

IN THE SUPERIOR COURTS OF THE GAMBIA



IN THE HIGH COURT OF THE GAMBIA

CRIMINAL CASE NO: HC/074/18/CR/011/A0

BETWEEN:

THE STATE.....COMPLAINANT

AND

EBRIMA TOURAY.....ACCUSED PERSON

CASE CALLED ON THE 10TH OF JANUARY 2025

BEFORE HON. JUSTICE EBRIMA JAITEH

PARTIES

- **ACCUSED PERSON – PRESENT**

APPEARANCES

- **A. COLLEY FOR THE STATE - PRESENT**
- **K. SANYANG FOR THE ACCUSED PERSON**

JUDGEMENT

By an information filed by the Prosecution dated the **13th February 2018**, the accused person is charged with the following offences:

COUNT ONE

Trade name infringement contrary to section 35 (3) of the Industrial Property Act Cap. 95:01 Vol, 15 Revised Laws of The Gambia, 2009 punishable under section 43 (4) of the Industrial Property (Amendment) Act, 2015; and

COUNT TWO

Acts of unfair competition contrary to section 36(2) (a) of the Industrial Property Act Cap. 95:01 Vol 15 Revised Laws of The Gambia, 2009 punishable under section 43 (4) of the Industrial Property (Amendment) Act 2015.

FACTS OF THE CASE

The accused person, Ebrima Touray operates a medium business under the name EMT Enterprise engaged in the business of buying and selling of building materials in various shops situated at Kanifing Industrial Estate Area, Serre kunda and in Brikama. The Complainant, Batimat, situated at Kanifing Industrial Estate, Kanifing Municipality is a well-known business entity and similarly, sells building materials and house hold items.

Police Investigations revealed that Batimat received a complaint from a customer that the price of the wheel barrow was too expensive when EMT Enterprise was selling it at a cheaper rate. Thereafter, the police mounted an investigation and it was discovered that the accused was selling an imitation of the same product with the inscription of the name "BATHNAT" on the wheel barrows. These inscriptions confused the public mores so when the quality of the product is not the same with the original imported by Batimat. The accused is alleged to have imported one thousand nine hundred and fifty (1,950) wheelbarrows and out of which thirty (30) were imitation however, seventeen (17) were retrieved by the police and kept with Batimat for safe keeping.

According to the accused person, when the incident was discovered by the Police, he contacted the manufacturer who in turn confirmed that the fault was theirs, and as a consequence a letter was issued to Batimat acknowledging mistake and liability on their part and this caused Batimat to request the accused person, Ebrima Touray to pay the sum of thirty thousand dalasis being cost incurred for engaging the services of a lawyer, Amie Bensouda and Co. The accused in compliance furnished this said amount and with the aid of a welder man the inscription on the wheelbarrow were removed and returned to the accused.

SUMMARY OF THE PROSECUTION'S CASE

The prosecution in proof of its case called six (6) witnesses namely; Hassan Baldeh- Police officer, Fatou Jallow- Police Officer, Demba Mbye- Police Officer, Bablu Sing Foni (Soni)- Sales Manager at Balaji Enterprise, Ali Jammeh- Staff of Business Registry, Ministry of Justice and Usman Gomez- Staff of Batima Limited. The prosecution also tendered the following **Exhibits; 8 photographs Exhibit C1 to C8**, Cautionary

Statement of the accused person **Exhibit C9**, Certificate of Business registration in the name of Batimat **Exhibit C10** and Certificate of Incorporation of Batimat -**Exhibit C11**

According to the PW 1, 2, and 3, Police officers, sometime in September, 2017 a complaint was received about an alleged trade name infringement. An investigation was conducted at the accused person's shop and it was discovered that he had imported wheelbarrow bearing inscription and designed "BATHNAT". It was further realised, that these inscriptions made the wheelbarrows confusingly similar with the wheelbarrow sold by Batimat Limited. As a consequence, seventeen (17) wheelbarrows were confiscated, photographed and thereafter, taken to Batimat Limited for safe keeping.

PW4 the sales Manager at J. Balaji also a shop dealing in building materials stated he bought one Hundred (100) wheelbarrows from the accused person with BATHNAT inscription on the sides.

PW5 is a staff of the companies Registry, Ministry of Justice. He stated that Batimat Limited is a registered Company/trade name. The certificate of incorporation was tendered through him.

