



IN THE UNITED REPUBLIC OF TANZANIA

THE BUSINESS REGISTRATIONS AND LICENSING AGENCY [BRELA]

IN THE MATTER OF THE TRADE AND SERVICE MARKS ACT, CAP. 326

AND

IN THE MATTER OF THE TRADE AND SERVICE MARKS REGULATIONS,

2000

AND

**IN THE MATTER OF OPPOSITION TO THE APPLICATION FOR
REGISTRATION OF A TRADE MARK NO.TZ/T/2019/1960 TOTAL &
GLOBE DEVICE (COLOUR AND LOGO) IN CLASS 6 IN THE NAME OF**

TOTAL SA

AND OPPOSITION THERETO BY SUZHOU DAKE MACHINERY CO., LTD

BETWEEN

TOTAL SA APPLICANT

AND

SUZHOU DAKE MACHINERY LTD..... OPPONENT

Date of Final Orders: 16/12/2022
Date of Hearing 21/09/2023
Date of Ruling/Decision: 18/09/2025

BEFORE:

Seka Kasera,

Deputy Registrar of Trade and Service Marks

RULING

A. INTRODUCTION

1. This ruling is in respect of opposition brought by SUZHOU DAKE MACHINERY LTD (hereinafter the Opponent), to object to the application by TOTAL SA (hereinafter the Applicant) for registration of a Trademark No. **TZ/T/2019/1960 TOTAL & globe device** (colour and logo) in class 6 of the Nice Classification of Goods and Services (hereinafter the Nice Classification).

B. THE PARTIES

2. The Opponent is a company incorporated in China with a place of business at *Room 618, Building Number 1, Lucky City Commercial Center, Suzhou Industrial Park, Suzhou City, Jiangsu Province, China* and in this matter, the Opponent is being represented by Endo & Company Advocates (Trade and Service Marks Agent) of P.O. Box 76630, Dar es salaam, Tanzania.
3. The Applicant is a corporation organized and existing under the laws of France, with the place of business at *92400 Courbevoie, 2, Place Jean Millier, La Defense 6, France*. The Applicant is being represented by Stallion Attorneys/Rive & Co (Trade and Service Marks Agent) of P.O. Box 5664, Dar es Salaam, Tanzania. Through Applicant's Written Submission, the Applicant gave notice of the new name, Total Energies SE.

C. BRIEF BACKGROUND TO THE CASE (PROCEDURAL HISTORY)

4. On the 27th day of September 2019, the Applicant, through their Trade and Service Agent, Akiplaw Advocates, applied for registration of a Trademark “**TOTAL** and Globe device” in class 6 in respect of;

“containers and meal containers for storage or transport; metal plugs; cylinders, tanks, and metal vats for gas and petroleum products; pipelines, hoses, and metal pipes for the transport of gas and petroleum products”

which was allocated No. TZ/T/2019/1960 by the Registrar of Trade and Service Marks (hereinafter referred to as “the Registrar”).

5. The Registrar provisionally refused the Trademark application on the ground that it is phonetically similar to an existing registered Trademark TZ/T/2015/107 “TOTO” in the name of Toto Limited, a limited liability company incorporated under the Companies Act, Cap 212 of the laws of Tanzania. The Applicant, being dissatisfied with the decision of the Registrar, successfully filed a Considered Reply to the Registrar, and the said Trademark application was thereon accepted as applied.

6. On the 15th day of March 2021, the Registrar advertised the application on the Tanzania Industrial Property Journal: “the

Official Journal of Patents and Trade / Service Marks for Tanzania Mainland No. BRELA.IP.IPJ.1001 No. 3” published by the Office of the Registrar, in compliance with **Regulation 27** of the Trade and Service Marks Regulations, 2000 (the Regulation).

7. The Opponent, having the intention to oppose, made an application for opposition and sought an extension of time within which to oppose the registration. The prayer was granted by the Registrar within which to file the formal Notice of Opposition.
8. On the 25th day of July, 2021, the Opponent, through the services of their Agent, ENDO & CO. Advocates, filed a Notice of Opposition in compliance with **Section 27** of the Trade and Service Marks Act, Cap. 326 R.E. 2002 (“the Act”), and **Regulation 34** of the Regulations, to object to the registration.
9. The Registrar duly transmitted the Notice of Opposition to the Applicant for purposes of filing a Counter Statement as required under **Regulation 36** of the Regulations, which the Applicant duly filed as required.
10. Upon completion of initial pleadings, both parties submitted their evidence by way of Statutory Declaration as required by the law.

