

DECISION OF THE REGISTRAR OF TRADEMARKS

IN THE MATTER OF: **TRADE MARK APPLICATION NO. 1833/2019**
'ULTRA X-PRESSION' IN CLASS 26 IN THE
NAME OF HAIR CREDENTIALS ZAMBIA
LIMITED

IN THE MATTER OF: **OPPOSITION TO REGISTRATION PURSUANT**
SECTION 23 OF THE TRADE MARKS, ACT
CHAPTER 401 OF THE LAWS OF ZAMBIA.

BETWEEN

SOLPIA GROUP INCORPORATED

OPPONENT

AND

HAIR CREDENTIALS ZAMBIA LIMITED

APPLICANT

Before Mr. Benson Mpalo : Registrar of Trademarks

For the Opponent: Mr. J. Chileshe and Mr. N. Silwamba of Messrs Eric
Silwamba, Jalasi & Linyama Legal Practitioners

For the Applicant: Mr. Isaac Nonde of Isaac & Partners

RULING

STATUTES REFERRED TO:

The Trade Marks Act, Chapter 401 of the Laws of Zambia



CASES REFERRED TO:

1. Britannia Industries Limited v Britania Products Zambia Limited (2020) [Decision of the Registrar]
2. DH Brothers Industries (Pty) Limited v Olivine Industries (Pty) Limited (2012 ZMSC 17)
3. Hotel Cipriani SRL v Cipriani (Grosvenor Street) [2008] EWHC 3032 Ch, the UK
4. Trade Kings Limited v Unilever and Others (2002) ZMSC 9
5. N.R. Investments Limited v Tiger Foods Brands Intellectual Property Holdings Company (PTY) 2012/HPC/0373
6. Zambia Sugar Plc V. Fellow Nanzala SCZ Appeal No. 82/2001

INTERNATIONAL CONVENTIONS REFERRED TO:

1. Paris Convention for the Protection of Industrial Property 1883
2. The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)



BACKGROUND

1. This is a matter in which Hair Credentials Zambia Limited (hereinafter called the 'Applicant') of Plot No. 7461, Corner of Nchoncho & Washama Roads, off Lumumba Road, Lusaka, Zambia, lodged an application for registration of trade mark number 1833/2019 **'ULTRA X-PRESSION & LABEL'** (hereinafter called 'the Applicant's mark'), in class 26 in respect of: *Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers*. The application was examined, accepted and published in the Zambia Industrial Property Journal of 25th December 2020 at page 575.
2. On the 23rd of February 2021 Solpia Group Incorporation (hereinafter called the 'the Opponent') of C/O M/S Worldwide Formations, P.O Box 33964, Dubai, United Arab Emirates, filed a Notice of Opposition to registration of the Applicant's mark.

GROUND OF OPPOSITION

3. In its Notice of Opposition, the Opponent averred that it is the sole and lawful proprietor in several countries of the world of the trademark **'X-PRESSION'** (hereinafter called 'the Opponent's mark') which was duly registered in Nigeria in the name of Linda Manufacturing Company Limited, in class 26 in respect of *weave on and hair attachment products*. The Opponent stated that the trademark was assigned to Solpia Group Incorporated and is also registered with the Africa Intellectual Property Organisation (ARIPO) in class 26, designating Botswana, Liberia, Namibia, Tanzania and Uganda.
4. The Opponent contends that the Applicant's mark **'ULTRA X-PRESSION'** bears a striking resemblance and is confusingly similar to the Opponent's **'X-PRESSION'** trademark and is sought to be registered in class 26 for goods which are of the same description as that of the Opponent.

5. The Opponent therefore relies on the following grounds of opposition:
- (a) That the registration of the Applicant's mark will contravene the provisions of section 16 of the Trade Marks Act, Chapter 401 of the Laws of Zambia.
 - (b) That the Applicant's mark was applied for in bad faith having deliberately copied from that of the Opponent's trademark.

