

CIVIL ENFORCEMENT OF TRADEMARK RIGHTS IN ZIMBABWE

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Abstract

Protection of property rights is one of the key functions of any legal system. The assertion of rights by right holders in the event of infringement or misuse is one of the key roles of the civil courts in Zimbabwe. A number of courts including the Magistrates Court, the High Court, and the Supreme handle civil trademark disputes in Zimbabwe. The civil process is one of the key enforcement mechanisms available to trademark right holders in Zimbabwe. Creativity in the intellectual property sector is hinged in part on the level of enforcement availed by the law and the courts to right holders. Without the law providing real remedies when infringement of intellectual property rights takes place, rights accorded by the law to trademark owners will be of no value. This study examines the status of civil trademark law in Zimbabwe with a view to ascertain the extent of its effectiveness. The following aspects of the civil litigation process were looked at; the cost involved, the duration of proceedings, the right of audience, the available remedies, the set-up of the courts, evidence required, onus of proof and other aspects. These challenges can be resolved by a number of measures which do not require infrastructural or expensive changes in the legal system.

Keywords

intellectual property, trademark, civil, enforcement, Zimbabwe

Introduction

Enforcement of rights accorded by the law is very important for the full realisation of any given rights. According to Keplinger (2008, p.2) the protection of property rights is one of the keystones of a free and flourishing society. Protecting intellectual property (IP) from unauthorised use and ensuring that creators, rights holders and governments reap the full benefits offered by the IP based industries ought to be a top priority at both national and international levels. To a larger extent the judiciary plays an important role in civil enforcement of any intellectual property rights including trade mark rights. Without the ability to get remedies from competent courts in cases of infringement, trademark rights given by the law can become ineffective and of no use. This has led Keplinger to argue that:

... IP rights are only valuable if they can be protected, and enforced: "a right without a remedy is not a right." While digital technologies have revolutionized the way in which we create and do business, those same technologies have fueled a dramatic escalation in IP-crime. Combating IP infringement, especially in the serious forms of counterfeiting and piracy, is now a major challenge for many countries and regional institutions. (Keplinger, 2008, p. 2)

One area of IP affected by infringements is trademark law. For the law to be effective and for right holders to have comfort that their investments are protected affected intellectual property rights holders must have real legal recourse in the event of infringement of their rights. In this way right holders may reap the benefits of their investment and rights.

The Paris Convention for the Protection of Industrial Property (Paris Convention) in Article 10^{ter} (1) imposes an obligation to member nations to have appropriate legal remedies in their legal systems in matters concerned with trademarks and other Intellectual Property Rights (IPR) rights. Trademarks are mentioned by name in the article to emphasise their importance. This requirement is further confirmed by the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) in Article 41 (1). The Article emphasises the need for nations to set up good and effective enforcement systems that prevent infringements. These systems must be both expeditious and deterrent in nature to would be infringers. Zimbabwe is a member to both the above Treaties. Zimbabwe has domesticated some of the enforcement provisions of the international instruments in its national laws. See for example the Trademark Act (Chapter 26:04).

The WIPO Handbook (2004) defines a trade mark as any sign that individualises the goods of a given enterprise and distinguishes them from the goods of its competitors. The trademark must clearly be a badge or mark of origin of the goods. In this regard the Supreme Court of Zimbabwe in the case of *Zimbabwe Gelatine (Pvt) Ltd v Cairns* SC-130-02 at 4 of the cyclostyled judgement stated that:

The purpose of registration of a trade mark is that no other party should use the trade mark. Kerly's *Law of Trade Marks and Trade Names* at p 12 para 2:08 says:

"The function of a trade mark is to give an indication to the purchaser ... of the trade source from which the goods come or the trade hands through which they pass on their way to the market."

It follows that once a trade mark is registered, persons who purchase goods with the registered trade mark associate those goods with the owner of the trade mark. (Supreme Court, 2002, p.4)

In other words the products of two competing producers must clearly show that they are manufactured by different enterprises even though they are of the same type.