11. The Registrar accordingly fixed the matter for hearing on the 21st day of September, 2023.
12. Both parties filed Form TM/SM 7, being a Notice to the Registrar of Attendance at Hearing, in which they indicated their intention to appear before the Registrar on the date of the hearing. They also prayed that they be allowed to argue their matter by way of written submissions; the Registrar duly granted the prayer of the parties, and the matter was heard by way of written submissions.

D. BRIEF STATEMENT OF THE FACTS

i) Facts as per the Opponent

13. In the Notice of Opposition, the grounds for opposition were zeroed to similarities, well known mark, and prior use rights of the Opponent's Mark.
14. The Opponent contends that the opposed application for registration of a Trademark TZ/T/2019/1960 **TOTAL** & Globe device (Colour & Logo) in class 6 is likely to deceive or cause confusion with the Opponents' earlier used unregistered Mark **TOTAL** in class 6 in Tanzania. He further adduced that, the application intends to register closely related and similar goods to those of the opposing party registered mark business particularly for goods in class 8 which are made up of metal, of which the Opponent has

acquired a goodwill and reputation in relation to goods in Class 8, in the market that is likely to deceive and cause confusion contrary to **Section 27(2)(a)** of the Act.

15. The Opponent claims that, the Trademark **TOTAL** was first used in Tanzania in April 2018, and he has filed an application for registration of his earlier used unregistered Trademark **TOTAL** in class 6 at the same time as the Notice of Opposition pursuant to **Section 27(2)(a)** of the Act.

16. The Opponent contends that, the Applicant's Trademark so nearly resembles the Opponent's prior registered Trademark, the use of which would be likely to deceive or cause confusion in the trade as to the nature, origin, characteristics, and suitability of the Applicant's product and would be contrary to law as to be likely to deceive or cause confusion.

17. The Opponent further asserts that, the Applicant is aware that the Opponent has been in long use of the Trademark "**TOTAL**" and has established a trade goodwill in her business, hence the Applicant cannot take advantage over the goodwill established by the Opponent's market.

18. The Opponent contends that, their mark is highly visible on social networks and enjoys notoriety and prior use of the Trademark "**TOTAL**" in class 6 of the Nice Classification since

5th April, 2018. The Opponent attached some extracts from his Facebook official page for Tanzania, which he claims show that the Mark **TOTAL** is used for some products in class 6 of the Nice Classification.

19. The Opponent further claims that the concept of prior use is protected in our jurisdiction by courts of law in Tanzania upon satisfying that one's business has acquired trade goodwill in the market with a well-known mark.

20. The Opponent contends that he has established a goodwill in her Trademark **TOTAL** in respect of goods in classes 6, 7, 8, and 9, of which he enjoys both local and international reputation. He further referred to the World Trade Organization (WTO) and averred that, Tanzania being a member of the Organization which encourages protection and enforcement of Intellectual Property Rights (IPRs) through Trade Related Aspects of Intellectual Property “TRIPs Agreement”, is obligated to ensure that the protection of Trademarks achieve public policy goals by taking effective actions against any act of Trademark infringement including expeditious remedies to prevent infringement.

21. The Opponent concluded that the offending Trademark does not belong to the Applicant and is not entitled to registration in terms of the provisions of Sections **2** and **21** of the Act. Therefore, the Opponent prays that the opposed

application be refused and that an order of costs be made in his favor.

22. To support his arguments, the Opponent filed his evidence by way of Statutory Declaration signed by **Mr. Liu Qiang**, which was adopted to form part of the proceedings as his evidence in chief. He attached a total of four exhibits, to wit;

i. Trademark application (Consolidated form and payment receipt) dated 29/06/2021 marked as exhibit **S1**, extracts from the Opponent Facebook page marked as exhibit **S2**, extract of shops and cover of products extracted in google and those available on Opponent's Facebook page as available in Tanzania marked as exhibit **S3**, bill of lading and copies of non-negotiable bill of lading marked as exhibit **S4**.

ii. The Trademark has been used and registered on the goods in overseas areas and jurisdictions in Israel, Seychelles, Peru, Palestine, Pakistan, Chile, Mexico, Panama, Paraguay, OAPI, and Indonesia. Further, the Opponent testified that the Trademark has been promoted by means of Facebook, outdoor advertisements, and vehicle advertisements.