PW6 is a staff of Batimat Limited. He stated that sometimes in 2017 the accused person sold out some wheelbarrows which customers confused with Batimat Limited wheelbarrows. This led to the customer's complaint to Batimat that they were selling two different wheelbarrows at different prices. The accused person, Ebrima Touray was confronted by the Police, but he blamed the manufacturers in China for the mistake. The accused person upon the instruction of Batima through their Lawyer compensated Batimat Limited the sum of Twenty-five thousand dalasis (D25, 000:00) and also paid the welder man for the removal of the inscription before the 17 wheelbarrows were returned to the accused person.

SUMMARY OF THE DEFENCE CASE

The accused person gave lone evidence in chief and did not call any other witness in defence of his case. In his testimonies to this Hon. Court, he stated that he is trading under the brand name EMT which is the unregistered mark used for the sale of his wheelbarrows. He stated that he is accused of infringing Batimat's trademark and this is because he ordered from the same manufacturer with Batimat. Both orders were placed at the same time. However, when he received his own consignment, he realised that some of the wheelbarrow had the mark "BATHNAT" inscribed. These marks were similar to that of "BATIMAT" of Batimat Company Limited. He thereafter

complained to the manufacturer in China and they confirmed in response, that, it was their mistake. This was communicated subsequently to Batimat and in response, a letter was issued. This is admitted in evidence and marked Exhibit D1.

That he ordered one thousand nine hundred and fifty (1,950) wheelbarrows from the Chinese Company which were supposed to bear the mark EMT but thirty (30) out of this bore a different mark "BATHNAT". Upon the instruction of Batima Company, the seventeen (17) confiscated wheelbarrows bearing the imitated inscription were later returned back to him after the removal of the design and the subsequent payment of the legal fees thirty thousand dalasis (D30,000:00) to Batima Company.

Under cross examination, the accused person agreed that Batimat is his competitor in the sale of wheelbarrows and that Batimat is a well-known tradename in The Gambia and that is why they have a brand. That EMT is the name of his business as well as his brand name but it is not a registered brand. He admitted selling some before realising the imitation and stopped after Batimat came to his shop with Police Officers. He however, denied selling one hundred (100) wheelbarrows to Balaji J.

In proving its case the prosecution filed written address dated 27th December, 2023. The defence also filed similarly, dated the 21st December, 2023. Both prosecution and defence raised the same issue for determination to wit:

Whether the prosecution has proved its case beyond reasonable doubts?

I have carefully read their written addresses and i am of the firm conviction that the sole issue shall be adopted as mine in the determination of the suit and this i shall accordingly reproduced herein:

COURT'S ISSUE FOR DETERMINATION

Whether the prosecution has proved its case beyond reasonable doubts?

ARGUMENT OF PROSECUTION ON THIS SOLE ISSUE

The prosecution is of the firm conviction that to prove these offences the ingredients of the offences in both counts must be proved. These are as follows: **on count one:**

- That the accused person used Bathnat on his wheel barrow which trade name is confusingly similar with Batimat trade name;

- That the accused person is a third party and did not have the consent of Batimat Limited to deal in the said wheel barrow; and
- That the action of the accused person misled the public.

COUNT TWO:

- The accused person used Bathnat inscription on his wheel barrow.

The prosecution submitted that all these elements were established by the evidence of the prosecution. That PW1, 2 and 3 confirmed recovering seventeen (17)-wheel barrow from the accused person. This was not denied by the defence; in fact they acknowledged this fact after the payment of the stated sum of money as legal fees to Amie Bensouda and Co. Under cross examination the accused also acknowledged that these wheel barrows were recovered from his shop. I refer to his evidence in the court's record of proceedings wherein he stated as follows:

Question

Did you stop selling wheel barrow voluntarily?

Answer

No, I have a shop that is close to Batimat Shop. They were the one that realised this and they came with a Police Officer and took the Wheel barrows to Batimat, but when Batimat received a letter from the manufacturer, they returned the Wheel barrows to me. Then Batimat lawyer told me that he has spent D30, 000:00 to get a service of a lawyer and I did return the D30, 000:00 to Batimat.

