

**THE REPUBLIC OF UGANDA  
IN THE HIGH COURT OF UGANDA AT KAMPALA  
(COMMERCIAL COURT DIVISION)  
HCCS NO. 3 OF 2011**

**TUSKYS (U) LTD:.....PLAINTIFF  
VEVRSUS  
TUSKER MATTRESSES (U) LTD:.....DEFENDANT**

**BEFORE : HON. LADY JUSTICE HELLEN OBURA**

**JUDGMENT**

On 1<sup>st</sup> December 2008 **Tuskys (U) Ltd**, the plaintiff company which was incorporated in Uganda on the 7<sup>th</sup> of July 2008 registered a trademark in Part A called “**TUSKYS**” in respect of goods in Class 18, to wit: arts and crafts and was issued with Certificate of Registration No. 31804 (Exhibit P1). The plaintiff created an internet domain name “TUSKYS UGANDA” on 18<sup>th</sup> December 2008 as well as a website under the name [www.tuskysuganda.com](http://www.tuskysuganda.com). It is the plaintiff’s case that it does e-commerce in fulfillment of its objectives through its internet domain and website.

On the other hand, on the 11<sup>th</sup> of February 2009 Tusker Mattresses Ltd a Kenyan registered holding company of the defendant company registered a trademark in Part A Class 16 in the name and style of:

**“Time To Go  
TUSKYS  
Your Friendly Supermarket”.**

The defendant company which was assigned the trademark runs retail chain supermarkets in Kampala under the above stated trademark.

The plaintiff brought this suit alleging that its trademark is being infringed by the defendant who is operating its supermarkets under the name “**TUSKYS**”. The plaintiff in its amended plaint is seeking orders for a permanent injunction restraining the defendant from any further use of the plaintiff’s registered trademark, general damages for the infringement, interest and costs of the suit.

The defendant in its amended written statement of defence (WSD) denies the alleged infringement and contends that it operates several supermarkets around Kampala under its registered trademark “Time to Go, TUSKYS, Your Friendly Supermarket”. Furthermore, that its trademark is used in respect of a different class of goods (16) while the plaintiff’s is in respect of goods in class 18 and as such there is no likelihood of confusion in respect of the goods or among the customers.

At the scheduling conference and hearing of the case, the plaintiff was represented by Mr. Alex Kibandama of M/S Synergy Solicitors & Advocates and Mr. Masereka of M/S Okwakol & Co. Advocates. I also note that subsequently, a notice of change of advocate by which court was notified that M/S ENS Africa Advocates had taken over conduct of the case from M/S Synergy Solicitors & Advocates was filed. The defendant was initially represented by Mr. John Magezi of M/S Magezi, Ibale & Co. Advocates but Mr. Lugoolobi Hamidu of M/S Ayigihugu & Co. Advocates appearing jointly with Mr. Nionzima Vianne later took over conduct of the case.

The facts agreed upon in the joint scheduling memorandum and affirmed at the scheduling conference are that:-

1. The plaintiff is the registered proprietor of “TUSKYS” trademark in Uganda in respect of goods in class 18 (arts and crafts).
2. The defendant is the registered proprietor of the “Time to Go, Tuskys, Your Friendly Supermarket” trademark in Uganda in respect of goods in class 16 and is involved in the business of running supermarket retail chain under their registered trademark.
3. The defendant/respondent duly complied with the orders of Hon. Justice Hellen Obura and accordingly rebranded all its shop and items to reflect their registered trademark.
4. The plaintiff avers that the defendant’s use of the word Tuskys mark in conduct of their business is an infringement of their trademark for which its reputation and trade pattern has been greatly injured.

The parties agreed on two issues for the determination of this court, namely;

1. Whether the defendant’s registration and use of trademark registered under No. 31953 in class 16 is an infringement of the plaintiff’s trademark registration No. 31804 in Class 18.
2. Whether the plaintiff is entitled to the reliefs claimed.

The parties agreed to file witness statements for their respective witnesses and they did so. The plaintiff called only one witness while the defendant called three witnesses.

Mr. Daniel Rukundo Mugenga (PW) stated in his witness statement that he has been the managing director of the plaintiff company since its incorporation in November 2008. He testified that he came to know about the defendant company sometime in November 2010 when he proceeded to Goodprice Supermarket in Ntinda to buy a bottle of mineral water and he was handed a receipt with the mark and word “TUSKYS” which immediately caught his attention. Below the mark was the defendant’s name. According to him, he made an inquiry from the lady and got to learn that the defendant who the lady knew and referred to as “TUSKYS” are a supermarket chain.

PW stated further that he informed his lawyers who investigated the matter and found that the defendant had also registered a mark with the word “TUSKYS” and yet there is no relationship between his company Tuskys (U) Ltd which primarily engages in the business of worldwide advertising, selling, promoting and distributing arts and crafts especially made by

women. PW contends that he has items namely; receipts, a polythene bag, photographs of the defendant's signs on the building and its trademark registration in support of his claim that the defendant is using the mark "TUSKYS".

