

ZIMBABWE YELLOW PAGES (PRIVATE) LIMITED  
versus  
E-DIRECTORIES (PRIVATE) LIMITED

HIGH COURT OF ZIMBABWE  
DUBE JP  
HARARE, 25 March 2022 & 20 July 2022

### **Opposed Application**

*P.C Fanti*, for the Plaintiff  
*B Murenga*, for the Defendant

DUBE JP

### **Introduction**

The applicant brought a claim in terms of the Trademarks Act [*Chapter 26:04*], the Act, to interdict and restrain the respondent from infringing rights flowing from its trademark, passing off its services and an order for removal of infringing marks and related getups or any confusingly or deceptive similar trademarks from all matter in its possession or control.

### **Background**

The applicant is the registered owner of the Zimbabwe Yellow Pages trade mark. It is a multimedia advertising and communications company registered as part of the its mark and helps sellers connect with buyers of products and services through online, mobile marketing, print advertising and social media. It owns and operates an online business directory through the domain [www.zimyellow.com](http://www.zimyellow.com) and prints a yellow page directory including an annual national phonebook containing all commercial and government contact details in alphabetical format. The Zimbabwe Yellow Pages trademark is in respect of advertising, business management, business administration and office functions in terms of the Act. The applicant's trademark consists of an image of black "walking fingers" enclosed in a rectangular shape with a yellow background with the inscription Zimbabwe Yellow Pages endorsed under the walking fingers logo.

The respondent company was registered in 2014 and uses the brand name E - Yellow Pages and produces the E -Yellow Pages directory which it distributes. It has no registered mark. The applicant averred that

the respondent's use of the marks Zimbabwe Yellow Pages and zimyellowpage and operation of a website at the domain www.zimyellowpage.com. in relation to its advertising services, is service in respect of which the applicant's trademark is registered. It submitted that the respondent infringed its trademark by making use of the mark Zimbabwe Yellow Pages on its online and print products , Zimbabwe Yellow Pages on its zimyellowpage websites without the applicant's permission in respect of identical services as the registered mark. It claims that it has built a substantial reputation or goodwill in the name Zimbabwe Yellow Pages and the walking fingers logo in Zimbabwe and contended that the respondent has committed acts of passing off and is taking advantage of its goodwill and reputation in unfairly competing with it and poaching its clients by using an identical and confusingly similar trademark or getup thereby passing off its goods as the applicant's.

The respondent challenged the propriety of the application on the basis that the applicant's certificate of registration has expired and argued that there is no trademark to talk about. It took issue with averments in the applicant's answering affidavit that it renewed its trademark registration certificate and the attachment of evidence of renewal of registration marked MCR2 and contended that the applicant should not be allowed to introduce new evidence through an answering affidavit, urging the court to dismiss the application . It challenged the validity of the Zimbabwe Yellow Pages trademark on the basis that it is a service name given to the name of the service offered and averred as follows:

“In Zimbabwe there are several sites using this same brand name, for example zimbabweyp.com and Directory Publishers Yellow Pages. It therefore(is) impossible for one to own a product, keyword or service name and make it its own company name. The applicant is trying to personalise a product or keyword or service name and make it its company name. ‘‘Zim’’ is an acronym whilst yellow pages is a product, keyword or service name which is used worldwide . It therefore goes without much stretching that the names Zimbabwe and yellow pages are not capable of private ownership in terms of the law”.

It submitted that as the applicant's service is universally known as Yellow Pages and that Zimbabwe being the name of a country, it should not be allowed to personalise the words Zimbabwe Yellow Pages, contending that the words yellow pages are not capable of trademark protection .In addition ,it argued that it is undesirable to limit other companies who offer similar services and would like to advertise yellow pages directories from doing so. It urged the court to order the applicant to add a conjunction to its trademark so as to make the applicant's trademark strong , arbitrary and distinctive instead of stopping the respondent from using the zimyellowpages and Zimbabwe Yellow Pages marks.

The respondent refuted that it has infringed the applicant's trademark or passed off the applicant's goods as its own. It submitted that its service is like any other yellow pages service and product provider, has a clear 'E' used in conjunction with the words Yellow Pages which is different from the applicant's name "Zimbabwe Yellow Pages" save for the colour yellow which is used on several sites worldwide. It argued that there are notable differences being the domain, the services offered and the marks. It does not own the domain but only uses it for marketing and was not registered in Zimbabwe but is accessible in Zimbabwe like any other online marketing business. It denied infringing the applicant's trademark, its contention being that there is no likelihood of confusion between the respondent's clients and those of the applicant. It maintained that the applicant has failed to prove the elements of misrepresentation, damage and goodwill required for a successful passing off claim.