23. The Opponent expressly and vehemently denied the contents of the Applicant's Counter Statement filed in response to the notice of opposition.

ii) Facts as per the Applicant

24. In his Counter Statement, the Applicant commenced by providing a brief historical background of a composite Trademark “**TOTAL**” and stated that, **TOTAL** is a global integrated energy producer and provider, the 4th largest publicly traded integrated oil and gas company, and the world’s second-largest solar energy operator. He asserted that **TOTAL** was incorporated as a company in France in 1924 and that the name and Trademark **TOTAL** were adopted in 1954; it has therefore been extensively used in relation to the Applicant’s business for approximately 97 years.

25. The Applicant stated that, currently, they are operating in more than 130 countries and are distributing their products in more than 150 countries, and that a large number of **TOTAL’s** subsidiaries are based in the African Continent. Therefore, **TOTAL** trades worldwide through its subsidiaries, where in Tanzania, its subsidiary company is called Total Tanzania Limited, which started its operations in 1969. Therefore, **TOTAL** has been present in the Tanzanian market for approximately 62 years.

26. The Applicant averred that, through its subsidiary company, **TOTAL** trades extensively in Tanzania and is, in fact, well known and considered to be one of the most reputable companies. That, the subsidiary operates a network of 90 **TOTAL** branded service stations across the

country, which offer a variety of petroleum products and other chemicals encountered by motorists and the public in Tanzania on a daily basis. Additionally, **TOTAL** has registered its Trademarks in numerous countries, and it owns over 2500 registrations for the **TOTAL** incorporation Trademark. The Applicant cited a vivid example in Tanzania where a total of 19 registered Trademarks were in different classes of goods.

27. The Applicant further specified the class of goods which **TOTAL** has been dealing with to include all aspects of the petroleum industry, distribution of fuel and related products with nearly 4500 service stations in different countries, including Tanzania, production of other special fluids and chemicals for industrial and consumer markets, production of low carbon electricity or solar power, and related equipment.

28. The Applicant further countered that **TOTAL** has, over the years, invested considerable funds in advertising and promoting the Trademark as used in trade, particularly in its composite logo formats worldwide. The Applicant mention its advertising strategies to include sponsoring major sporting events such as World-Renowned Formula One Grand Prix (for 40 years), the Total Football Africa Cup of Nations, Total UF17/U20 African National Championship, Total Women Africa Cup of Nations, the Confederation of African Football's (CAF), African Cup of Nations (AFCON), and that TOTAL logo

was incorporated in the logo of the Total African Cup of Nations tournament.

29. That, as a result of **TOTAL's** extensive use of its Trademarks in relation to its multinational business as well as the international exposure of the Trademarks through advertising, the Trademarks have acquired an international reputation and good will and are considered well-known Trademarks. The well-known status of **TOTAL** as a brand has been confirmed by International brand valuation companies such as Brand Finance Limited, which, for many years, has recognized it as one of the world's most valuable brands, and this information is in the public domain.

30. In response to the Opponent's grounds of opposition, the Applicant categorically denies that the Opponent has reasonable grounds to oppose its Trademark based on **Section 27(2)(a)** of the Act. The Applicant is of the view that, for the Opponent to rely on the cited provisions of the law, his demonstrations must base on substantive documentary evidence that when **TOTAL** Trademark application in question was filed on 27th September 2019, its alleged Trademark had already been used extensively in the course of trade in Tanzania to the extent that a mark had acquired reputation and good will specifically in relation to the goods for which **TOTAL** intends to register its Trademark or closely related good.

