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

AND

IN THE MATTER OF TRADE MARK APPLICATION NO. 111471 钉钉 (WORD) IN
CLASSES 9, 35, 38, 41, 42, 44 AND 45 IN THE NAME OF DINGTALK HOLDING
(CAYMAN) LIMITED

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

PROCEDURAL BACKGROUND

On 18th March 2020, Dingtalk Holding (Cayman) Limited (hereinafter referred to as “the Applicant”) filed an application to register the mark 钉钉 T.M.A No. 111471. The application was filed in respect to goods and services in classes 9, 35, 38, 41, 42, 44 and 45 of the International Classification of Goods and Services.

The application was duly examined in accordance with the provisions of the Trade Marks Act, Cap 506 of the Laws of Kenya. By a report dated 7th October 2020, the Trade Marks Examiner issued a refusal notice indicating that the application had been refused registration on the grounds that it is similar to another mark existing on the Trade Marks Register with the following particulars:



TM No. 99308 DING DING (word and device) in the name of Shenzhen First Element Technology Co., Ltd, in class 9 in respect to Smartphones; Tablet computers; Satellite navigational apparatus; Encoded identification bracelets, magnetic; Cell Registered

phone straps; navigational instruments; mobile phones; Telephone apparatus; Laptop computers; Notebook computers.

On 11th December 2020, the Applicant filed written submissions in response to the Examiner's refusal notice stating inter alia as follows:

1. The Applicant has registered and applied to register its DINGTALK mark in several jurisdictions around the world among them the European Union, Morocco, the Philippines and Costa Rica.
2. Pursuant to Section 15(1) of the Trade Mark Act, 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.
3. That when assessing the similarity of the two trade marks, 'A global appreciation' approach must be taken as per the court's reasoning in *Sabel v Puma (1998) RPC at pages 199-224*.
4. That upon comparison of the Applicant's mark and the cited trade mark, there is a significant visual difference because the cited mark is a word and device mark while the Applicant's trade mark is a word in Chinese characters. In the matter of *Trade Mark Registration Number 3012409 in the name of Tien Lei Trading Ltd and Yongsong Zhao*, the Intellectual Property Office of the United Kingdom (UK) stated as follows:

The average UK consumer will recognize the earlier mark as consisting of what appear to be Chinese or Japanese characters but, being unfamiliar with the meaning of such characters will regard them in effect as a device.

5. That the visual similarity should be given the most weight because most consumers in Kenya do not understand Chinese and so they would not have any phonetic or conceptual perception of the Applicant's trade mark.
6. That the Applicant seeks to register its trade mark for goods and services in classes 9, 35 38, 41, 42, 44 and 45 while the cited trade mark is registered for goods in class 9. The only common class between the cited trade mark and the Applicant's trade mark is class 9.
7. That guided by the fact the Applicant's trade mark and the cited trade mark are visually, phonetically and conceptually very different trade marks when perceived as a whole, it is only reasonable to conclude that there is no similarity between the Applicant mark and the cited trade 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 as follows:

Is the Applicant's mark T.M.A No. 111471 in classes 9, 35, 38, 41, 42, 44 and 45 similar to the cited mark TM No. 99308 in class 9?

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 between the marks in appearance

In making a determination on the similarity of the marks, it is important to consider that the marks in question should be compared in their entirety. The overall or net impression of the two marks should be considered. I will analyse the Applicant's mark and the cited mark to determine whether they are similar in terms of their appearance.

The Applicant's mark is written in Chinese characters 钉钉 . As per the form TM 2, filed by the Applicant, the Chinese characters transliterate to "DING" and "DING" with



the translation being "Nail". On the other hand, the cited mark is DING DING . Looking at the aspect of visual similarity, I am of the view that the marks would be considered visually not similar by the average consumer in Kenya. For the consumers who are conversant with Mandarin, the visual similarity would only be in respect to the words "DING" "DING". In considering the phonetic similarity relating to the Applicant's mark and the cited mark, both marks would be pronounced in the same way, if the characters in the Applicant's mark are transliterated. The average consumer in Kenya is likely to recognise the characters in the Applicant's mark as characters of a foreign script, more likely Chinese or Japanese, may not be able to pronounce the same or understand the meaning and will consequently consider the mark to be a device mark. As relates to the conceptual similarity, I am of the view that the Applicant's mark and the cited mark are not conceptually similar.

2) Similarity of the goods

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: “...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.”

Romer J in *Jellinek’s Application* (1946) 63 RPC 59 at 70, 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.

Bentley and Sherman in Bentley L, and Sherman B, *Intellectual Property Law* (3rd edn, Oxford University Press), 859, state that when determining whether or not a trade mark application is similar to an earlier mark, the comparison ought to be between the goods or services for which the earlier mark has been registered and the goods or services to which the application relates. An interpretation of the specification and characterization of the goods or services is then required to determine if the goods

are of a similar description.

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.

In this case, the Applicant seeks to register its mark in respect to goods and services in classes 9, 35, 38, 41, 42, 44 and 45 of the International Classification of Goods and Services. On the other hand, the cited mark is registered in respect to goods in class 9 of the International Classification of Goods and Services. In my view, there is no similarity between the Applicant's goods and services in classes 35, 38, 41, 42, 44 and 45 with the cited marks' goods in class in 9. In looking at the goods in class 9 in the Applicant's application and the goods in class 9 in the cited mark, I am of the opinion that there is a similarity in some of the goods in the Applicant's application and the cited mark.

However, having considered the issue of similarity of the marks in question, the similarity of the goods and services and the average consumers of the said goods and services, I am of the view that the said application should be allowed to proceed to publication in the Industrial Property Journal.

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 7th October 2020, is hereby revoked.

2. The Applicant's application for the registration of T.M.A No. 111471 “**钉钉**” in classes 9, 35, 38, 41, 42, 44 and 45 of the International Classification of Goods and Services is hereby allowed to proceed to publication in the Industrial Property Journal.

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 30th day of May 2024



.....

CONCILIA WERE

ASSISTANT REGISTRAR OF TRADE MARKS