As regards the propriety of averments in the answering affidavit related to renewal of the certificate of registration of the trademark, I view that the applicant's evidence of renewal of registration marked MCR2 attached to the answering affidavit does not constitute new evidence or fresh allegations and is admissible. The applicant averred in its founding affidavit that "the registration is valid and in full force and effect". The applicant's evidence of renewal of registration marked MCR2 and averments related thereto, has the effect of clarifying the assertion that the registration of the trademark is valid and in full force and effect. The application is properly before the court.

Where there is a challenge to a trademark's entitlement to protection, it ought to be resolved first before an enquiry is carried out to determine allegations of trademark infringement and passing off. An applicant seeking an interdict to restrain infringement of trademark rights and conduct constituting passing off of its products is required to establish a clear right, actual or reasonably apprehended injury and absence of any other adequate remedy by which the applicant can be protected with the same results see *Setlogelo v Setlogelo* 1921 AD 227, see also *Flame Lily Investments (Pvt) Ltd v Zimbabwe Salvage (Pvt)Ltd* 1980 378 .

This dispute centres around use of the words, Zimbabwe Yellow Pages and zimyellowpage. The argument that the applicant's trademark is not capable of protection in terms of the law for the reason that yellow pages are the name of a product or service offered and that Zimbabwe Yellow Pages as a trademark cannot be personalised is essentially a challenge related to genericness of the words Zimbabwe Yellow Pages and zimyellow pages. Although

the respondent did not make any reference to the word generic in its challenge, in reality, the gist of its argument is that the applicant's trademark is generic and is not protectable at law.

I did not form the impression that the respondent thoroughly researched and paid sufficient thought to this challenge. The respondent in its pleadings and argument made persistent reference to "personalisation of yellow pages" and suggested that yellow pages was now a universal term applicable to a particular type of service. Respondent did not proffer any legal backing or authorities for this proposition. All the authorities it cited in this case focus on infringement and passing off and none on the validity of and protection of the trademark. Counsel for the respondent's feeble attempt to set out the historical background to the yellow pages appeared to be an afterthought. Substantial attention ought to have been paid to this issue in the opposing affidavit and heads of argument. The respondent failed to draw specific attention to relevant provisions in the Act.

Likewise, the applicant ought to have anticipated this argument in its founding affidavit and set out the historical background to the term and concept of "yellow pages". Applicant appeared to sidestep the argument that its registered mark was affected by a defect. It chose instead to persist with its argument that its marks were validly registered and that respondent's marks were confusingly similar and that its conduct amounted to passing off. The applicant paid lip service to the point and consequently failed to sufficiently address the respondent's argument on protection of the trademark.

Where a trademark is challenged on the basis that it is generic, it is not enough to rely on the fact that a trademark is registered. Intellectual matters are technical and complex. It is essential for parties to carry out sufficient research before putting pen to paper and crafting pleadings. Courts should not be left guessing what defence a party is raising or be required to carry out research for the parties. It is essential for parties to comprehensively prepare for cases and to properly formulate and contextualise their cases. It is not the responsibility of the court to formulate claims and defences on behalf of parties. More often than not judges find themselves carrying out most of the research in cases they deal with in a bid to do justice between the parties. This approach to litigation ought to be discouraged.

## **What is a generic trademark**

Trademarks can be classified into five different categories; (1) generic (2) descriptive (3) suggestive (4) arbitrary and (5) fanciful, see *Surgicenters of America, Inc. v. Medical Dental Surgeries Co*, 601 F.2d 1011, 1014 (9th Cir.1979). This categorisation of marks is essential and helps in the determination of whether a mark can be protected at law, see also *Filipino Yellow Pages INC v Asian Journal Publications INC* No 98 -55366, a United States Court of Appeals decision of December 1999.