31. The Applicant further counters that the Opponent has failed to prove that it owns prior Trademark rights in its Notice of Opposition, nor did he provide any tangible information or substantive details regarding its alleged prior use of the mark **TOTAL** in Tanzania. Further, the Opponent has failed to provide any information, including media followers and financial figures, which demonstrate the extent of its sales or the relevant product in the trade, or the level of distribution of the product in the trade. Therefore, the submitted evidence is sparse, irrelevant, unreliable, and unreasonable.
32. Furthermore, the Applicant contends that the Opposition filed by the Opponent is malicious and brought in bad faith, there is no likelihood of confusion between the two Trademarks, of the Applicant and of the Opponent, and further, there is no similarity between the goods of interest to the Applicant and the Opponent.
33. To support their application for registration of a Trademark, the Applicant filed his evidence by way of a Statutory Declaration. The Statutory Declaration was signed by one **Stephanie Polselli** on behalf of Total Energies SE (formerly TOTAL SA). The Applicant adopted his Statutory Declaration, the Opponent's evidence in support of the submissions made in its Counter Statement, and the Trademark application in question.

34. The Applicant, throughout his evidence, maintained his position as indicated in the Counter Statement. The Applicant also noted, without admitting, some of the contents of the paragraphs in the Opponent's Statutory Declaration.
35. To support his evidence, the Applicant attached exhibits to the effect of official confirmation of the Applicant's change of name, information regarding **TOTAL's** history and its subsidiaries in different countries, **TOTAL's** goods and services, copies of reports issued by reputable brand valuation company Brand Finance from 2016-2019, Information regarding **TOTAL** trading activities in Tanzania, copies of registration certificates confirming the validity of these Trademark registrations and information regarding **TOTAL's** sponsorship Africa Cup of Nation event.
36. The Applicant contends that, based on the documentary evidence he has submitted, it is on the view that the evidence has demonstrated that through its extensive trading activities under the **TOTAL** Trademark, its Trademark has acquired an international reputation and goodwill which extends to Tanzania. The Applicant insists that reputation and goodwill cannot be disassociated or separated from its Trademark, which is subject to the Trademark application in question, which is sought to be registered for its specific goods of interest.

37. However, the Applicant expressly and vehemently denied the evidence filed by the Opponent in its totality. Briefly, the Applicant states that the alleged confidentiality of the advertising materials are without basis and they are already in the public domain.

E. RELIEFS SOUGHT BY THE PARTIES

38. The Opponent prays that the opposed application be refused and that an order of costs be made in their favour.

39. The Applicant prays that the Opposition by the Opponent be dismissed with costs and the application No. TZ/2019/1960 **TOTAL** & globe device (Colour) in class 6 in the name of the Applicant be allowed to proceed to registration, and that an order of costs be made in their favour.

F. ISSUES FOR DETERMINATION

40. The issues as framed from the disputed facts and agreed to by the parties: -

(I) Whether the opposed Trademark No. TZ/T/2019/1960 **TOTAL** & Globe Device (colour and logo) is visually and nearly identical to the Opponent's Trademark **TOTAL** that is likely to deceive and or cause confusion between the

trade of the Applicant and Opponent and to the members of the public.

- (II) Whether the Opponent's Trademark **TOTAL** is a well-known Mark.
- (III) Whether the two Trademarks can co-exist due to honest concurrence.

G. SUBMISSIONS BY THE PARTIES

i) The Case for the Opponent

41. In his written submission, the Opponent insists that the registration of Trademark TZ/T/2019/1960 **TOTAL** & Globe Device (colour and logo) be rejected based on the grounds of Opposition adduced in the Notice of Opposition and undoubted evidence shown in his Statutory Declaration. Having gone through the submissions, the Opponent's main submission is based on two issues, namely, Opponent's prior use protection, and Opponent's prior and exclusive rights in the Trademark **TOTAL** in class 6 of the Nice Classification.

42. The Opponent referred to **Section 27(2)** of the Act, the spirit behind that provision is to provide protection for a Trademark which is not registered but in use, and further, it intends to ensure no one benefits from the investment of other persons without prior consent or agreement. To cement

his position, the Opponent cited the case of **JC Decaux Sa and JC Decaux Tanzania Limited V. JP Decaux Tanzania Limited** Commercial Cause No.155M of 2018, whereby, her Ladyship B.K Philip said that,

“...in my considered opinion, legally, it is not correct for a person to register a trademark or a business/company name confusingly similar to widely used and known trademarks with well-established goodwill in its business/trade while aware of the existence of the same simply because that trademark is not registered in his/her country. It has to be noted that a trademark goes together with investment in terms of goodwill in a particular business.”