In addition to what is stated in the witness statement, PW also testified orally about the plaintiff's facebook page whose printout was admitted as Exhibit P.12 (i)-(ix) shortly before the trial commenced. He stated that he opened the facebook page in January 2012 for purposes of interacting with the plaintiff's customers, potential customers and investors. He testified that the page was dormant until August 2012 when the plaintiff company was ranked No. 1 by VC4africa a company based in Netherlands as the most venture for Africa because of its growth plans for locally made products. It was his evidence that the response by the plaintiff company to the ranking generated interest and 638 persons viewed the post.

During cross-examination, PW confirmed that all communications on the facebook page were made after 15<sup>th</sup> August 2012 and conceded that if he had not posted a facebook account on the plaintiff's website they would not have generated all the communications exhibited as P12 (i)-(ix). He also conceded that when he registered the trademark in Uganda he knew that it existed in Kenya because he had seen it there where he also does business. He stated furthermore that he knew that the mark was associated with supermarkets.

On the defendant's side the 1<sup>st</sup> witness (DW1) was Mr. Kelvin Karungu who stated that he is the e-business manager for Tusker Mattresses Ltd and its subsidiaries. He testified that as the e-manager his role is to develop and execute on-line marketing strategies and maintain customer base, establish goals for the company's e-commerce strategies, grow the company's market share and recommend expansion plans to management, and generate non-product related sales revenue. He also testified that the defendant company owns and operates "Tuskys.com" domain name which it registered in 2006 and it also launched/set up a website, [www.tuskys.com](http://www.tuskys.com) on or about the 30<sup>th</sup> day of December 2011 under his supervision and he confirms that there was no advertisement or any display of the defendant's merchandise or product on the website.

According to him, any advertisement that may have appeared on any website purporting to be that of Tusker Mattresses Ltd before December 2011 was/is doctored and part of a scam of unknown intentions and was not authorized by the defendant. He stated that the defendant operates an email address [info.ug@tuskys.com](mailto:info.ug@tuskys.com) which was created in 2009 for its administration and it is hosted under the Tusker Mattresses Ltd domain name, tuskys.com which he oversees, controls and manages.

On cross-examination he stated that Tusker Mattresses Ltd is the holding company for Tusker Mattresses (U) Ltd and so decisions are made at the head office based on strategy and any business decision is then implemented in both Kenya and Uganda. He also stated that the defendant company has an online presence on its website which serves Tusker Mattresses (K) Ltd and Tusker Mattresses (U) Ltd. The website has information about: - the locations of the supermarkets in Kenyan and Uganda as well as the contact details, sales strategies and the

products that are sold. He explained that if one googles the word “Tuskys”, “tuskys.com” would appear and if one clicks on that it would bring Tuskys Uganda and Kenya.

He testified further that tuskys.co.ug is not the defendant’s domain name in Uganda because by the time the company came to Uganda that domain name had already been taken up by another firm. When DW1 was referred to Exhibit P10 (ix), he stated that according to the content of that email the sender is trying to look for the IT manager of the defendant company.

On cross examination in reference to paragraph 7 of his witness statement, DW1 confirmed that the defendant company as well as the holding company in Kenya did not have a web presence until 2011 when the website was launched. He said that he used the strong words “doctored” and “scam of unknown intentions” in paragraph 8 of his witness statement to emphasize the point that Tusker Mattresses Ltd did not have a website at that time so anything purportedly posted on its website could not have been done by it.

In that regard, he explained that there is a lot of scam in the e-business or online world which has a lot of spamming of emails, fake advertisements which purport to come from a certain location and that is why you get things like hacking into a website. He also explained that there can be different links where people are told for example to type [www.tuskys.com](http://www.tuskys.com) and it turns out to be a different link which points to a different location. On this point, he concluded that there are many fraudulent websites, for example one can create a website and claim that it is for Tusker Mattresses.

On re-examination he clarified that Exhibit P9 (i) is the advertisement posted on 26<sup>th</sup> November 2010 which he referred to in his witness statement. He further clarified that the address in Exhibit P9 (ii) is for the plaintiff and not the defendant’s and the domain tuskys.co.ug which appears in Exhibit D 7 (i) which was registered on 12<sup>th</sup> January 2011 is for the defendant. As regards D6 (v), he clarified that the two email addresses stated there are not displayed anywhere on the defendant’s website. He also confirmed that Mr. Chris Kibathi who is mentioned in P10 (ix) works with Tusker Mattresses (K) Ltd.

The defendant’s 2<sup>nd</sup> witness (DW2) was Mr. Steven Makuha Kamau, who is the managing director of Tusker Mattresses Kenya and Uganda. He stated in his witness statement that the defendant company which was incorporated under the laws of Uganda is a subsidiary of Tusker Mattresses Ltd of Kenya which has for over ten years operated under the “Tuskys Your Friendly Supermarket” brand name. It was his evidence that in March 2009 Tusker Mattresses Ltd assigned all its rights, title and interests in the said trade name together with the goodwill of the business to which the trademark relates to the defendant which applied to register it under the name “Tuskys Time To Go”, “Your Friendly Supermarket” on the 11<sup>th</sup> February 2009 and the same was gazetted in the Uganda Gazette of 3<sup>rd</sup> July 2009, Vol. C11 No.31 erroneously as “Your Friendly Supermarket”. He stated that the correct representation “Time To Go, Tuskys, Your Friendly Supermarket” was gazetted in a corrigendum of

Uganda Gazette of 13<sup>th</sup> November 2009 and a Certificate of Registration No. 31953 was issued in respect of goods in Class 16.

