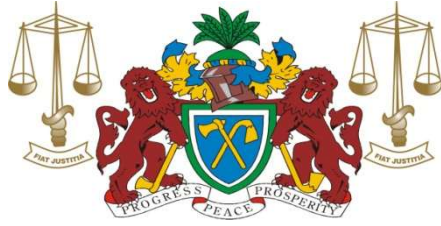


IN THE SUPERIOR COURTS OF THE GAMBIA



IN THE HIGH COURT OF THE GAMBIA

HC/636/14/CO/162/D2

BETWEEN

**MALICK CAMARA(Treading as Nyang
Bantang General Merchant and
Sports Partner Spot Seller
German).....PLAINTIFF
AND**

OUSMAN JALLOW.....1ST DEFENDANT

EBRIMA JALLOW.....2ND DEFENDANT

**CASE CALLED: TUESDAY 14TH FEBRUARY, 2023.
BEFORE HON. JUSTICE F.A ACHIBONGA
PARTIES EXCEPT 1ST DEFENDANT
M.O.S BATCHILLEY WITH ADAM H.B FAAL
I.JALLOW FOR DEFENDANTS – PRESENT**

RULING

On 09/12/20, the plaintiff/respondent herein filed a writ of summons against the applicant herein and another seeking the following reliefs:

1. General Damages for wrongful imitation of the plaintiff's Trademark; SALLER bearing registration Number GM/M/2006/00254.
2. An injunction to restrain the 1st and 2nd defendants whether by their directors, officers, servants, agents or otherwise howsoever from using or continue to do the following acts namely:
 - i. Infringing the plaintiff's registered Trademark Number GM/MM/2006/00254 SALLER sporting articles.
 - ii. Use of the plaintiff's trademark SALLER sporting articles on Gambia National Football Team jersey depicting The SALLER Logo.
 - iii. Passing off or attempting to pass off the sporting articles on Gambia National Football Team jersey depicting The SALLER Logo coloured white on a red jersey of the defendants as for the plaintiff's jersey.
3. An order for delivery up to the sheriff and destruction of all of the defendants goods bearing the Trademark SALLER sporting articles on the Gambia National Football Team jersey depicting The SALLER Logo coloured white.
4. An inquiry as to damages or an account of profits and payments of all sums found due upon taking such inquiry or account.
5. Interest at the rate of 25% per annum on all amounts found to be due pursuant to section 7 of the laws of England application Act. Cap 5:01.
6. Cost
7. Further or other reliefs.

Relief 2 (iii) has been left out on purpose as it is a repetition of relief 2 (ii).

After the defendants were served with the originating processes and the time limited for the 1st defendant/applicant herein to file his defence had lapsed and no defence filed by him or on his behalf, the plaintiff/respondent pursuant to the 2013 Amendment Rules – order 23 (14) 5 (as amended) filed a motion on notice on 6/10/22 for judgment, but before the plaintiff's case for judgment could be heard, the 1st defendant/applicant filed the present application on 25/10/22 seeking to dismiss Relief 1 endorsed on the writ of summons on grounds that it discloses no cause of action against the applicant and that it is scandalous, frivolous, embarrassing to the applicant and an abuse of the court process.

This ruling is therefore in respect of the 1st defendant/applicant's application to dismiss or strike out relief 1 endorsed on the writ of summons.

The gravamen of the applicant's application can be found in paragraph 8 of the affidavit in support of the application which states as follows;

“Ibrahim Jallow Esq. of counsel for the 1st defendant has informed me and I verily believe him to be true and correct that, assuming without conceding that the plaintiff's claims/allegations against the 1st defendant are true, the plaintiff claimed (sic) of wrongful imitation of Trademark against the 1st defendant is not maintainable in law. An allegation of wrongful imitation of Trade-mark is only maintainable in law against the manufacturer of the product and not retail seller or user.”

Having failed to file a defence to the respondent's suit, it lies ill in the mouth of the applicant to at this stage be seeking to deny factual averments made in the statement of claim or the affidavit

in support of the motion for judgment. By failing to file a defence to the action, the applicant is deemed to have admitted the factual averments contained in the statement of claim and same can not be disputed through the backdoor as the applicant by almost all the averments in the affidavit in support of the application is seeking to do. The only reason why the application is entertained by this court is because, by virtue of paragraph 8 of the affidavit in support, the applicant is in effect making and relying on a legal defence by way of a Demurrer pursuant to order 17 of the High Court Rules, - second schedule as the applicant's claim basically is that even if the allegations made by the respondent in his claim were true, the claim of wrongful imitation of Trademark is not maintainable in law and that same can only be maintainable in law against the manufacturer and not a retailer.

Counsel for the applicant contends that the applicant not being a manufacturer, he can not be held to have infringed on a Trademark.

