. 1st ed. p 75
[42] (1975) RPC 297

persuasive for Common law countries like South Africa and Zambia. In that landmark judgement, Lord Diplock held inter alia:

> *'In so far as unregistered common law marks are concerned, the principles to be derived from the cases are consistent with and can be applied in present day conditions and, in any judgement, result in the position at common law being parallel [equal] with the position under the statute'.* [43]

Put simply and as guided by Lord Diplock, Common law rights must run concurrently with statutory rights in Zambia.

2.5 Are Unregistered Trademarks at the Brink of Extinction in Zambia?

It has been established in this study that a trademark can either be registered or unregistered but either mark has its own distinctive rights. As earlier pointed out, it is undisputed that Section 12 of the Zambian Trademark Act has preserved Common law rights to a certain extent, but the controversial issue that has been at the core of the Zambian legal system, is whether the Zambian Courts have given Section 12 of the Zambian Trademark Act the correct interpretation. In the famous controversial case of ***DH Brothers (PTY) Limited v Olivine Industries (PTY) Limited***[44] the Registrar of Trademarks in Zambia in the proceedings below held that 'Appellant's Trademark "Daily" could not be accorded protection on account of non-registration even though the Appellant had shown sufficient prior use of the mark in Zambia.' [45]

The brief facts in this matter were that the Respondent applied to the Registrar of Trademarks to register its trademark "Daily" which the Appellant opposed on the ground that it was the true proprietor of the trademark "Daily" in Zambia and that it had been using this mark several years before the Respondent took out an application to register the same trademark. In determining this matter and considering Sections 16 and 17 of the

[43] Ibid. In arriving at a such a decision, the British Court were interpreting provisions of the British Act that preserved common law rights.
[44] DH Brothers Industries (PTY) Limited v Olivine Industries (PTY) Limited Appeal No. 74/2010
[45] Ibid

Zambia Trademark Act, the Registrar of Trademarks ruled that the trademark "Daily" could not be protected, as it was not a registered trademark in Zambia.[46]

In view of the foregoing, it seems that the Honourable Registrar of Trademarks failed to direct himself to the relevant provisions of the Zambian Trademark Act. In my view, section 16 and 17 of the Zambian Trademark Act were not the right provisions to invoke to effectively address the issues that the Registrar was requested to adjudicate on. For all intents and purposes, Section 16 of the Zambian Trademark Act does not deal with prior use of an unregistered trademark, but the said section merely prohibits the registration of a deceptive marks. Section 16 of the Act provides as follows:

> *'It shall not be lawful to register as a trademark or part of a trademark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice or would be contrary to law or morality, or any other scandalous design.'* [47]

Furthermore, Section 17 of the Act deals with prohibition of registration of identical and resembling trademarks and provides thus:

> *(1) 'Subject to the provisions of subsection (2) no trademark shall be registered in respect of any goods or description of goods that is identical within a trademark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or that so nearly resembles such a trademark as to be likely to deceive or cause confusion,*
>
> *(2) In the case of honest and [co-current] use or other special circumstances which. In the opinion of the Registrar, or the High Court in the event of an appeal from a decision of the Registrar, make it proper so to do, the Registrar or the High Court as the case maybe may permit the registration of trademarks that are identical or nearly resemble each other in respect of the same goods or description of*

[46] Ibid

[47] Section 16 of the Zambian Trademark Act Cap 401 of the laws of Zambia.

goods by more than one proprietor subject to such conditions and limitations, if any, as the Registrar or the High court may think right to impose.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of trademarks that are identical or nearly resembling each other in respect of the same goods or description of goods, the Registrar may refuse to register any of them until their rights have been determined by the Tribunal or have been settled by agreement in a manner approved by him or on an appeal by Tribunal.' [48]

Whilst the reasoning advanced by the Registrar of Trademarks may have been correct that Section 16 as read with section 17 of the Zambian Trademark Act prohibits the registration of deceptive and identical marks, the issue of 'prior use' of the mark "Daily" that the Respondent had raised in the opposition proceedings, was at variance with Section 16 and 17 of the Act that the Registrar of Trademarks seemed to have relied on. The Registrar, clearly failed to demonstrate that once 'prior use' is established in opposition proceedings, Section 16 and 17 were not the right provisions to invoke if this matter were to be prudently resolved.

That notwithstanding, the Respondents escalated their appeal to the Zambian High Court raising one ground of appeal: 'That the learned Registrar of Trademarks misdirected herself in law and in fact when she held that the trademark "Daily" cannot be accorded protection on account of non-registration notwithstanding that the Appellant had demonstrated sufficient prior use.' [49] The High Court considered the arguments both parties had advanced…and noted that the question it had to determine, was whether an unregistered Trademark which resembles or is identical to another mark which is also not registered could prevent the other mark from being registered under the law and the rules in the Zambian Trademark Act…in determining this appeal, the Court agreed with the findings of the Registrar of Trademarks and found comfort in the Preamble, Section 16

[48] Section 17 of the Zambian Trademark Act Cap 401 of the Laws of Zambia.
[49] Supra note 45.

and 17 of the Zambian Trademark Act and ruled that the said sections did not offer protection to an unregistered trademarks and that protection is only offered to registered trademarks.[50]

The decision by the High Court was equally shocking in the sense that the Court failed to look at this matter wholistically. The issue raised by the Appellant should just not have been confined to Sections 16 and 17 of the Zambian Trademark Act, but the Court ought to have looked at other relevant provisions of the Act like Section 12 that accords protection to an unregistered trademark. That notwithstanding, the Appellants were still not deterred by the decision of the High Court and escalated their dissatisfaction to the highest Court in the land; the Supreme Court of Zambia.

On appeal to the Supreme Court of Zambia, the Appellant raised two grounds of appeal:

1. *'That the High Court Judge erred in law and fact when she held that Section 16 of the [Zambian} Trademark Act as read together with other provisions of the Trademark Act, does not accord protection to an unregistered trademark and*
2. *That the Court in the proceedings below misdirected itself in law and fact when it held that the Appellant's mark "Daily" could not accorded protection on account of non-registration even though the Appellant had shown sufficient prior use of the trademark in Zambia.'* [51]

The Zambian Supreme Court had the occasion to hear the substantive arguments from both parties which in principle, were the same issues that were raised in the Court below. The Appellant invited the Court not to only look at Sections 16 and 17 of the Act but also to other relevant provisions of the Act as clearly stated in their first ground of appeal. The Respondents stuck to their arguments that the fact that the mark "Daily" was not registered in Zambia, it could not be accorded protection. It is this writer's view that the arguments that were advanced by both parties on appeal were very simple and the failure by the Registrar of Trademarks, the High Court of Zambia and finally by the Supreme

[50] Ibid
[51] Ibid

Court of Zambia to invoke the right provisions in adjudicating over this matter, distorted Intellectual Property Law in Zambia. In addition to Sections 16 and 17 of the Zambian Trademark Act that were extensively referred to by the Court, the Zambian Supreme Court also appeared to have relied heavily on the provisions of Sections 7 of the Act which simply prevents any person from instituting any proceedings to recover damages for the infringement of an unregistered trademark.[52] The reasoning picked from Section 7 by the Zambian Supreme Court was that as long as a mark is not registered, infringement proceedings cannot be instituted. This narrative by the Court may be true to a certain extent but it is submitted that the core issue in the DH Brothers' case was not just about infringement but the Court ought to have dealt with a spectrum of issues which included but not limited to, prior use vis a vis unregistered trademark.

To the amazement of many legal scholars in Zambia and the Central and Southern African region, the Zambian Supreme Court considered the arguments and authorities submitted by both parties and adjudged as follows:

> *'We have anxiously addressed our minds to the combined arguments for and against the appeal and the authorities cited. We have also considered the arguments and submissions made in the Court below. We have also examined the judgement appealed against. The question of determination in this appeal, in this Court remains as that which was the Appellate High Court judge. The facts of the case are very simple and straight forward…the question for determination in this appeal which as observed was also the question before the Appellate High Court judge, is: "Whether an unregistered trademark, which resembles or is identical to another mark, which is also unregistered can prevent the other unregistered from being registered under the law and the rules in the Trademark Act".* [53]

In deciding this appeal, the Court claimed to have considered the relevant provisions of the Zambian Trademark Act and ruled against the Appellant and stated:

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[52] Section 7 of the Zambian Trademark Act, Cap 401 of the Laws of Zambia.

