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IN THE MATTER OF THE TRADE MARKS ACT CAP 506 OF THE LAWS OF KENYA

AND

**IN THE MATTER OF TRADE MARK APPLICATION NO. 114474 “NUTREO” (WORD)
IN CLASSES 1 AND 5 IN THE NAME OF UPL CORPORATION LIMITED**

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

BACKGROUND

On 29th October 2020, UPL Corporation Limited (hereinafter referred to as “the Applicant”) filed an application to register the mark “NUTREO” (word). The Application was filed in classes 1 and 5 of the International Classification of Goods and Services in respect to the following:

Class 1: Chemicals for use in industry as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; substances for tanning animal skins and hides; compost, manures, fertilizers; biological preparations for use in industry and science.

Class 5: Herbicides, pesticides, insecticides, fungicides, vermicides, rodenticides, weedicides, preparations for killing weeds and destroying vermin.

The application was duly examined by the Registrar of Trade Marks in accordance with the provisions of the Trade Marks Act, Cap 506 of the Laws of Kenya. Vide a letter dated 22nd January 2021, the Trade Marks Examiner issued a refusal notice against registration of the said mark on the ground that it is similar to another mark existing on the Register of Trade Marks with the following particulars:

IB/D/0001/1049058 “Nutrio” in classes 5, 29, 30 and 32.

On 2nd June 2021, the Applicant filed written submissions against the Examiner’s refusal notice stating inter alia as follows:

That in view of the fact that the Examiner’s letter does not disclose a similar preexisting mark in class 1, it is the Applicant’s submission that the Applicant’s Mark

should be allowed to proceed to advertisement and subsequently registration in class 1.

That in order for the Registrar to properly test the similarity of the two marks, the Applicant's Mark and the Cited Mark must be compared as a whole. If the marks are compared and judged by their appearance and the different stylizations taken into account, it will be noted and appreciated that the Cited Mark and the Applicant's Mark are not sufficiently similar for any confusion of the public to be likely to arise when the marks are used in trade for the specific goods covered under the respective specifications. The Cited Mark is NUTRIO while the Applicant's Mark is NUTREO. The two marks are distinct and unique and distinguishable from each other.

Kerly's Law of Trade Marks and Trade Names, 12th edition ("Kerly's") in paragraph 17-11 states that *"a trademark is the whole thing and the whole picture of each has to be considered. "Kerly's cites the case of the Application to register "Erectiko" (1935) 52 RPC 136 where Farewell J. said: "I do not think it is right to take a part of the word and compare it with a part of the other word; one must be considered as a whole and compared with the other word as a whole ... I think it is a dangerous method to adopt to divide the word up and seek to distinguish a portion of it from a portion of the other word."* The principle that both marks must be compared as a whole is now well established by the various decisions of the Registrars of Trademarks and is cited with approval in paragraph 565 of the KIPI Manual for Examination Procedure which also refers to the dicta of Farewell J. in the Erectiko case.

In the Pianotist Case [1906] 23 RPC 774, Parker J laid down the test to be used in comparing word marks as follows: *"You must take the two words. You must judge both of them, both by their look and by their sound, you must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the circumstances; you must further consider what is likely to happen if each of those trademarks is used in a normal way as a trademark for the goods of the respective owners."* [The dicta of Parker J is on page 439 paragraph 17-07 of Kerly's].

The Applicant further submitted that the Registrar must also consider the kind of customer who is likely to buy the goods on which the two marks will be applied. In considering the customer, it must be borne in mind what kind of goods are to be bought and whether they are the kind of goods that are selected with deliberation and the type of customers or consumers who will purchase the goods in class 5 which are referred to in the specifications of the Cited Mark and the Applicant's Mark.

The Applicant submitted that the above resultant goods for which the Applicant's Mark is proposed to be used are the kind which require a level of circumspection and caution and must therefore be selected with deliberation. Furthermore, the kinds of customers who are likely to purchase the kinds of services covered by the

Applicant's Mark are well informed customers who ordinarily take care when making their purchases. The Applicant also submitted that this greatly diminishes the likelihood of confusion or deception of the public.