43. With regard to Opponent’s prior exclusive rights in the Mark **TOTAL** in Class 6 of the Nice Classification, the Opponent submitted that, class 6 is designed for common metals and their alloys; metal building materials; transportable building of metal; materials of metal for railways tracks; non electric cables and wires of common metal; iron monger, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores of which the Opponent started using Trademark **TOTAL** covering goods in class 6 of the Nice Classification earlier in April 2018.

44. The Opponent relies on the documentary evidence filed, such as copies of bills of lading and non-negotiable bills of lading, extracts of shops and covers of products extracted from Google and the Opponent's Facebook page as available in Tanzania which have clearly widely established that the Opponent has prior rights to Trademark **TOTAL** in Tanzania unlike the current Applicant's application before the Registrar.

ii) The Case for the Applicant

45. The Applicant adopted the statements in its Counter Statement dated 22nd day of September 2021 and Statutory Declaration dated 31st day of March 2022 to form part and parcel of its submission in chief. The Applicant submitted that, the Opponent in support of its ground of opposition argued mainly on two issues, that, it is the rightful proprietor that he has acquired the goodwill in the Mark, and that, it contravenes the provisions of **Sections 19(b), and (d);20(1); 27(2)(a), and 27(2)(b)** of the Act.

46. It is the Applicant's submission that, in order for the Opponent to rely on **Section 27(2)(a)** of the Act, its demonstrations must base on the substantive documentary evidence that whether the application in question was filed on 27th day of September 2019, and its alleged Mark had already been used extensively in the course of trade in Tanzania to an extent of the Trademark to acquire the

reputation and good will in trade. The Applicant is of the view that the evidence which was filed by the Opponent is sparse and ambiguous and does not categorically prove that a substantial number of members of the public in the relevant sector were aware of the Opponent's Trademark in relation to relevant goods. Therefore, such evidence is insufficient to be relied on and conclude that its Trademark had acquired the requisite reputation and good will.

47. The Applicant further submits that there is no evidence submitted to prove that, by the 27th day of September 2019, when the application was filed, it had already established a reputation and goodwill in Tanzania in relation to any of the goods which are covered by the specification of goods of the Applicant's Trademark application in question. The Applicant cemented his point by referring to **Section 27(2)** of the Act.

48. The Applicant further submitted that, the documentary evidence submitted by the Opponent described goods that were shipped, and the annexed bill of lading dated April 2018 proves that the goods were still in Shanghai, China, where they originate (Port of loading). It is the Applicant's submission that the evidence submitted does not prove that the actual goods concerned were already in the Tanzania market and accessible by the consumers at the date of filing its application.

49. He submitted that the images in relation to the alleged Trademark, which the Opponent submitted, were promoted in social media after the filing of the Applicant's Trademark in question on the 27th day of September 2019. The Applicant is of the view that the promotion of the Opponent's goods through the said images and the social media posts is irrelevant, as they postdate the Applicant's Trademark application.

50. The Applicant is on the view that, the Opponent's evidence is irrelevant, unreliable and unconvincing and it cannot be reasonably concluded based on this information that the Opponent had any reputation or goodwill in respect of the Trademark "**TOTAL**" in relation to the relevant goods that are covered by the Applicant's specification at the time when the Applicant's Mark in question was filed for registration.

51. The Opponent submitted that the principle guiding Trademark law highlights that the Trademarks must be compared holistically and not in parts, and he refers to the case of **ULTRA Garment Limited and Another V Dalmia Cement Bharat Limited** *Notice of Motion No. m 76 of 2014*. He further submitted that a Trademark may only be considered to be identical to another if it is reproduced without any modification or addition of all elements constituting the Trademark or if the Trademark, viewed as a

whole, contains differences so insignificant that they may go unnoticed.