[53] Supra (note 45)

> *'We also totally agree with the arguments on the submissions on behalf of the Respondent and with the Appellate High Court judge in her analysis of the relevant provisions of the Trademark Act, Cap 401 of the Laws of Zambia in so far as they relate to the undisputed facts in this appeal. It is also our conclusion that both the Registrar of Trademarks and the Appellate High Court Judge were on firm ground when they held that the Appellate' trademark "Daily" could not be accorded protection on account of non-registration, though the Appellate had shown sufficient prior use of the trademark in Zambia...appeal therefore fails and dismissed with costs.* [54]

The decision by the Zambian Supreme Court was shocking to the legal fraternity in Zambia and could be to other jurists in other jurisdictions. The effect of this decision is that the historical legal value of prior use of a mark that is embedded in Common law values and principles is no longer recognised in Zambia. Clearly, the reasoning by the Honourable Justices of the Zambian Supreme Court was flawed. Earlier in this study, the effect and import of Section 12 of the Zambian Trade Act was discussed. The provisions of Section 12 clearly states that an unregistered trademark can effectively be used to oppose the pending registration application of another mark if sufficient prior use of an opposing mark has been established. Whilst it is admitted that the Respondent did not specifically plead Section 12 of the Zambian Trademarks Act, it is submitted that this was a matter that boarded on basic cannons of Intellectual Property Law and the Honourable Court therefore, ought to have exercised great care and diligence when this matter came before it on appeal. Furthermore, under their grounds of appeal and heads of arguments, the Appellant appeared to have referred the Court to the relevant provisions of the Act and for this reason, it would be prudent to argue that Section 12 of the Zambian Trademark Act had been pleaded before the Supreme Court. However, even if it were to be assumed that Section 12 was not specifically pleaded, the Supreme Court being the highest Court in the land ought to have considered this matter wholistically, moved itself and uphold the intents and purposes of Section 12 of the Zambian Trademark Act. It is

[54] Ibid

therefore submitted that the application of Section 7 by the Court when adjudicating over this matter, was a misapplication of the law by the Honourable Court.

The decision by the Zambian Supreme Court, has attracted a few commentaries from jurists in Zambia and South Africa who have expressed dismay at the Court's reasoning. An Intellectual Property Law academician at the University of Zambia has argued that the action that was brought by the Appellant in the DH Brothers' case was defective in the sense that the action was improperly before Court…she further argued that where commencement of a civil matter is prescribed by law, commencement of proceedings must conform to the prescribed law. [55]

The above views canvassed by the learned academician are to a certain extent correct in that once a mode of commencement is prescribed by law, such prescription must not be deviated from, regardless of the relief that is being sought. However, what the learned academician advertently or inadvertently omitted to comment on is why the Supreme Court of Zambia failed to consider, the provisions of Section 12 of the Zambian Trade Act that has clearly established the principle that once sufficient prior use is proved, an unregistered trademark can successfully oppose a pending registration application of another similar unregistered mark. The Supreme Court of Zambia clearly could not see the essence of Section of 12 of the Zambian Trademark, which has a counterpart under section 36 of the South African Trademark Act. It is therefore submitted that the issue which the parties in the DH Brothers case was asking the Supreme Court to resolve, bordered on Section 12 of the Zambian Trademark Act (which preserves Common law rights) and not anything else.

Following this controversial decision by the Zambian Supreme Court, legal jurists in the Southern African region, have in no uncertain terms, criticised this decision. Werksmans Attorneys have argued that the Zambian Supreme Court decision may have serious consequences for business [more particularly in the Central and Southern African region]; until this decision was made by the Court, it has always been possible to rely on

[55] CN Tembo 'DH Brothers Industries (PTY) Limited v Olivine Industries (PTY) Limited Appeal No. 74/2010 SAIPAR Case Review' May 2018, available at http://www.scholarship.law.cornell.edu/scr/vol1/iss2/11 accesses on 20 November 2021

an unregistered trademark in trademark opposition proceedings as provided by common law by demonstrating repute and good will.[56] The learned attorneys have further contended that as far as the Zambian Supreme Court decision is concerned a 'business will no longer be able to rely on Common law rights in trademark opposition proceedings making it possible for a competitor to register an identical mark or confusingly similar trademark to an unregistered trademark in Zambia...and against this backdrop of this decision from Zambia and the rapid economic change in many African countries, unregistered trademarks have never been more vulnerable than now'[57]

Other jurists in the region have added their voice in criticising the decision of the Zambian Supreme Court. Mac Spence and others of Spoor and Fisher have argued that 'proprietors and [trademark] practitioners must note the simple result that Zambia, unlike most Commonwealth and other jurisdictions is now a "first to file" country where an unregistered trademark, however well-known cannot afford grounds for opposition, it may however be useful still in an action for passing off…these decisions have evidently placed Zambia in breach of its obligations under Article 6 bis of the Paris Convention.[58]

The jurisprudence that has emanated from the Zambian highest Court is regrettable, as it is clearly an affront to basic principles of Common law and Intellectual Property Law as a whole. Prior use vis a vis unregistered trademark, is a dead concept in Zambia. Regardless of how well-known your mark may be, unregistered trademarks are bound to be infringed in Zambia and the proprietor of the well-known mark will have no recourse, at least not to the Zambian Courts of law. Put simply, according to this decision that has been passed by the Zambian Supreme Court, the proprietor of a mark, is only guaranteed of protection of that mark in Zambia, if that mark undergoes trademark registration formalities and anything short of that the mark is exposed to possible infringement. The defence of prior use is no longer available as a tool in opposition proceedings in Zambia, the question then that begs is; what is the legal status of

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[56] D Wegierski 'Werksmans Attorneys Africa Legal Brief Series' June 2012 available at http://www.werksmans.com accessed on 30th August 2023.

[57] Ibid

[58] M Spence, T Marietta 'Zambia: Well-Known but unregistered Trademarks do not provide grounds for Opposition' INTABulletin 15 July 2012 available at http://www.inta.org/INTABullentin/Pages/ZAMBIAWell-KnownButUnregisteredTrademarksDoNotProvideGroundsforOpposition.asps accessed on 20 April 2022

unregistered trademarks in Zambia, have they lost their efficacy? Is registration of a mark the only option available to access full protection of a mark? The answers to these questions could be haze.

First, whilst it is submitted that the Zambian Trademark Act is sufficiently couched with regards to the concept of prior use vis a vis unregistered trademarks, the interpretation of the Zambian Trademark Act by the Zambian Supreme, was clearly a misapplication of the law. Whilst it is conceded that there has not been any decided case by superior Courts in Zambia regarding Section 12 of the Act prior to the DH Brothers' case, it is however in public domain that Zambia is a Common law country and the case ought to have been decided against the backdrop of Common law doctrines. Secondly, there have been some further arguments on whether, with the decision of the DH Brothers, other common law rights such as unlawful competition and passing off actions have also suffered the same fate in Zambia. The answer to this concern appears to be in the negative. The Zambian Supreme Court had the occasion to consider the issue of passing off in another matter of ***Trade Kings Limited and Unilever Plc.*** [59] which was unrelated to the DH Brothers' case. In that Trade Kings' case, the Zambian Supreme Court held inter alia:

> *'…[Counsel for the Respondent] submitted quite correctly in some respects that issues of infringement and passing off are independent regardless whether there is registration of the trademark or not, the submission has merit in so far as an action for passing off of goods maybe concerned and to which we will return later…the action off is another matter altogether [Counsel for the Respondent] 's submissions that it is independent has support in the authorities and is unaffected by the Trademarks Act…as Christopher Wadlow puts it in his book, "The Law of passing off 2nd ed at page 2, Passing Off and the law of registered trademarks deal with some overlapping factual situations' but deal with them in different ways and from different standpoints….passing off emphatically does not confer monopoly*

[59] Trade kings Limited v Unilever Plc Cheesebrough Ponds (Zambia) Limited, Lever Brothers (Private) Limited and Lever Brothers (Zambia) Limited. SCZ Judgement No. 2 of 2000.

> *rights in any names, marks, get up or other indicia, nor does it recognise them as property in their own rights."* [60]

In deciding this appeal, the Supreme Court of Zambia confirmed that passing off actions are not legislative driven, and such are not affected by the Zambian Trademarks Act. Implicitly, the Court upheld Common law values regarding passing off actions. Put simply, unlike prior use vis a vis unregistered trademarks, the relief of passing off is still very much alive under the Zambian legal system.

2.6 Unregistered, but Well-Known Marks: Another Zambian Dilemma.

Foreign well-known marks are a species of unregistered marks that tend to be problematic in the sense that different jurisdictions deal with these marks differently. The well-known difficulty associated with foreign well-known marks starts with their utilisation and reputation as they tend to transcend national borders and tend to seek protection in other states other than those states that initially registered them. Lately, it has been argued that in jurisdictions like South Africa, foreign well-known marks have been given preferential treatment over local well-known marks and invariably, this has resulted into an unbalanced protection between local well-known marks and foreign well-known marks.

