

Case

**MIGOO INDUSTRIAL AND TRADING
COMPANY (U) LIMITED**

VS

**RIDA INTERNATIONAL INDUSTRY
(U) LIMITED**

H.C.C.S No. 0359 OF 2019



**INNOVATE.
GROW.
DISCOVER.**

MIGOO INDUSTRIAL AND TRADING COMPANY (U) LIMITED

Vs

RIDA INTERNATIONAL INDUSTRY (U) LIMITED

H.C.C.S No. 0359 OF 2019

Before: Hon. Justice Stephen Mubiru

BACKGROUND

The Plaintiff's claim is for infringement of its industrial design and passing off for which it sought a permanent injunction restraining the Defendant from further infringement.

The Plaintiff is a producer of gumboots since 2012 and has been in the business of producing the same under the MIGOO trademark. The Defendant Company began selling and distributing gumboots very similar to those of the Plaintiff and registered the trademark in 2018 before the Plaintiff. The actions of the Defendant undercut the profits of the Plaintiff since their gumboots were cheaper on the market and attracted the buyers of the Plaintiff.

The questions before court were whether the action of the Defendant infringed the industrial design of the Plaintiff in respect of the gumboots and whether the Defendant passed off his gumboots as those Plaintiff.

RULING

On the question of infringement, the court relied on Section 71 of the Industrial property Act 3 of 2014 (The Act) which lays down a definition of what an industrial design is as *"that aspect of a useful article which is ornamental or aesthetic that may consist of three dimensional features like a shape or surface of an article or a three dimensional feature such as patterns, line or colours."*

Additionally, in order to qualify for registration under The Industrial Property Act 3 of 2014, the design must not, to the proprietor's knowledge, have been in use by a person other than the applicant at the time the design was adopted by the applicant. For a design to be original there must be some substantial difference between the new applied for design and the pre-existing design.

A slight change of outline or configuration, or an unsubstantial variation is not

sufficient to enable the author to obtain registration.

The court relied on the act and the TRIPS agreement to emphasize the protection granted to a party that is granted an Industrial Design in accordance with the act and the tests employed by the court in order to establish infringement and likelihood for confusion focusing on the nature of goods for which the Industrial design was granted.

The court relied on the test of an ordinary user with imperfect recollection and that of an informed user who is particularly observant, either because of his or her personal experience or his or her extensive knowledge of the sector in question. It emphasised that in most infringement matters, the role of an ordinary user with imperfect recollection falls on the judicial officer who examines the goods together and reach his/her own conclusion.

In the present case, having examined the gumboots side by side, the court found that the gum boots that had been registered and the infringing gum boots were so similar one would need a very keen eye to tell them apart.

To establish the likelihood for confusion, the court employed a number of considerations including the nature of good to which the industrial design is applied; the intended purpose of such goods; the method of use of the goods; complementarity; competition (whether the goods in issue are in competition in the market); their respective distribution channels; the relevant consumer circles; the degree of freedom of the designer in developing the design; and the usual origin of the goods.

Likelihood for confusion was established as the learned trial judge took the view that seeing the two gum boots, an average consumer would believe that the goods in question come from the same undertaking or from economically linked undertakings.

The nature and purpose of the goods was also so similar it was practically impossible to distinguish the two get ups.

The court sought to determine whether passing off had been established relying on the decision of Lord **Oliver in Reckitt and Coleman Properties Ltd v. Borden Inc. [1990] 1 WLR 491; [1990] 1 All ER 873** which highlighted the test for passing off.

The three elements required to prove passing off according to Lord Oliver; a goodwill or reputation attached to the relevant goods or services; a misrepresentation by the Defendant to the public (whether or not intentional) leading or likely to lead the public to believe the goods or services offered by him are the goods or services of the Plaintiff; and that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation.

KTA ADVOCATES

The learned justice agreed with the Plaintiff's witnesses that the Plaintiff had acquired a reputation in the business and become a household name from the 10 years they had spent in the business. The goods had been sold to customers in the same line of trade as the Plaintiff and the Plaintiff had suffered actual loss in the business evidenced by the drop in sales due to the Defendant's gum boots that were cheaper than the Plaintiff's.

A case for passing off was successfully made out by the Plaintiff based on the facts of the case.

The court went on to address the issue of registration, and found that prior registration in itself was insufficient to grant a party protection or to establish priority in registration. Relying on Section 41 of the act court held that the use in this case was found by the court to be bonafide usage that would not confer upon them the claim of infringement successfully.

The court in the circumstances found it fitting to grant the Plaintiffs the remedies they sought to wit; an injunction, special damages, general damages, interest and costs.

RELEVANCE

This case shed light on the interpretation of the Industrial Property Act of 2014 specifically pertaining to the industrial designs. The court analysed the law and the specific provisions pertaining to considerations of the court in determination of infringement and passing off actions in cases of Industrial designs.

The case also examined the various tests courts have employed many a time to establish infringement applying them within the context of the Ugandan Intellectual Property Legal regime. The locus decision of Lord Oliver is also still good law and applicable to passing off actions as was highlighted in this decision.



Contact Us

📍 Floor 3, Plot 4 Hannington Road
Kampala, Uganda, P.O. Box 37366,
☎ +256 414 530 114 / +256 414 531 078
✉ partners@ktaadvocates.com