52. Conclusively, the Applicant submits that the Opponent has failed to demonstrate that the Applicant's Trademark application conflicts with any provisions of the Act, and that the Applicant has discharged its onus to prove that its Trademark is registrable in terms of the Act.

iii) Rejoinder Submissions

53. Summary of Rejoinder submissions by the Opponent's Counsel.

The Opponent, in his rejoinder, reiterated his submission in chief and further argued that, in civil cases, including Trademark cases, the standard of proof is on a preponderance of possibility or balance of probabilities. He further averred that his Statutory Declaration contains reliable evidence to prove acquired reputation and goodwill, and that the bill of lading and copies of negotiable bill of lading, extracts of shops, and covers products from Google search engine, and Opponent's Facebook page.

54. The Opponents submit that the Applicant has misapplied the case of **JP Decaux Tanzania Limited** (Supra) since the Defendant in the referred case did not dispute that

the Trademark of the Plaintiff is a well-known mark, and he admitted he was aware of the existence of the Plaintiff's Trademark and business prior to registration.

55. The Opponent submits that the assertion that the Opponent does not operate in the gas and petroleum industry and that the main industry in which the respective parties operate are evidently different, and that the assertion is misleading and immaterial.

56. He submitted further that Section **20(1)** of the Act asserts that the unregistered mark is not protected under **Section 20** and that the position is very clear, both registered and unregistered Marks are protected in Tanzania. The fact that a mark is a well-known Mark by the public, although not registered, can stand as sufficient ground of opposition against any application for registration of a Trademark that infringes its rights or tends to mislead the public.

57. Conclusively, he submitted that, the Trademark **TOTAL** in class 6 owned by the Opponent although not registered, is protected by both, domestic and international laws, and the assertion that the Trademark of the Opponent is unregistered hence it cannot be protected is misleading and irrelevant because the Opponent acquired reputation and goodwill in the trade even before the existence of the Applicant. Therefore, he prays that the Applicant's Trademark be disregarded and the Opponent's Application

No.TZ/T/2021/1306 TOTAL in class 6 in the name of the Opponent be allowed to proceed for registration.

H. DETERMINATION ON EACH ISSUE

58. The Applicant's Opposed Trademark and the Opponent's Trademark (said to be Well-Known and application) are produced herein for clarity:

Applicants Opposed Trade Mark	Opponent's Trade Mark
TZ/T/2019/1960	
	

59. I have read all the closing submissions filed by the Learned Counsels. In the course of deciding this matter, due regard is paid to their submissions without necessarily reproducing them as they are.

60. On the first issue as to whether the disputed Trademark No.TZ/T/2019/1960 **TOTAL** & Globe Device (Colour and logo) is similar to the Applicant's Trademark and is likely to cause confusion. Throughout the proceedings and in their

final submissions filed at this Registry, the Opponent maintained that, the two Marks are similar and allowing registration of the Applicant's Trademark to proceed to registration will impair the objective of providing consumers with reliable indication of the expected source of wares or services. The Opponent, in his submissions, admits that the Applicant's Trademark is different from his since the Applicant's Trademark has a globe device logo and colours; however, it should not be taken as a criterion to differentiate these two Trademarks, as there is a bad motive on the part of the Applicant.

61. I see no need to dwell on the determination of this issue for the reason that, in the first place, it is a firm and legal stance of the law that, while comparing and considering a trademark, the Mark has to be seen as a whole and not in parts. The same position was highlighted in the case of **Ultratech Cement Limited and Anr. Vs Dalmia Cement Bharat Limited, No.37 and 42 of 2014**, where the High Court of Judicature at Bombay stressed that;

“The proprietor gets exclusive right to the use of the trademark taken as a whole, and they cannot preclude others from using any part of the trademark independently or in combination with different words altogether. As far as claiming rights over any part of such trademark is concerned, the proprietor must apply for registration of such part as a separate trademark.”

62. As a matter of fact, the two Marks are composed of one common element of the word “**TOTAL**” which is virtually similar. However, I am mindful that the common element in both Trademarks is the word **TOTAL**, although there is a variation on the colour and structure of the same word. On the Opposed Trademark, the word **TOTAL** is in red, preceded by an oval globe device in multiple colors (red, yellow, blue), and that makes the two marks virtually dissimilar. It is a generally accepted principle that a Trademark must be considered as a whole, including the get-up of the Trademark. This rule is well found in the case of **Colgate Palmolive Company V. Zacharia Provision Stores and others**, *Civil Case No.1 of 1997 (Unreported)*, in which the Court held that;

“that it is necessary to compare the whole of the Plaintiff’s mark and get up with the whole of the Defendant’s marks and get up to see whether there are similarities which go create or sow the prospects of the confusion or actual deception”.