Registration of a trademark does not confer exclusive rights to the registered owner . In terms of s 5 (4) of the Trade Marks Act [*Chapter 26:04*], the Act, registration of a trade mark constitutes *prima facie* evidence of any matter required or authorised by or under the Act to be entered in the register of trademarks. Registration of a trademark raises a presumption of validity of a trademark and implies that the mark is not generic entitling the proprietor of the mark to trademark protection. The applicant placed too much reliance on s 5 (4) .

A generic term is one that is commonly used as a name or description of a service or goods. In *Kendall-Jackson Winery, Ltd. v E. J. Gallo Winery*, 150 F.3d 1042, 1047 n. 8 (9th Cir. 1998), the court said the following of generic marks, “Generic marks give the general name of the product; they embrace an entire class of products.” In *Filipino Yellow Pages*, the court defined a generic term as follows:

“A ‘generic’ term is one that refers, or has come to be understood as referring, to the genus of which the particular product or service is a species. It cannot become a trademark under any circumstances.” *Surgicenters*, 601 F.2d at 1014 (citing *Abercrombie*, 537 F.2d at 9-10). As explained by one commentator, a generic term is “the name of the product or service itself-what [the product] is, and as such the very antithesis of a mark.”

The court stated that in determining whether a term is generic, the "who-are-you/what-are-you" test applies as follows:

“A valid trademark mark answers the buyer's questions ‘Who are you?’ ‘Where do you come from?’ ‘Who vouches for you?’ But the [generic] name of the product answers the question ‘What are you.’ .. ” and states that a mark that answers the buyers questions 'Who are you?' 'Where do you come from?' and 'Who vouches for you?' But the [generic] name of the product answers the question 'What are you?' . *Official Airline Guides , INC V Goss , 6 F 3d1385, 1391R(9th Cir 1993).*(quoting 1JThomas McCarthy , *Trademarks and Unfair Competition* 12.01 (3rd ed 1992) Under this test,”

In *Stuhlberg Int'l Sales Co., Inc. v John D. Brush Co, Inc*, 240 F.3d 832, 840 (9th Cir. 2001), the court held that the test for determining whether a mark is generic is a question of fact and held as follows:

“To determine whether a term has become generic, we look to whether consumers understand the word to refer only to a particular producer's goods or whether the consumer understands the word to refer to the goods themselves.” *KP Permanent Make-Up, Inc.*, 408 F.3d at 604. If buyers understand the term as being identified with "a particular producer's goods or services, it is not generic." *Surgicenters of Am., Inc. v. Medical Dental Surgeries Co.*, 601 F.2d 1011, 1016 (9th Cir. 1979). "But if the word is identified with all such goods or services, regardless of their suppliers, it is generic." *Id.* (citing *King-Seeley Thermos Co. v Aladdin Indus., Inc.*, 321 F.2d 577, 579 (2d Cir. 1963).”

If the primary significance of the trademark is to describe the type of product rather than the producer, the trademark is a generic term and [cannot ] be a valid trademark. See also *Yellow Cab Co. v Yellow Cab of Elk Grove, Inc.* United States Court of Appeals, Ninth Circuit Aug 9, 2005. Generic terms identify the product and not the source of the product. Generic trademarks cannot be protected at law. Testing a trademark to determine if it is generic is good for business because this has the effect of barring practices where businesses ringfence and personalise marks that are universal or constitute service names and discourages unscrupulous business practices and monopoly of service names .

The burden of proving genericness of a registered trademark rests on a respondent to prove that the trademark is not capable of protection under trademark law. The act of registration of a trademark discharges the proprietor's common law burden of proving the validity of the mark. Where the trademark impugned is not registered, which usually happens at registration stage, the burden is on an applicant to prove that his mark is not generic. In this case, the respondent bears the burden of proving that the applicant's registered mark is generic .

The term “yellow pages” is defined in the Thesaurus Dictionary as “a telephone directory or section of a directory usually printed on yellow paper where business products and services are listed alphabetically by field along with classified advertising”. Yellow pages are telephone directories of businesses that lists various industries according to their generic categories, instead of being listed alphabetically. They are used globally and have become associated with the “walking fingers” logo. The name and concept of “yellow pages” was first used in 1883, when a printer in Cheyenne, Wyoming, US is said to have run out of white paper for printing and used yellow paper instead. Reuben H. was the first person to come up with the concept of the Yellow Pages directory in 1886 printed on yellow paper.