In addition to that, the prosecution led evidence through PW 4 a staff of Balaji Enterprise who had adduced unchallenged evidence that the accused supplied him with one hundred (100) -wheel barrows which had bathmat inscription on them. Further, a staff of the Business Registry, Ministry of Justice gave oral evidence to this court that Batimat Limited is a registered trade name and therefore distinct from EMT Enterprise owned by the accused person and this made the accused person a third party.

As a consequence, it is the prosecution submission that they had established element of actual confusion caused by this unlawful act and the public was made to believe that the two types of wheel barrows were the same. He referred to Article 16.1 of the TRIPS Agreement 1994 which is binding in this jurisdiction by virtue of the Country's signatory to the convention.

Prosecution also referred to **Clipsal Australia PTY LTD V Clipso Electrical PTY LTD NO.3 (2017) FCA 60 as reported in Case book on Enforcement of Intellectual Property Rights 4th Edition at pages 43.**

Learned Counsel for the Prosecution argued that the act of using, possession and sale of infringed products are continuous acts that can occur or constitute the same transaction. That the mere fact that he had sold 100 to Balaji J., the public has been misled in believing that the wheelbarrows were the same. This therefore, means that, count one and two have been successfully proved beyond reasonable doubt.

The Prosecution in addition to the above submissions drew the court's attention to the fact that the accused should not be excused for the alleged defence of mistake caused by the manufacturer. He stated that going by the evidence adduced before this court, it is established that the accused person's action was deliberate. He had the wheel barrows and was selling it. He however, claimed that he stopped once he realised the mistake but later conformed that he didn't stop voluntarily but because of the intervention of the complainant and the Police Officers.

That the accused person had through out his testimonies referred to Exhibit D1 that it was the mistake of the manufacturers; a claim which is not genuine for the court to rely on. Learned Counsel buttressed his argument on this point with reference to section 8 of the Criminal Code on mistake of fact is a defence based on which action of the accused person may be excused in law. But was quick to add that the accused person must make a genuine prima facie case of genuine mistake of fact before his actions or omissions may be excused in law.

Also, that having a thorough look at Exhibit D1, the purported letter from the manufacturers was not address to Batimat but to the Manager of the Police Station. The letter was not dated or signed by the manufacturers and there is nothing to show that Batimat Company ordered its wheel barrow from the same Company. He therefore urged upon this hon. Court not to attach any weight on Exhibit D1. That assuming without conceding that Exhibit D1 is a genuine letter and that the manufacturer in China made a mistake of using Bathnat on the accused person's wheel barrows, the accused should have immediately corrected the mistake but not continue to free ride and benefit from mistake of the manufacturer.

Learned Senior Counsel cautioned, that, it cannot rely on hear say allegation of mistake of fact caused by a third party who cannot be called as a witness to conclude that the accused person did not have the intension to infringe a trade name. Also, that PW6 in his testimony stated that clients were complaining

about the price disparity for the same wheel barrow sold by the accused person. The Prosecution's evidence had established that Batimat was deprived of some sales as clients definitely preferred to buy at a lesser price. Therefore, the accused person upon discovery ought to have rejected all the infringing wheel barrows if they actually did not fit the description of goods ordered from the manufacturer. The mere fact that he ignored this confirmed his intention to mislead the public.

He submitted further that in contract for sale of goods that if the buyer fails to reject goods in a timely manner, the risk will be transferred to the buyer. The accused person is therefore criminally responsible for procuring infringed wheel barrow and commercially benefiting from the sale.

Learned Senior Counsel finally urged this Hon. Court to convict the accused person on both counts and hold that the prosecution has proved its case beyond reasonable doubt.

ARGUEMENT OF THE DEFENCE ON THE SOLE ISSUE

As indicated earlier, the defence did not call witnesses but relied on the evidence in defence and in its written address adopted the same issue as resolved by the prosecution and submitted as follows:

Learned Junior Counsel for the defence on count one argued that the prosecution has failed to prove their case beyond reasonable doubt since the mens rea and actus reus have not been satisfied. That the accused person denied ordering the wheel barrow with the inscription BATHNAT because the accused person and Batimat limited all ordered their wheel barrow from the Chinese Company Qingdao Haodong Hand Truck Co. Ltd. Who in return, had accepted liability as though the accused person had never ordered the wheel barrows from them. That Exhibit D1 evidencing denial on the part of the accused person was admitted into evidence without objection from the prosecution.