Paragraph 571 of the KIPI Manual of Examination procedures ("KIPI Manual") also states that *"Confusion is less likely where a great deal of thought or enquiry as to fitness of the goods for the purpose might precede the purchase and where accordingly, the trademark enters into the matter only to a relatively small extent"*.

That the Applicant uses goods in class 5 in relation to a bio-nutrition program that ensures proper nutrient availability, uptake and use efficiency by crops, and can be applied through foliar, soil and fertigation methods whereas the Cited Mark is primarily used in relation to sport nutrition products as seen on the website: <https://www.x-technology.com/en/rnd>. It is clear that the Applicant's business activities and its proposed use of the Applicant's Mark is different from that under the Cited Mark. As a result of these business activities being distinguishably different to the user, the commercial likelihood of deception or confusion arising is greatly reduced.

The Applicant further submitted that the Cited Mark covers goods in classes 29, 30 and 32 which are distinguishably different from the goods of interest to the Applicant under the Applicant's Mark in classes 01 and 05.

The Applicant submitted that for the reasons set out above, the goods differ and thus, the commercial likelihood of deception or confusion arising will further be diminished.

The Applicant indicated that for the reasons set out in the submissions, the Applicant's Mark T.M.A. No. 114474 NUTREO should be allowed to proceed to advertisement and subsequently registration in classes 01 and 05 as there are no similarities between the Applicant's Mark and the Cited Mark.

RULING

I have studied the documents on record and considered the Applicant's submissions against the Examiner's refusal notice. I am of the view that the issue for determination is whether or not the Applicant's mark T.M.A. No. 114474 "NUTREO" (word) should be allowed to proceed to registration in classes 1 and 5.

Section 15(1) of the Trade Mark Act provides as follows:

'Subject to the provisions of subsection (2), no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or in respect of services is identical or nearly

resembles a mark belonging to a different proprietor and already on the register in respect of the same services or description of services.’

To make a determination on the above issue, I shall consider the following factors;

1. Similarity of the marks in appearance; and
2. Similarity of the goods.

1. Similarity of the marks in appearance

In determining the issue of similarity of the marks in question, it is critical to consider that the marks should be compared in their entirety. The overall or net impression of the two marks should be highly regarded.

In *Clarke v Sharp*¹ it was stated as follows:

“One must bear in mind the points of resemblance and the points of dissimilarity, attaching fair weight and importance to all, but remembering that the ultimate solution is to be arrived at, not by adding up and comparing the results of such matters, but by judging the general effect of the respective wholes”.

In the English case of *Lloyd Schuhfabrik Meyer & Co GmbH vs. Klijsen Handel BV*² the ECJ stated as follows:

“The perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect.”

In *Sabel BV v Puma AG*³, it was stated that the visual, aural or conceptual similarity of the marks must be assessed by reference to:

“the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components...the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role...the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details”.

I will consider the Applicant’s mark and the cited registered mark to determine whether the two are similar in terms of their appearance.

The Applicant’s mark is the word “NUTREO” (word) written in capital letters.

¹ (1898)15 RPC 141 at 146

² (1999) ECR I-3819

³ Rudolf Dassler Sport [1998] RPC 199 at 224

The Cited Mark on the other hand is “Nutrio” (word).

In considering the visual comparison, I am of the view that there are both points of similarities and differences between the marks in question.

The words “NUTREO” and “Nutrio” although not identical, are similar. Both marks have the letters “N”, “U”, “T”, “R” and “O”. The distinguishing letters in the marks are letters “E” and “I”. In addition, as relates to the cited mark, the “utrio” is indicated in small letters.

In considering the phonetic similarity, I am of the view that the words “NUTREO” and “Nutrio” are pronounced in a similar manner.