He also stated that the defendant uses variously/interchangeably the slogans/phrases such as, “pay less, get more, everyday” which is aimed at boosting sales and inspiring customers. He concluded that registration of the defendant’s trademark is bona fide with no intent to confuse and the defendant does not have or operate any website in Uganda apart from [www.tuskys.com](http://www.tuskys.com) restrictively operated by its principal company Tusker Mattresses in Kenya.

On cross examination, he testified that he was the managing director when they rolled out the businesses of Tusker Mattresses Ltd which is the owner of “Time To Go Tuskys Supermarkets” in Uganda in 2009. It is his testimony that the intellectual property of Tusker Mattresses Ltd was a key factor in the roll-out to Uganda because they wanted the same face in Kenya with the brand name “Tuskys” to be in Uganda. According to him the brand name “Tuskys” was registered in Kenya but he could not confirm the year of registration and the trademark number.

DW2 confirmed that in Kenya they have registered “Tuskys Local” and “Tuskys Chap-chap” but he could not confirm that they registered “Tuskys Night & Day” and “Time To Go Tuskys Supermarket”. He later stated that they have not registered “Time To Go, Tuskys, Your Friendly Supermarket” in Kenya although they started using it. When he was shown a deed of assignment of a trademark and Exhibit D1 being the trademark he stated that the trademark that was registered in Kenya as No. 59526 is “Tuskys Your Friendly Supermarket” and it is the same that was assigned to the defendant. He also confirmed that Exhibit D2 is the trademark that was registered in Uganda.

On re-examination, DW2 clarified that the trademark assigned to the defendant by Tusker Mattresses Ltd is the one in schedule “A” to the Deed of Assignment which is “Time To Go Tuskys Your Friendly Supermarket”. He also clarified that it was Tusker Mattresses Ltd that applied for registration of the trademark in Uganda and it is the registered owner of the trademark. He explained that there are different taglines used by the company at different times to sell the brand “Tuskys”. They include: **“Your Friendly Supermarket”, “Time To Go”, “pay less, get more, everyday” “Tuskys Always Fresh”**

The defendant’s 3<sup>rd</sup> and last witness was Mr. Nginyi Patrick Kairu who is an attorney duly appointed by the defendant to represent them in Uganda. He testified that he is a Kenyan and an architect who came to Uganda in 1996 and he started working with Tuskys in 2008/2009 when he introduced it to the Ugandan market and also helped in its registration. He stated that he was privy to a discussion in which the managing director of the defendant company instructed the lawyers to register the trademark with the words “Time To Go TUSKYS Your Friendly Supermarket” but they instead erroneously only put “Your Friendly Supermarket” and this was corrected by a corrigendum (Exhibit D4).

It was the testimony of DW3 that the claim by the plaintiff is frivolous because its trademark is under a different class of goods which are not similar to the defendant's and the two logos are also completely different and so the two trademarks can co-exist without confusing the public. Asked about some postings on the net (Exhibit P9), he stated that the defendant company does not have any on-line presence. He remarked that the posting has nothing to do with the defendant and it must have been posted by people who do not know the operations of the company.

When shown Exhibits P8 (i) and P8 (ii) he acknowledged that they are the defendant's logo and the word "TUSKYS" come out more prominently. He also said they have since abandoned the marks in Exhibits P6 and P7 which were used before the court order.

In re-examination, he explained that during the time of taking over of some businesses by the defendant there were problems that ended up in court and the sign posts and all the markings in the buildings were done through a court order as a result of which the sign posts were even put up by a Court Bailiff. Furthermore, that immediately thereafter the defendant in that case sought a court order to maintain the status quo when the signs were already up and so there was nothing much that could be done to correct the mistakes that were made. However, as soon as they got a court order in respect of this case they moved and made the changes then reported back to court with photographs of the status of each of the shops.

As regards Exhibits P9 (i) and P9 (ii), DW3 stated that it appears they were posted by an on-line directory but to the best of his knowledge they did not order it.

At the close of the defendant's case counsels agreed to file written submissions which they did and have been considered in this judgment. Counsel for the plaintiff raised two preliminary legal issues which in his view became apparent during the trial and if resolved can dispose of the entire suit. These are:-

1. Contempt of court by the defendant's alleged continuous disobedience of the court order in Misc. Application No. 4 of 2011.
2. Failure by the plaintiff to follow the due process established by law when registering the offending mark.

On the 1<sup>st</sup> preliminary issue, counsel for the plaintiff submitted that the plaintiff vide Misc. Application No. 4 of 2011 sought an injunction to restrain the defendant from using its trademark pending the determination of this suit and this court ordered that the respondent/defendant should revert back to its registered trademark and use it fully. It was contended that the defendant has in contempt of that order continued to use the word "TUSKYS" singularly and this was confirmed by DW3 in cross examination. Counsel for the plaintiff referred to Order 41 rule 2 (3) which gives court power to order for attachment of the property or detention in a civil prison of the person guilty of disobedience or breach of any terms of injunctions.

He prayed that this court finds that the defendant is in continuous contempt of its order and orders that commensurate general damages be paid to the plaintiff.