Intellectual Property Enforcement in Zimbabwe

Trademark infringement and counterfeiting activities are on the rise globally and some of such goods are finding their way to the market in Zimbabwe. Various goods are passed off, infringed or counterfeited in various parts of Africa. These range from luxury goods, medicinal drugs, motor vehicle spares, seed, pesticides and other commodities. Some Zimbabwean right holders have been victims of this problem. Cases of counterfeit seeds, ball point pens, motor vehicle spares such as filters and other commodities have been reported in the press and other forums in Zimbabwe. Some of the cases have found their way to the courts. The courts have also added their voice to the challenge of trademark infringement and other IP violations in Zimbabwe. In the case of *S v Moyo & Anor* HB-21-09 Justice Ndou noted that:

This is novel prosecution in this region for the protection of the creations of the human mind. This is a welcome development in our jurisdiction where ...infringement is very rife but enforcement is extremely low. This scenario has resulted in the confusion of the public as to the source of the goods, products or service. In the circumstances intellectual property rights infringement has to be curbed with zeal and determination. (Justice Ndou, 2009, p.3)

While this was said in the context of a criminal case, the point applies with equal force to civil disputes. The problem seems to be that there is little to no enforcement of intellectual property rights when they occur in Zimbabwe. There are a number of reasons for this state of affairs some of which are analysed below in section 2.

Use of the Civil Court System to Protect Trade Mark Rights

Intellectual Property (IP) is a technical, specialised and evolving discipline of the law in many developing countries. This holds true in Zimbabwe. In Zimbabwe the Magistrates court and High Court may deal with first instance civil disputes, the former court's jurisdiction is only limited by the value in the dispute. The Supreme Court handles appeals from the High Court.

The Trade Mark Act in section 9B(c) grants jurisdiction to hear trademark disputes to Magistrates Courts among other courts so long as the value in dispute does not exceed the monetary limit of the said court. This is a good development since Magistrates Court civil process is faster, cheaper and accessible as compared to civil litigation in the High Court. The court fees are less and the fact that Magistrates Courts are located in every town and district means that these are the courts that can be accessed by everyone in Zimbabwe. For the whole of

Zimbabwe there are only four High court sittings at Harare, Bulawayo, Mutare and Masvingo. These serve a population of over 13 million people. These courts have minimal number of judges. To that extent the provision of 9(B) and (c) of the Trademark act is user friendly and positive in so far as it allows the lower courts to deal with trade mark disputes. What needs to be addressed is the issue of training on the part of the courts.

The challenge that will require resolution is that of training. Training of judicial officers is essential for them to be effective. Judicial officers require on job training to appreciate trademark and other IP matters, otherwise the expected benefits of quick decisions and lower cost will not be realised at all. Indeed the case of *S v Moyo* HB-21-2009 discussed elsewhere in this article exposes that lack of knowledge among the magistracy. The substantive and procedural law errors made by the lower court in that case were too glaring. Of course, the other contributing factor is that the courts do not handle that many cases in IP as a result they are not familiar with the subject. This is because there are less disputes of IP related matters (whether criminal or civil) that are taken to the courts.

In terms of section 9(3)(a) of the Trademarks Act a court awarding damages may have regard to the flagrancy of the infringement and award additional damages or exemplary damages where they are justified. This is a good approach which bases the award of damages on the level of infringement. This provision clearly makes infringements unrewarding to infringers as they are made to pay for all the unjustified benefits they may have received from infringing activity. How the courts will interpret the provision is yet to be seen since the coming into force of the amendment that introduced the provision in September 2010. Another interesting feature of the provision is that it is in sync with article 41.1 of TRIPS.