It is Learned Junior Counsel Further argument that Exhibit D1 is a clear indication that the accused person is not guilty of the offence charged but rather the manufacturers who have accepted their mistake. That the accused person and the owners of Batimat have long been ordering from the Chinese Company for so many years and have never encountered such. He cited the case of R V Malcherek and Steel (1981) 2 ALL ER 422 and in R V Pittwood (1902) 19 TLR 37 stated:

"A person may be found criminally liable if they fail to comply with a contractual duty they owe to another"

That in this case, the Chinese Company failed in their contractual duty towards the accused person and as such, the accused has to innocently suffer for their mistake as supported by Exhibit D1.

Moreso the owners of Batimat trade name after receipt of exhibit D1 from the Chinese Company itself caused the accused person through their counsel to make an undertaking for no future infringement of their client's trade name and the owners of Batimat requested through them in a letter to withdraw the case against the accused person. This letter is admitted into evidence and marked Exhibit DE1 dated the 22nd May 2023 which is stated at paragraph 4 that:

"As a result, our client request that this matter be withdrawn against Ebrima Touray"

As a consequence, Counsel argued the prosecution witnesses who continued their evidence in court after the first three were just testifying in a case that has already been withdrawn by the complainant, Batimat.

That since Prosecutors from the Attorney General and Police have a right to initiate and discontinue cases, private persons / individual equally have a right to initiate suits, more so were the alleged harm directly affects him / her and for this reason an individual can discontinue his / her own suit without regard to public interest even where the consequence of the alleged harm directly affect him/her after such has been solved by the parties concerned. That PW6 a staff of Batimat Company Limited has led evidence to the fact that the trade name owner has ratified the issues between them and as a result the accused person has paid the sum of thirty thousand (D30,000:00) dalasis towards legal fees and the wheel barrows subsequently returned to the accused person, Ebrima Touray.

In view of the preceding submission, from the court's understanding, the defence in essence is denying the charges. They are vehemently submitting that it was the mistake of the Chinese company as evidenced with Exhibit D1 and acknowledged by the Chinese Company to Batimat. That coupled with that led to the payment of the stated D30, 000:00 dalasis as legal fees to the lawyers and subsequent withdrawal of the suit by the complainant, Batimat.

Therefore, all these defence culminating in creating doubt in the mind of the court which should in principle, be resolved in favour of the accused person against the prosecution.

In respect of Count two, the defence is urging the court to discharge the accused person on this count. This is because since count one has been proven to emanate entirely from the Chinese Company, it will therefore only be fair to consider that count two will not have emanated if there was infringement of count one by the accused person. The court is referred to the case of Emmanuel Ibeziako V. Commissioner of Police (1963) 1 ALL N.L.R at 279 where the court stated thus:

"It is trite law that if on the whole, the court is left in a state of doubt, the prosecution would have failed to discharge the proof which the law places on them".

Learned Junior Counsel finally urged this Hon. Court to acquit and discharge the accused person as the prosecution has woefully failed to prove their case against the accused person.

THE COURT'S RESOLUTION OF THE SOLE ISSUE

Whether the Prosecution has proved its case beyond reasonable doubt?

It is a well settled principle that in criminal trials the prosecution has the sole duty of proving its case beyond reasonable doubt as per section 144 of the Evidence Act. The doubt created must not be beyond all shadow of doubt but a doubt that would be created in the mind of the ordinary person in the street reasonably.

It is therefore the duty of the court to determine whether in view of the pleadings, the issue raised and the ingredients of the offence, the prosecution has reasonably discharged this heavy burden, as legally incumbent upon them.

I shall herein reproduce the charges preferred against the accused person:

COUNT ONE

Trade name infringement contrary to section 35 (3) of the Industrial Property Act Cap. 95:01 Vol, 15 Revised Laws of The Gambia, 2009 punishable under section 43 (4) of the Industrial Property (Amendment) Act, 2015; and

COUNT TWO

Acts of unfair competition contrary to section 36(2) (a) of the Industrial Property Act Cap. 95:01 Vol 15 Revised Laws of The Gambia, 2009 punishable under section 43 (4) of the Industrial Property (Amendment) Act 2015.