With due difference to counsel for the applicant, this may be true under common law, but once the industrial property Act Cap 95:04 forms part of our laws and caters for matters, subject matter of the application, same shall be applicable and not the common law position or for that matter the position of another jurisdiction. It is only when there is a lacuna in our laws, that, we fall on the common law or persuasive decisions or position of the law in other like - sister jurisdictions. I therefore intend to apply the industrial property Act in resolving this application.

By Section 27 of Cap 95:01, a person or entity can only have an exclusive right to a mark by registering the said mark in accordance with the provisions of Cap 95:01. Once a person or

entity register's a mark under the Act, he or she is entitled to certain rights conferred on him or her by virtue of section 31 of the Act. By section 31 of the Act, a registered mark owner is protected against the use of the registered mark by another person or entity other than the registered owner without the latter's agreement, which right can be enforced in court by the registered owner against any such person or entity who infringes the registered trademark by using same without his or her agreement or who performs acts which makes it likely that the infringement will occur. The fact of registration of a mark is a question of fact not law.

Thus, once a plaintiff claims he or she has registered a mark, he or she is entitled to lead evidence in support of that claim and it can not be said that even if the plaintiff's claim of registration is admitted he will not be entitled to judgment. The fact of registration itself entitles the plaintiff to maintain an action against the infringement of that mark by a person other than the registered owner in respect of goods and services. Thus once the respondent claims to have registered the trademark, subject matter of this suit, he has to be given the opportunity to demonstrate the fact of registration. I do not understand Cap 95:01, particularly Section 31 thereof as protecting the registered owner of a trademark against the manufacturer of goods only. It applies to even retailers and distributors of the said goods and to that extent I do not see how a demurrer claim as in the present case can succeed.

In this case, the respondent per paragraph 5 of his statement of claim states that he duly registered the trademark under the industrial property Act, Cap 95:01. Since the respondent has not

filed a defence to deny this averment, he is deemed to have admitted same and the fact of the plaintiff having registered the mark, subject matter of this suit is not in dispute at this stage.

Having registered the mark, the plaintiff is entitled under section 43 (2) of the Act – Cap 95:01 to institute the present suit against the applicant. It is the duty of the plaintiff/respondent to demonstrate that the applicant indeed infringed on his registered trademark by using same to sell goods in The Gambia. This burden is a factual one as opposed to a legal burden and same can only be discharged through evidence and the respondent must therefore be given the opportunity to produce his evidence before the court. To that extent, I do not see how it can be said that even if the fact of the respondent's registration of trademark is conceded, his action is still not maintainable against the applicant. I do not therefore see how the applicant can claim the respondent's claim is an abuse of the court process or even that he has a legal defence to the respondent's action based on the fact that a trademark action is only maintainable against the manufacturer of goods. The applicant's claims in this regard are therefore rejected by the court.

Counsel for the applicant in his submissions contends that the Act only protects "Marks" and not "Trade Marks" and that Section 31 of the Act has to do with "Marks".

If my understanding of the Contention of counsel for the applicant is correct and I presume it is, counsel for the applicant is seeking to say there is a difference between a "Mark" and a "Trademark" and that the Act protects against the infringement of a "Mark" not a "Trademark" and since the respondent's claim is in respect of a

“Trade Mark” he can not seek protection under the Act, which deals with “Mark”.

I do not see the basis of counsel for the applicant’s contention. The definition section of the Act on the issue of marks, trade names etc; Section 26 thereof defines a “Mark” as follows;

.....“Mark” means a visible sign capable of distinguishing the goods (“Trade Mark”) or services (“service mark”) of an enterprise.”

Thus, a “Mark” is generic and could be a “Mark” in relation to goods or services and when it relates to goods, it is a “Trade Mark” and when it relates to services it is a “service mark”.

A “mark” therefore includes a “Trade Mark.”

I therefore do not have any doubt in my mind that when it comes to goods as in the case of the respondent’s claim, a “mark” is the same as a “Trade Mark.”

Counsel for the applicant also refers to Section 43 (2) of Cap 95:01 and contends that it is only the owner of the mark who can sue. That is true but the owner of the mark is the person or entity that has registered the mark under the Act and since the respondent claims to have registered the mark, subject matter of this dispute under the Act, he is presumed to be the owner of the said mark.

For the above reasons, I hold the view that the plaintiff/respondent’s claim of wrongful imitation of trade mark against the 1st defendant/applicant is maintainable in law, unless the factual averments therein are controverted, so as to make

them unreliable or that no evidence is led in support of the said claims. It can not therefore be the case that even if the claims/allegations against the 1st defendant/applicant are admitted, he still has a legal defence to the suit; at least same is not borne out of the present application.

In sum, the 1st defendant/applicant's motion to set aside or strike out relief 1 endorsed on the writ of summons lacks merit and same is hereby dismissed.

.....
HON.JUSTICE F.ACHIBONGA
(JUDGE)
14/02/2023

**ISSUED AT BANJUL UNDER THE SEAL OF THE COURT AND THE HANDS
OF THE PRESIDING JUDGE THIS 14th FEBRUARY, 2023**