The other constraint to enforcing rights under the civil process is the cost involved. Litigation is in general a slow and expensive process and it is more so in IP matters due to their complex nature. The United Kingdom Jackson report (2009, 3) finding that “in some areas of civil litigation costs are disproportionate and impede access to justice”, applies to Zimbabwe. In Zimbabwe lawyers charge for their services based on the time spent on a case. In addition, the tariff of charges varies depending on the level of experience. The more experienced the lawyer is the more he or she charges for his or her services. The charges can range from \$150 per hour to as much as \$400 per hour for the senior counsels in Zimbabwe. Justice Harms notes that legal costs under the common law system tend to be more than in the civil law systems. For example he states that the cost of a typical patent case in the United States ranges from \$1million to \$3million. Of course trademark litigation is not as expensive in Zimbabwe but still relatively expensive. However, taking into account the average incomes in Zimbabwe the legal costs mentioned above are still high. The cost of litigation is definitely a factor that a claimant or right holder will consider before resolving to approach the courts in the case of an infringement of his or her trademark rights.

In Zimbabwe the general common law rule is that the award of litigation costs are within the court's discretion. In other words the court can order one party to pay the costs of the other. While the courts normally use the principle that costs follow the event, meaning that the successful party in a civil case is awarded costs by the court, this does not happen in every case. The purpose of this rule is to make frivolous litigation costly. The above rule does not always apply for a number of reasons. Secondly, even where the principle is used the costs recovered from the unsuccessful party are not the full costs that the successful party will have used in the case. This is because the costs have to be taxed according to a tariff and the tariff more often than not bears little relationship to what lawyers actually charge their clients. The court rules peg a tariff of fees that are recoverable from the unsuccessful party. This tariff is less than the tariff that lawyers use to charge their clients. As a result the costs recovered are only a fraction of the actual expenses incurred. This is a disincentive to civil enforcement of trademark rights through the courts. In addition, unless the unsuccessful litigant voluntarily pays the costs after taxation or agreement on the figure between counsels, the successful party has to execute to get the fees. Execution means more unrecoverable costs in some instances. The attempt at execution may fail if the judgement debtor has no executable property.

The courts do sometimes award costs at a higher scale or at a legal practitioner and client scale. This rate of costs is higher and the successful party recovers all fees paid to his or her legal practitioner. The challenge though is that this award is made in special circumstances where the other party has acted *mala fides*. For example through abuse of the legal system or behaved in a reprehensible manner during the court proceedings such as deliberately misleading the court, see for example *Momberume v Marange Apostolic Church of St Johanne & Ors* HH-130-13, *Gumbo v Steelnet (Zimbabwe) (Pvt) Ltd* HB-84-13 and *Mutandwa v Zhuwaki & Ors* HH-115-13. As a result such awards of costs are rarely made by the courts. In the main the costs at the ordinary scale are awarded in the majority of civil cases.

Barton and Cooper (2013) believe that adjudication must remain a central option of enforcing trademark rights. Its properties of transparency, clarity, power, precedent, and ability to bring a public regulatory voice to intellectual property disputes make adjudication an invaluable resource. But its accelerating costs, delays, uncertain expertise, and possible relational destructiveness have spawned a private market for alternative methods. The civil process must weather these challenges to remain relevant and useful to users.

It should be borne in mind that the duty to enforce civil rights rests with the right holder themselves. The 'private' nature of IP rights suggests the importance of resolution of disputes between parties either out of court or under civil law. It is therefore incumbent upon right holders to use the civil system, test it and where necessary advocate for reforms of the system.

In addition, for judges and the courts in general to function they need to preside over cases. Trademark owners have the role of referring their disputes before the court system. Right holders play a crucial role in ensuring effective enforcement of their rights. Right holders have to be vigilant at all times to ensure that their rights are not infringed and when infringed they should be quick to take action. The corrective action taken by right holders through the courts help to shape the IP jurisprudence of the nation. Without this critical stakeholder the court system will not function well.

