

RWANDA / JUDGMENT

# MADIOS v. BIC

RCOMA 00319/2016/CHC/HCC

## COURT

Commercial High Court

## DECIDED

9 September 2016

## CASE / FILE NUMBER

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## MADIOS v. BIC

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## Text

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MADIOS v. BIC [Rwanda COMMERCIAL HIGH COURT – RCOMA 00319/2016/CHC/HCC (Mutajiri, P.J., ) 09/09/2016] The law governing the intellectual property –The right to claim for the mark – The act of forgery on the mark –Renewing the period of the registration of the mark - Any infringement of copyrights or related rights protected under this law, committed wilfully or by gross negligence, by any third person for profit-making purposes and without owner's right consent shall constitute an act of forgery. Any third person, who knowingly sells, offers on sale, is making rent, detains or introduces on the territory of the Republic of Rwanda, the alleged infringing goods for commercial purposes, shall be considered as committing the same offence. – The Law N° 31/2009 of 26/10/2009 on the protection of intellectual, article 261. The law on on the protection of intellectual –The right on mark –Any person who will import in Rwanda the goods of the pens of BIC CRISTAL without being authorised by the company BIC as soon as it has the legal right to its mark they have to be seized and be destroyed. Article 261 of the law N° 31/2009 of 26/10/2009 on the protection of intellectual property. The damages –The procedural damages –The article 258 of the law of 30 July 1888 instituting the Civil Code (CCB III) relating to the contractual obligations or contracts. Facts: The Company BIC sued the company MADIOS Ltd

before Nyarugenge Commercial Court and claims damages arguing that MADIOS Ltd forged its pens. The court decided that MADIOS Ltd has imported within Rwanda the forged pens, and it was condemned to pay damages, and it has been ordered to take those pens out of the market and destroy them. Then after MADIOS Ltd appealed to the Commercial High Court request to analyse that BIC had right to claim for its mark which has been registered in 2003. By arguing on the issue of knowing whether BIC had right to claim, the one representing MADIOS Ltd says that it does not produce pens rather it sells them, he added on that were not tested and be proven that they don't meet the standards. He goes on arguing that the court has stated that it committed the offense by importing within Rwanda the pens of BIC without being authorized by BIC while no other person had that right to be proven to have it on the mark of BIC which has been registered in 2003 and the goods reached there in 2015 after 12 years have elapsed the company BIC not having registered it again as provided for by the law, while no other person imported them, MADIOS Ltd argues that it committed no fault by importing them within the country in case the mark of BIC was no longer valid. The one representing the company BIC, in arguing, he said that its mark has been registered before the enactment of the law on the protection of intellectual property. With regard to knowing whether the company BIC had its headquarter in Rwanda, the one representing it says that it has the Headquarter in America but it has been registered in Rwanda to the extent that any one who wants to make commerce of the goods of BIC has first to request for the authorization. The company MADIOS Ltd claims for the damages and the lawyer's fees amounting to 20,000,000 Frw and the interests that it would have profited if it has not been prohibited to sell

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its goods that he said to have legally purchased and claims for the procedural damages and lawyer's fees. The company BIC also claims from MADIOS Ltd the damages amounting to 10,000,000 Frw for having committed the forgery against it and the lawyer's fees amounting to 2,000,000 Frw. Held: 1. The fact that MADIOS Ltd says that it did not committed any act of forgery when it imported and sold the Bic of CRISTAL since the owner of this mark did not renew the period of its registration and it did not reveal any individual or a company it has given the title to sell them in Rwanda may not be considered since the fact that on 04/09/2003 has registered its mark of BIC CRISTAL en forme de stylo as it is proven by the certificate issued by the competent organ. The fact that, as the article 291 of the law N° 31/2009 of 26/10/2009 mentioned above provides for that the renewal of the marks registered is done within ten years of the entry into force on 26/10/2009. Therefore the company BIC has the rights on its mark on until 25/10/2019 since it registered it in 2003, which means that the act of importing within the country the pens in mark of BIC CRISTAL en forme de stylo without being authorized by BIC constitutes the act of forgery which is in contradiction with the law.

2. Whoever any one who will import in Rwanda the goods of the pens of BIC CRISTAL without being authorised by the company BIC as soon as it has the legal right on its mark, they have to be seized and be destroyed.