The Zambian approach regarding well-known marks, is quite different from the approach that South Africa has taken. In Zambia, prior defensive registration of a well-known mark is required before the proprietor of that mark can exert any rights. It therefore follows that enforcing unregistered, foreign well-known marks in Zambia, is another problematic trademark maze that Zambia is grappling with. It is undisputed that in as much as protection of a mark can easily be secured by undertaking registration formalities on the statute books, the territorial concept that is associated with a registered mark entails that the mark that is so registered can only be protected from infringement in the territory in which that mark was initially registered and not in any other state. Therefore, it has been argued that foreign well-known marks circumvent the national trademark laws, as these marks do not ordinarily require registration on the local statutes. Whether

[60] Ibid

arguments for the concept of territoriality can still stand in modern day era with rapid global economic growth, is beyond the scope of this study. However, it would suffice to state that some scholars have argued that there has been relatively very little action either at international level or regional levels on the protection of unregistered [well-known] marks apart from the two most important provisions found in the Paris Convention and The Agreement on Trade Related Aspects of Intellectual Property[61], which will be discussed in detail later in this paper.

In as far as this study is concerned, it has been established so far that unregistered trademarks are not protected in Zambia unless they are registered. This is the current law as espoused by the Zambian Supreme Court in the DH Brothers case. If this is the legal position then, the next legal question for consideration in this study, is whether, unregistered but well-known marks have suffered the same fate in Zambia?

In modern day trade, unregistered trademarks can sometimes be well-known marks, depending on whether these marks have met certain conditionalities set out in the requisite international instruments. Even though getting a mark registered could be the most preferred way of securing trademark protection, Zambia has made some positive strides by acceding to some international instruments. These international instruments have introduced an aspect of 'unregistered trademark law' into Zambia which is at variance with the provisions of the Zambian Trademark Act.

The source of protection for well-known marks emanates from international instruments. Zambia has been a member of the Paris Convention for the Protection of Industrial Property[62] since 1965; a member of the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) since 1995 and a member of the Madrid Agreement and Protocol on the international registration of trademarks since 2001. The nature of

[61] L Bently & B Sherman Intellectual Property Law 4ed (2014) 821

[62] Zambia acceded to this ancient treaty many years after its enactment. The Paris Convention was revised in Rome in 1886, in Madrid in 1890 and 1891. Subsequent revisions were undertaken in Brussels in 1897 and 1900 with the Washington amendment following in 1911. Other revisions done were in the Hague in 1925 followed by London in 1958 and Stockholm in 1967 with the latest amendment being on 28th September 1979.

protection that these international instruments offer, is adequate for Zambia to enforce and protect unregistered, but well-known marks in its territory.[63]

The Paris Convention for the Protection of Industrial Protection is one of the first and arguably the most important of the various multilateral treaties protecting intellectual property which was subsequently followed by TRIPS. The lack of provisions defining minimum substantiative rights and mandating enforcement, paved way to the enactment of the Agreement on Trade Related Aspects of Intellectual Property, a multilateral treaty that seeks to observe these shortcomings.[64]

The rationale behind the protection of well-known marks is that a well-known mark has already acquired good will from the originating state, allowing the registration or the use of a confusingly similar mark constitutes an act of unfair competition and misleads the public.[65] There has not been any known case that has been decided in Zambia to illustrate the concept of well-known marks but the comparative lessons from the South African jurisdiction, in particular the Mc Donald case will be called in aid later in this study.

Article 6bis of the Paris Convention and Articles 16(2) and (3) of the TRIPS Agreement provide for well-known marks or famous marks. Article 6 bis is one of the notable provisions of the Paris Convention which provides to refuse or to cancel the registration; and to prohibit the use of a trademark which constitutes a reproduction, an imitation or translation, liable to create confusion of a mark considered by the competent authority of the country of registration or use to be well-known in that country as being already the mark of a person entitled to the benefits of the convention and used for identical or similar goods.[66] Similarly, TRIPS on the other hand requires that members comply with Article 6 bis of the Paris Convention by reinforcing the protection provisions

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[63] Adams and Adams Attorneys available at https://www.adamsadams.com/index.php/africa/africaniplaw/zambia/ accessed on 2nd January 2016

[64] SM Reiss 'Commentary on the Paris Convention for the Protection of Industrial Property' available at http//www.lex-ip.com/Paris.pdf accessed on 30th June 2016

[65] Ibid

[66] Article 6 bis of the Paris Convention for the Protection of Industrial Property

of well-known marks and further extending the protection to the goods or services which are not similar to the mark that is registered…[67]

The import of Articles 6bis of the Paris Convention is that protection is available for unregistered trademarks that qualify to be famous or well-known though the Convention itself has not defined what a well-known mark is. However, it can be argued that put together, the two instruments, which is the Paris Convention and TRIPS seem to provide some basic legal framework for the protection of unregistered, but well-known mark.

In Zambia however, well-known marks are dealt with differently in that there must be prior registration of a well-known mark before any of the akin rights can be enforced. The requirement to have a well-known mark defensively registered seems to conflict with the provisions of the Paris Convention and the TRIPS Agreement and invariably, this adds up to the many enforcement challenges that are faced in Zambia in the use of unregistered trademarks. The law in Zambia is that for well-known marks to be protected, they must be defensively registered. The Zambian Trademark Act provides for defensive registration of well-known marks. Section 32 of the Act deals with defensive registration of well-known marks and provides as follows:

> *(1) 'Where a trademark is registered in Part A of the register has become well-known as respects any goods in respect of which it has been used than the use thereof in relation to other goods would be likely to be taken as indicating a connection in the course of trade between those goods and a person entitled to use the trademark in relation to the first mentioned goods, then, notwithstanding that the proprietor registered in respect of the first mentioned goods does not use or propose to use that trademark in relation to those other goods and notwithstanding anything in section thirty-one, the trademark may on the application in writing in the prescribed manner of the proprietor*

[67] Article 16 (2) and (3) of the Agreement pn Trade Related Aspects of Intellectual Property Rights.

registered in respect of the first mentioned goods, be registered in Part D of the register in his name in respect of those goods as a defensive mark and, while so registered, shall not be liable to be taken off the register in respect of those goods under section thirty-one

(2) The registered proprietor of a trademark may apply for the registration thereof in respect of any goods as a defensive trademark, notwithstanding that it is already registered in his name in those goods. Otherwise, then as a defensive trademark or may apply for the registration thereof in respect of any goods otherwise than as a defensive trademark notwithstanding that it is already registered in his name in respect of those goods as a defensive trademark, in lieu of each case of the existing registration.

(3) A trademark registered as a defensive trademark and that trademark as otherwise registered in the name of the same proprietor shall, notwithstanding that the respective registrations are in respect of different goods, be deemed to be, and shall be registered as, associated trademarks.

(4) On an application by any person aggrieved to the High court or, at the option of the applicant and subject to the provisions of section sixty-four, to the Registrar, the registration of a trademark as a defensive trademark may be cancelled on the ground that the requirements of subsection (1) are no longer satisfied in respect of any goods in respect of which the trademark is registered in the name of the same proprietor otherwise than as a defensive trademark or maybe cancelled as respects any goods in respect of which it is registered as a defensive trademark on the ground that there is no longer any likelihood that the use of the trademark in relation to those goods would be taken as giving the indication mentioned in subsection (1).

(5) The Registrar may at any time cancel the registration as a defensive trademark of which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trademark.

(6) Except as otherwise expressly provided in this section, the provisions of this Act shall apply in respect of the registration of trademarks as defensive trademarks and of trademarks so registered as they apply in other cases, and the provisions of section nine relating to the infringement of a trademark registered in Part A of the register shall apply to the infringement of any defensive trademark registered in terms of this section if that registration is valid' .[68]

Well-known trademarks are another form of unregistered trademarks that have posed enforcement challenges in Zambia. Despite the various international instruments that accord full protection to well-known marks across their respective territorial borders, Zambia has however taken a different approach and insists on defensive registration of well-known marks. It is in public domain that well-known marks are increasingly becoming very popular due to the dictates of modern trade. However, enforcing rights akin to well-known marks is inherently difficult as the Paris Convention and TRIPs have not provided for mandatory requirements for the recognition and enforcement of well-known marks. Even though well-known marks are an important aspect of intellectual property law, enforcing this branch of trademark law, has equally been problematic in Zambia. It is therefore submitted that the defensive registration of well-known marks is a counterproductive concept and files in the teeth of international trade.

[68] Section 32 of the Zambian Trademark Act Chapter 401 of the Laws of Zambia provides for defensive registration of well-known trademarks, which is a counter part of Section 27 of the UK trademark Act 1938. With the advent of International Treaties like the Paris Convention and TRIPS, the UK has amended its Act over time, but the substantive provisions of the Zambian Trademark Act Chapter 401 of the Laws of Zambia have remained unchanged for over 65 years now. Surely a piece of legislation that was enacted many years ago cannot sustain or support the modern demands of trademark law, Zambia will continuously face this predicament until a new law is put in place.