The role of a judge in civil trademark enforcement

According to Jackson *supra* the creation and use of IP plays a crucial role in economic activity and in the achievement of many social goals, such as effective health care or renewable energy. He further asserts that the background to any IP regime must be a civil justice system which enables parties to assert or defend their IP rights (IPR). Such a civil justice system must deliver correct judgments at affordable cost in the complex field of IP. (Jackson Report, 2009). In terms of the Zimbabwean constitution judicial authority is vested in the courts. The courts are independent and only subject to the constitution and the law which they must apply impartially. No person or organ may interfere with the functions of the courts. A number of courts exist in Zimbabwe but of interest to the civil enforcement of rights are the Magistrates court, the High Court and the Supreme Court. The first two may deal with first instance cases while the latter one is an appeal court. The High Court also deals with civil appeals from the Magistrates courts. A specialist administrative court, the Intellectual Property Tribunal also exists in Zimbabwe. While it took long for it to be operationalised, this has since been done by the Judicial Law Amendment Act of 2017. The court was formalised as a specialised division of the High Court. Intellectual property rights are in the main quasi property rights in Zimbabwe. Therefore the approach of a court in handling trademark cases is similar as in any other civil matter. At common law and constitutionally all persons are entitled to a fair hearing before an independent tribunal in Zimbabwe.

The role of the judiciary consists in securing respect for and efficient enforcement of legislation and protecting rights and freedoms. It is not sufficient that legislation establishes rights or means of acquiring rights, acquired rights must be guaranteed through efficient channels of justice controlled by a solid judiciary capable of protecting rights against violation and abuse. Badrawi (2004, p.1) asserts that one of the most important rights for which protection and efficient enforcement must be provided relates to the human intellect. Human intellect plays a crucial role in the development of nations and companies. Inventions, arts and culture and other intellectual property spur economic growth and revenues for individuals and the State. As such intellectual property rights just like any other form of property deserves protection by the courts. Harms (2004, p.12) has added that the validity of intellectual property protection depends heavily on

judicial system performance and that a right without a remedy is an expensive fantasy. As such innovators and investors can only continue creating new technologies if there is a guarantee that that such right will be protected by the courts in the event of infringement. At the same time infringers will also know that infringement does not pay if properly granted rights are upheld by the courts.

In many instances technological developments outstrips legal development. This has happened in many areas of intellectual property law. See for example such cases as *Northern Office Micro Computers (Pty) Ltd & Ors v Rosenstein* 1981(4) SA 123, *MGM Studios Inc. v Grokster Ltd* 380 F 3d 1154 (9th Circuit 2004). Cybersquatting and domain names are one such area of law. As such judges in intellectual property cases have to be proactive and ever willing to learn. This fact was noted by the Zuallcoblely et al. (2012, p.7) where they say, "Because IPR constitute an ever-changing area of law, the need for training may be an ongoing cost." Indeed the intellectual property landscape is littered with so many changes and developments such that the need for constant training of judicial officers involved in the subject is a must in order to apprise them of recent trends. Zuallcoblely et al supra adds that without continuing training and education, specialised judges may be less equipped to hear new issues, and the court may become less efficient and consistent. In addition, to the training an individual judge must be able to be practical and proactive so as to deal with new issues using old laws.

An element of judicial activism is necessary to deal with such changes or with evolving challenges such as widespread infringements. A case in point is the approach adopted by the Chinese courts in 2005 where they held that landlords are contributory liable for trademark infringement perpetrated by their tenants with their knowledge. The plaintiffs were brand owners of Burberry, Chanel, Gucci, Louis Vuitton and Prada against the landlord of the Xiushui Market – also known as the "Silk Market" – together with five individual vendors. Each of these vendors had been identified as selling the plaintiffs' illicit brands on at least two occasions. The plaintiffs issued warning letters to the landlord seeking assistance in stopping the infringements. The landlord had ignored the letters. (WIPO Magazine 2008)

The courts confirmed that, after receiving notice of violations by particular vendors, the landlord must take prompt and effective measures to stop the infringements. The court also ruled that the landlord and vendors should be jointly and severally liable to pay compensation for losses, plus enforcement costs, totaling around US\$2,500. The landlord appealed. On appeal the Beijing Higher People's Court rejected the appeals. It is submitted that the level of judicial activism in the above cases is to be encouraged in the field of trademark law where legal trends often lag development trends. Dealing with willful infringements and violation of trademark rights require a robust approach to enforcement.