63. Based on the Opponent's submission that the fact that the Applicant’s Trademark has a globe device logo and colour, it cannot be taken as a criterion to differentiate these two Trademarks, especially when we consider the degree of “users” of these products. The Opponent has failed to demonstrate through submitted evidence that consumers may perceive **TOTAL** as **TOTAL & Globe device** in determining the similarity or dissimilarity of the Trademark.

The same position was held in the case of **Distilleries Ltd v Vitamin Foods Ltd** (2002) T.L.R 15 and in the case of **Oakville Hills Cellar, Inc. v Georgallis Holdings, LLC** (2016-1103), The Federal Circuit concluded that, substantial evidence supports the Board's finding that the Marks were sufficiently dissimilar as to the appearance, sound, meaning and commercial impression.

64. Based on the above cases and submissions made by the parties, I am inclined to rely on the anti-dissection rule of trademarks and adopt a reasoned opinion of the Applicant's Counsel that the Opponent's Trademark (unregistered/application) is evidently distinguishable from the Applicant's Trademarks, especially when looked at as a whole. Therefore, the first issue is to be answered in the negative.

65. To answer the second issue as to whether the Opponent's Trademark **TOTAL** is a well-known Trademark, the learned counsel for the Opponent argued that, the Opponent has established a goodwill in her Trademark "TOTAL" in respect of goods in class 6, 7, 8 and 9 of the Nice Classification of which enjoys both local and international reputation consequently, it is entitled to benefit from the protection for a well-known Trademark under **Section 19(d)** of the Act.

66. In connection with the well-known status of the Opponent's Trademark, claimed prior and exclusive rights in the Trademark "**TOTAL**" in class 6 of the Nice Classification, and as per the Statutory Declaration, the Opponent adduced his documentary evidence such as bill of lading and copies of negotiable bill of lading and extract from the opponents Facebook page to establish its claimed prior use right.

67. It is my considered view that, according to **Section 27(2)(a)** of the Act, the relevant goods which must be considered in determining if the Opponent's Trademark has acquired the requisite reputation and goodwill are the goods that are covered by the specification of goods of the Applicant's Trademark application in question. The Opponent's claims lack credit to prove that by the 27th day of September 2019, when the Applicant's Trademark was filed, it had established reputation and goodwill in Tanzania in relation to any of the goods which are covered by the Applicant's specification of goods.

68. I expected to see proof of the use of the Trademark "**TOTAL**" in Tanzania, being the consuming public in this connection. To prove this, evidence should have been from the consumers of the Opponent's services in question and the business cycles dealing with the type of goods. Even though the Applicant mentioned without proof (i.e., certificates of Trademark registration from other jurisdictions), on how the Trademark has acquired registration in several other

jurisdictions, that is not sufficient proof that it is a well-known Trademark in Tanzania and globally. As per the evidence filed, the Opponent has failed to produce any tangible and reliable documentary evidence to prove the alleged use of its Mark or on the sale of goods of its specifications.

69. The evidence on the records suggests that the document describes the goods that were shipped as power tools and hand tools. However, the documents do not prove that the actual goods concerned were already in Tanzania and accessible to the consumers on the particular date. It is my finding that the documents submitted and the Facebook contents confirm that the goods were in the market only in the year 2019. We cannot, therefore, ascertain the well-known status of the Opponent's Mark without proof.

70. It is my considered view that, although the Opponent submitted proof of bill of lading, the Opponent has failed to establish whether their Trademark **TOTAL** has been widely promoted in the country in respect of goods falling under class 6 of the Nice Classification. In the absence of clear evidence from the Opponent's Statutory Declaration, it cannot be said that the Opponents have advanced sufficient reasons to warrant the Registrar to grant the order sought. Therefore, with respect to the second issue, I determine it in the negative, as well.

71. I now turn to consider the third issue, which is whether the two Trademarks can co-exist due to honest concurrence. I determine this issue in the affirmative, and I will explain the reasons behind herein below.