**The ingredients of the offences charged are as follows:
on count one:**

- **That the accused person used Bathnat on his wheel barrow which trade name is confusingly similar with Batimat trade name;**
- **That the accused person is a third party and did not have the consent of Batimat Limited to deal in the said wheel barrow; and**
- **That the action of the accused person misled the public.**

COUNT TWO:

- **The accused person used Bathnat inscription on his wheel barrow.**

On count one the prosecution has led evidence and established the fact that in proof of its case they have satisfactorily demonstrated that the accused person used a trade mark name confusingly similar with Batimat without authority thereby misled the public into believing that the products are the same in quality and more costly as per unit price.

It is a trite that infringement of intellectual property rights occurs when a work protected by intellectual law is used, copied, or exploited without the owner's permission. Hence industrial property rights protect against unlawful imitation, such as when competitors adopt another company's invention to save cost.

In this jurisdiction, Section 35 (3) of the Law makes it unlawful to use a trade name similar to another trade name which is likely to mislead the public as to the nature of the enterprise identified by that trade name. The evidence, Exhibit C2, established that the name "Batimat" is the trade name of the Company Batimat Limited, a registered Limited Liability Company. As per Exhibit C10, their Certificate of Business Registration and Exhibit C11, their Certificate of Incorporation under the Companies Act, 2013.

I shall countenance the prosecution's submission on PW1, 2, and 3 evidence who all narrated how the incident was reported to the Police and upon investigations at the accused person's shop the imitated wheel borrows were retrieved and keep in safe custody with the complainant Batimat. That during the course of investigation these items were subsequently returned to the accused after negotiated settlement of the sum of thirty thousand (D30, 000:00) dalasis by the accused to the complainant, Batima.

Therefore, this hon. Court in the determination of this case is of the firm conviction that the accused person actually infringed on Batimat's trade

notwithstanding the fact that the mistake emanated from the Chinese Company. That the mere fact that the public was misled into believing that they are of the same brand i.e. Batimat and Bathnat is sufficient to sustain the charges preferred.

In proof of its case the prosecution has succeeded in establishing confusion by the public which actually led to the complaint received by Batimat Company from its customers at the detriment of the public to the lawful gain by the accused person's continuous sales and profiteering from the imitated products. The products were commercially used and they are not within the exemption of permitted act for fair usage.

To substantiate my reasoning on the above, i refer to the case of SOCIETY BIC S.A & ORS V. CHARZIN INDUSTRIES LTD (2014) LPELR- 22256 (SC).

“Trade mark is a distinctive mark of authenticity through which the product of a particular manufacturer may be distinguished from those of others by word, name, symbol or device. A car manufacturer who fixes or inscribes on his cars the three-pointed stars may be infringing the Mercedes Benz trade mark. Also affixing the flying lady on a car may be infringing the Rolls Royce Trade Mark. Both examples are the distinct mark of authenticity by which both motor cars are distinguished from those of other manufacturers. Trade Marks are registered and remain personal to the manufacturers”

It follows therefore that being able to distinguish between trademarks is dependent on the word, name, symbol or device used by trade mark owners. In the exercise of comparison between marks, it has been held that it is wrong to take two marks side by side to determine whether they are identical, or some close resemblance exists. The issue is whether the person who sees or has seen the proposed trade mark will confuse it with the existing trade mark, as to create confusion and be deceived that proposed trade mark is the same as the existing one. See **HOLDENT INTERNATIONAL LIMITED V PETERSVILIE NIGERIA LIMITED (2013) LPELR 21474 (CA)**

In the Holdent case (supra), a passage from the Matter of Application for registration of a trade mark by Sandow Ltd. (1914) 31 RPC 196 OF 205 was cited where Sargant, J, Stated:

“The question is not whether if a person is looking at the two trade marks side by side there would be a possibility of confusion; the question is whether the person who sees the proposed trade marks in the absence of other trade mark, and in my view only of his general

recollection of what the nature of the other trade mark was would be liable to be deceived and to think that the trade mark before him is the same as the other, of which he has a general recollection”

Besides general recollection of the nature of the products, the use of phonetics in determining whether marks are identical and confusingly similar are paramount in the comparison of marks. Herein in this case the accused person mark is **BATHNAT** and the Complainant is **BATIMAT**. All of them have the first syllable as **BATH** and **BA**. But the full words contain these syllables- **BATH/NAT** and **BA/TI/MA**. These first two vowels have the same pronunciation and with the tendency of confusing the public.