Protection of intellectual property rights require judges and court officials who are proactive, willing to learn and robust for it to be effective. Without the prospect of protection of rights inventors and other intellectual property right holder will lose any incentive to invest in the creation of intellectual property. For the court to be able to control the proceedings effectively, the court must knowledgeable and up to date with the law and technology in dispute. While the common law tradition limit the judge to playing a passive role as compared to the inquisitive role of the continental judge, the judge in Zimbabwe must still control the proceedings. The Court is not merely an umpire but holds a duty to see to it that justice is done. Where necessary it is within the judge's responsibility to take measures that curtail the litigation process as well as reducing the costs of the process.

The role of lawyers in civil enforcement of trademark rights

Like their bench counterparts legal practitioners too have an important role to play in ensuring the adequate protection of trademark rights and other intellectual property rights. It is the legal practitioners who guide the court on the issues in contention, the applicable case precedents and the state of the law through the pleadings they file as well as the submissions they make in court. As such poor quality practitioners are unhelpful to the bench. In addition, it is from the pool of active practitioners that judges are normally appointed from therefore a well-qualified team of lawyers is an effective requirement for the enforcement of intellectual property rights.

Special intellectual property courts

Article 45.5 of the TRIPs agreement does not require of countries to create specialist courts for the enforcement of IP rights. The provision does not totally prevent but merely lays out a minimum requirement which a country may surpass if it chooses. What is the best option for Zimbabwe in this regard? Blakeney *supra* believes that the creation of specialist courts is not best for developing nations. Kong (2005) holds a different view. Commenting on the context of China, he says that judicial enforcement of IPRs requires highly specialised and professional adjudicators learned in science, engineering and law. Such professionals are then appointed to the IP specialist courts with the sole mandate of hearing IP disputes. His argument is that once that is done “a degree of consistency in law enforcement is assured” (Kong, p. 813). Others disagree with this approach:

Specialist IP courts are not always affordable or feasible. In a given country there may be a general lack of resources, a low IP case load and little IP expertise. A centralized IP court may make access to justice illusory. Sometimes common sense may be more important than expertise because it is a moot point of whether all IP work is specialist work. Can a judge, who can read, not see whether one

book is a copy of another? Can a judge, who can hear, not find that one piece of music is a copy of another? And can a judge, who lives in a real world, not decide whether or not one trademark is confusingly similar to another? (Harms, 2004, p.10)

This argument makes good sense for poor nations but can also be too simplistic to an extent. While the point concerning resources and case load are valid and strong the latter part of the argument is weak. Granted some IP matters may be decided on a common sense approach, this does not apply to all IP matters. For trademark the argument holds true. In Germany for example they have a Federal Patent Court whose role is to hear appeals from the German Patent and Trademark office and to hear patent validity cases. This fact clearly confirms the fact that they appreciated the complexity of these types of cases.

Speaking on the German Patent Court composition Bornkamm's (2004, p.4) said that the Patent Court is famous for one feature, that in trademark cases the judges all have a legal background, while in patent cases there is a mixed bench. In such cases the court is made up of judges with legal, scientific and technical background. As a consequence of this type of composition he notes that "it no wonder that this court hardly ever hears expert evidence". In addition to this court only specialist courts deal with intellectual property cases in Germany.

The argument made by Kong is valid but its applicability to a developing or a least developed nation that is grappling with resource constraints is doubtful. The argument about technicality is more applicable in the technical cases dealing with patents but not to other IP matters such as copyright and trademark. Resource constraints and fewer IP cases in Africa may suggest that such a move may not be the best. It is a fact that IP registrations by locals in Africa are insignificant and to suggest that there can be many IP disputes to keep such a specialist court busy may be a fallacy.