Zambia has for the last 65 years consistently peddled this unproductive path of defensive registration of well-known marks. In a matter of trademark application No. 292/2001[69] decided by the Registrar involving an attempt to protect a well-known mark 'Supakill' the Registrar affirmed the provisions Section 32 of the Zambian Trademark Act that deals with defensive registration of well-known marks. In the 'SUPAKILL' case, an application was made by Trade Kings (the Applicant) under Section 16 of the Zambian Trademark Act for the registration of the trademark 'SUPAKILL' The application was subsequently opposed on the following three grounds:

> *(I) 'That there had been prior use of the trademark 'SUPAKILL' in Zambia prior to the application for trademark registration mark No. 292/2001 by Trade Kings,*
>
> *(II) That consequently the mark had acquired a reputation in Zambia in respect of the goods on which the mark appeared,*
>
> *(III) That by virtue of prior use of the identical mark and on goods identical to those covered by the application, the applicant's mark offended against the provisions of Section 16 of the Trademark Act in that the use of the mark 'SUPAKILL' by the applicant would be likely to deceive or cause confusion, or otherwise would be disentitled to protection in a court of justice'.*[70]

The issue in casu was that the Applicant had made an application for the registration of the mark - 'SUPAKILL" pursuant to the provisions of the Zambian Trademark Act. The Applicant contended that the mark, ought to have been registered by the Registrar of Trademarks, having met all registrability requirements of a mark. On the other hand, the application was opposed and contended by the Opponent that the mark 'SUPAKILL' had been in use for some time in Zambia before the registration application was taken out by the applicant and that as a result, the mark, 'SUPAKILL' had accrued a reputation.

[69] In the Matter of Trademark Application No. 292/2001 'Supakill' by Trade Kings limited and Opposition Thereto by Twiga Chemical Industries Limited. Registrar of Trademarks then Mrs A.M. Banda - Bobo rendered this decision on 19th September 2007. A physical copy of the Ruling was obtained from the Patents and Companies Registration Agency after conducting a physical search on 4th August 2022.

[70] Ibid

Furthermore, the Opponent made further insinuations before the Registrar of Trademarks that the mark 'SUPAKILL' was a 'well-known' mark'. [71]

From the above arguments, the opponent in the SUPAKILL case, was attempting to rely on the Common law principle of 'prior use' coupled with good reputation of a mark which would subsequently give the opponent the right to a 'passing off' action. The arguments by the opponent were justified in that once 'prior use' of a mark was established, the impending registration of that mark immediately collapses. However, the Zambian Registrar of Trademarks' decision yet again defied the common law norms. In her Ruling delivered six years later, the Honourable Registrar of Trademarks dismissed the opposition to 'SUPAKILL' trademark registration and held inter alia:

> *'Having had sight of the [pleadings] and heard the parties herein…the [opponent] is unsuccessful as Section 16 of the Trademark they attempted to rely on cannot support their claim because the opponent has not adduced evidence of the existence and continued use of their trademark in Zambia. We tend to agree with the Applicant that's assertion that that a one-off importation more than five years ago prior to the application being lodged is not ground enough to claim reputation. Section 17 of the Act is very clear about the prohibition registration of identical and resembling trademarks. However, this section pre-supposes the existence of a validly registered mark on the register. It is trite law and practice that use of an unregistered mark does not give the owner exclusive legal rights to that mark…protection of trademarks is territorial in that protection of a trademark will only be recognised in the Country of registration, "Supakill" was never registered in Zambia and therefore cannot claim legal protection under the Zambian registration system.'*[72]

With regards to well-known marks, the Honourable Registrar of Trademarks went on further and stated that:

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[71] Ibid
[72] Ibid

'It was claimed by the Opponents that "Supakill" is a well-known trademark throughout Africa, Unfortunately, the Trademark Act as it exists in Zambia today, does not provide for the protection of well-known unregistered trademarks and therefore, such a claim cannot be sustained, this brings us back to the issue of territoriality in the protection of Industrial Property matters.' [73]

It is therefore trite that unregistered, but well-known marks, are not accorded automatic protection in Zambia unless they are defensively registered pursuant to the provisions of Section 32 of the Zambian Trademark Act. Admittedly, there has not been much literature about well-known marks in Zambia but what is certain however is that there has been some consistency in the way the Registrar of Trademarks has dealt with the issue of well-known marks. In another matter of Trademark application of pharmaceutical products, the Registrar of Trademarks retaliated the provisions of Section 32 of the Zambian Trademark Act and held that:

'…in my recent ruling involving an already registered trademark "Benylin" and a mark called "Baxylyn", I held that the protection that is granted under the Trademark Act, Cap 401 of the Laws of Zambia relates to registered trademarks. This means that until the law is amended there is no statutory protection in Zambia for all kinds of unregistered trademarks including well-known marks…' [74]

In conclusion, unregistered trademarks are clearly under immense pressure. In Zambia, there is no statutory protection for all kinds of unregistered trademarks – this is indeed scary for Intellectual Property Law. Prior use vis a vis unregistered trademarks, is no longer available as a tool for opposing an impending registration application of a similar mark. The genesis of prior use of a mark is rooted in Common law cannons that evolved over many years, but these canons are now being thrown to the wind in Zambia. It is therefore this writer's firm view that the decision by the Zambian Supreme Court is

[73] Ibid

[74] Registrar of Trademarks' Ruling in the Matter Trademark Application No. 837/2014 Benalux 4Flu in the Name of Aardash Pharma Limited and Opposition thereto by Johnson and Johnson Pharmaceuticals Pursuant to the Trademark Act Cap 401 of the Laws of Zambia,

regrettable and if not reversed soon, unregistered with the akin rights of prior use are headed for extinction. Similarly, the narrative that Zambia has been pushing over well-known marks is equally retrogressive. Section 32 of the Zambian Trademark Act that makes defensive registration of well-known marks mandatory, is counterproductive to modern trade. Trademarks are meant to facilitate and enhance trade at an international level. Therefore, requesting a proprietor of a well-known mark to defensively register their mark in Zambia against the backdrop of the repute of the mark, simply exposes well-known mark to infringement risks. In sum, enforcing unregistered trademarks and their akin rights is inherently problematic in Zambia and the Zambian Courts have not risen to the occasion to redress this.

CHAPTER THREE

3. DEALING WITH UNREGISTERED TRADEAMRKS: PERSPECTIVES FROM THE SOUTH AFRICAN JURISDICTION.

3.1 Brief Historical Aspects of South African Trademark Law.

Zambia and South Africa have a lot of similarities in their trademark law, as both countries practice a dual legal system that is influenced by Common law values. The law relating to trademarks in South Africa is governed by the Trademarks Act and Common law, with the origins traced to English law. The development of the South African legislation dates to 1875 when Britain created a machinery for the registration of trademarks which resulted in passing similar enactments in the British colonies and the Republic of South Africa…the British Cape colony Act No. 22 of 1877 was subsequently enacted which established a register of trademarks and contained provisions based on the British Act. Further subsequent enactments followed in the province of Natal in 1885, Transvaal in 1892 and later the various provincial enactments were all repealed by the Union Act No. 9 of 1875.[75] It is not within the scope of this work to detail the historical origins of trademark law in South Africa but would suffice to s

The law relating to trademarks in South Africa is pretty much the same as Zambian trademarks law. The law relating to trademarks in South Africa is governed by the Trademarks Act[76] and Common law values that have significant roots in English law. The development of the South African legislation dates back as far as 1875 when the British created a machinery for the registration of trademarks which resulted in passing similar enactments in the British colonies and the Republic of South Africa… in the Cape Colony Act No. 22 of 1877 was passed which established a Register of Trademarks which had provisions based on the British Act. Later, other legislative enactments were rolled out in the provinces of Natal in 1885, Transvaal in 1892 and subsequently other provincial enactments, which were all repealed by the Union Act No. of 1875.[77]

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[75] Webster & Page op cit (note 40) 4
[76] South African Trademarks Act No. 194 of 1993
[77] Webster & Page op cit (note 40) 4

It is not within the scope of this study to extensively detail the historical origins of South African trademark law but would suffice to state that the South African trademark law was influenced by English law. However, even though the current South African Trademark Act was specifically enacted to provide for the registration of trademarks, certification of trademarks and collective marks,[78] the principles and doctrines of English and Common law run concurrently with the statutory registration system. The statutory law was never meant to supersede the rights that came with Common law but was strategically introduced as a complementary system. As earlier pointed out in this study, Common law has its own weaknesses - proved costly for the mark proprietor to prove his/her rights. Furthermore, the reliefs offered by Common law were general in nature making it a less preferred way of enforcing rights.

3.2 Does the South African Trademark Act Recognise Common Law Rights?

As earlier stated in this study, Common law rights are an essential part of trademark law that have evolved over time, with their origins traced from English law. However, it has been established in this study that some Common law rights are at the brink of extinction in Zambia due to the Courts' inability to interpret the Zambian Trademark Act correctly. If this is the position in Zambia, what comparative lessons then, can Zambia draw from the South African jurisdiction? It is submitted that all the lessons that Zambia needs to learn from the South African jurisdiction about unregistered trademarks vis a vis Common law rights starts with Section 36 of the South Arican Trademark Act No. 194 of 1993 which has a counterpart in Section 12 of the Zambian Trademark Act. Section 36 of the South African Trademarks Act states as follows:

> *(1) 'Nothing in this Act shall allow the proprietor of a registered trademark to interfere with or restrain the use by any person of a trademark identical with or nearly resembling it in respect of goods or services in relation to which that person or a predecessor in title of his has made continuous and bona fide use of that trademark from a date anterior:*

[78] Preamble of the South African Trademarks Act No. 194 of 1993.