In *Filipino*, the court considered the words "Filipino Yellow Pages" looked at the dictionary meaning of the words yellow pages and followed the approach adopted in *Anti-Monopoly, Inc. v General Mills Fun Group*, 611 F.2d 296, 304 (9th Cir.1979) where it was stated that, "if the primary significance of the trademark is to describe the type of product rather than the producer, the trademark is a generic term and cannot be a valid trademark." The court also relied on *AmCan Enters., Inc. v Renzi*, 32 F.3d 233, 234 (7th Cir.1994) for the proposition that the term "yellow pages" has become a generic term for "a local business telephone directory alphabetized by product or directories service. The court held that the words yellow pages are generic with respect to telephone directories and has become "synonymous with business directories throughout the world."

Looking at other jurisdictions, in *Yell Ltd v Giboin & Ors* [2011] EWPC 9 England and Wales, the court dealt with a claim for trademark infringement and passing off challenged on the basis that the trademark and logo is used all over the world in relation to directories, and are generic and not distinctive. The court considered the approach adopted in *Filipino* and remarked that the fact that a trademark is generic in one territory does not mean that it is so in another and that genericness of a trademark is a question of fact. In *Phone Directories Company Australia Pty Ltd v Telstra Corporation Limited* [2014] FCA 373, April 11 2014), the court held that the marks YELLOW and YELLOWBOOK.COM.AU were not registrable as trademarks on the basis that the colour yellow is generic in the context of directories, and that it simply signifies a directory rather than a particular company's directory. There is acceptance in most jurisdictions that the term "Yellow pages" is generic to "a local business directory alphabetized by product or service".

Clearly, Yellow pages are a service name of the goods and services offered. Yellow pages is a name by which the product is known rather than the name of the producer and is a generic name for a business directory. It is a service name of the service offered and is used worldwide. It cannot on its own be protected as a trademark. Generally, it is accepted that the words Yellow Pages lack distinctiveness and are generic. In order to avoid issues of trademark, players in the directories market have resorted to naming these directories slightly differently. In other countries they are called silver pages, town pages or rainbow pages and De Gule Sider (Yellow Pages) in Denmark. "Yellow pages" has become "synonymous with business directories throughout the world."

The applicant makes use of Zimbabwe as part of its trademark in combination with the words yellow pages and has used and copied an international trend of using the yellow pages directories to advertise its services. It is accepted in academic circles that if a trademark containing a country name is registered, the assumption is that either the law of that country permits it or the country concerned has given permission for use of that name. A mark which comprises a name of a country where registered still has to be assessed against other grounds for refusal of registration or validity of a trademark contemplated in law, such as genericness, lack of a distinctive character or non-conformity of the mark with public policy or morality.

Part 15 A of the Act prohibits registration of a trademark that contains a name or abbreviation or initials of the name of, or official sign or hallmark adopted by the State unless authorised by the State. It is not known if the applicant is authorised to use Zimbabwe as part of its trademark. Zimbabwe is defined in Webster's New World College Dictionary, 4<sup>th</sup> Edition as a country in Southern Africa. No doubt "Zimbabwe" is a generic word and is not owned by any particular individual terms.

The question is whether the combination of the words yellow Pages and Zimbabwe is of any assistance to the applicant. The respondent's approach of urging the court to treat the words separately ought to be discouraged. A trademark should not be judged by an examination of its individual parts but as a whole even if its individual components may be generic. "Zimbabwe Yellow Pages" is a composite term and ought to be considered as a whole as it appears in the market place rather than split it into individual terms.

In *Filipino*, the court considered use of the words Filipino Yellow Pages as a composite trademark and refused registration thereof on the basis that it is generic. The court followed the approach adopted in *Surgicentres* where it was held that what must be considered is whether "the consuming public considered the composite term "surgicenter" to mean a surgical center generally speaking, as opposed to a surgical center maintained and operated by the plaintiff and rejected the approach of looking at the individual components of a trademark in order to determine if it is generic. In *Surgicenter*, the court considered the mark "surgicentre" as a trademark and held that the words "surgery" and "centre" were generic after also considering their dictionary meanings and but held that generic individual terms can be combined to form valid composite marks. The "generic plus generic equals generic" approach when considering

whether a composite trademark is generic was discouraged .See also *United States Jaycees v San Francisco Junior Chamber of Commerce* 513 F.2d 1226 (9th Cir. 1975)