The Zimbabwe Intellectual Property Tribunal

Some developing countries such as Thailand have established specialised courts to hear IP disputes in their jurisdictions. Zimbabwe adopted a similar model by enacting the Intellectual Property Tribunal Act (Chapter 26:08) in 2001. It took until June 2017 for the court to be operationalised. Zimbabwe in its written response to the TRIPS Council in 2005 at the time it was seeking membership to TRIPS asserted that it had established an intellectual property tribunal to adjudicate over all civil matters pertaining to enforcement of intellectual property rights. It was further said that "recruitment of the judges of the Tribunal is complete and it is expected that the Tribunal will start operating shortly" (World Trade Organisation, 2005). Contrary to the optimism contained in the statement the court is to date not operational. It appears financial problems have hindered the commencement of operations of this important court in Zimbabwe.

The Intellectual Property Tribunal Act (Chapter 26:08) as read with various IP legislations empowers this court to hear disputes in civil matters concerning the enforcement of IP from the Trademarks Act (Chapter 26:04), Patents Act (Chapter 26:03), Copyright and Neighboring Act (Chapter 26:05), Geographical Indications Act (Chapter 26:06), Industrial Designs Act (Chapter 26:02) and the Integrated Circuit Layout-Designs Act (Chapter 26:07). In terms of section 7 and 8 of the Act, the Tribunal exercises jurisdiction in all civil matters arising from the above enactments. As part of its powers the court have the same powers as the High Court in civil cases in making orders requiring a party to pay security for costs, securing the attendance of any person before it and making discovery of documents. Another positive aspect of the Act is that the court has powers to enforce its decisions. This is unlike the Labour Court created by the Labour Act (Chap 28:01) which has no power to enforce its own judgements. The labour Court relies on other courts such as the Magistrate Courts and the High Court to enforce its judgements. This creates unnecessary further litigation in the said executing courts as well as delays in finalising labour matters. See *Ndlovu v Higher Learning Centre* HB-86-10, *Chiraire v Mt Darwin Bazaar* HH-121-13, *Baudi v Kenmark (Pvt) Ltd* HH-4-12. All these cases were opposed applications for enforcement of an arbitral awards in terms of the Labour Act. The position in the Intellectual Property Tribunal Act is positive and the legislature may have learnt from the challenges experienced in the Labour Court with regard to execution of awards and judgements.

The specialist tribunal does not take exclusive jurisdiction in all IP matters but shares it with the other civil courts. IP related disputes can be heard in the ordinary courts or in this specialist court. Section 9B of the Trademarks Act (Chapter 26:04) reads as follows;

- 9B.** Proceedings in respect of an infringement of a registered trade mark may be instituted –
- (a) in the Tribunal; or
 - (b) in the High Court; or
 - (c) subject to the jurisdictional limits provided for in the Magistrates Court Act [Chapter 7:10], in a magistrate's court: Provided that the Tribunal shall not have jurisdiction to entertain criminal proceedings.

The positive thing about the above section is that it does not bestow exclusive jurisdiction in IP matters to that specialist court but makes that court compliment the already existing courts in the country. This makes justice easily available to right holders.

Unlike the High Court Rules the legislation creating the Tribunal allows parties to appear before the court in person or as represented by legal practitioners. The allowance for self-actors to appear before the court can help individuals and small corporates to enforce their rights through the forum as opposed to the High Court which compels companies of whatever size to be represented by counsel thereby

making justice expensive for parties. This submission does not seek to show that counsel is not useful but rather that it is not every litigant who can afford legal representation. At the same time, without legal representation presenting a case before a court is a mammoth task for many people of average sophistication.

It is submitted that notwithstanding the positive aspects of the law creating the Intellectual Property Tribunal Act, Zimbabwe is not yet at a stage where it can afford a specialist court for intellectual property cases only. The level of IP cases brought before our courts over the years as well as the economic position of the country suggests other approaches to making justice available to intellectual property litigants are necessary. In recognition of this fact, the Tribunal has with effect from June 2017 been made a division of the High Court as opposed to a stand-alone court. This approach is an acceptable alternative to a stand-alone specialist court and is in accord with Blakeney's suggestion of a middle of the road approach. In this approach a nation establishes or strengthens existing commercial courts so that they can handle IP matters better. In this way IP matters may be diverted in the general court system to judges with specialist knowledge of the subject or a division of the existing courts.