It is important to note that the infringed product trade mark is a registered mark at the Registrar General's office in accordance with **section 31 of the Industrial Property Act, Cap. 95:01, Vol, 15, Revised Laws of The Gambia, 2009**. Therefore, the registered trade name “Batima” is more binding and legally enforceable than “Bathnat”. Legally, registration gives it an edge over an unregistered trade name and therefore its infringement that is the use of the product without permission for commercial gains attracts penalties and punishable under the Industrial Property (Amendment) Act, 2015.

This Hon. Court shall hold that the mere fact that the parties have settled by virtue of the stated D30, 000:00 paid by the accused person and withdrawal of the case is not sufficient to exonerate the accused person from the charges preferred against him. It is a settled principle of law that the power to initiate criminal proceedings against an individual subject to the approval of the Attorney General, lies exclusively with the Director of Public Prosecution. **Section 85 (1) of the 1997 Constitution of the Republic of The Gambia, provides that The Director of Public Prosecution shall have power in any case in which he or she considers it desirable to do so, and subject to the approval of the Attorney General-**

(a) To initiate and under take criminal proceedings against any person before any court for an offence against the law of The Gambia

(b) To take over and continue any criminal proceedings that has been instituted by any other person or authority.

By virtue of public policy this is a crime against the state, so individuals are not the only parties there is a public interest and the discretion lies with the Office of the DPP in consultation with the Attorney General to continue or discontinue the proceedings. Since the State, the office of the DPP has not withdrawn the charges, neither the accused person nor the Complainant Batimat has the

right to discontinue the proceedings and this I shall hold as the position of the law as contained in the above constitutional provision.

As a consequence, the court shall discountenance the defense's submission on acquittal and discharged. The prosecution has proved its case on copy right infringement as per the Industrial Property Act, Revised Laws of The Gambia and punishable under the Amendment Act, 2015. This, I shall hold as a fact and has found the accused person guilty as charged and is hereby, convicted accordingly.

CONVICTION

Ebrima Touray is therefore convicted on both counts, one and two under section 35 (3) and 36(2) (a) of the Industrial Property Act, Vol. 15 Revised Laws of The Gambia, 2009 and punishable under section 43 (4) as per the Amendment Act, 2015.

ALLOCUTUS

Court: Do you have any thing to say to the court in mitigation in respect of your conviction?

SENTENCE

I have listened to Counsel S.K. Jobe's plea in mitigation on behalf of the convict. I must state that this is a very serious offence and has the tendency of causing damages to the economic and market forces in commercial business competition. The objective of the copy right regime amongst other is to foster healthy competition in business and encourage fair participation. The courts have a role in deterrence of fraudulent act and those found wanting contrary to the relevant legislation protecting business rights and interest of parties and this, I shall hold as a fact.

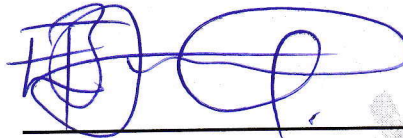
However, from the proceedings and during the cause of investigation it could be inferred that Ebrima Touray, the convict has not wasted the court's time and in compliance, had accepted payment of the legal service fees of D30, 000:00 to the Complainant, Batimat Company Limited.

In the interest of justice and considering the convict's plea in mitigation accordingly, in sentencing the convict, I shall temper justice with mercy. In this respect, Ebrima Touray is hereby sentenced by virtue of section 43 (4) of the Industrial Property, Amendment Act, 2015 as follows:

- 1. Ebrima Touray is to pay a fine of Two Hundred and Fifty Thousand Dalasis (D 250,000:00) and in default to serve for an imprisonment term of Three (3) years.**

2. Infringement is eminent and Injunction is hereby granted prohibiting any further infringement of the Complainant's product.

This is my Judgment and the Parties are reminded of their right of appeal against conviction and sentence.



**HON. JUSTICE EBRIMA JAITEH
(PRESIDING JUDGE)
10TH JANUARY 2025**

**ISSUED AT BANJUL UNDER THE SEAL; OF THE COURT AND THE
HAND OF THE PRESIDING JUDGE THIS 10TH DAY OF JANUARY
2025**