

LETICIA KUDA MUPAWOSE
Versus
ONA BRANDS (PVT) LTD

HIGH COURT OF ZIMBABWE
COMMERCIAL DIVISION
CHIRAWU-MUGOMBA J
Harare, 18 February, 13, 14 and 17 March 2025

B. NGWENYA, for the applicant
W. KAMUSASA, for the respondent

OPPOSED APPLICATION

CHIRAWU-MUGOMBA J: The applicant seeks an interdict in terms of s8(1) of the Trade Marks Act (Chapter 26:04), the 'Act'. However, the correct section is 9A but this is neither here nor there. The applicant's case as pleaded is very simple. She contends that since the 31st of May 2024, she is the registered proprietor in the Republic of Zimbabwe, Botswana, Mozambique and Malawi of the trademark FESO under AP/M/2023/005745 in classes 1, 3 and 35 in respect of hair products. She attaches a copy of the certificate of registration which shows that the mark is registered with the African Regional Intellectual Property Organization (ARIPO).

Applicant further avers that since about April 2023, the respondent whilst the application was pending, has been using in Zimbabwe a mark consisting of the word FESO in relation to hair growth products. This name clearly resembles that of the applicant and is likely to deceive and cause confusion amongst consumers. She submits that in their marketing strategies, the respondent is copying and pasting from statements that applicant would have posted prior especially on social media. Further that the respondent is marketing and distributing a product called FESO Hair Growth Miracle Combo under the name ONA. Further that the respondent on its products is using a flower resembling FESO which was actually registered by the applicant as part of its mark. She states that the applicant's customers have been deceived and are now confused.

In response the respondent states as follows. It has always been using the words ONA Brands on its products which is distinct from that of the applicant. Its packaging does not clearly resemble that of the applicant's and there is no likelihood of confusion. The use of the word FESO is simply to indicate the ingredients that are contained in the respondent's products. This is required by the law relating to goods and services. The respondent contends that FESO is not an invention of the applicant but has been used since time immemorial to wash women's hair and for other health purposes. To buttress its case, the respondent attaches an affidavit from an expert. Further that prior to the application, the respondent had always been using the word FESO.

Save to reiterate that the use of the word FESO causes confusion, nothing much turns on the applicant's answering affidavit.

At the hearing the legal practitioners largely abided by the heads of argument filed of record. In the heads of argument, the applicant crystallises the question before the court as whether or not there has been an infringement of the applicant's registered trade mark and if so, what are the remedies. The test for infringement has been set in the case of *Cairns Foods Limited vs. Netrade Marketing (pvt) Ltd*, SC-106-21. The applicant has met the test. There is likelihood of confusion caused by use of the word FESO. The goods offered are similar in that they are all found in the hair growth industry. The contention by the respondent that FESO relates to traditional plants misses the point. Using a plant and labelling it are different issues. In *INNSCOR AFRICA Limited vs. Slice Distributors (pvt) Ltd and anor*, SC-43-22, the court properly found that the words, 'Luv', cannot be divorced from the whole mark. The same argument applies to use of the word FESO. The court in that case set out the test for confusion and deception to the average consumer. The applicant is not seeking an interdict for past infringements but present and future- *Marshall and anor Versus Atulepe Investments (Proprietary) Ltd T/A Workboss Hardware*, HH-195-22. The respondent has not stopped the conduct complained of. The applicant has set a case for trademark infringement and is entitled to the relief sought.

In its heads of argument the respondent identified the same issue of trade mark infringement as the applicant. Further whether or not the word FESO is descriptive and whether the respondent has other legally competent defences. Further, that it had raised