72. Based on the Act, Trademarks can **honestly co-exist** where two different **enterprises are at liberty** to use a similar or identical Trademark to market a product or service without necessarily interfering with each other's businesses. In Tanzania, this is backed under **Section 20(2)** of the Act, which provides that; -

*“In the case of **honest concurrent use**, or of other special circumstances, trade or service marks that are **identical or nearly resemble each other** in respect of the same goods or services or closely related goods or services **may be registered in the name of more than one proprietor**, subject to such conditions and limitations, if any, as considered necessary to impose.” (Emphasis is mine.)*

73. I am mindful that co-existence can only be allowed if there is honest concurrent use or other special circumstances. The parties in this matter, through their submissions they seem not to be at liberty to co-exist in Tanzania.

74. It is undisputed facts and evidence by both parties that they have registered their respective Marks in several jurisdictions of the World, and there is clear evidence that in the same countries the two Marks enjoy registrations. They peacefully and honestly co-exist without causing any confusion among members of the general public. The standard of test for honest and peaceful co-existence is the peaceful existence in the market, as evidenced by “consumer evidence”, and not solely at the Register, as stated in the case of **Nairobi Java House Limited Vs. Mandela Auto Spares Ltd**, *Civil Appeal No. 13 of 2015 (2016) UGCOMMC 12*. Such honest and peaceful co-existence does exist in Tanzania between the two parties, particularly in goods falling in class 9 of the Nice Classification.

75. Parties may so wish to recall the decision in relation to the twin Opposition in the matter of Opposition of Trademark No. **TZ/T/2019/1969 TOTAL & Globe Device** (Colour and logo) between **Suzhou Dake Machinery Ltd Vs. Total SA**. The dispute was between the same parties and the same cause of action, save for the class of goods, which was class 9 of the Nice Classification. I was honored to preside as the chair and made a ruling that the two Trademarks should honestly and peacefully co-exist. Partly, the ruling stated that;

“My assessment of the generality runs in line with the philosophies of co-existence of trademarks. In principle, trademarks can co-exist where two different enterprises

are at liberty to use a similar or identical trademark to market a product or service without necessarily interfering with each other's businesses. In Tanzania, this position is backed by the law as provided under Section 20(2) of the Act."

76. Therefore, I am allowing these two Trademarks **TOTAL** and **TOTAL & Globe Device (Colour and Logo)** to honestly and peacefully co-exist in the Register and in the market as well, with the conditions that, no party is allowed to trade on goods not registered since I am persuaded and hereby conclude that the two Trademarks are virtually dissimilar when the Marks are considered as whole.

77. In support of my decision to insert condition, I refer the parties to **Section 20(2)** of the Act and the case of **Goenka Institute of Education and Research V. Anjani Kumar Goenka 2009 (40) PTC 393 (Del)(DB)** whereby, the Division Bench of the Delhi High Court stated that, to ensure students are not lead into the belief that the two institutions spring from the same sources; the Court directed the Appellant to take steps to add such information of disclaimer or maintain sufficient distinction between the name of schools of the Appellant and Respondents. They were also supposed to add the name of their Trust in brackets below the school's name, also to promotional material and literature of the school, and mention categorically that they were not affiliated to any

other institution using the name of Goenka as a Trademark or a name.

I. FINAL ORDERS

78. In the upshot, I find that the Opponent was unable to demonstrate that there were good reasons for opposing the registration of Trademark No. **TZ/T/2019/1960 TOTAL & Globe Device (Colour and Logo)**. Prior use, similarity of Trademarks, and the well-known status in the circumstances of this opposition were not proved to justify the refusal of registration of the Applicant's Trademark. I therefore find that the Application for Opposition is patently wanting in merits. Accordingly, it is dismissed in its entirety, and each party shall bear its own costs.

It is accordingly so ordered.

Dated and signed at **Dar es Salaam**, this **18th** day of **September, 2025**.



Seka Kasera

DEPUTY REGISTRAR OF TRADE AND SERVICE MARKS

This ruling is rendered by **Seka Kasera**, Deputy Registrar of Trade and Service Mark at **Dar es Salaam**, this **18th September, 2025**.



Seka Kasera

DEPUTY REGISTRAR OF TRADE AND SERVICE MARKS