On the 2<sup>nd</sup> preliminary issue, it was contended for the plaintiff that the procedure followed by the defendant in the registration of its trademark was illegal as it did not comply with the provisions of the Trademarks Act, Cap 217 which was in force in 2009. Counsel referred to section 19 which provides for the application procedure for registration of a trademark, section 34 which provides for general powers to rectify registers, section 36 which provides for the procedure for rectification of the register and section 37 which provides for alteration of registered trademark. He then argued that the defendant sought to circumvent the procedures provided for in the above laws by first applying to register a mark that was not in contention and then later changed the entire mark to the prejudice of the plaintiff through an alien process under the pretext of a corrigendum. He urged this court not to condone such illegalities but to declare the offending mark illegal and strike it off the register then award damages to the plaintiff.

In reply to the above submissions, counsel for the defendant criticised the approach used by the plaintiff's counsel of raising the two preliminary issues as being factually incorrect and procedurally erroneous and fatal. He submitted that while the plaintiff's counsel attempts to demonstrate that DW3 accepted that the defendant still continues to use the word "TUSKYS" singularly in some cases, this is a misrepresentation because in re-examination DW3 stated that as soon as this court issued an injunction ordering the defendant to stick to its registered trademark changes were made and photographs of status signifying compliance with the court order were submitted to court.

Without even delving much into the submission of counsel for the defendant on this so called preliminary point of law, I wish to deal with the matter summarily by pointing out that it is an agreed fact number 3 as reproduced herein above that "*the defendant/respondent duly complied with the orders of Hon. Justice Hellen Obura and accordingly rebranded all its shop and items to reflect their registered trademark.*" I therefore find it strange and irregular that counsel for the plaintiff could agree that the defendant complied with the order then turn around to contradict themselves by arguing that the same order has been disobeyed and this should attract sanction.

It is clear from the documents attached to the amended written statement of defence filed after this court made the order that the logos on the plaintiff's shops/supermarkets and items were not the same as those that were attached to support the claim in the original plaint. I believe this was the basis for the parties and their counsel agreeing that the orders were complied with and the shops and items were rebranded to reflect the registered trademark. I therefore find that the submission on the first preliminary issue is misconceived and an afterthought devoid of any substance or merit and I accordingly overrule.

I wish to observe that even if there was any disobedience of the court order the procedure adopted to raise the same is irregular and the timing is prejudicial to the defendant who was

never given a chance to adduce evidence to prove compliance with the order. For that reason alone I would have still overruled the objection even if the alleged disobedience of the court order was shown.

On the 2<sup>nd</sup> preliminary point of law, it was submitted by counsel for the defendant that evidence was adduced to show that the defendant instructed its lawyers to apply to register the trademark with the words “Time To Go TUSKYS Your Friendly Supermarket” but they instead erroneously registered the mark “Your Friendly Supermarket” only which was corrected by a corrigendum in accordance with section 19 (7) of the Trademarks Act Cap. 217 as it then was in force. He argued that the defendant could not have corrected its unregistered mark under sections 34, 36 and 37 of the Trademark Acts which only applies to marks that are already registered/entered on the register.

I have looked at the provisions of the Trademarks Act that the plaintiff’s counsel argues were not complied with in the process of registering the trademark and I completely agree with the defendant’s counsel that they only apply to marks that are already registered and that is why phrases like “the registered proprietor”, “non insertion in” and “omission from the register” are used. The defendant was not a registered proprietor of “Your Friendly Supermarket” mark as no evidence was brought to that effect so the argument that the correction of the name should be made under sections 34, 36 and 37 of the Act is misconceived.

In any event, it was the Asst. Registrar of Trademarks who signed the corrigendum by which the general public was notified that the advertisement that appeared earlier was erroneously put as “Your Friendly Supermarket” and the correct representation should have been:

**“Time To Go  
TUSKYS  
Your Friendly Supermarket”.**

I want to believe that the applicant had complied with the requirement of the law and that is why the Asst. Registrar of Trademarks put that corrigendum. The plaintiff’s counsel has not put any evidence before this court to show that the mark had already been registered at the time of putting the corrigendum to justify the argument that the entry should have been corrected or altered in accordance with the provisions of sections 34, 36, and 37 of the Act. Absence of that, all the above provisions are irrelevant and inapplicable to the instant case and in the premises. I do not find any merit in the 2<sup>nd</sup> preliminary point of law. I therefore overrule it.

Before I take leave of these preliminary issues, I must at juncture point out something that came out in the evidence of DW2 and is also glaring on Exhibits D2, D3 and P4 but both counsels never paid any attention to it. DW2 testified in re-examination that the applicant for **“Time To Go TUSKYS Your Friendly Supermarket”** and the registered owner is Tusker Mattresses Ltd the holding company based in Kenya. This evidence is confirmed by Exhibits D2, D3 and P4 being the certificate of registration of the trademark and the Uganda Gazette



notices of 3<sup>rd</sup> July 2009 and 13<sup>th</sup> November 2009 respectively which clearly indicate the registered owner and applicant as Tusker Mattresses Ltd.

It should therefore be noted that the defendant is merely an assignee of the trademark as per the Deed of Assignment dated 4<sup>th</sup> March 2009 and not the registered owner. No evidence was put before this court to show that defendant applied for registration of the mark as required by section 27 (1) of Cap. 217 which was in force at the time. Instead it was shown by evidence that Tusker Mattresses Ltd was the one that applied and was registered as stated above. Therefore, if any person is to be faulted for any irregularity in the registration process then it is Tusker Mattresses Ltd which in law is different from the defendant never mind that their respective directors could be the same persons.