The Judicial Laws Amendment Act number 7 of 2017 which operationalised the IP Tribunal as a division of the High Court sought to help the ease of doing business in Zimbabwe. The approach does have merit for a country like Zimbabwe. This Act effectively operationalised a law that had gathered dust since its enactment in 2001. What may now be needed is a training programme for the judiciary and other IP enforcement agencies. The need for training for judicial officers in Zimbabwe is very real. See for example the glaring errors that were done by the trial courts in infringement cases in the case of *S v Moyo & Anor* HB-21-09 and *S v Chiadzwa S v Chiadzwa* HH-28-04. The reviewing Judge and the appeal court respectively noted glaring errors that were done by the trial courts. The courts need to be equipped with pertinent trademark and other IP knowledge for them to function effectively for the good of business in Zimbabwe.

Challenges Faced in Civil Enforcement of Trademark Rights

Enforcement of rights through the civil method has met with some challenges in Zimbabwe. The problems range from lack of exposure to intellectual property matters including lack of judicial precedents for the courts, practitioners and owners and low levels of damages awarded for infringement cases. In addition, the country lacks a viable alternative dispute resolution system for intellectual property matters to complement the courts in certain circumstances. The cost of enforcing rights in the civil courts is also on the high side.

Lack of exposure to trademark and other IP matters

Intellectual property is a relatively complex and unfamiliar subject to many Zimbabweans. This unfamiliarity with the subject applies to an extent to lawyers and some judicial officers. The latter fact is confirmed by the fact that of the few reported intellectual property cases that were heard in the magistrate courts, the majority of decisions made were reversed on appeal. See for example the cases of *S v Ndlovu* supra and that of *S v Chiadzwa* HH-28-04. In both cases the relevant legal principles were not applied leading to the convictions being set aside on review and appeal respectively. The Kenyan Court of Appeal in the case of *Sanitam Services (E.A.) Ltd v Rentokil Kenya Ltd & Anor* [2006] eKLR 228/2004 acknowledged that intellectual property is a sparsely litigated subject in Kenya. The court said intellectual property is "...a branch of law which has scanty litigation and therefore minimal jurisprudential corpus in this country..." This observation with the necessary changes being made applies with equal force to Zimbabwe. There is few to limited jurisprudence in the field of intellectual property even for the so called soft IP such as trademarks.

Apparently this problem does not only apply to developing countries as the recent Canadian case of *R v Stowbridge* (2014 NLCA 4) will show. The accused was convicted by a judge in Newfoundland for selling trademarked goods without authority in violation of the Canadian Criminal Code and other IP violations. For the first offence he was sentenced to 180 days in prison and a fine of C\$5000 and for the trademark offence he was sentenced to 180 days imprisonment to run concurrently with the copyright violation sentence. He appealed arguing that the penalty was disproportionate. The appeal court agreed with him. The prison term was reduced to two months and the fine was quashed. In doing so the appeal court noted that there were no reported cases in the province of Newfoundland in respect of trademark offences. The court was compelled to rely on decisions of other jurisdictions. There are indeed parallels between this case and the two cases cited above. Both courts did not have local precedents to rely on in dealing with the cases before them. Secondly the first instance courts made errors in sentencing the accused because of unfamiliarity in dealing with trademark offences.

Suitable case precedents do not exist due to limited decided cases having gone through the court system. The problem is most acute for matters dealing with damages for trademark infringement. As a result judges and practitioners have to grapple with lack of suitable precedents for use to guide their activities and work. This lack of precedents complicates and makes the work of lawyers and courts in intellectual property cases difficult.