3. The court realises that the damages provided by the court on the first instance are reasonable since, as it has explained it, the claimant did not prove the loss that MADIOS Ltd caused to it when it imported and sold on the Rwandan market BIC CRISTAL.
4. The court relealises that the claimed procedural damages and lawyer's fees have basis but the lawyer's fees have to be calculated in combination within the procedural damages and again they have to be provided basing on the law of 30 July 1888 mentioned abaoe, since MADIOS Ltd is the one which went on involving the company BIC within the court proceedings for no ground, and it involved in in court proceedings knowing that it is the one at fault, therefore the fact that they made expenses regarding the case, such as hiring and paying a lawyer to plead on its behalf, their expenses have to be paid by the one which involve it within the court proceedings, but due to the fact that claimed damages are too excessive, MADIOS Ltd has to pay to BIC 1,000,000 Frw for the procedural damages and the lawyer's fees provided within the discretion of the court. Appeal of MADIOS Ltd since it has been legally lodged, but it found it basless. It decides and orders that any one who will import within Rwanda the goods of pens of BIC CRISTAL without being authorised by the company BIC as soon as it it has legal right on its mark will be seized and be destroyed. Statutes and Statutory instrument referred to: The law N° 31/2009 of 26/10/2009 on the protection of intellectual property, article 261 and article 291; The law of 30 July 1888 istituting the Civil Code (CCB III) relating to the contractual obligations or contracts, article 258. No case was referred to.

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### Judgment

I. BRIEF BACKGROUND OF THE CASE [1] This case started before Nyarugenge Commercial Court, BIC suing MADIOS for the act of forging its pens and claims thereon the damages and other related damages as there are mentioned within the claim at the first instance level. [2] Within its verdict, the court decided that MADIOS Ltd imported the forged pens and it has been condemned to pay diverse damages and it has been condemned also to remove those pens on the market and destroy them. [3] MADIOS Ltd was not satisfied with the decision of the court and appealed against that judgment arguing that there should be analysed whether BIC had the right of claiming the right on the mark it registered on 4th September 2003. [4] Within this case there should be analysed whether BIC has to claim right on the mark that it has registered in 2003 and to know whether there has been the act of forging made by MADIOS Ltd on the mark of the company BIC, assessing whether the damages claimed by each party may be provided. II. LEGAL ISSUE OF THE CASE With regard to analysing whether whether BIC has to claim right on the mark that it has registered in 2003 and to know whether there has been the act of forging made by MADIOS Ltd on the mark of the company BIC [5] Me MANIRAHARI Nouredini says that to decide on this case, the court referred to the case of Colgate while they are not similar in nature moreover that colgate had people representing it in Rwanda while while BIC is not represented and MADIOS Ltd does not make pens rather it sells, in addition those pens were not tested and be

proven that they don't meet the standards or they are different to those which were on the market. [6] He goes on explaining that the fact that the court has stated that MADIOS Ltd has committed the act of forgery basing on the provisions of the law when it imported the pens in kind of Bic while the company BIC did not authorised it to do so, that within its arguments, the company BIC did not reveal the one it has authorised to import its goods in Rwanda, to be proved to have that right, but he/she was not and ground was that the mark of the company BIC has lost its validity as provided for by the article 153 of the Law N° 31/2009 of 26/10/2009 on the protection of intellectual property. [7] He concluded stating that the company BIC did not respect the provisions of this article more importantly that they argue that the mark of "BIC CRISTAL en forme de stylo" has been registered on 4th September 2003 while the goods have reached in customs in December 2015, the fact that 12 years have elapsed and they do not prove that they have requested to reigister it again as provided for by the law, which is the ground that they do not even reveal any one who

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had that right of imprting those pens within the country to the extent that MADIOS Ltd may be considerd as if it is at fault, while it is eveident that their mark has expired. [8] Me MUNYANEZA Remmy says that at the first instance MADIOS Ltd did not deny that the mark is for the compay BIC which has to be matched with the article 168 of the Law N° 21/2012 of 14/06/2012 relating to the civil, commercial, labour and administrative procedure. Here the appellant proves what he/she criticizes against the first judgment and he/she has not to attack the ground he/she did not reveal to the court. [9] He goes on saying that the issue is not the mark which has been registered on 4/9/2003, rather there are three marks, the first one is the "logo of BIC" which has been registered in 1973, the second is "the form of the pen" which has been registered in 2003, the last one is "the name of CRISTAL" which has been reigistered in 2009. He goes on saying that all those have been registered before the enactment of the law on the protection of intellectual property and the law of 25 February 1963 was applied. This means that the article 153 of the law of 2009 mentioned by his colleague is baseless since it provides for the renewal of the marks registered in accordance with this law. The article 291 of the law of 2009 more precisely within its paragraph one and three, which is the one providing about the marks registered in accordance with the law of 1963. [10] With regard to arguing that none has been given right of selling the pens in Rwanda, this is meaningless within this case, rather there may be analysed if the act performed is not the forgery moreover that they imported the goods without the authorisation given by the owner of the mark. [11] While with regart to arguing that they did not made the pens rather they purchased and imported them for sale, this is in contradiction with there article 261 of the law on the protection of intellectual property, it details the meaning of the act of forgery where it provides for making commercial profits. [12] With regard to the issue of knowing whether the company BIC has its place where it works in Rwanda, Me MUNYANEZA Remmy responds that it does not works in Rwanda since it is established in America but it has registered its mark in Rwanda and that whoever wants to sell its items requests it to authorise him/her to. [13] Me MANIRAHARI Nouredini explains that the court may not refer to the caselaws referred by the