2. Similarity of the Goods

In Jellinek’s Application⁴, Romer J proposed a three-fold test when assessing whether goods and services are similar to other goods and services, namely the nature and composition of the goods, the respective uses of the goods, and the trade channels through which the goods are bought and sold. It was indicated that no one factor was considered conclusive and it was not considered necessary for all three factors to apply.

In the **Intellectual Property Law** book by Lionel Bentley and Brad Sherman (2nd Edition) at page 859 the authors state as follows:

‘The question of whether goods or services are similar depends on the facts of the case. When deciding whether or not a trade mark application falls foul of the relative grounds for refusal, the comparison is normally between the goods or services to which the application relates.... This requires the Court to interpret the specification and then to characterize the goods or services and see if they fall within the specification.’

The **WIPO Intellectual Property Handbook: Policy Law and Use** at page 85 indicates the following:

“Trade marks are registered for goods in certain classes which have been established for purely administrative purposes. The classification of goods cannot therefore be decisive for the question of similarity. Sometimes, totally different goods are listed in the same class (for instance computers, eye glasses, fire extinguishers and telephones in class 9), while similar goods can clearly be listed in different classes (adhesives may fall into classes 1, 3, 5 and 16).

The **WIPO Intellectual Property Handbook: Policy Law and Use**, at page 86 states that:

⁴ (1946) 63 RPC 59 at 70

“...identical marks are unlikely to create confusion as to the origin of the goods if the goods are very different. As a general rule, goods are similar if, when offered for sale under an identical mark, the consuming public would be likely to believe that they came from the same source. All the circumstances of the case must be taken into account, including the nature of the goods, the purpose for which they are used and the trade channels through which they are marketed, but especially the usual origin of the goods, and the usual point of sale.”

The Applicant proposes to register his mark in respect to goods in classes 1 and 5 of the International Classification of Goods and Services. The Cited Mark on the other hand is in respect to goods in classes 5, 29, 30 and 32 of the International Classification of Goods and Services. This incorporates class 5, which is a class that the Applicant seeks to protect its mark. In essence, the specification of goods which the Applicant seeks to register in class 5 is also covered by the Cited Mark's goods in class 5.

As far as class 1 is concerned, the Cited Mark is not registered in respect to goods in class 1.

In Kerly's Law of Trade Marks and Trade Names 12th Edition, at paragraph 10-12, the test whether or not goods or services are “of the same description” would seem to be supplied by the question -Are the two sets so commonly dealt in by the same trade that his customers, knowing his mark in connection with one set and seeing it used in relation to the other, would be likely to suppose that it was so used also to indicate that they were his? That the matter should be looked at from a business and commercial point of view.

It is my view that the goods which the Applicant seeks to register are similar to those of the Cited Mark as relates to class 5. As relates to the Applicant's specification of goods in class 1, I see no similarity in goods in comparison to the Cited Mark.

DECISION

For the reasons set out above and having taken into account all the circumstances of this case, I rule as follows:

1. The Trade Marks Examiner's refusal notice dated 22nd January 2021 is hereby upheld in so far as goods in class 5 are concerned;
2. The refusal notice dated 22nd January 2021 is hereby revoked as far as goods in class 1 are concerned.
3. The Applicant's application for registration of the mark “NUTREO” (word) T.M.A. No. 114474 hereby fails as far as class 5 is concerned and registration of the said mark shall only be allowed to proceed in class 1.

4. The Applicant is required to file Form TM 19 (upon payment of the requisite fees), deleting the specification of goods in class 5 before the said application can be allowed to proceed to publication.

The Applicant should however note that these proceedings and the subsequent decisions are not a bar to any opposition proceedings that may be filed under the provisions of the Trade Marks Act once the mark is duly published in the Industrial Property Journal. Should an opposition be filed, the same will be considered on its merits by the Registrar of Trade Marks in accordance with the provisions of the Trade Marks Act.

Ruling delivered at Nairobi this 12th day of November 2024



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CONCILIA WERE

ASSISTANT REGISTRAR OF TRADE MARKS