the following critical defences. (a) The word FESO on the application for a trade mark is descriptive and no one has monopoly over it , (b) the use of the word FESO amounted to a *bona fide* description and it was therefore protected by the defence contained in terms of s11 of the Act, (c) that there is no likelihood of confusion as envisaged in s8(1) of the Act and (d) it has acquired rights of prior use. The respondent drew a distinction between this case and that of INNSCOR (*supra*), It submitted that in the latter what was at stake was the word 'luv' that had been registered and such word is not descriptive. The dominant impression test is relevant – *Mobil Oil Zimbabwe (pvt) Ltd vs. Travel Forum*, 1990 (1) ZLR 67. FESO is not an invention of the applicant but is descriptive making it harder to protect as a mark- *Marshall* case. Further, s12(1)(c) of the Act prohibits the trade marking of a word which is not invented. In *casu*, FESO is not an invented word. The name should be available to other traders in the same industry. No impression is created in the mind of consumers or the public at large that the name emanates exclusively for the applicant. The evidence of the expert proves such assertion. The average consumer cannot be confused based on the test set out in *Plascon Evans Paints Limited vs. Van Riebeeck Paints (pvt) Ltd*, 1984(3) SA 623 (A). ONA Natural Oils differentiates the applicant's and respondents' products in that they use different colours. There is no affidavit before the court from any consumer to depict the confusion but just statements. Additionally, not every use of the trade mark by a competitor constitutes an infringement- *Discovery Ltd and ors vs Liberty Group Ltd* , 2020 (4) SA 160 (g) AD 22. Lastly the respondent contends that it is protected by the prior use defence as outlined in *Marshall and anor, (supra)*.

In my view the issues that arise in this matter are as follows:-

1. The legal implications of application and registration of a trade mark.
2. Prior use
3. Descriptiveness of the word FESO
4. Deception and confusion in relation to a trademark.

It is noted that the applicant applied and registered its trade mark under ARIPO. There is no case law that I could find on the implications of this. However the situation is covered in the Act through the provisions of s97A as follows:-

“Any trade mark which has been registered by the ARIPO Office in accordance with the Protocol and in respect of which Zimbabwe has been designated—

(a) shall have the same effect, *mutatis mutandis*, as a trade mark registered under this Act; and

(b) shall be accorded the same protection, *mutatis mutandis*, as a trade mark registered in accordance with section ninety-seven.”

Expressed simply, a registration under ARIPO is just as good as one under the Act. What then exactly are these rights? I had occasion to deal with this issue in *INNSCOR Africa Limited vs. Slice Distributors (pvt) Ltd and anor*, HH-06-23 as follows,

The law on trademark infringement has been set in this and other jurisdictions. In the *Cairns Foods Limited vs Netrade* matter (*supra*), the Supreme Court had this to say,

“Perhaps the starting point in examining the law governing trademarks is the effect of registration itself. A trademark is defined in the interpretation provision, namely s2 of the Trade Marks Act [*Chapter 26:04*] (the Act), in the following words:

“trade mark means a mark which is used or proposed to be used in relation to goods or services for the purpose of:

- (a) indicating a connection in the course of trade between the goods or services and some person having the right either as proprietor or as a registered user to use the mark whether with or without any indication of the identity of that person, and
- (b) distinguishing the goods or services in relation to which the mark is used or proposed to be used from the same kind of goods or services connected in the course of trade with any other persons, but does not include a certification mark.” (The underlining is for emphasis)

In terms of s 5 (4) of the Act, the register of trade marks is *prima facie*, evidence of any matter required or authorised by or under the Act to be entered therein. In resolving the dispute between the parties, therefore, the contents of and what appears in the register is critical.

The provision governing infringements of trademarks is s8(1) of the Act which reads;

“(1) Subject to this section and sections ten and eleven, a registered trade mark shall be infringed by any unauthorised use in the course of trade, whether as a trade mark or otherwise of a mark that is identical to the registered trade mark or so nearly resembling it as is to be likely to deceive or cause confusion, where that mark is used in relation to the same or similar goods or services as those in respect of which the trade mark is registered.” (underlying is for emphasis).”

In *casu*, the trade marks that are contested are the following,

PARTY	SYMBOL
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Applicant	
Respondent	

The respondent submits that it had prior use of the word FESO. DUBE(JP) in the *Marshall* case dealt extensively with the defence of prior use as follows:-

“Trademark registration is not absolute. The general rule is that a person who obtains registration of a trade mark can prevent others from using that mark. Prior use is one of the exceptions to this rule and is aimed at unfair competition. Where one uses an unregistered mark before registration of another similar or identical mark, he has an entitlement to continue using the unregistered mark. He acquires what are known as prior rights. The right to prior use arises where two or more persons use their marks without registration or where there is a subsequent registration by one of the parties. The concept entails that an owner may acquire rights in an unregistered mark through use. The concept of prior use has its roots under common law.