The situation pertaining to the training programme of judges and magistrates apply with equal force to the position of lawyers in private practice in Zimbabwe. The relevant intellectual property statutes such as the Trademark Act (Chapter 26:04) and the Patent Act (Chapter 26:03), for example makes any registered lawyer a potential patent or trademark agent in Zimbabwe. This has the net effect

that a lawyer who never formally trained in intellectual property can become an intellectual property practitioner appearing before the superior courts of Zimbabwe. This situation may result in poor quality submissions before the court if such practitioner is not diligent. While some lawyers who have no formal training in the field of intellectual property can become good intellectual property practitioners, some form of on job training may be necessary in some instances. Likewise a court which is not very conversant with the area of law concerned cannot easily appreciate issues and manage the litigation effectively let alone pass quality and consistent judgements that can be relied on by the public. As a consequence consistency and predictability of the law are lost from such a court. It is submitted that a level of on job training for the courts is justified and necessary to improve on the quality of judgements made by the courts.

Low levels of damages awarded by the courts in trademark cases

Article 45 of TRIPS enjoins national laws to provide for damages that are adequate to compensate the right holders. The damages granted in a trademark infringement case are delictual in nature and aim at compensating the owner of the right for his patrimonial loss sustained through the infringement. See *Omega Africa Plastics (Pty) Ltd v Swisstool Manufacturing Co (Pty) Ltd* 1978 (3) SA 465 (A) 471. According to Cornish and Llewelyn (2003) the regular aim of an award of damages is to compensate the plaintiff for the harm and or injury caused by the defendant without any justifiable cause. The damages seeks to put the right holder in the position he would have occupied had the damage not been caused. Lord Wilberforce put it succinctly in the case of *General Tyre & Rubber Co v Fire Firestone Tyre & Rubber* [1976] RPC 197 (CA) 214 where he said that; “the measure of damages is to be as far as possible, that sum of money which will put the injured party in the same position as he would have been if he had not sustained the wrong”. The aim of the damages is not to punish the defendant but to restore the victim to the position he would have occupied but for the wrong. This is not a simple exercise and the courts have grappled with this question in a number of cases in Zimbabwe.

It is the duty of the plaintiff to adduce evidence to show his loss and the court in turn has to assess and grant damages if loss or injury is proved. In many instances the measure of damages is the loss of profits the owner has sustained in respect of the infringing articles he could and would have made and sold. The courts sometimes use the notional royalty that could have been paid if there was a licence agreement as the starting point in ascertaining the damages due to the plaintiff. In an attempt to assist the courts in assessing damages better some legislatures in some countries have resorted to pegging pre-estimated damages in statutes. No statutory or pre-estimated damages are provided for in Zimbabwe. The Trademark Act (26:04) now allows a court to award additional damages if the defendant flagrantly infringed the rights of the right holder. The provision lacks precision on the formula that the courts can use in awarding such damages. This is

a major drawback. A simple formula like one providing that a court may award damages which are three times the value of the infringement could have helped.

Conclusion

Zimbabwe has a number of relevant and necessary intellectual property legislations that can be used to protect and advance the rights of right holders of trademark rights. There are an adequate array of laws dealing with both industrial property and other intellectual property branches of the law. The challenge lies in the enforcement of these laws by the right holders, the public, the courts and other players in the intellectual property enforcement ecosystem. A number of steps can be taken to improve the situation. These include amending section 9(3) (a) of the Trademarks Act (Chapter 26:04) by providing a simple formula for calculating the damages like 'three times the benefit obtained', strengthening the intellectual property division of the High Court and requiring certain court decisions dealing with trademark rights and intellectual property rights in general to be given prominent publication in the press, judicial websites and other forums. There is need for trained judicial officials to whom technical cases can be diverted for hearing whenever they arise. To that end the operationalisation of the Intellectual Property Tribunal as a division of the High Court was necessary and timely. It has to be applauded. . It is noted that the fight against infringement, counterfeiting and piracy can be won if all stakeholders take a coordinated approach. To this end national coordination and cooperation of various stakeholders is essential. Right holders may for example assist in the funding of training of the enforcing agencies such as the police and Customs officials to identify counterfeit and infringing products in the market.

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