court of first instance. VIEW OF THE COURT [14] The article 261 of the Law N° 31/2009 of 26/10/2009 on the protection of intellectual property provides for that “Subject to the provisions of this law, any industrial or commercial use, in the Republic of Rwanda, of an invention, utility model, industrial design and model, mark or other distinctive sign of business, trade name, geographical indication or layout design integrated circuit, which is the subject of a protection title granted under this law and made by any person other than the owner of the title and without his/her consent, shall constitute an act of forgery. Any infringement of copyrights or related rights protected under this law, committed wilfully or by gross negligence, by any third person for profit-making purposes and without

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owner’s right consent shall constitute an act of forgery. Any third person, who knowingly sells, offers on sale, is making rent, detains or introduces on the territory of the Republic of Rwanda, the alleged infringing goods for commercial purposes, shall be considered as committing the same offence”. [15] While its article 291 provides for that “At the commencement of this Law, the patents granted, industrial designs and models and marks registered under the Law of February 25th 1963 on patents, under the law of February 25th, 1963 on industrial designs and models, under the law of February 25th, 1963 on marks of factory or trade shall remain valid but, subject to paragraphs

- (2) and (3) of this Article, shall be considered to have been granted or registered under this law. The patents thus granted and the industrial designs or models thus registered shall remain valid for the whole of the remaining period up to the end of the duration of the protection accorded under the above law, subject respectively to payment of the annual maintenance in force or renewal fees provided for in this law. The registration of marks made according to the provisions of paragraph one of this article shall be renewed within ten (10) years of the entry into force of this law. [16] The court realises that the arguments of Me MANIRAHARI Nouredini that MADIOS Ltd committed no act of forgery when it imported and sold Bic of CRISTAL since the owner of this mark did not renew the period of its registration and it did not reveal any individual or a company it has given the title to sell them in Rwanda may not be considered since the fact that on 04/09/2003 has registered its mark of BIC CRISTAL en forme de stylo as it is proven the certificate issued by the competent organ, the fact that, as the article 291 of the law N° 31/2009 of 26/10/2009 mentioned above provides for that the renewal of the marks registered in ccordance with the law of 25th February 1963 is done within ten years of the entry into force of the law N° 31/2009 of 26/10/2009, the fact that the mentioned law has entered into force on 26/10/2009, the company BIC has the rights on its mark on until 25/10/2019, which means that the act of importing within the country the pens in mark of BIC CRISTAL en forme de stylo without being authorized by BIC it is the act of forgery which is in contradiction with the provisions of the article 261 of the law N° 31/2009 of 26/10/2009 mentioned above. [17] The court realises again that the appellant may not base on the fact that the owner of the mark does not reveal an individual or a company it has authorised to sell those pens to be proven as the ground of proving that it has the right of

selling them without being authorized by the owner of the mark since what is analysed here is the right, issued by the owner of the mark, of importing and selling the pens in its mark. With regard to the damages claimed by MADIOS Ltd [18] Me MANIRAHARI Nouredini requests that his client may be provided with the damages for the loss incurred due to the prevention of selling its goods that it has legally purchased, the fact that it is about six months that it has been hindered to exercise its right on its property by incompetent people, it requests the court to decide that it has to be compensated 20,000,000 Frw of the damages and the interests that it would have profited if it sold and goes back to purchase and it requests again the procedural damages and lawyer's fees amounting to 5,000,000 Frw.