Prior use vests certain rights in a user which are known as vested rights. Section 10 of the Act provides for vested rights and stipulate as follows:

“10 Saving of vested rights

Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it, in relation to products or services in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date anterior to—

- (a) the use of the first-mentioned trade mark in relation to those products or services by the proprietor or a predecessor in title of his; or
- (b) the registration of the first-mentioned trade mark in respect of those products or services in the name of the proprietor or a predecessor in title of his;

Whichever is the earlier, or,”

Section 10 makes provision for vested rights. It provides that use of an unregistered trademark that precedes a subsequent registration has no effect of infringing the registration. Vested rights are acquired without any formalities of registration. A registered proprietor of a mark has no better rights than a person who has had continuous and bona fide prior use of a similar or identical mark prior to the use of the mark by the registered proprietor. A registered

owner has no entitlement to interfere with or restrain the use by any person of the trade mark for the reason that it is identical with or nearly resembling a registered trademark in relation to products or services for as long as it is shown that the respondent was the first person to use the mark and has had continuous and uninterrupted use of the unregistered mark from a date before the use or registration of the registered trade mark in relation to goods or services. In effect, s10 codifies the common law concept of prior use”.

Further, that:-

“Once there is a challenge, the issue that arises is whether use of the unregistered mark should continue. It is the party that used the mark first who acquires the right of prior use. He has to show that he started using his mark before the other mark was registered. Prior use protects the product concerned, the logo, its name or marks without registration and enables the proprietor of an unregistered trade mark to operate and use a mark in one’s geographical area. The right takes precedence over a registered trademark and prevails even in a case where there is a subsequent registration of the mark.

The user must show that he has been using the impugned mark prior to the registration of the mark, continuously and that the use was *bona fide*. The date when the mark was first used is significant for purposes of determining who has prior use. A defense of prior use does not attack the validity of a subsequent trademark registration. The person relying on the defense of prior use must be the user of the unregistered mark. The use of the impugned mark must be shown to have occurred prior to the registration application and trademark owner’s use of the registered trademark, see *Lin Mingkai v Fuyun* [2018] ZGFMZ 43, 3 September 2019. Prior use is usually raised in unfair competition cases as a cause of action”.

In *casu*, the respondent’s opposing affidavit is scant on detail. There is no information on when it started to use the name FESO on its products or where or how. The claim is a bold assertion and in my view, it is not enough to sustain the defence of prior use. See also *BAYER AKTIENGESELLSCHAFT vs. MILLBORROW HEALTH ANIMAL ZIMBABWE (PVT) LTD* HH-04-25 on prior use.

The respondent has submitted that the word FESO is descriptive and that the applicant has no monopoly over it. It relies on s11(1)(b) of the Act which reads as follows:-

11. Saving of use of name, address or description of goods and of utilitarian features of distinguishing guise

(1) The registration of a trade mark shall not interfere with—

(b) the use by any person of any bona fide description of the character or quality of his goods or services.

In the *Marshall* case, the court had this to say on descriptiveness,

“Registration of a mark constitutes *prima facie* evidence of validity. A trademark registration affords the registered owner or proprietor use of a mark and protection. The onus is on a party challenging descriptiveness of a mark to prove it. Descriptiveness can be used as a challenge to an application for registration of a mark or in trademark infringement cases where a mark is said to be descriptive.

Where there is an allegation that a trademark is descriptive, the court must ask whether the mark describes the essence of the product in issue. See *Kellogg Co v Cairns Foods Limited* (1997) (2) ZLR 230 (S) where the court considered the use of the words “Froot Loops” and held as follows:

“...Froot Loops” is merely partly descriptive, in that it does not describe the essential feature of the product—that is it is a breakfast cereal”

Creative or made-up words are capable of protection and a descriptive mark harder to enforce. Descriptive marks are censured to curb monopoly over the use of a word or phrase.”