Relief Sought

6. The Opponent respectfully requests that the Applicant's application be refused registration with costs.

COUNTERSTATEMENT

7. The Applicant filed a counterstatement on the 30th of April 2021. From the onset, the Applicant contended that the Opponent is not entitled to oppose registration of the Applicant's mark in Zambia as the said trade mark is and has at all material times been subsisting and registered in the name of Stripes (Zambia) Limited in class 26 under number 466/2005 as of 14th July, 2005. It was further argued that as the Opponent's foreign trade mark is not registered in Zambia, the Opponent cannot seek protection under the Trade Marks Act.
8. The Applicant denies that its trade application was filed in bad faith, arguing that the trade mark ULTRA X-PRESSION is already being used and is registered in the name of the Applicant's sister company, Strategic Industries Limited, in Kenya in class 26 as of 10th April, 2008. The Applicant further denies that the Opponent's foreign trade mark upon which the Opponent relies, has any sufficient reputation in Zambia as the trade mark is already registered to a different company.



9. The Applicant asserted that its trade mark **ULTRA X-PRESSION** is, in any event, neither identical nor similar to the Opponent's foreign trade mark **X-PRESSION** as any likelihood of confusion or deception to the public is prevented by the distinctive word '**ULTRA**' and the noticeably different logos that the trademarks are identified by.
10. The Applicant denies that the Opponent is entitled to any of the reliefs sought in its notice of opposition and requests that its trade mark application be granted registration with costs as the Opponent's Notice of Opposition is frivolous, embarrassing and aimed at discrediting the Applicant's application without proper justification.
11. Lastly, relying on Regulation 56 of the Trade Marks Regulations, the Applicant requested the Registrar to exercise his discretion to give security for costs as the Opponent has confirmed in its notice of opposition that it neither resides nor carries on business in Zambia.

OPPONENT'S EVIDENCE

12. The Opponent filed its evidence by way Affidavit, sworn by one Prince Azubuike Onyekwelu in his capacity as Company Secretary of the Opponent company.
13. It was Mr Onyekwelu's evidence that the Opponent's trademark "X-PRESSION" was first registered and protected in Nigeria in the name of Linda Manufacturing Company Limited on 27th June 2003 and the certificate of registration was issued on 16th May 2006. A copy of the certificate of registration was exhibited, marked "**PAO2**". That the said trade mark was assigned to the Opponent, Solpia Group Incorporated on the 16th of December 2015 and a copy of the certificate of assignment was exhibited marked "**PAO3**". Further, that the Opponent registered the trademark X-PRESSION at the African Regional Intellectual Property



Organisation (ARIPO) where the countries Botswana, Liberia, Namibia, Tanzania and Uganda were designated. A copy of the ARIPO Certificate of Registration was exhibited, marked **"PA04"**.

14. That the Opponent trades its product in Zambia online and has a strong presence as shown by the following links:

<https://www.ubuy.com.zm/brnad/x-expression?g=xpression>,

<https://zambia.desertcart.com/brand/expressions%20braiding%20hair>

<https://www.amazon.com/X-expression-Premium-original-ultra-Braid/dp/B01fEEOCOG>

15. That the deponent conducted a search on Google for the name "X-Pression" and "Ultra X-Pression" respectively and noted that the search result reveals the Opponent's trademark. Screen shots of the search were exhibited and marked **"PA08"** and **"PA09"**.

16. That the Opponent's Advocate, one Jonathan Chileshe of Messrs Eric Silwamba, Jalasi and Linyama was instructed to carry out a market research and found the Opponent's products in a shop situated in Kamwala which sells the Opponent's product. A picture of Mr. Chileshe holding two products with the Opponent's trade mark "X-PRESSION" was exhibited and marked **"PA010"**. That Mr. Chileshe took a subsequent photo of the products which the deponent alleges is very noticeable that the Opponent has a version of its "X-PRESSION" products called ULTRA BRAID. A picture of the same products was exhibited, marked **"PA011"**.

17. That Linda Manufacturing company Limited, the original proprietor and the company which assigns and supplies X-pression products, regularly ships consignments to one Chinedu Dennis Ohaeri in Lusaka, Zambia.



Commercial invoices by Linda Manufacturing Company Limited were exhibited, marked “**PAO13**”.

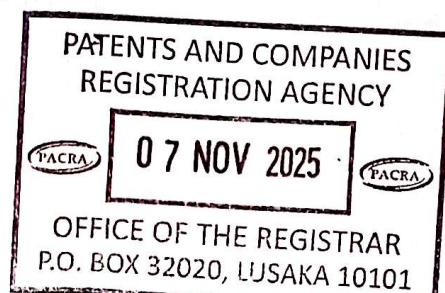
18. That the Applicant’s mark bears a striking resemblance to the name of the Opponent’s trademark “X-expression” and product ‘Ultra Braid’ as can be seen by a perusal of the exhibits contained in the Affidavit. Further, that there is a strong likelihood that the registration of the Applicant’s mark will cause confusion and deceive the public in Zambia as there is no difference between the Applicant’s mark and the Opponents well established trademark.