The conclusion in *Filipino* was that the words Filipino used in combination with Yellow Pages is generic and cannot be the subject of trademark protection under any circumstances, even with a showing of secondary meaning and that the words Filipino Yellow Pages, even if descriptive rather than generic, are not a valid and protectible trademark with respect to a telephone directory for the Filipino-American community. The court remarked that “words which could not individually become a trademark may become one when taken together” and that the "ultimate test" of genericness is "how a term is understood by the consuming public. It is only where the “significance of the term in the minds of the consuming public is not the product but the producer”, that a trademark is said not to be generic , see also *Anti-Monopoly, Inc. v Gen. Mills Fun Grp*, 611 F.2d 296, 302 (9th Cir.1979);*California Cooler, Inc. v Loretto Winery, Ltd* 774 F.2d 1451 (9th Cir. 1985.

Essential at the end of the day, the court is required to consider whether the consuming public considers the composite term Zimbabwe Yellow Pages and zimyellowpage to mean yellow pages generally speaking, as opposed to a yellow pages directory maintained and operated by the plaintiff. This question ought to be answered in the context of Zimbabwe where the Yellow pages directory is produced and marketed by several publishers. The “who-are-you/what-are-you” test is applicable at this stage of the enquiry. Unfortunately, the court was not addressed on the effect of the composite words constituting the trademark . The respondent did not proffer any evidence on surveys, advertising of the trademark, length and the manner of use of the trademark, the public’s understanding of the words in issue which would have been useful. Consequently, the court is handicapped to fully consider the factual inquiry concerning whether the significance of the words Zimbabwe Yellow Pages in the minds of the consuming public is not the product but the producer. Evidence of the applicant’s customers if relevant would seem to favour the applicant. The respondent has failed to discharge the burden of proving the genericness of the applicant’s trademark .

### **Trademark infringement**

An applicant in a trademark infringement claim has the burden of establishing unauthorised use of its registered trademark , in the course of trade , of an identical mark or a mark so nearly resembling it as to be likely to deceive or cause confusion, in relation to goods and services in

respect of which the trade mark is registered in terms of 8(1) (a) of the Act .The applicant's gripe is with use of the word marks Zimbabwe Yellow Pages and zimyellowpages by the respondent and not the logo. The applicant was the first to use the zimyellowpages mark .The applicant's domain name zimyellowpages ,serves the same function as a trademark , see *Yahoo ,Inc.v Akash Arora & Anor* [1999(19) PTC 201(Del)]. Use of a website to market or sell a product or services using a trademark without authority constitutes use as envisaged by s 2(2) and 2(3) of the Act. The respondent used the mark Zimbabwe Yellow Pages and zimyellowpages for commercial activity to promote its services is use in respect of which the applicant's trademark is registered, and constitutes trademark use in the course of trade as envisaged by the provisions of the law. The respondent's use of the applicant's Zimbabwe Yellow Pages trademark and zimyellowpages on its a website in the course of trade to sell similar or identical goods without consent or authority constitutes trademark infringement .

The test for identity and similarity of marks was laid down in *Plascon Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd* 1984 (3) SA 623 (A). The focus is on the effect and impression the mark has on the notional customer, see also *Cairns Foods v Netrade* where the court stated thus:

“...in infringement proceedings what the court is required to do is to consider the notional use to which the party seeking to enforce registration puts its trademark and protect the monopoly created by the terms of registration,” see *Bata Ltd v Face Fashions CC & Another 2001 (1) SA 844 (SCA).*”

The directories in respect of which the marks are used are of the same colour, shape and are similar. Use of the word marks, Zimbabwe Yellow Pages and zimyellowpage on the respondent's website, Facebook and Linked in pages and social media resemble the applicant's marks and is deceptively similar to the applicant's marks. The fact that the respondent uses zimyellowpage instead of zimyellowpages , thus uses the mark without an 's' does not assist it . There is no need for a forensic audit of the two marks. The respondent's use of the mark Zimbabwe Yellow Pages and zimyellowpage on its online and print products constitutes unauthorised use of an identical and similar marks without the applicant's permission in respect of identical services as the registered mark. The respondent' use of the mark so nearly resembles its mark as to be likely to deceive or cause confusion as the difference between its registered mark and the offending mark is not significant enough causing confusion in the market.