With the above observation, I now turn to consider the issues that were canvassed before me on the merits.

**Issue 1: Whether the defendant's registration and use of trademark registered under No. 31953 in class 16 is an infringement of the plaintiff's trademark registration No. 31804 in Class 18.**

Counsel for the plaintiff argued this issue in two parts. The first part of counsel's argument was based on the priority registration of the mark "TUSKYS" and the accruing rights that must be enjoyed by the plaintiff. He relied on the cases of *Capital Radio Ltd v F.M. Holdings & 2 others HCCS. No. 300 of 2005* and *Re Morgan (1981) 18 Ch. Div. 93* to support the argument that the plaintiff registered its trademark first and therefore that was deemed to be actual notice to the defendant who subsequently registered a similar mark. It was therefore submitted that the plaintiff's mark ought to be given priority protection.

The 2<sup>nd</sup> part of the argument was on the alleged infringement of the plaintiff's mark by the defendant. Counsel for the plaintiff alluded to the evidence of PW1 that the mark "TUSKYS" was registered by the plaintiff under Trademark No. 31804 in respect of goods in class 18 on the 1<sup>st</sup> day of December 2008. He argued that by that registration the plaintiff acquired exclusive right to use the mark in accordance with section 36 (1) of the Trademarks Act, 2010. Therefore registration of identical or resembling mark likely to confuse the public is forbidden and no other such mark should be on the Ugandan market. He relied on the case of *Standard Signs Uganda Limited v Fred Leo Ogwang t/a Shandard & Anor HCCS No. 240 of 2006* where this court quoted a passage from the case of *Schweppes Ltd v Gibbens (1905) 22 RPC 113,601*, and *Hannesty & Company v Veating (a) (1998) 25 R.P.C 361* at page 367 which require the court to compare the marks because the eye is usually the best test.

Counsel then submitted that the plaintiff adduced evidence to prove that the plaintiff's trademark was being infringed by the defendant's registration and use of its mark and the client's are also being confused by the use of similar emails and websites. He argued that the plaintiff has built a substantial reputation and clientele base which is under the threat of being overshadowed by the defendant's infringement. He buttressed his argument on the alleged

confusion with the case of *Nice House of Plastics v. Hamidu Lubega HCCS. No. 695 of 2006* where it was held that:-

*“The test of confusion is likelihood of confusion. This is the probability that a reasonable consumer in the relevant market will be confused or deceived and will believe that the impugned goods or service come from or are sponsored by the protected user, or that the two users are affiliated.”*

He submitted that in cases of trademark infringement, the aggrieved party need not produce substantial or compelling evidence of actual confusion. All that need to be shown is a likelihood of confusion. He prayed that this court finds that the defendant’s registration and use of its trademark is an infringement to the plaintiff’s registered trademark and therefore order deregistration of the infringing mark.

In reply to the above submissions on the first issue, counsels for the defendant submitted that in so far as the first part of the plaintiff’s submission is concerned, the defendant’s trademark registered in Class 16 does not infringe the plaintiff’s trademark registered in Class 18 because the two trademarks are fundamentally different and registered under different classes of goods. They submitted that it is trite that a registrar upon receipt of an application to register a trademark is required to conduct a search under rule 30 of the Trademarks Rule SI 217-1 to ascertain whether there are on record in respect of the same goods or description of goods any marks identical with the mark applied for or so nearly resembling it as to render the mark applied for likely to deceive or cause confusion and based on his finding the registrar may permit or decline to proceed with the application. They argued that when the defendant applied for registration of its mark **“Time To Go TUSKYS Your Friendly Supermarket”** the registrar allowed it because it was fundamentally different and easily distinguishable from the plaintiff’s mark when written or spoken.

They submitted that Section 52 of the Trademarks Act Cap. 217 afforded the plaintiff a remedy of either opposing the defendant’s application for registration of the trademark or applying to strike it off. The case of *Interconsumer Products Ltd v. Nice & Soft (2003) Ltd Misc. Application No. 256 of 2011* was relied on to support that position. It was also contended that all the authorities relied upon to support the plaintiff’s case are not applicable.

On the 2<sup>nd</sup> part of this issue, the defendant’s counsels submitted that concurrent use of the respective trademarks cause no actual confusion. They argued that all the postings and email correspondences adduced by the plaintiff to prove the alleged confusion are fabrications. It was submitted that Exhibit P9 (ii) which is a continuation of Exhibit P9(i) was posted on Friday, 26 November 2010 and bears the defendant’s trademark and the plaintiff’s email address [info@tuskys.co.ug](mailto:info@tuskys.co.ug) yet according to Exhibit D7 (i) the domain tuskys.co.ug out of which [info@tuskys.co.ug](mailto:info@tuskys.co.ug) is hosted was registered on 12<sup>th</sup> January 2011 after the date of the posting of P9 (i) & (ii) showing that it is a fabrication and confirming the testimony of DW1 of scams.