APPLICANT’S EVIDENCE

19. Under consideration herein is the Applicant’s Further Affidavit in support of Application and Counterstatement filed on the 18th of July 2022 deposed to by one Milimo Stephen, the Administrative Executive of Hair Credentials Zambia Limited.
20. Mr. Milimo stated that he saw and read what purported to be an un-notarised and undated Affidavit in support of opposition in the name of one Prince Azubuike Onyekelu and opposed to the contents therein.
21. He stated that in Zambia the trade mark **X-PRESSION** is and has at all material times been subsisting and registered in Part A of the Register in the name of **STRIPES (ZAMBIA) LIMITED** in Class 26 under number 466/2005 as of 14th July, 2005 in respect of *hair additions and attachments, hair pieces, braids, buttons, press buttons, hooks and eyes, pins and needles and artificial flowers*. A copy of the Certificate of registration for the said trademark was exhibited, marked “**MS1**”. He further explained that Stripes Zambia Limited changed its registered name to Hair Credentials Zambia Limited (the Applicant). Evidence of the said change was exhibited and marked “**MS2**”.



22. Mr. Milimo expounded that the Trademark **"X PRESSION"** had been continuously used since 14th of July 2005. There was produced and marked as exhibit **"MS3"** a copy of what was purported to be material in support of the foregoing.
23. He argued that in any event, the purported foreign trademark **X-PRESSION** by the Opponent is not registered in the Trademarks Register in Zambia at the Patents and Companies Registration Agency ("PACRA"). He exhibited, marked **"MS4"** and **"MS5"** copies of a lodgement schedule for General Search of Records and a PACRA print out relating to the Trademark No. 466/2005 "X-PRESSION" in class 26 to show validity of the said trademark
24. Mr. Milimo stated that he was reliably informed by the Applicant's Advocates, Messrs. Isaac and Partners, believing the same to be true, that the Opponent is precluded from invoking a priority claim of their foreign trademark **X-PRESSION** in Zambia as the Opponent had not shown that it complied with the provisions of the Trade Marks Act prior to filing its opposition.
25. Mr. Milimo further asserted that the Applicant's application is neither a deliberate attempt by the Applicant to copy the Opponent's foreign trademark nor an attempt to associate itself with the Opponent's purported goodwill and reputation attached to its foreign trademark as the Applicant's application for the proposed trademark is adapted to distinguish, when the two trademarks are compared as a whole.
26. In addition, the deponent stated that he was reliably informed by the Applicant's Advocates, that the Applicant's trademark is already being used and is registered in the name of the Applicant's sister company, Strategic Industries Limited, in Kenya, in Class 26 under trademark



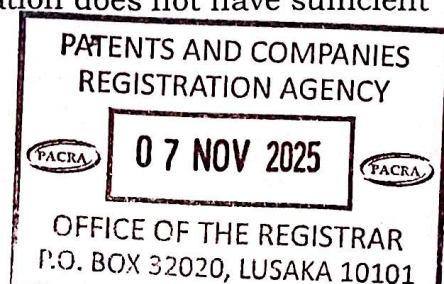
number 63032 as of 10th April 2008. A Certificate of Registration for the said trademark in Kenya was exhibited, marked **"MS6"**.

27. He contended that the Opponent's opposition was a mere attempt to blemish the Applicant's already existing trademark which the Applicant has been continuously using since its inception in 2015 and that the Opponent further aimed to misguide the majority of the general public in Zambia and other consumers over the quality of the Applicant's products under its already existing trademark.

28. Mr. Milimo further explained that on the 1st of November 2021, Strategic Industries Limited transferred its Intellectual Property rights in its various assets to Style Industries Limited. A copy of what purports to be the IP Transfer and License Agreement was exhibited and marked **"MS6"**. That Style Industries Limited and the Applicant are part of a Group of Companies belonging to Godrej Consumer Products Limited (Company registration No. L24246MH2000PLC129806), a company duly registered and having its registered address in the Republic of India. Mr. Milimo exhibited a list of subsidiaries of the said Godrej Consumer Products Limited marked **"MS7"**.