(a) To the use of the first-mentioned trademark in relation to those goods or services by the proprietor or a predecessor in title of his; or

(b) to the registration of the first-mentioned trademark in respect of those goods or services in the name of the proprietor or a predecessor in title of his, whichever is the earlier, or to object (on such use being proved) to the trademark of that person being registered in respect of those goods or services under section 14.

(2) Nothing in this Act shall allow the proprietor of a trademark entitled to protection of such trademark under the Paris Convention as well-known trademark to interfere with or restrain the use by any person of a trademark which constitutes, or the essential parts of which constitute a reproduction, imitation or translation of the well-known trademark in relation to goods or services in respect of which that person or a predecessor in title of his has made continuous and bona fide use of the trademark from a date anterior to 31 August 1991 or the date on which the trademark of the proprietor has become entitled in the Republic, to protection under the Paris Convention whichever is the later, or to object (on such use being proved) to the trademark of that person being registered in relation to those goods or services under section 14.' [79]

The import and effect of Section 36 of the South African Trademark Act is that Common law rights have been preserved in the Republic of South Africa with very minimal enforcement challenges. How then has Section 36 of the South African Trademark Act been interpreted that would provide valuable lessons for the Zambian jurisdiction?

The starting point would be to consider one of the most recent decisions made by the South African Court of Appeal; the case of **Etraction (Pty) Limited v Tyrecor (Pty) Limited**[80] is very instructive on this subject matter. The brief facts of this matter were that the Appellant, Etraction (Pty) Limited conducts business as a trader in wheels, tyres and related products and was a registered proprietor under the Trademarks Act No.94 of 1993

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[79] Section 36 of the South African Trademark Act No. 194 of 1993.

[80] Etraction (Pty) Limited v Tyrecor (Pty) Limited (20185/2014) 2015 ZASCA 78

of the trademark "INFINITY". The Respondent, Treycor (Pty) Limited were one of the competitors who imported into South Africa and sold tyres under the brand name "Infinity" [81]

This study has considered the decision by the South African Court in the Etraction case to be very instrumental and valuable to Zambia for two reasons: first, the facts of Etraction case are very similar with the DH Brothers' case that was decided differently in Zambia by its Supreme Court. Therefore, the legal jurisprudence that emanated from the South African Court in the Etraction case is not only instrumental to the South African legal fraternity but could also provide some persuasive reasoning to the Zambian jurisprudence.

The core issue that the Court was invited to adjudicate on in the Etraction case were that the Appellant, Etraction claimed that their mark "INFINITY" was validly registered under the Trademarks Act No. 194 of 1993 whilst on the other hand, the Respondent, Tyrecor claimed continuous and bona fide use of the mark "Infinity" prior to the registration of the same mark by the Appellant. The two marks were very identical "INFINITY" and "Infinity", what merely separated them was that the Appellant's mark was couched in capital letters whilst the Respondent's mark was in lower case letters, save for the first letter "I". In dismissing the appeal and granting partial expungement of the mark, the South African Court of Appeal extensively referred to Section 36 of the South African Trademark Act and held inter alia:

> *'The purpose of this section is to prevent a proprietor of a trademark from exercising rights merely because of priority of registration and it preserves whatever common-law rights there may be antecedent to the rights of the registered proprietor. A party relying on this defence must establish bona fide and continuous use of the mark, either by its predecessor in title, or at a time prior to the use or registration of the registered mark…Falk used the trademark Infinity in relation to tyres prior to Tyrecor and prior to Etraction's registration of the mark. Two questions must be addressed, the first is*

[81] Bid

> *whether that use was of the character specified in section 36(1) …and the second question was whether Falck was Tyrecor's predecessor in title…unlike a registered trademark, an unregistered mark is not itself an incorporeal seal asset capable of being owned. It contributes to the good will of a business by identifying a business, goods, or services in the marketplace with a particular source and, unlike a registered mark, it is capable of being alienated separately from the good will that business…it is only on registration that the applicant for the registration becomes the proprietor of the registered mark. It cannot therefore be the case that in order to enjoy the protection afforded by Section 36(1) of the Trademarks Act, it is necessary to show that the party claiming protection owned the mark in issue…the clear purpose of Section 36(1) is to protect common law rights arising from continuous and bona fide use of an unregistered trademark prior to either the use or registration of the mark in issue…consistent with that purpose, any person entitled to bring passing off action based on the reputation they had acquired from the use of the unregistered mark would be entitled to invoke Section 36(1) against a claim for infringement by the proprietor of a registered mark…'* [82]

Clearly, the reasoning adopted by the South African Court of Appeal was legally sound as it allayed the many fears that have been expressed in Zambia that Common law rights have been abolished. First, the South African Court made it very clear from its decision that Section 36 of the Trademarks Act (that has a counter part in the UK Act) was strategically placed in the South African Trademarks Act for the preservation of Common law rights that maybe antecedental to the rights of registered trademark holder. In the ancient times, traders would use a mark without any form of formal registration, but the law still envisaged that the reputation and the good will that such a mark would accrue, still needed to be protected. The drafters of the South African Trademarks Act saw the need to craft in Section 36, which the South African Courts have interpreted correctly.

[82] Ibid

In summing up its decision in the Etraction case, the South African Court of Appeal finally stated and held that Tyrecor was the successor in title to Falck's business of selling Infinity tyres in South Africa and was entitled to rely on the latter's bona fide and continuous use of the mark Infinity to resist Etraction's infringement claim.[83] The decision in the Etraction case is quite a recent decision in the South African legal jurisprudence and clearly underscores the importance of Common law rights vis a vis unregistered trademarks. It is therefore submitted that the decision in the Etraction case, must be a relief to legal jurists and scholars in South Africa that Common law values and principles that evolved thousands of years under English law, have received this level of recognition under the South African Intellectual Property Law.

Furthermore, the South African Superior Courts have maintained their consistency in the recognition and upholding of Common law rights, as there have been a subject of discussion in many other cases that were decided earlier than the Etraction case. In the case of **Nino's Italian Coffee v Nino's Coffee Bar** [84] the Court was called upon to a make a pronouncement and give an interpretation of Section 36 (1) of the South African Trademark Act. The Court held inter alia that 'the underlying purpose of this section is to prevent a proprietor of a trademark from exercising his rights merely on the basis of priority of registration and it preserves whatever Common law rights there may be antecedent to the rights of the registered proprietor'.[85] The reasoning by the Court in the Nino's case is that first, Section 36(1) of the South African Trademark Act curtails the purported rights of a registered trade mark user on the mere fact that the mark has been registered. Secondly and more importantly, the Court was alive to the preservation of Common law rights that comes with the invocation of section 36. On the other hand, even though Section 36 has been given more prominence in the preservation of Common law rights, Section 10(12) of the South African Trademark also has the effect of preserving Common law rights, the only difference being that the later provision presupposes that

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[83] Ibid

[84] Nino's Coffee Bar & Restaurant CC v Nino's Italian Coffee & sandwich Bar CC & Another; Nino's Italian Coffee & Sandwich Bar CC v Nino's e Bar & restaurant CC 1998 (3) SA 675

[85] Ibid

reputation has been established and is in existence before Common law rights can be enforced.

3.3 Is "Bona Fide" Use an Essential Factor in Proving Common Law Rights?

Whilst the principle enunciated in Section 36(1) of the South African Trademarks Act was clearly intended to protect Common law values, the South African Courts seized the moment to interpret the meaning of "bona fide" use as provided for under the Act. The Courts have attempted to define what constitutes or does not constitute bona fide use. In the case of **Rembrandt** [86] stated that use:

> '…*for an ulterior purpose, not associated with a genuine intention of pursuing the object for which the Act allows the registration of trademark and protects its use, cannot pass as bona fide user.'* [87]

The Court's point in the Rembrandt case is that for one to qualify as a bona fide user, there must be no ulterior motive on the part of the mark proprietor, the intention for the use of that mark must be genuine and its use must be within the confines of the South African Trademark Act. In establishing whether there has been bona fide use of the mark to satisfy the elements under Section 36 of the South African Trademark Act, the Court will interrogate the proprietor's motive and genuineness in the utilisation of that mark.

Further in the **Gap case,** [88] Harms JA defined bona fide user to mean:

> *'a user by the proprietor of his registered trademark in connection with the particular goods in respect of which it is registered with the object or intention primarily of protecting, facilitating, and furthering his trading in such goods, and not for some other, ulterior objective'.* [89]

In view of the foregoing, it is this writer's view that for one to invoke the provisions of Section 36 of the South African Trademark Act, continuous and bona fide use of the mark must be proved. Whilst the Court may not have defined a specific period that would

[86] Rembrandt Fabrikante en Handelaars (Edms) Bpk v Gulf Oil Corporation 1963 (3) SA 341, at 351 C-F
[87] Ibid
[88] AM Moolla Group Limited and Others v The Gap Inc and Others 2005 ZASCA 72
[89] Ibid

amount to “continuous use” it is submitted that the continuous period envisaged by the Act would be a period that would be subjective and dependant on the circumstances of each case. The Court has however guided that ‘a trademark must be used for the purpose of distinguishing the goods of services connected in the course of trade with any other person’. [90] Therefore, a mark that is not in use would not qualify under Section 36(2) of the Act.