The respondent contends that the word FESO describes the ingredient contained in its products and is found only on those that contains this product. Regrettably, both parties did not deal extensively with this aspect in the heads of argument and submissions in court. I had occasion to google on FESO and two items caught my attention of which I take judicial notice of. The first was a newspaper article in the Herald newspaper of the 23rd of November 2016 titled, “ The coming of soap to our village”. Depicted in the article is a picture of the FESO plant and its indigenous names. The author vividly describes the plant and the experiences and perspectives of her mother and grandmother. She concludes by stating, “ *In this global world, we have the choice to choose what products we can use. Mbuya vaMandiworesa would ululate today, if she was to see that some health stores promote the use of ruredzo as shampoo or soap.*” The second article is available on fesoafrika.co.za and is associated with the applicant. I quote part of the write up, “ *Feso is widely occurring and naturally growing wild plant that has been used by women in Zimbabwe to wash their hair since time immemorial. Feso is a creepy crawling plant and if one grinds it with stones, it becomes slimy and foams*”. Unlike the word, “luv”, in the *INNSCOR Africa Limited vs. SLICE distributors (pvt) Ltd and anor*, SC-43-23 that the Supreme Court found to have been an invention of the appellant, in *casu*, the word FESO is not an invention of the applicant. I agree with the respondent that the applicant has no monopoly over use of the word especially in the hair products industry. To that end, I have had regard to the report of Professor Taka Mduluzi in terms of s22(1)(3) of the Civil Evidence Act [Chapter 8:01]. The applicant did not place before the court any contrary report. I must hasten to add that whether or not the trade mark should have been registered is not an issue before the courts. It is one that can only be entertained should there be a challenge to the registration.

The applicant contends that there is deception on the part of the respondent’s part thus causing confusion in the market. The applicant in other words is claiming that the symbols are similar in relation to use of the word FESO. This issue is subsumed under the broad framework of passing-off. This was crystallized in *Kellog Co vs Cairns Foods Ltd* , 1997 (2) ZLR 73 (S) as follows,

Here we are not relying on the common law, as in passing-off, but on the provisions of *Chapter 26:04*. The first question is whether the rights acquired by Kelloggs, by the registration of the trade mark Froot Loops, have been infringed. In terms of s 8(1) of *Chapter 26:04*, those rights are infringed by:–

- “(a) unauthorised use as a trade mark in relation to goods or services in respect of which the trade mark is registered, of a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion; or
- (b) unauthorised use in the course of trade, otherwise than as a trade mark, of a mark identical with or so nearly resembling it as to be likely to deceive or cause confusion if such use is –
- (i) in relation to or in connection with goods or services in respect of which the trade mark is registered; and
- (ii) likely to cause injury or prejudice to the proprietor of the trade mark.”

It seems to me that we are plainly concerned with subsection (a)”.

In *Cairns Foods Limited vs Netrade Marketing (pvt) Ltd*, SC-106-21, the court placed reliance on the internationally recognized *locus classicus* as follows,

The test for infringement was eminently stated in *Plascon Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd* 1984 (3) SA 623 (A) at 640G-641E, relied upon by counsel for the appellant in advancing the argument that there exists the likelihood of deception or confusion. The court stated:

“... a comparison between the mark used by the defendant and the registered mark and, having regard to the similarities and differences in the two marks, an assessment of the impact which the defendant’s mark would make upon the average type of customer who would be likely to purchase the kind of goods to which the marks are applied. The notional customer must be conceived of as a person of average intelligence, having proper eyesight and buying with ordinary caution. The marks must be viewed as they would be encountered in the market place and against the background of relevant surrounding circumstances. The marks must not only be considered side by side, but also separately ... If each of the marks contain a main or dominant feature or idea the likely impact made by this on the mind of the customer must be taken into account.”

As it has been put, marks are remembered rather by general impressions or by some significant or striking feature than by photographic recollection of the whole.” (Underlining added for emphasis).

Further that, “*Deception or confusion is a matter of first impression not an outcome of a study*”. I am indebted to DUBE JP, in the *Marshalls* case for clearly outlining the test for deceptiveness and confusion as follows,

“This approach was followed in *Cairns Foods Ltd v Netrade Marketing (Pvt) Ltd SC 106/21*, where the court cautioned that a court ought not to undertake a forensic audit of the two marks. See also *Uniliver P.L.C. & Another v Vimco (Pvt) Ltd & Anor* HH 175/14; *Vivon Investments (Pvt) Ltd v Win-King Investments (Pvt) Ltd* HH 272/16.

From these cases can be drawn a step- by- step approach to establish if a mark is identical with or so nearly resembling the registered mark as to be likely to deceive or cause confusion as follows:

- a) similarity of the marks
- b) similarity of products or services
- c) the likelihood of confusion arising from the similarities

The court may consider the following factors, the degree of resemblance between the marks, nature of the trade, nature of the products in question, the length of time the trademarks have been in use and distinctiveness of the trademarks or trade names”.