Using words identical or similar to another's trademark as a domain names and conducting similar business is likely to cause confusion. A notional customer looking for the applicant's goods and services on the internet who searches the words Zimbabwe yellow Pages, is likely to come across the respondent's websites and will likely think that he has come across goods and services originating from the applicant. The respondent's use of Zimbabwe Yellow Pages and zimyellowpages online amounts to unauthorised use of a mark so nearly resembling its mark as to be likely to deceive or cause confusion. A directory called Zimbabwe Yellow Pages is likely to be confused with an E – Yellow pages directory. The respondent's zimyellowpage and Zimbabwe Yellow Pages marks are identical and similar to the applicant's trademark.

In determining the likelihood of confusion, the focus is on the notional customer and his perception of the product, see *Plascon Evans* case. As held in *Bata Face Fashions CC v 2001* (1) SA 844 (SCA),

“... the likelihood of confusion must ‘be appreciated globally ‘ and that the ‘global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind in particular their distinctive and dominant components.’”

The respondent produces and distributes printed hardcopy directory listings annually bearing the mark Zimbabwe Yellow Pages, see annex ED1. The mark zimyellowpage appears on the front of the booklet and Zimbabwe Yellow Pages is printed on the spine of the booklet. The respondent operates and controls a website at the domain [www.zimyellowpage.com](http://www.zimyellowpage.com). The words Zimbabwe Yellow Pages appear on the respondent's webpage. The respondent has been using the applicant's registered mark on its domain and controls a Facebook page with the name Zimbabwe Business directory which it uses to advertise its services to the public and uses the hashtag # Zimbabwe Yellow Pages. It has a Linked In page with the name Zimbabwe Yellow Pages. The applicant's registered mark appears on the respondent's social media pages and when customers search applicant's company name, Zimbabwe Yellow Pages online, they are likely to be directed to the respondent's online platforms and associate those platforms with the applicant. The dominant feature in the registered marks is the words Zimbabwe Yellow Pages. The use of the words Zimbabwe Yellow Pages and zimyellowpage by the respondent in relation to its advertising services is use in respect of which the applicant's trademark is registered. It is unauthorised use of an identical and confusingly identical mark in the course of trade. Annexure C3 an E- Directories(Pvt) Ltd form confirms use in the course of trade.

The goods and services offered, being the printed and online directories are the same and the questioned marks similar. The party's products and services are marketed in the same way. The use of the marks by the respondent raises the possibility of the public being likely to be confused regarding the origins of the goods or services.

A notional customer who sees the words Zimbabwe Yellow Pages on the spine of the respondent's advertising booklet, is likely to buy it thinking that it is the applicant's. Similarities such as these raise the possibility that internet users would be thinking that the websites, the products marketed and marks have a common source or connection and are likely to mislead the public into believing that they are buying the applicant's goods. Use of the words zimyellowpage and Zimbabwe Yellow Pages is likely to deceive and cause confusion.

When a notional customer searches Zimbabwe Yellow Pages and encounters the respondent's webpage, zimyellowpages, and e-yellow pages he is likely to assume that the website belongs to and is dealing with the applicant's goods and services. A notional customer looking for advertising services who sees the words Zimbabwe Yellow Pages and zimyellowpage would remember the words and not necessarily have a recollection of the applicant's mark as a whole. The use amounts to use of an identical and confusingly similar mark to that of the applicant.

The respondent's use of the marks has already caused confusion in the market with the applicant's customers confusing the respondent's goods for the applicant's. Two customers paid the respondent for advertising services believing that they were paying for the applicant's services. The applicant produced affidavits and emails from its customers, who stated that they had come under the impression that the respondent and the applicant were connected. A customer who sent payment to the respondent instead of the applicant states as follows in an affidavit; "I'm a bit confused as to what is happening here. Are you all or the same companies." When she engaged the respondent, she clearly thought that she was seeking the services of the applicant. This resulted from use of similar marks on similar goods and services resulting in confusion in the market regarding the origins of goods.

An applicant in a trademark infringement is not required to show evidence of actual confusion. Nevertheless, there is actual evidence of confusion where customers have been deceived or confused about the origins of the directory products and services. This shows that the respondent's marks did in fact mislead some customers.

## Passing off

Passing off is a delict that occurs when a business misrepresents and misleads prospective customers into believing that the goods it markets and supplies customers are actually those of another in a bid to benefit from its goodwill or reputation thereby injuring its business. The passing off action seeks to protect not only the applicant's business from unfair trading and competition. The protection extends to the consumers of the product and services concerned.