3.4 Are Unregistered, Foreign Well-Known Marks Accorded Automatic Protection Under the South African Trademark Law?

In this study, it has been established that foreign well-known marks are another category of unregistered trademarks. These marks derive their identity from international instruments such as the Paris Convention for the Protection of Industrial Property and the Agreement on Trade-Related Aspects of Intellectual Property Rights. Well-known marks are therefore a species of unregistered trademarks that have their own unique enforcement challenges. The first difficulty that is associated with well-known marks is that even when the international instruments have provided certain guidelines on their use and rights, the protection that is accorded to these marks, vary from one jurisdiction to another. For example, it was pointed earlier in this study that Zambia does not accord automatic protection to well-known marks, but instead, uses a defensive registration system.

Well-known marks are treated differently in different jurisdiction resulting in some eminent scholars arguing that very little has been done at the international level on the protection of unregistered marks, although it has been widely acknowledged that the most important provision relating to well-known marks is Article 10bis of the Paris Convention[91] which obliges member states to assure effective protection against unfair competition.[92] Well-known marks are, therefore, a product of the Paris Convention and the import of Article 6bis[93] is that it places an obligation on member states, to recognise and protect

[90] McDonald’s Corporation v Joburgers Drive Inn Restaurant (Pty) Ltd and Another, McDonald’s Corporation v Dax Prop CC and Another; McDonald’s Corporation v Joburgers Drive Inn Restaurant and Dax Prop CC (1997) (1) SA 1
[91] Paris Convention for the Protection of Industrial Property, 20 March, 1883
[92] L Bently & B Sherman Intellectual Property Law 4ed (2014) 811
[93] Paris Convention for the Protection of Industrial Property, 20 March 1883

well-known marks in the states where these marks are not registered. The lack of adequate protection provisions in the Paris Convention triggered the enactment of another international instrument; the Agreement on Trade Related Aspects of Intellectual Property which indicates that in assessing whether a mark is well-known, member states shall consider the knowledge of the trademark in the relevant sector of the public including knowledge in the member concerned that has been obtained as a result of the promotion of the trademark.[94] Put simply, the import and effect of Article 16 (2) of the TRIPS is that the ordinary language and common knowledge in the sector concerned ought to be used in determining whether the mark is famous or not. In other words, a subjective test ought to be implored in determining whether a mark is famous or not.

In view of the foregoing and having established that you need to defensively register your well-known mark in Zambia; what then is the South Africa's position regarding foreign well-known marks? The answer to this question would start with an examination of the South African Trademark Act, which appears to have given effect to Article 16(2) of TRIPS in so far as it relates and applies to the recognition and protection of well-known marks. Sections 10(6) and 35 of the South African Trademark Act are instructive provisions on foreign well-known marks. Section 10(6) of the Act states:

> *'Subject to the provisions of Section 36(2), a mark which, on the date of application for registration thereof, or, where appropriate of the priority claimed in respect of the application for registration thereof, constitutes, or the trademark which is entitled to protection under the Paris Convention as a well-known mark within the meaning of section 35(1) of this Act and which is used for goods or services identical or similar to the goods or services in respect of which the trademark is well-known and where such use is likely to cause deception or confusion.'* [95]

Furthermore, Section 10(6) of the South African Trademark Act is supplemented with Section 35 which '*restrains the use of the well-known mark in the Republic of South Africa, either as an imitation, reproduction or translation of a well-known mark.in relation to*

[94] Article 16 (2) of the Agreement on Trade-Related Aspects of Intellectual Property rights 1994.
[95] Section 10(6) of the South African Trademark Act No. 194 of 1993.

similar or identical goods or services, which is likely to cause deception or confusion.' [96] Unlike the Zambian Trademark Act which provides for defensive registration of well-known marks, the South African Act expressly provides for protection of well-known marks, even when such marks are not registered in the Republic of South Africa. Clearly, Sections 10(6) as read with Section 35 of the South African Trademark Act, are reflective of the modern business trends that transcends national borders. The recognition of well-known marks was one of the innovations undertaken in the current South African Trademark Act. The legal jurisprudence that came from the South African Courts before the enactment of the Trademarks Act No.194 of 1993 was that well-known marks were not recognised in South to the extent to which they are now under the current Act.

Whilst the innovation of recognising foreign well-known marks under the South African Trademark Act is a milestone for South African Intellectual Property law, the practical interpretation of Section 10(6) and 35 of the Act has caused some potential legal issues to the proprietors of local well-known marks in South Africa that the Courts may need to deal with, at some point sooner or later. Just like Zambia, which is still grappling with the legal issue of unregistered marks, not being recognised in the country, unless and until these marks are registered, South Africa on the other hand, seems to be grappling with a different problem of local well-known marks being exempted from the provisions of Section 10(6) and 35 of the South African Trademark Act. It is therefore this writer's view that unregistered trademarks, irrespective of the country in which they are used, are bound to be problematic, nonetheless.

Against the backdrop of Sections 10(6) and 35 of the South African Trademark Act, Klopper has argued that the aim of these provisions are to protect well-known trademarks of foreign proprietors who do not have any business or enjoy any good will in South Africa and this protection does not extend to well-known trademarks of local proprietors.[97] In addition, the South African Courts have had the occasion to interpret Section 35 and in the case of Blue Lion Manufacturing[98] the Court retaliated that Section 35 of the South African Trademark Act was intended to protect foreign well-known marks

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[96] Section 35 of the South African Trademark Act No. 194 of 1993.

[97] Klopper op cit (note42) 139

[98] Blue Lion Manufacturing (Pty) Limited v National Brands Limited & Another 2004 BIP 84 (T)

and the relief under Article 6bis of the Paris Convention for the Protection of Industrial Property was not available to local proprietors.[99]

In as much as The South African Trademarks Act has provided for well-known marks under Sections 10(6) and 35 of the Act, the lack of definition of well-known marks under the Act could be cited as one of the challenges that the South African Courts have to deal with. The Paris Convention has not defined well-known marks either but suffice to say that there has been some progress jurisprudence from the South African Courts, to give effect to the provisions of both the Paris Convention and the Trademarks Act itself. As the South African economy grew and the subsequent enactment of the current Trademarks Act, the Courts were yet again faced with the challenge of dealing with a famous well-known mark that was not registered in South Africa but sought to extend protection in the Republic. The courts were yet again called upon to interpret and give effect to the “elusive and abstract” concept of “famous well-known marks.”

In the McDonald’s case[100] which was decided just after the enactment of the current South African’s Trademarks Act, with its robust Section 35 of the Act, the Court was faced with a core issue; whether a foreign well-known mark, was entitled to protection or covered by Section 35 of the Act? The brief facts of the McDonald’s case are that the Appellant, Mc Donald are one the largest franchisers of fast-food restaurants in the world incorporated in the State of Delaware in the United States of America, which business they commenced in 1955 and later expanded internationally from 1971. The McDonald’s trademark is widely used in their restaurants throughout the world including those who were franchised to do so. It was undisputed at trial that McDonalds had obtained registration of its trademarks in South Africa in 1968, 1974, 1979, 1980, 1984 and 1985, but at the time the proceedings were commenced, McDonalds had not traded in the Republic of South Africa.[101]

On the other hand, the Respondent, Joburgers Drive Inn Restaurant, A South African based company, registered a company called “Golden Fried Chicken (Pty) Ltd

[99] Ibid, at Pg 89
[100] McDonald’s Corporation v Joburgers Drive Inn Restaurant (Pty) Limited and Dax Prop CC 1997 (1) SA 1 (A)
[101] Ibid

and established fast food outlets using McDonald's trademarks. As if this wasn't enough, Joburgers Drive Inn Restaurant made an application to the Registrar of Trademarks to expunge McDonald's trademark in terms of Section 36(1) (a) and (b) of the South African Trademarks Act No. 62 of 1963[102] which application was vehemently opposed by McDonalds, who equally filed counter arguments. During the proceedings, it so happened that the current South African Trademarks Act with a new Section 35 was enacted, and the Court inevitably had to resolve the dispute considering the new Section 35. That notwithstanding, the Court I that hall mark decision held that Section 35(1) of the South African Trademarks Act No. 194 of 1993 extends protection to the owner of a foreign well-known mark, whether, such person carries business, or has any good will in South Africa.[103]

It was the Court's further contention that a mark is well-known in the Republic of South Africa if it is well known to persons interested in the goods or services to which the mark relates and the degree of knowledge of the mark that is required would be similar to that protected in the exiting law of passing off.[104]