29. He contended that the opposed application was not filed in bad faith as the Applicant has demonstrated that it had already used the trademark before in Kenya through its sister company as far back as 10th April, 2008. That in any event, the Applicant's mark is neither identical nor similar to the Opponent's foreign trademark, and that any likelihood of confusion or deception to the public would be prevented by the distinctive word **"ULTRA"** and the noticeable different logos that the trademarks are identified by.

30. Further, Mr. Milimo argued that the foreign trademark **X-PRESSION** upon which the Opponent relies in this application does not have sufficient

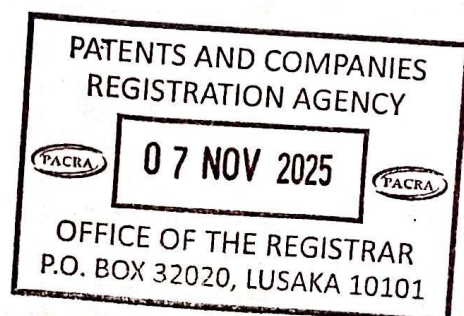


reputation in Zambia as the trade mark is already registered to a different company as stated above.

31. Mr. Milimo contended that the Opponent is not entitled to any of the reliefs sought in its notice of opposition to application for registration of trademark **ULTRA X-PRESSION** as the said trade mark is not likely to deceive or cause confusion on the part of the public when used in a normal and fair manner in connection with the goods covered by its proposed registration.

OPPONENT'S WRITTEN SUBMISSIONS

32. The opponent filed its written submissions on 29th of August 2022.
33. In response to the Applicant's further affidavit in support wherein the deponent demonstrated that the Opponent's foreign trade is not registered in Zambia, the Opponent submits that a perusal of exhibit "**MS5**" in the said affidavit reveals that the trademark "X-PRESSION" was removed from the register. The Opponent submitted that this formed the basis of the Opponent's opposition as they sought to register their globally recognised trademark but had to first oppose the Applicant's intended registration.
34. The Opponent has argued that the registration of the Applicant's mark will result in a strong likelihood of confusion and relies on section 16 of the Trade Marks Act to oppose the registration of the Applicant's mark. Referring to exhibits "**PAO10**" to "**PAO13**" of the Opponent's affidavit, the Opponent submits that it has detailed and demonstrated that its internationally known trade mark has presence in Zambia. Further, that a perusal of exhibit "**POA10**" to "**POA12**" shows the gross similarity between the Opponent's product which bears the trademark "**X-expression**" and the Applicant's intended mark "**Ultra-Xpression**". The Opponent



contends that if the Applicant's mark is allowed to be registered, this would undoubtedly deceive and cause confusion among the public.

35. The Opponent cited the case of **N.R. Investments Limited v Tiger Foods Brands Intellectual Property Holdings Company (PTY) 2012/HPC/0373** where the court considered the test for determining similarity of trademarks which were broken down as follows:

1. *To hear evidence.*
2. *Compare the articles; in doing so ascertaining.*
 - 2.1 *Whether or not there is a likelihood of the similarities deceiving the average customer.*
 - 2.2 *whether or not there are points of dissimilarity.*
 - 2.3 *What is the collective effect of the findings in 1& 2 above?*
3. *Whether or not there is some essential point of difference or resemblance which overcomes or establishes the effect of the other points of resemblance and in so doing, determine:*
 - 3.1 *how much of the matter complained of is common to the world.*
 - 3.2 *how much of the matter complained is common to the trade in other similar articles.*
 - 3.3 *How much of the matter complained of is common to the trade in the specific commodity i.e. is it the colour, shape, form or originality of arrangements.*

36. Applying the above test to the case in *casu*, the Opponent submitted that it has sufficiently met all the grounds of this test in the following manner: a) It has demonstrated in exhibit "PAO11" and "PAO12" that the Applicant's mark bears both the name "ultra" and "X-expression" which are graphically and phonetically similar to the Opponent's trademark.

b) That there is very little dissimilarity save for the font and colour of the Applicant's intended trademark.



c) It has demonstrated in paragraphs 9-12 of the Opponent's affidavit how the Opponent has regional reputation owing to its various trademark registrations in the respective countries and paragraph 13-15 of how the Opponent enjoys local presence in Zambia.