It was further submitted that Exhibit P10 (xi) purportedly sent on 26<sup>th</sup> July 2011 which says the sender had keenly looked at the defendant's website clearly was a fabrication in light of DW1's testimony that the defendant's product are advertised on Tusker Mattresses Ltd (Kenya) website which was launched on 30<sup>th</sup> December 2011 so there is no way the sender could have keenly looked at what had not been launched. For the same reason, it was submitted that Exhibit P10 (ix) was also a fabrication.

On the whole as regards the emails, it was submitted for the defendant that the inquiries were suspicious because they were sent to [info@tuskys.co.ug](mailto:info@tuskys.co.ug) and [info@tuskysuganda.com](mailto:info@tuskysuganda.com) both operated by the plaintiff and displayed on the plaintiff's web page. It was therefore contended that it is highly probable that all email inquiries allegedly intended for the defendant could have been generated with a view to allege confusion and implicate the defendant.

On another note, it was also submitted for the defendant that in relying on the email print outs the plaintiff did not comply with section 8 (2) of the Electronic Transactions Act of 2011 which provides that a person seeking to introduce a data message or an electronic record in legal proceedings has the burden of proving its authenticity by evidence capable of supporting a finding that the electronic record is what the person claims it to be. It was argued that no such evidence was adduced in this case to prove the authenticity of the email print outs.

On likelihood of confusion, it was submitted further that in determining whether confusion is likely, regard must be given to the strength of the mark, proximity of goods, similarity of the marks, marketing channels used, type of goods and the degree of care likely to be exercised by the purchaser, evidence of actual confusion and likelihood of expansion of the product line as was held in *AMF, Inc. v Sleekcraft Boats*, 599 F. 2d 341 (9<sup>th</sup> Cir. 1979).

It was then submitted that as regards marketing channels, the plaintiff's is internet based with sophisticated clientele while the defendant's is a chain of retail supermarkets and so there is no likelihood of confusion. Even then it was argued that discerning from Exhibit D6 (iv) the alleged online trade is a myth and cannot constitute sufficient 'use in commerce' to establish priority for trademark infringement.

On the exhibits adduced to show the appearance of the defendant's trademark on its shops, it was submitted that Exhibit P4 being a photograph of the defendant's shop in Ntinda was taken before the changes ordered by this court was effected due to an earlier injunction in another suit which maintained the status quo but this was subsequently changed. It was however, conceded that the word "TUSKYS" comes out more conspicuously on the signage because that is how it appears in the trademark that was assigned and later registered by the defendant.

Still related to the marketing channels, it was further submitted that the plaintiff's website [www.tuskysuganda.com](http://www.tuskysuganda.com) and email addresses [info@tuskysuganda.com](mailto:info@tuskysuganda.com) and [info@tuskys.co.ug](mailto:info@tuskys.co.ug) are different from the defendant's email address [info.ug@tuskys.com](mailto:info.ug@tuskys.com) and

are hosted on different domain names. It was also submitted that the parties deal in different types of goods so there is no likelihood of confusion.

It was also submitted that the plaintiff did not adduce evidence to show that it is in business to support its allegation that it has built substantial reputation and clientele base. It was contended that on the contrary, it was the defendant who tendered Exhibit D10 (i) – (iii), specifically a letter from the Uganda Registration Services Bureau to show that the plaintiff has never filed a resolution to open a bank account, never filed returns, and notice of situation of registered offices or annual returns which is proof of company carrying on business.

In rejoinder, counsels for the plaintiff reiterated their earlier submissions and argued that in determining likelihood to deceive or cause confusion the law puts emphasis on identical marks and does not focus on classes of goods as the defendant would want to convince this court.

On the e-mails alleged to have been fabricated, it was argued that the sources are disclosed and there is proof that they were intended for the defendant but ended up going to the plaintiff's e-mail address because of the confusion caused by the similarity in the marks and e-mail addresses.

In response to the plaintiff's arguments based on section 8 (2) of the Electronic Transactions Act No. 8 of 2011 about the plaintiff's burden to prove authenticity of the e-mails, it was submitted that the plaintiff was never at any time moved by court to prove the authenticity of the e-mails during the trial so raising the issue in the submission is irrelevant. It was argued that in any event Section 5 (1) of the same Act provides that information shall not be denied legal effect, validity or enforcement solely on the ground that it is wholly or partly in form of a data message.

I have duly considered the above submissions and the legal principles upon which the arguments are based as elucidated in the authorities cited. I have also carefully perused the pleadings and the documents in support. Both trademarks were registered under The Trademarks Act Cap. 217 which was repealed and replaced by The Trademarks Act, 2010.

Section 6 of Cap. 217 which is now Section 36 (1) of the Trademarks Act 2010 conferred upon the registered proprietor the exclusive right to the use of the trademark in relation to the goods for which it is registered. Section 6 (1) of that Act provided:

*“Subject to this section and sections 9 and 10, **the registration** (whether before or after the commencement of this Act), **of a person in Part A of the register as proprietor of a trademark** (other than a certification trademark) **in respect of any goods shall, if valid, give or be deemed to have given to that person the exclusive right to the use of the trademark in relation to those goods.....”***

Under section 36 (2) of the 2010 Act, which previous was part of section 6 (1) of Cap. 217, the exclusive right to the use of a trademark is taken to be infringed by a person who, not being the owner of the trademark or a registered user of the trademark uses by way of permitted use, a mark identical with or so nearly resembling it, as to be likely to deceive or cause confusion in the course of trade in relation to any goods of the same description where the use would result in a likelihood of confusion and in such a manner as to render the use of the mark likely to be taken; (a) as a trademark relating to goods; or (b) in a case in which the use of the goods or in physical relation to the goods or any publishing circular or other publication used to the public, as importing a reference to some person having the right as owner or as registered user of the trademark or to goods with which that person is connected in the course of trade.