The McDonald's case was perfectly decided by the South African courts. The inclusion of Section 35 in the current South African Trademarks Act and the subsequent decision by the South African Court in which it was confirmed that well-known marks are entitled to protection; is a hall mark decision that will serve as a trademark beacon not only to South Africa, but to the entire region in the Central and Southern Africa. The McDonald's decision is clearly in line with of all intents and purposes of the Paris Convention for the Protection of Industrial Property and the Agreement on Trade-Related Aspects of Intellectual Property. However, even though the Court in the McDonald's case interpreted Section 35 of the South African Trademarks Act correctly, there is one important legal issue that remains and that is, the fact that these well-known marks trade as unregistered marks, there is an underlying potential issue that these unregistered well-known could "infringe" local registered marks and cause confusion with goods or services

[102] This Act preceded the current Trademarks Act No. 194 of 1993. Under Section 36(1) and (2) of the old Act, a mark could be expunged if the mark was registered without any bona fide intention to use the mark
[103] McDonalds, supra note 98
[104] Ibid

that are identical or similar. This is further compounded by the insertion of Section 34(1)(c)which provides that:

> *'The rights acquired by registration of a trademark shall be infringed by the unauthorised use in the course of trade in relation to any goods or services of a mark which is identical or similar to a trademark registered if such trademark is well known in the Republic and the use of the said mark would be likely to take unfair advantage of, or be detrimental to the distinctive character or the repute of the registered trademark notwithstanding the absence of confusion or deception …'*[105]

The provision has brought some controversy among some South African scholars who have argued that this type "infringement" that was introduced in the current South African Trademark Act was alien to the South African legal system as the traditional sense of the word, infringement can only be proved once an offending article is established. It is therefore submitted by this writer that the introduction of Section 34(1) into the South African Trademark Act, just merely added up to the many challenges that have come to be associated with unregistered trademarks.

Furthermore, Sullivan has argued that '*where a registered trademark is well-known, the protection afforded to that mark has a wider reach and can be extended, in certain circumstances to dissimilar goods and services. A well-known registered trademark will be infringed if another party uses an identical or similar sign in relation to dissimilar goods or services and that use takes "unfair advantage" of or is detrimental to the distinctive character or the repute of the mark and the protection of this kind is aimed at preventing the unique identity of a well-known mark from being diluted or taken advantage of...'*[106]

In conclusion, it is submitted that foreign well-known marks by their very nature trade as 'unregistered trademarks' in the states where they are not initially registered but

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[105] Section 34(1) (c) of the South African Trademark Act No. 194 of 1993.

[106] B Sullivan 'Protection of Well-Known Marks 'February 2008 available at http://www.henryhughes.co.nz/site/News.ArticleCaseNotes/KingsChoiceTrademarkApplicationaspx accessed on 24 February 2017

tend to acquire recognition and protection in such states without undergoing any form of registration formalities. As pointed earlier, well-known marks are not accorded automatic protection under the Zambian Trademark law, unless such a well-known mark is defensively registered. Whilst it can be argued that the concept of defensive registration is in line with the trademark principle of territoriality, the guidelines provided under the Paris Convention for the Protection of Industrial Property and the Agreement on Trade-Related Aspects of Intellectual Property Rights would not support a defensive registration system as that obtaining under the Zambian Trademark Act. By adopting a defensive registration of well-known marks, the Zambian legal system seems to have a created another legal difficulty and that is, foreign well-known marks can easily be infringed in Zambia notwithstanding the good will and reputation of the mark in the countries of its origin.

Is the South African approach any better or what comparative lessons are there to pick from the South African jurisdiction regarding unregistered, foreign well-known marks? It has been established in this study that the insertion of Section 35 of the current South African Trademark Act accorded well-known marks an automatic protection in the Republic of South Africa. The South African Courts rose to the challenge and retaliated in the McDonald's case well-known marks, even when they are not registered in the Republic ought to be recognised. However, this recognition by both the South African Trademarks Act which was subsequently endorsed by the Courts posed different legal challenges in the administration of these well-known marks. As pointed out earlier, foreign well- known marks accorded more preferential treatment compared to local well-known marks and that a new form of infringement commonly referred to as "dilution'. Whether these difficulties were foreseen or not, just goes to show that although South Africa's approach to unregistered, famous well-known marks is far much better than Zambia, unregistered trademarks, by their very nature, are indeed problematic in that they are associated with a lot of legal inconsistencies.

CHAPTER FOUR

4. DO UNREGISTERED TRADEMARKS LIMIT STATUTORY RIGHTS?

4.1 The Perceived Uncertainties of Unregistered Trademarks.

As pointed out earlier in this study, a trademark can either be registered or unregistered. A mark is said to be registered if it meets out the registrability requirements under the respective statutory law and the registrability rights will flow from there. Put simply, once a mark is registered, statutory rights will automatically accrue to that mark and subsequently, some form of mark protection will be guaranteed; just by mere virtue of that registration. For this reason, there has been a tendency by the would be mark holders to prefer placing their mark on the statute books as opposed to using unregistered trademark.

This study has established that even when a mark has been validly registered, it can be expunged at the hands of an unregistered mark holder who is armed with prior and continuous use. Therefore, the protective assumption that flows with registering a mark is merely theoretical.

On the other hand, unregistered marks, as the name itself suggests, are unregistered, but are a product of Common law values and principles. Therefore, unregistered, and registered trademarks can co-exist, save in circumstances where a proprietor of one mark opts to claim that his mark is more superior than the other. At the core of this study, therefore, is the great controversy that has been sparked by eminent South African scholars on whether rights that accrue by virtue of using unregistered marks can exist independently of statutory rights for an indefinite period. The emerging interface theories between registered and unregistered trademarks are increasing get lounder.

In view of the foregoing then, would it be prudent to argue that unregistered trademarks have now fallen in the domain of limiting statutory rights? The answers to these concerns would be difficult to effectively deal with, for reasons dealt with earlier as unregistered can mutate in its claim, but what is certain is that it is erroneous to argue that statutory rights are unassailable.

In Zambia, the potential interface legal challenges between registered and unregistered trademarks, sadly, seem to have died off following the decision of the Zambian Supreme Court which decided that the Zambian Trademark Act does not accord protection to unregistered trademarks. What this means therefore is that any mark that seeks to be protected in Zambia, must be registered pursuant to the relevant provisions of the Zambian Trademarks Act. By this proposition, it can safely be argued that statutory rights seem to be superior in Zambia as no form of protection is accorded to unregistered trademarks under the Zambian Trademark Act.

In South Africa however, the position is somewhat different, as Section 36 of the South African Trademarks Act has preserved Common law rights, save for the minor interpretation and enforcement challenges that are encountered occasionally. The learned scholar, Wim Alberts has been instrumental and very critical on issues surrounding unregistered trademarks, and the uncertainties that these marks have brought into the South African legal system. One of the key and outstanding issues that the learned author has brought to the fore, in one of his articles is the issue of trademark use versus trademark registration. Ingeniously, the learned author has argued that '*trademark rights can exist both under the statute and common law but the question that arises is who has superior rights between a proprietor who is armed with prior use of the mark and prior registration? There is a complex of factors and permutations of use or registration of a mark that would not necessarily put rights in a "straight jacket…'* [107] It is therefore submitted that the debate surrounding superiority of trademarks between a registered and unregistered trademark, is something that the legal fraternity never anticipated. The essence of registering a mark is to set out definitive trademark rights beforehand and get some form of legal guarantee that the rights so granted, are unassailable to a certain extent. However, the concept of prior use is a 'mole' in trademark law in that claims of prior registration can sometimes defeat statutory rights. To this extent, it can therefore be argued that unregistered trademarks limit statutory rights. The interface challenges that inherently exist between registered and unregistered trademarks is what partially triggered the confusion when the Zambian Supreme Court decided that, even

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[107] Alberts op cit (note1) 160

where there is prior use, unregistered trademarks cannot be accorded protection under the Zambian Trademarks Act.

What then is the answer to the question: who holds superior rights between a proprietor armed with prior use of a mark and a registered trademark holder? The answer to this question will forever be illusive. With regards to this point of superiority, Alberts has argued that '*neither use nor registration is inherently superior to the other and priority will [largely depend on a complex of facts].*[108]

The debate surrounding the various permutations that can arise in the use of unregistered trademarks has demanded that a closer look be taken at the interface of registered and unregistered trademarks. Similarly, an additional argument that has risen with unregistered trademark is that of honest and concurrent use. Alberts has again argued that if an application to register a mark is opposed based on prior use, it may be possible to obtain an honest and concurrent use, pursuant to section 14 of the South African Trademarks Act. [109] In such a case, Registrar of Trademarks would accept the application for honest and concurrent use, and this would act as a bar from instituting infringement proceedings …the important principle is that trademark proprietors have to police the use of their mark on an intensive scale.[110] From the foregoing, it is submitted that prior use of a mark, that is in fact, unregistered, can disadvantage a proprietor of a registered mark in a number of ways, defeating the very essence of statutory law.