37. The Opponent reiterated its stance that Zambia is a member of the Madrid Protocol, which safeguards international trademarks, including the Opponent's mark. It referenced the relevant international treaties, namely the Madrid Protocol, the Paris Convention, and the TRIPS Agreement. The Opponent argued that these treaties hold persuasive value. To support this, the Opponent cited the case of **Zambia Sugar Plc V. Fellow Nanzala SCZ Appeal No. 82/2001** where the Supreme Court of Zambia held that international instruments on any law, albeit ratified and assented to by the state cannot be of force but merely persuasive value.

APPLICANT'S WRITTEN SUBMISSIONS

38. The Applicant filed its written submissions on 9th September 2022. The Applicant submitted that the issues arising in this matter are twofold, namely, whether the Opponent has sufficient legal standing to challenge the Applicant's application and, whether the Applicant's application was applied in bad faith and is strikingly similar to that of the Opponent's trade mark.

39. The Applicant contends that the Opponent has not complied with the relevant provisions of the Trade Marks Act which is the governing Act under which the Opponent seeks protection of its purported trademark "X-PRESSION". The Applicant submits that the Opponent therefore has no legal standing to challenge the Applicant's application.

40. The applicant cited section 73(1) of the Trade Marks Act which grants priority for trademark registration to persons who have applied for



protection in a Convention country, to register their trademark in the relevant country with the same filing date as their initial application in the Convention country. The Opponent argued that the prescribed procedure in the said section was not followed by the Opponent. That the Applicant on the other hand has adduced evidence in its Further Affidavit to demonstrate that the Opponent's purported foreign trademark is not registered under the Trade Marks Register in Zambia.

41. To fortify its submission, the Applicant relied on the case of **DH Brothers Industries (Pty) Limited v Olivine Industries (Pty) Limited (2012 ZMSC**

17) where the Supreme Court stated that a party cannot be accorded protection of the Trade Marks Act to oppose or prevent the registration of another party's trade Mark if its own trade Mark is not registered on the Register of Trademarks.

42. The Applicant further submitted that the Opponent has no sufficient interest to claim priority of their purported trademark "X-PRESSION" because the said trademark has at all material times been subsisting and registered in Zambia in favour of **Stripes (Zambia) Limited**. Furthermore, that the Applicant has shown evidence in its Further Affidavit that it has been using the phrase "ULTRA X-PRESSION" in its products continuously from as early back as July 2005 garnering goodwill and reputation in Zambia, Kenya and India. It was therefore submitted that the Opponent has failed to show sufficient interest to seek the Tribunal's protection under the Trade Marks Act.

43. In arguing whether the Opponent's purported foreign trademark is confusingly similar with the Applicant's trademark, the Applicant submitted that the Opponent's opposition is lacking in merit as the two trademarks are different. The Applicant contended that the trademarks are different by virtue of the trademark **ULTRA X-PRESSION** and the



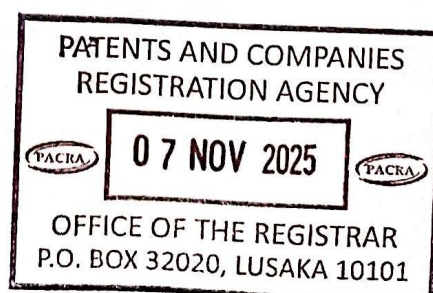
Opponent's trademark **X-PRESSION** having a difference in the word '**ULTRA**' which would allow the public to distinguish between the two and by virtue of the logos of the two products being visually different. They pointed out that the degree of resemblance is very slim due to the logos, font size and packaging being different. Further, that the Opponent did not put forward evidence pointing out how the two products are similar and may cause deception.

44. Moreover, the Applicant argued that it has demonstrated that it has been using its trademark **X-PRESSION** and **ULTRA X-PRESSION** for several years in different countries without any issues as to it having confusing similarity with the Opponent's purported foreign trade mark.

45. In addition, the Applicant stated that the Opponent failed to meet the test of showing that its products are confusingly similar with the Applicant's product and the likelihood of deceiving its customer as observed in the case of **Trade Kings Limited v Unilever and Others (2002) ZMSC 9** wherein the erstwhile Chief Justice held that:

In Trade Mark cases it must always be kept in mind that the actual issue is not whether or not the judge would or would not have personally been deceived, but whether or not after hearing the evidence, comparing the articles, and having had all the similarities pointed out, the true conclusion is that the ordinary average customer or retailer dealer is likely to be deceived.