Having made a finding that the word FESO is descriptive, can a court proceed with an inquiry on whether or not infringement has occurred based on the likelihood of confusion? In my

view, it can. Regard being had to the two marks, the trade mark for applicant has the words FESO prominently featuring. It has a pink flower resembling the FESO plant in bloom. It also has the words, “ back to the roots”. It has a black background. That of the respondent has a green background with the words ONA and natural oils in small print. It also has the words as relating to the shampoo, growth “miracle, FESO hair shampoo” and just below that, “ All hair types”. It is common cause that both applicant and respondent are in the same hair growth industry. The applicant attached evidence of what it called the attempt by the respondent to , ‘copy and paste’ what ever it (applicant) had already posted on social media and the confusion created amongst customers judging by the correspondence that it had received.

Applying the test in the *Plascon-Evans* matter, in my view, a notional customer in the market place is likely to be confused when looking at the two marks with the inclusion of the word FESO. If the respondent contends that it used the word to show an ingredient, there is nowhere on its product that depict the words, “ contains FESO”. Infact, the word FESO is featured prominently and in my view this is what draws a notional customer to the product. Indeed, the correspondence attached by the applicant shows this confusion. In my view, a consumer is likely to associate the word FESO with the products of the applicant. The word FESO in my view has acquired a distinctiveness as associated with the applicant.

The applicant seeks relief in terms of s9A of the Act which reads as follows,

Section 9A of the Trademarks Act provides as follows:

“9A. Entitlement to and nature of civil remedies for infringement

(1) Subject to this Act, an infringement of a registered trade mark shall be actionable at the suit of the proprietor and any registered user of the mark.

(2) Subject to this Act, in any proceedings for an infringement of a registered trade mark there shall be available to the plaintiff all such remedies by way of damages, interdict, attachment, the rendering of account, the delivery of improperly marked goods or of articles used or intended to be used for marking goods or otherwise, as are available in respect of the infringement of any other proprietary right.”

The requirements for an interdict have been set out in a plethora of cases including the locus classicus of *Setlogelo v Setlogelo* 1914 AD 221 at 227 as follows:

- (1) A clear right;
- (2) An injury actually committed or reasonably apprehended; and
- (3) The absence of similar or adequate protection by any other ordinary remedy.

In my view, the applicant has established a clear right, that it is the proprietor of the registered trade mark. The respondent is marketing its products that contains FESO as an ingredient using a mark that is likely to cause confusion in the market. The applicant can only be protected by the remedies set out in the Act.

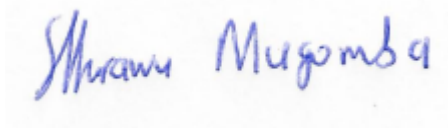
Disposition

The applicant has made out a case of trade mark infringement. It is entitled to the remedies available at law. On costs, this is a very important case in the development of jurisprudence on intellectual property and adds to the growing body of law. In my view, the most appropriate order of costs is that each party to their own.

Accordingly, it is ordered as follows,

1. The respondent be and is hereby interdicted and restrained from infringing the applicant's Trade Mark AP/M/2023/005745 in classes 1, 3 and 35 by the use of a logo with a combination of the words ' FESO' together with a label or any other words which nearly resemble the appellant's trade mark Number AP/M/2023/005745 for its hair products to deceive or cause confusion in relation to the appellant's hair growth products.
2. The respondent be and is hereby interdicted and restrained from using any mark, trade name, label or set up likely to result in its hair growth products being taken to be those of the applicant without clearly distinguishing such products from those of the applicant.
3. The respondent be and is hereby interdicted from passing off its hair growth products as those of the applicant registered under Trade Mark Number AP/M/2023/005745.
4. The respondent shall within seven days of service of this order, deliver to the applicant or the Sheriff for destruction all packaging, labels, posters, wrapping, advertising matter, documents and other material in its possession bearing the word FESO which resembles the applicant's registered trade mark.

5. In the event that the respondent neglects, fails or refuses to comply with paragraph 4 above, the Sheriff be and is hereby authorised to search, seize and destroy all such packaging without further notice.
6. Each party shall bear their own costs.

A handwritten signature in blue ink, reading "Shrawan Mugomba". The signature is written in a cursive style and is centered within a light blue rectangular box.

B NGWENYA LEGAL PRACTICE, applicant's legal practitioners

LUNGA MAZIKANA ATTORNEYS, respondent's legal practitioners