In *Zimbabwe Gelatin Pvt Ltd v Cairns Foods (Pvt) Ltd* (1) ZLR 252 (S) the court stated the purpose of the delict as follows:

“The delict of passing off is not intended to stifle competition but unfair competition based on representing one's goods as being those of another... What is wrong in this case is for the appellant to manufacture a similar product and then give it the same name as that of the respondent's product “See also *Cairns Foods v Netrade* SC 6/21; *Woolworth & Company (Zimbabwe) Ltd v The W Store & Another* 1998 (2) ZLR 402 (S), where the court quoted sentiments expressed by Harms JA in *Caterham Car Sales & Coachworks Ltd v Birkin Cars (Pty) Ltd* 1998 (3) SA 938 (SCA).”

In *Reckitt & Coleman Products Ltd v Borden Inc and Ors* [1990] 1 All ER 873 the court said the following of the delict, ‘no man may pass off his goods as those of another’. The requirements of the delict of passing off were laid out in *Erven Warmink BV v J Townsend & Sons* (Hull Ltd [1979] AC 731, [1979] 2 ALL ER 927 @ 932, as follows:

“My Lords, AG Spalding & Bros v A.W Gamage Ltd (1915 ) 84 LJ CH 449 and later cases make it possible to identify five characteristics which must be present in order to create a valid cause of action for passing off ; (1) a misrepresentation (2) made by a trader in the course of business (3) to prospective customers of his or ultimate consumers of goods and services supplied by him (4) which is calculated to injure the business or goodwill of another trader ( in the sense that this is a reasonably foreseeable consequence) ( 5) which causes actual damage to the business or goodwill of a trader by whom the action is brought or ( in a quia timet action) will probably do so ‘’.

A claimant must establish the existence of goodwill or reputation. Goodwill required is in the form of customers. It must be shown that the applicant has a good customer base and that its goodwill or reputation is injured by the use of the words Zimbabwe Yellow Pages and zimyellowpages. Where reputation as well as a good customer base is proved , the balance tips more in favour of the proprietor of the trademark. There must be some misrepresentation in the course of business by the respondent to the general public leading or likely to lead the

public into believing that the goods or services offered by the respondent belong to the applicant thereby causing some confusion as regards the identity of the goods and services offered and proof of actual or potential damage to it resulting from the misrepresentation. The court must strike a balance between the public interest of free competition and the need to protecting a proprietor of a trademark against unfair competition. Lastly, there must be actual or potential damage to the drawing power of the applicant's business, resulting from the misrepresentation see *Caterham Car Sales & Coachworks (Pvt) Ltd* 1998 (3)SA 938 (A); *Reckitt & Colman Products Ltd. v Borden Inc* [1990] 1 WLR 491.

The applicant has accumulated goodwill for its name and built a solid reputation and considerable goodwill in the trademark by virtue of extensive use as a company name, trading name and its brand name. The words Zimbabwe Yellow Pages and zimyellowpages is closely related to it, its business, reputation and goodwill since 2006 when it has been using the trademark. It has used it openly through its print and online business directory and the domain zimyellowpages and was in the market 8 years before the respondent started using Zimbabwe Yellow Pages as a mark. It has through time established notable goodwill in the name Zimbabwe Yellow Pages. It has presence in the directories market and the name Zimbabwe Yellow Pages has become distinctive with the yellow pages directory. It has put time, money and effort into developing and maintaining markets for its services. The web pages or social media references prove extensive advertising and the evidence of its customers who thought they were buying applicant's goods shows the link made by customers as regards its getup of the goods and services and the identity of the applicant lending support to a finding of goodwill. The name and trademark Zimbabwe Yellow Pages has become synonymous in Zimbabwe with the applicant.

The respondent's goods and services are branded with the applicant's marks. It operates and controls a website at the domain. zimyellowpage.com and the words Zimbabwe Yellow Pages appear prominently on the respondent's website homepage. It owns and controls a Facebook page with the name Zimbabwe Business Directory where it advertises its services using the hashtag# Zimbabwe Yellow Pages, and has a LinkedIn page with the name Zimbabwe Yellow Pages. The respondent produces printed hardcopy directories listings annually which bear the mark Zimbabwe Yellow Pages. The mark zimyellowpages appears prominently on the front of a booklet it produces and Zimbabwe Yellow Pages is printed in large print on the spine of the booklet. The marks are associated with the applicant's name, product and services and

word trademark and are used these in the course of its trade thereby misrepresenting the applicant's tradename, trademark in the course of its own trade to its prospective customers and consumers of goods and services supplied by it, as its own, without the consent of the applicant.