The Etraction case, seems to be an instructive authority on Section 36 that has preserved Common law rights under the South African Trademark Act. However, Speres referred to Supreme Court's analysis of Section 36 as a misstatement and argued that *'a defendant seeking the protection of Section 36 need not prove anything more than continuous, substantial, and bona fide prior use in relation to the relevant goods or services and the substantiality requirement appears to be academic authorities. The point Speres made was that "at common law, rights to protect an unregistered trademark flow from the delict off unlawful competition, specifically passing off with proof of reputation for*

[108] Ibid
[109] W Alberts 'Check who is Using Your Trademark" (2007) 15 Juta Business Law 32
[110] Ibid

the mark being required to found the claim as opposed to the Court's held position that any person entitled to bring a claim of passing off based on a reputation would be entitled to defend its use of the same mark against a claim statutory mark infringement on the basis of Section 36.'[111] In view of the foregoing, it is acknowledged that Section 36 has recognised the preservation of Common law rights, but the interpretation with regard to what it actually means or what must be proved within the wording of Section 36 for it to be invoked, is likely to be another academic argument that will entangle scholars.

4.2 The Future: Can Interfacial Challenges Be Remedied?

Trademark law has certainly become the cornerstone of global modern trade and the jurisprudence that flows from it is worth taking a closer look at. The historical traces of trademarks and their origins clearly shows that unregistered marks were at one time fancied, as they served as a source of goods or services. With time, legislative innovations creeped in, which resulted in a dual protection system of marks. The dual protection legal system is synonymous with English law, which influenced trademark law, both in Zambia and South Africa. This eventually saw Common law rights being applied concurrently with statutory law. This concurrent application of the law appears to have worked well in both jurisdictions but certainly the Zambian legal system cracked in about 2012 when the Zambian Supreme Court ruled that unregistered trademarks cannot be accorded protection under the Zambian Trademarks Act. Questions have been asked as to why the Zambian Courts would pass such a controversial decision in the wake of modern trade? Nonetheless, it is this writer's view and with respect, that the Zambian Supreme Court failed to apply its mind to the controversial issue of the inherent interfacial challenges that sit between registered and unregistered trademarks. Therefore, it is submitted that the Zambian Trademark law is now in a much worse off position than it was before the decision in DH Brothers was passed.

What then is the remedy for the Zambian Trademark law? Can further or amending the legislation help? The answer to this question might not be categorical, but it appears that the Zambian Trademark Act seems to be sufficiently couched in terms of preservation

[111] J Speres 'Prior use defence to trademark infringement' (2016) Intellectual Property 33

of Common law rights. However, what has been the problem, it is submitted, is the statutory interpretation by the Courts, of the Zambian Trademark Act. Whilst it is acknowledged that unregistered trademarks are inherently problematic, the decision by the Zambian Supreme Court was not in line with international norms of trademark law. It is therefore submitted that the future for the law in Zambia, lies with the Supreme Court. The Court can move on its own motion and for public interest considerations, reverse the decision that was passed in the DH Brothers case.

What about South Africa, what lessons does this study bring to the fore with regards to unregistered trademarks and Common law rights? It is submitted that the South Trademark Act has clearly preserved Common law rights under Section 36 of the Act and this indeed, is a great milestone for South African Trademark law. However, this study has also shown that despite this recognition of Common law rights under the Act, there has been some form of lack of consensus as to what really must be proved within the wording of section 36 of the Act. In the Etraction case considered earlier in this study, the South African Supreme Court of Appeal relied heavily on Section 36 and for reasons explained earlier, some scholars have not agreed with the position of the Court over Section 36 of the Act. That notwithstanding, the South African Trademark law is sound, and Zambia has a lot to learn from that jurisdiction.

CHAPTER FIVE

5. CONCLUSIONS AND RECOMMENDATIONS

This study has traced the origins of Common law and how unregistered trademarks were utilised from the medieval times, before any form of trademark registration system was introduced. Trademarks have been in use from time immemorial, long before the advent of industrialisation. The value that the early traders attached to marks was effectively, the pride of their businesses, which they collectively vowed to protect. The consensus and respect that the early traders had for one another, eventually culminated into values that came to be known as Common law and these values, were subsequently protected by the Courts. Even though these values provided some form of initial trademark protection to the early traders, the nature and extent of trademark protection they offered, was inadequate. With time and the rapid industrialisation era that dawned, statutory form of trademark protection was introduced, that paved way to the enactment of various English Trademark Acts. These Acts were not intended to replace the trademark protection that were provided by Common law values but were intended to co-exist.

In this study, it has been shown how the English Trademark law subsequently influenced the enactment of both the Zambian and South African Trademark Acts. These two pieces of legislation are typically English law, but from a comparison perspective, both these Acts have a provision that has preserved Common law rights and values. The rationale behind statutory enactments, is not to replace Common law values but to co-exist. The wording of Section 12 of the Zambian Trademark Act clearly shows that the Zambian legislators wanted Common law rights preserved. Unfortunately, the Zambian Supreme Court decision decided to the contrary. The import and effect of that decision is that a proprietor of an unregistered mark cannot rely on his unregistered mark, in opposition proceedings. According to the Zambian Supreme Court, the Zambian Trademark Act has not extended protection to unregistered trademarks. With due respect to the Court, this decision was not correct and as a matter of fact, it has distorted the basic norms of trademark law in Zambia. Unregistered trademarks have been a hallmark of English law and so, they should be in Zambia too. Furthermore, the wording in Section 12 does not in any imply an ousting of Common law rights by the Act.

Therefore, it makes sad reading that unregistered trademarks are at the brink of extinction in Zambia. In view of this decision. It is submitted that the interfacial challenges that sit between registered and unregistered marks, are real and has made Zambia fall into grave error. As things stand now, the position in Zambia is that the rights that are acquired through trademark registration made pursuant to the Zambian Trademark Act are more superior than the Common law related rights. From this perspective, the question of superiority of marks has been answered in the Zambian context, though this is not the position that trademark scholars would have desired. Put simply, as far as the Zambian Supreme Court is concerned, when Common law rights are pitted against statutory rights, the later must take the day.

Furthermore, the pitfalls of the Zambian Trademark Act do not end with Section 36 only, but Section 32 also resurfaces with a problematic defensive registration system of foreign, but unregistered well-known marks. The import and effect of Section 32 of the Act is that any proprietor of a well-known mark must seek prior registration of that well-known mark to access trademark protection of that well-known mark in Zambia, notwithstanding the reputation and good will that maybe associated with that mark. Clearly there are a few problems associated with this system; first, that before the registration is complete, another holder of a similar or identical mark can use the mark in Zambia, thereby infringing the well-known mark with no recourse by the bona fide holder of the well-known mark under the Zambian Trademark Act, save perhaps in a passing off action. Secondly, what would happen if there were an earlier application of a similar mark in the Republic before an application for defensive registration was made? The answers to these issues could be complex but suffice to state that the current state of the Zambian Trademark Act as regards foreign, unregistered well-known marks is retrogressive. It is yet to be seen whether a new Trademarks Act will be enacted in Zambia. By way of comparison however, the South African Trademark Act expressly provides for the protection of well-known marks, irrespective of whether they have been registered or being used in the Republic of South Africa.

For the foregoing reasons, are they any desirable reforms that Zambia should undertake to remedy this situation? Perhaps yes, it is this writer’s view that first, whilst the

wording of Section 12 of the Zambian Trademark Act appears to be clear, maybe the rewording of that section could help the Courts and other stake holders to re-think that the Zambian Trademark Act provides for the preservation of Common law rights. The intents and purposes of Section 12 must be made clear. Similarly, Section 32 of the Zambian Trademarks Act that deals with defensive registration of well-known marks must be repealed and replaced with a more progressive provision that would be in line with tenets of modern commerce and trade. As the position is now, Zambia is a very risky zone for foreign, unregistered well-known marks.

Finally, with arguments advanced in this study, it appears that there isn't any trademark law system that can offer exclusive and absolute rights to a trademark holder, amid the many competing rights. At one point, it was probably felt that statutory rights were unassailable, but it is public knowledge that a statute does not confer absolute rights. Whilst it is acknowledged and submitted that the South African Trademark Act isn't a perfect piece of legislation, the legal jurisprudence that has come out from there, is worth learning from as a country. The Zambian Trademark Act is more than 66 years old, surely the law cannot remain that static, but the legal maze of superiority of trademarks rights will rage on but as aptly submitted by Alberts, '*trade mark registration remains the most effective method of protecting a valuable trademark…in great majority of cases, the infringement provisions of the Act will ensure that the mark closely linked to the business identity is indeed protected and that a trademark registration can do.'* [112]

[112] W Alberts 'The Reach of the Trademarks Act" available at http://www. Bowmanslaw.com/insights/intellectual-property/the-reach-of-the-trade-marks-act-wim-alberts accessed on 28 August 2021

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