46. On the basis of the above authority, the Applicant submitted that the Opponent's application is unfounded and should be dismissed.





ANALYSIS AND DECISION

47. I have carefully addressed my mind to the arguments for and against this opposition as well as the authorities cited. I have also thoroughly considered the evidence submitted by both parties in support of their respective claims.

48. In the Notice of Opposition, the Opponent cites two grounds for opposing the registration of the Applicant's trademark. Firstly, relying on section 16 of the Trade Marks Act, Chapter 401 of the Laws of Zambia ("the Trade Marks Act"), the Opponent seeks to prevent the registration of the Applicant's trademark '**ULTRA X-PRESSION**' on the basis that it is confusingly similar to the Opponent's trademark '**X-PRESSION**', which is registered in other jurisdictions. Secondly, the Opponent alleges that the Applicant's mark was applied for in bad faith having deliberately copied the Opponent's trademark.

49. I will first consider the ground of opposition premised on Section 16 of the Trade Marks Act, which provides as follows:

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

50. The foregoing provision is three-fold:

- (i) It prohibits the registration of a trademark (or part of a trademark) if its use is likely to deceive or confuse the public or otherwise, be disentitled to protection in a court of justice
- (ii) A trademark cannot be registered if its use would be contrary to law or morality. This means that the trademark cannot represent something illegal, unethical, or offensive.

- (iii) It prohibits the registration of any trademark that contains a scandalous design.

51. It is clear that the Opponent is relying on the first aspect, having alleged that the Applicant's mark '**ULTRA X-PRESSION**' bears a striking resemblance and is confusingly similar to the Opponent's trade mark '**X-PRESSION**' and argues that if the Applicant's mark is allowed to proceed to registration, the public is certain to be deceived that there is a trade connection between the Opponent's goods and the Applicant's goods.

52. Having reviewed the Opponent's affidavit evidence which exhibits the two respective trademarks, I have no doubt that the two trademarks share a striking similarity, as the Applicant's mark fully incorporates the Opponent's mark, with the word "**X-PRESSION**" appearing in both marks. This, as earlier stated, forms the basis of the Opponent's claim of a likelihood of confusion or deception in line with section 16 of the Trade Marks Act. However, in considering whether the opposition can succeed under Section 16, I will also seek to address the Applicant's argument concerning the Opponent's legal standing to challenge the registration of the Applicant's trademark, because the Opponent's trademark is not registered in Zambia.

53. The Applicant has argued that the Opponent does not have legal standing to oppose the registration of its mark because the Opponent's purported foreign trademark is not registered in Zambia. The Applicant has relied on the case of **DH Brothers Industries (Pty) Ltd v Olivine Industries (Pty) Ltd (2012 ZMSC 17)**, where the Supreme Court of Zambia held that a party seeking to oppose the registration of another party's trademark must have a registered trademark in Zambia."



54. The Opponent's evidence shows that the Opponent's trademark '**X-PRESSION**' is registered in Nigeria and other African countries through the Africa Regional Intellectual Property Organization (ARIPO) but is not registered in Zambia. Notwithstanding, the Opponent argued that Zambia is a member of the Madrid Protocol which protects international trademarks including its trademark '**X-PRESSION**' and therefore requests that the Applicant's mark be disallowed registration. The Opponent has further contended that its internationally known trademark has presence in Zambia. The Opponent exhibited in its Affidavit in Support of Opposition, pictures purporting to show products bearing the Opponent's logo "**X-PRESSION**" as proof of use in Zambia.
55. Certainly, the **DH Brothers case** has established a precedent in which the Supreme Court affirmed that a party who does not have a registered trademark in Zambia cannot invoke the protection of the Trade Marks Act to prevent the registration of a competing trade mark. The question for determination in the appeal, which was also the question before the Appellate High Court Judge, was "*Whether an unregistered trademark, which resembles or is identical to another mark, which is also unregistered, can prevent the other unregistered mark from being registered under the law and the rules in the Trade Marks Act?*"
56. In its analysis, the Supreme Court upheld the lower Court's finding that Section 16 of the Trade Marks Act should not be read in isolation of other provisions of the Act. That properly read with Section 17(1) of the Act, it will be seen that protection is only offered to registered trademarks and not similar or identical unregistered trademarks. It was the Court's conclusion that both the Registrar of Trade Marks and the Appellate High Court Judge were on firm ground when they held that the Appellant's trade mark "**Daily**" could not be accorded protection because it was not



registered, even though the Appellant had shown sufficient prior use of the mark in Zambia.