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[19] Me MUNYANEZA Remmy explains that the damages claimed by MADIOS Ltd are baseless because the company BIC committed no fault against it to pay the damages to it, rather MADIOS Ltd is the one which violated its intellectual right of the company BIC. While about the procedural damages and the lawyer's fees claimed by MADIOS Ltd, he argues that they are baseless since all the cases have been triggered by the acts of forgery that it has done, therefore it has not to claims thereon. VIEW OF THE COURT [20] The court realises that the damages claimed by MADIOS Ltd for the incurred loss are baseless since as it has been explained in the paragraph 19 and 20 of the judgment, it is the one which committed the fault, therefore no damage may be paid to it for its faults. With regard to analysing if the goods of the pens of BIC CRISTAL which will be imported by any person without being authorised by the company BIC will be destroyed. [21] Me MUNYANEZA Remmy explains that at the first instance, the company BIC has requested that the goods of the pens of BIC CRISTAL that will be imported by any one else without being authorised by the company BIC, the court orders that they will not be distributed on the rwandan market and be destroyed, instead the previous court said nothing thereon. VIEW OF THE COURT [22] The article 258 of the law n° 31/2009 mentioned above provides for that "Upon request by the owner of the protection cessation of release of counterfeit marks goods or goods infringing owner's right into the channels of commerce; 2° that the counterfeit marks goods or goods infringing owner's right goods be disposed of commercial channels, without compensation of any sort, in such a manner as to avoid any harm caused to the right owner. A mere removal of marks unlawfully affixed shall not be sufficient, other than in exceptional cases, to permit release of the goods into the channels of commerce; 3° that materials or instruments that were used or which may be used in the creation or manufacture of goods with imitative marks or infringing the rights of the owner of decision be disposed of outside the channels of commerce without compensation in order to evade the risks of infringement of the owner's right; 4° the seizure, forfeiture or destruction of the infringing goods and of any materials and instruments having mainly served in the commission of the offence. [23] The court realises that the request made by Me MUNYANEZA Remmy has basis, which is the reason why, as provided for by the article 258 of the law no 31/2009 mentioned above, any one who will import in Rwanda the goods of the pens of BIC CRISTAL without being authorised by the

compay BIC as soon as it has the legal right on its mark, they have to be seized and be destroyed. With regard to assessing the damages claimed by BIC [24] Me MUNYANEZA Remmy explains that on the first instance the company BIC requested to the court to condemn MADIOS Ltd to pay to it the damages for the fact of having committed the act of forgery against it, amounting to 10,000,000 Frw, the court decided that

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MADIOS Ltd has to pay the damages amounting to 1,000,000 Frw, and he realises that those damages are quite few considering how the intellectual property costs much to its owner to him/her to invent using diverse researches and therefore he requests the court to correct it and orders that the reasonable damages to be paid by MADIOS Ltd are the ones amounting to 10,000,000 Frw. [25] The one pleading on behalf of MADIOS Ltd said nothing on these damages. VIEW OF THE COURT [26] The court realises that the damages provided by the court on the first instance are reasonable since, as it has explained it, the claimant did not prove the loss that MADIOS Ltd caused to it when it imported and sold on the Rwandan market BIC CRISTAL. With regard to the procedural damages and lawyer's fees [27] Me MUNYANEZA Remmy explains that the company BIC on its side requests the court to condemn MADIOS Ltd to pay to it the procedural damages and the lawyer's fees for the appeal level amounting to 2,000,000 Frw. [28] The one pleading on behalf of MADIOS Ltd said nothing on those damages. VIEW OF THE COURT [29] The article 258 of the law of 30 July 1888 instituting the Civil Code (CCB III) relating to the contractual obligations or contracts states "that any act of individual that causes damage to another person obliges the one whose fault caused damage to repair it". [30] The court realises that the claimed procedural damages and lawyer's fees have basis but the lawyer's fees have to be calculated in combination within the procedural damages and again they have to be provided basing on the law of 30 July 1888 mentioned above, since MADIOS Ltd is the one which went on involving the company BIC within the court proceedings for no ground, and it involved in in court proceedings knowing that it is the one at fault, therefore the fact that they made expenses regarding the case, such as hiring and paying a lawyer to plead on its behalf, their expenses have to be paid by the one which involve it within the court proceedings, due to the fact that claimed damages are too excessive, MADIOS Ltd has to pay to BIC 1,000,000 Frw for the procedural damages and the lawyer's fees provided within the discretion of the court. III. DECISION OF THE COURT [31] It decides to admit the appeal of MADIOS Ltd since it has been filed within the legal procedure, but it analysed it and found it baseless; [32] It decides that nothing changes on the judgment RCOM 00017/2016/TC/NYGE except the procedural damages and the lawyer's fees added to the one of the first instance;

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[33] It decides and orders that any one who will import within Rwanda the goods of pens of BIC CRISTAL without being authorised by the company BIC as soon as it has legal right on its mark will be seized and be destroyed.

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