According to **Black's Law Dictionary 8<sup>th</sup> Edition**; *“trademark infringement means the unauthorised use of a trademark or of a confusingly similar name, word, symbol, or any combination of these in connection with the same or related goods or services and in a manner that is likely to cause confusion, deception, or mistake about the source of the goods or services.”*

The established principle is that in cases of alleged infringement of trademarks the court must look at the marks and compare so as to arrive at its own conclusion on the similarity of the marks. This position was stated in the case of **Schweppes Ltd v Gibbens (1905) 22 RPC 113,601**, as per **Warrington ,J** whose judgment was approved by the majority of the Court of Appeal and by the House of Lords. He cited with approval a quotation from **KERLY'S LAW OF TRADEMARK** at page 646 to the effect that:

*“It seems to me that each of these cases must be looked at by itself; and the judge looking at the label or get up or the device, whatever it may be that is complained at; with much assistance as to the practice of the trade as he can get from witnesses, must decide for himself whether the article complained of is calculated to deceive or not”.*

Similarly, **Lord Macnaghten** in **Hannessy & Company v Veating (a) (1998) 25 R.P.C 361** stated at page 367 that:

*“The eye, no doubt is generally the best test and you will have to come to a comparison of the marks or label sooner or later. Generally but not always, the comparison is enough”.*

As I stated at the onset, the plaintiff's registered trademark is “TUSKYS” and the one assigned to the defendant is:

**“Time To Go  
TUSKYS  
Your Friendly Supermarket”.**

There is no doubt that the word “TUSKYS” which is the plaintiff’s mark also stands out in the mark used by the defendant. If the two marks are put side by side as demonstrated below the words “Your Friendly Supermarket” in the mark used by the defendant would distinguish the marks because one would know that that of the defendant is a supermarket as the mark suggests.

	<b><i>“Time To Go</i></b>
<b>“TUSKYS”</b>	<b>TUSKYS</b>
	<b><i>Your Friendly Supermarket”.</i></b>

It is therefore my firm view that if the defendant uses the trademark assigned to it without leaving out the words “Time To Go Your Friendly Supermarket” it would not cause any likelihood of confusion.

However, what gave rise to this suit is the defendant’s abandonment of the mark assigned to it and adoption and use of the mark “TUSKYS” singularly which makes it identical to the plaintiff’s mark. In the application for a temporary injunction I did order the defendant to revert back to the use of the registered trademark “Time To Go TUSKYS Your Friendly Supermarket” and it was reported to court that the order was complied with. As stated hereinabove, it was also an agreed fact that the defendant duly complied with the order.

DW3 also testified that the defendant has since abandoned the marks in Exhibits P6 and P7 which were used before the court order. His evidence was neither challenged nor discredited. It is therefore my finding that upon compliance with that order, as confirmed to this court, the infringement, if any, occasioned by the use of the word “TUSKYS” singularly would cease forthwith.

It is also pertinent to point out that the plaintiff’s mark is in respect of goods in class 18 and it primarily engages in the business of worldwide advertising, selling, promoting and distributing arts and crafts especially made by women as testified by its managing director. Meanwhile the mark used by the defendant is in respect of goods in class 16 and it runs retail chain supermarkets that deal in assorted goods. It is important to note that neither the plaintiff’s goods whose samples are posted in Exhibit P12 (ii) nor the defendant’s goods bear the mark “TUSKYS”. The marketing channels of the goods are also different since the plaintiff’s is internet based and the defendant’s is supermarket based. I therefore do not see any likelihood of the defendant’s goods being confused as those of the plaintiff.

In the circumstances, it is the finding of this court that the mark used by defendant is neither identical to nor so nearly resembles the plaintiff’s mark and therefore the two trademarks can co-exist in the Ugandan market without any likelihood of deceiving or causing confusion to the consumers of the respective goods.

Be that as it may, the defendant acknowledged using the mark “TUSKYS” singularly up to the time the court order was complied with in 2011. It would therefore presuppose that there

was infringement of the plaintiff's trademark up to that point. However, no credible evidence of such infringement in terms of deceiving or causing confusion in the course of trade in relation to goods of the same description has been put before this court. What the plaintiff is relying on are e-mail print outs for postings done in November 2010 (Exhibits P9 (i) & (ii)) and Exhibits P10 (i)-(viii) which were sent to [info@tuskysuganda.com](mailto:info@tuskysuganda.com) and [info@tuskys.co.ug](mailto:info@tuskys.co.ug) after the suit was filed and the court order issued and complied with and the amended plaint as well as amended written statement of defence were also filed.