57. Applying the above principles to the current case, it is evident that while the Opponent has presented what appears to be evidence of its trademark use in Zambia, the Opponent is precluded from invoking the provisions of section 16 of the Trade Marks Act to challenge the registration of the Applicant's mark, as the Opponent's trademark is not registered in Zambia.

58. The Supreme Court's decision in the **DH Brothers case** reaffirms the principle of *territoriality* which holds that trademark rights are confined to the jurisdiction in which the mark is registered. However, there are exceptions to this rule which allow for broader protection under certain circumstances. Under international agreements like the **Paris Convention** (Article 6*bis*) and **TRIPS Agreement** (Article 16(2)), well-known trademarks may be afforded protection beyond the jurisdiction where they are registered. Even if a trademark is not registered in a particular country, if it is recognised as 'well-known', the owner can prevent others from registering or using confusingly similar marks in that jurisdiction. The Opponent has submitted that its trade mark is recognised across the African Continent and is registered to international treaties to which Zambia is a Signatory.

59. However, in the decision of the Registrar of trade marks in **Britannia Industries Ltd v Britania Products Ltd (2020)**, it was held that Article 6*bis* of the Paris Convention is not self-executing and requires legislative implementation before it can be invoked by the Registrar or the Courts. Consequently, since Article 6*bis* of the Paris Convention has not been incorporated into the Trade Marks Act, the exception for well-known marks to the principle of territoriality does not apply in Zambia.



60. For the reasons outlined above, the Opponent's ground of Opposition based on section 16 of the Trade Marks Act cannot be sustained and is accordingly dismissed.

61. I will now address the ground of bad faith, which the Opponent has also raised as a basis for challenging the registration of the Applicant's mark. The Opponent claims that the Applicant's application was made in bad faith, arguing that the mark 'ULTRA X-PRESSION' was intentionally copied from the Opponent's trademark 'X-PRESSION', an allegation which the Applicant strongly denies.

62. In the case of **Hotel Cipriani SRL v Cipriani (Grosvenor Street) [2008] EWHC 3032 Ch**, the UK High Court held that the correct approach to bad faith was to decide *a) what the defendant knew; and b) in the light of that knowledge, was the defendant's conduct "dishonest by ordinary standard of honest people."* Thus, the question whether the Applicant's application was filed in bad faith is a question of evidence. It must be shown by evidence that the Applicant was acting in bad faith at the time of filing the application.

63. The Opponent in its Affidavit in support has shown that the trade mark X-PRESSION was registered in Nigeria in June, 2003 by a company that later assigned the trademark to the Opponent. In contrast, the Applicant asserts that it has been using the phrase "ULTRA X-PRESSION" on its products continuously since July 2005. In this regard, I have reviewed Exhibits "MS1" and "MS2" from the Applicant's Further Affidavit, which show that the trademark 'X-PRESSION' was initially registered in 2005 in Zambia under the name STRIPES (ZAMBIA) LIMITED, which later changed to HAIR CREDENTIALS ZAMBIA LIMITED (the Applicant). I have also noted the evidence indicating that the trademark 'ULTRA X-PRESSION'



has been in use and is registered in Kenya through the Applicant's sister company since April 10, 2008.

64. Although the Opponent has attempted to claim rights over the X-PRESSION trademark prior to the Applicant's acquisition of rights to the ULTRA X-PRESSION trademark, no credible evidence has been presented to substantiate a claim of bad faith. The mere assertion that the Opponent may have prior rights to the X-PRESSION trademark does not imply that the Applicant was aware of the Opponent's trademark in a manner that would suggest dishonest conduct in seeking registration of a similar mark. In view of the foregoing, the second ground of opposition fails, as the Opponent has not adduced relevant evidence to support a claim of bad faith.

CONCLUSION

65. As the Opponent's substantive grounds in these proceedings have been unsuccessful, the Opposition is hereby dismissed. Therefore, the Applicant's trademark application No. 1833/2019 may proceed to registration, provided no appeal is filed within the prescribed time frame.

66. Leave to appeal is granted and each party shall bear its own costs incidental to these proceedings.

Dated the Day of 2025



Benson Mpalo

REGISTRAR OF TRADEMARKS