The test for confusion in passing off cases is whether the direct and indirect consumer of the goods and products is likely to be confused by the misrepresentation. In *Reckitt and Coleman*, the court held that "Mere confusion which does not lead to sale is not sufficient". The misrepresentation arising out of use of the words zimyellowpage and Zimbabwe Yellow Pages causes deception and is likely to deceive consumers as to the identity of the goods and services offered. The respondent's use of the applicant's marks did indeed lead the public to believe that the goods and services it offers are those of the applicant, resulting in them buying the respondent's goods instead of the applicant's, thereby confusing them. This fact is confirmed by direct evidence of confusion from customers. What must be appreciated is that it is not every customer who has to be confused. The direct evidence of the two customers suffices.

The respondent through its use of the Zimbabwe Yellow Pages and zimyellowpage marks used deceptively similar and confusing marks and misrepresented that its directories are those of the applicant. The respondent has tried to take advantage and associate with the applicant's trademark. The applicant has lost sales as a result of the misrepresentation. The respondent's actions are an attempt to associate with the applicant's trademark, exploit the applicant's goodwill associated with the mark and calculated to injure the applicant's business through the goodwill attaching to it.

The applicant being the registered proprietor of the trademark has lost business and continues to suffer harm as a result of the unauthorised use of the impugned marks. The respondent was aware of the existence of the applicant's goods and services and marks and nevertheless went on to start a similar business, offers the same goods and services and uses similar marks for its products and services. It acted in bad faith. The use by the respondent of the applicant's trademark does not constitute fair competition, constitutes passing off and is offensive. The applicant established a clear right to bar other users of similar or identical marks from using them without its authority and ask that the respondent remove the marks Zimbabwe Yellow Pages, zimyellowpage and related getup or any confusingly similar or deceptive marks from all matter in their possession or control. If the respondent's conduct is not stopped, there is a

likelihood or reasonable apprehension of continuation of injury in the form of loss to its business resulting from the unauthorised use of marks similar to its own in relation to advertising services. There is no other alternative remedy open to the applicant to stop the conduct complained of which remedy can adequately protect it with the same results other than an interdict.

As regards costs, I must that recognize in most claims for infringement of trademark and passing off, the practice is to warn the other party that it is infringing intellectual property rights and usually a cease and desist letter is written. It cannot be correct that in every instance where a losing party has been given a warning and litigation pursued, costs ought to be awarded on a higher scale. There must be some other conduct warranting punitive costs . I do not find any compelling reasons to penalise the respondent with an order of costs on a higher scale.

Accordingly, it is ordered as follows:

1. It is declared that, in terms of the Trade Marks Act, the respondent has infringed trade mark registration number AP/M/2009/000786.
2. Respondent, its employees, agents and any person acting through it be and are hereby interdicted and restrained from infringing the rights of the applicant flowing from trade mark registration number AP/M/2009/000786 by using, in the course of trade, in relation to services identical to the services included in trade mark registration number AP/M/2009/000786, the identical mark or any mark so similar thereto as to be likely to deceive or cause confusion.
3. Respondent be and is hereby interdicted and restrained from passing off its services as being those of the applicant or as being connected with those of the applicant in the course of trade, by the use of the marks: Zimbabwe Yellow Pages, zimyellowpage and related get up, or any other trade mark or get-up that is confusingly similar to the applicant's trade and get-up.
4. Respondent is ordered to remove the marks: Zimbabwe Yellow Pages, zimyellowpage and related get up, or any confusingly or deceptively similar trade marks, from all matter in their possession or under its control, including all signs, labels, websites, social media pages, promotional and advertising material, packaging, stationery and other printed or electronic matter of any nature and where the marks are inseparable or

incapable of being removed from such material to which they have been applied, delivering up such matter to the applicant.

5. Respondent shall pay the applicant's costs of suit.

*MawereSibanda Commercial Lawyers*, applicant's legal practitioners  
*M.T Chiwaridzo Attorneys –at-Law*, respondent's legal practitioners