The source of those e-mails were challenged by DW1 who is the e-business manager of Tusker Mattresses Ltd and its subsidiaries as being questionable when he said in paragraph 7 of his witness statement that Tusker Mattresses Ltd the holding company based in Kenya launched its website [www.tuskys.com](http://www.tuskys.com) on or about 30<sup>th</sup> December 2011 which he personally supervised and as at that time there was no advertisement or any display of its merchandise or products on the website. It was the evidence of DW1 as stated in paragraph 8 of his witness statement that any advertisement that may have appeared on any website purporting to be that of the defendant before December 2011 would be doctored and part of a scam of unknown intentions and was not authorized by the defendant. He further stated in paragraph 9 that the defendant operates an email address [info.ug@tuskys.com](mailto:info.ug@tuskys.com).

In cross examination, DW1 explained that there are very many fraudulent websites. He said Exhibits P9 (i) were posted on 26<sup>th</sup> November 2010 and the domain [tuskys.co.ug](http://tuskys.co.ug) which appears in Exhibit P9 (ii) is for the plaintiff. He further explained that the same domain which appears in Exhibit D7 (i) was registered on 12<sup>th</sup> January 2011 and it is not for the defendant. He also said the two email addresses stated in Exhibit 6 (v) are not displayed anywhere on the defendant's website.

In relation to Exhibit P10(ix), he conceded that Chris Kibathi mentioned therein works for Tusker Mattresses Ltd the holding company.

As correctly argued by counsel for the defendant, section 8 (2) of the Electronic Transactions Act of 2011 places the burden of proving authenticity of a data message or an electronic record on the person who is seeking to introduce it in legal proceedings. He is required to adduce evidence capable of supporting a finding that the electronic record is what the person claims it to be. Counsel for the plaintiff argued that since court never required the plaintiff to do so it was irrelevant to raise the matter. I find this argument very evasive of the issue at hand because it is a legal requirement that he who seeks to introduce a data message must prove its authenticity. Therefore counsel ought to have ensured that the law was complied with if he wanted me to rely on the document.

Under section 8 (4) the duty of this court is to assess the evidential weight of a data message or an electronic record with regard to (a) the reliability of the manner in which the data message was generated, stored and communicated; (b) the reliability in which the authenticity of the data message was maintained; (c) the manner in which the originator of the data message or electronic record was identified; and (d) any other relevant factor.

I believe the above provision seeks to address the mischief of manipulating electronic data for ulterior motives. It is common knowledge that e-mail communications and website postings being electronic data can easily be manipulated by the party interested in benefitting from it. For that reason courts need to exercise due care and diligence in assessing the evidential weight of a data message before relying on it. The question of proof of its authenticity cannot therefore be glossed over.

The witness statement of the plaintiff's only witness filed on 7<sup>th</sup> May 2012 never mentioned the postings and emails in Exhibits P6 (v), P7, P9 & P10 and how they were generated and stored. His additional evidence given orally was in respect of Exhibits P12 (ii)-(ix) which in cross examination he conceded would not have been generated if he had not posted a facebook account on the plaintiff's website. He also conceded that the plaintiff's website had been dormant until August 2012.

Exhibits P12 (ii)-(ix) was tendered in evidence to counter the contention by the defendant that the plaintiff had not commenced business as at 12<sup>th</sup> June 2012 as per the search report from Uganda Registration Services Bureau which shows that it had not filed; a return on allotment of shares, annual returns, a resolution with financial institution indicating the status of its account and notice of situation of its office. It is curious to note that the website only became active after D10 was admitted in evidence during the scheduling conference.

In the absence of proof of the authenticity of the data message adduced by the plaintiff they remain suspect therefore I cannot rely on them to find that the defendant's customers sent emails to the plaintiff company because they confused it for the defendant company. I also find that the email addresses and websites are not identical so they cannot be confused by a reasonable customer. In any case, the evidence of DW1 and DW2 confirm that the website is for Tusker Mattresses Ltd and not the defendant.

On the whole, the plaintiff has not on a balance of probability proved the alleged infringement. These findings answer the first issue in the negative.

## **Issue 2: Whether the plaintiff is entitled to the reliefs claimed.**

The plaintiff in its amended plaint prayed for:

- a) An order for a permanent injunction restraining the defendant from any further use of the plaintiff's registered trademark.
- b) General damages for the suffering occasioned by the infringement of the plaintiff's trademark.
- c) Interest at court rate.
- d) Costs of the suit.
- e) Any other reliefs as this court may deem fit.



Following my finding that the defendant has not infringed the plaintiff's trademark, I do find that the plaintiff is not entitled to any of the reliefs it sought from (a) to (c). However, I wish to observe that the defendant prior to the order of this court in Misc. Application No. 4 of 2011 did use the mark "TUSKYS" singularly and this prompted the plaintiff to bring this suit. If the defendant had strictly used the mark assigned to it this suit would have been avoid. For that reason, I will award the costs of this suit to the plaintiff although it has lost the suit.

In the result, the plaintiff's suit is dismissed and the defendant is ordered to pay costs for the reason stated above. For avoidance of any doubt the defendant is ordered not to ever revert back to the use of the mark "TUSKYS" singularly. It must always use its authorised mark:

***"Time To Go***  
**TUSKYS**  
***Your Friendly Supermarket".***

I so order.

Date this 8<sup>th</sup> day of July 2015.

Hellen Obura  
**JUDGE**

Judgment delivered in chambers at 4.00 pm in the presence of Mr. Nionzima Vianne for the defendant and Mr. Michael Agaba h/b for Alex Kibandama for the plaintiffs whose managing director was also present.

**JUDGE**  
08/07/2015

