

KENYA INDUSTRIAL PROPERTY INSTITUTE



KIPi Centre, Lavington, Along Kabarsiran Avenue,
Off Waiyaki Way
P.O. Box 51648-00200, Nairobi.
Tel: 020-6002210/11 6006326/29/36 2386220
Mobile: 0702 002020, 0736 002020
E-mail: info@kipi.go.ke
Facebook: @kipikenya, Twitter: @kipikenya
www.kipi.go.ke

REPUBLIC OF KENYA
IN THE MATTER OF THE TRADE MARKS ACT, CAP 506 OF THE LAWS OF
KENYA
AND
IN THE MATTER OF T.M.A. NO. 111293 IN THE
NAME OF DIAGEO IRELAND

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

BACKGROUND

On 2nd March 2020, Diageo Ireland (hereinafter referred to as “the Applicant”) filed



an application to register the mark T.M.A No. 111293. The application was filed in respect to goods in class 32 of the International Classification of Goods and Services as follows:

Class 32: Beer; porter; ale; lager; stout; non-alcoholic beverages.

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 28th May 2020, the Trade Marks Examiner issued a refusal notice indicating that the application had been refused registration on the grounds that it lacks essential elements as provided for under Section 12 (a, b, c, and d) of the Trade Marks Act.

On 6th November, 2020, the Applicant filed written submissions against the refusal to register their mark.

1. That it appears that the Proposed mark has been refused on absolute grounds in terms of Section 12 (a, b, c and d) of the Trade Marks Act.
2. The Refusal Notice does not specify the paragraph of Section 12 of the Trade Marks Act, upon which the provisional refusal is based. The Examiner ought to have been specific with respect to the specific paragraph of s. 12 of which the Proposed Mark falls short. The Examiner ought to have substantiated the basis for the refusal. With this kind of background, it is therefore left to the Applicant to attempt to figure out the real reasons for the provisional refusal.
3. That the Trade Marks Act in Section 12 states that in order for a trade mark to be registered, it must possess a degree of distinctiveness with relation to the goods or services it denotes as originating from a particular entity.
4. That the Applicant's trade mark is a three-dimensional (3D) trade mark.
5. That the bottle that is the subject of the Proposed mark is stubby, and not slim as bottles generally used for beers in Kenya. The bottle is characterized by a wider finish, with a curved stubby short neck. This merges into stubby, prominent rounded shoulders that in turn merge with the broad body that finally joins the broad base. The appearance of the bottle is almost like two curvatures flowing and sitting on top of each other with the smaller circle on top. The small circle is just beneath the lid/cap of the bottle and the other at the shoulders.
6. That the lid is very shallow so that the circle is made more pronounced by comparison and contributes to the stubbier look. Because of the two circles, the neck of the bottle also has a pronounced rounded contour. This free flowing double circular design is deliberately made so that it distinguishes itself from other bottles in the trade and conventional shaped bottles.
7. Further, the contours and the stubbier girth is designed to provide consumers a more substantial and balanced hand feel and pronounced grip. They would facilitate consumer recall and the consumer sensory experience of holding such a bottle that this would be a markedly different experience than other standard bottles. The overall effect would be something that consumers would remember and distinguish it from the general trade. The shape and design of the bottle therefore differs significantly from other bottles

- ordinarily used for beers in Kenya that are generally slim.
8. That according to established EU case law, “a minimum degree of distinctive character is sufficient to render inapplicable the ground for refusal set out in Article 7(1) (b) of Regulation No 40/94”¹ [emphasis added]. Article 7(1) (b) relates to refusal on account of lack of distinctive character akin to Section 12 of the Trade Marks Act.
 9. That Article 7(1) (b) CTMR (akin to S. 12 Trade Marks Act) does not distinguish between different categories of trade marks in determining whether a trade mark is capable of distinguishing the goods or services of one undertaking from those of other undertakings.
 10. That for signs consisting of the shape of the goods themselves, no stricter criteria shall apply than for other marks.
 11. That as such, the distinctiveness of the Proposed mark must therefore be assessed in accordance with the long established and settled case law, that is:
 - i. by reference to the goods and services in respect of which registration has been applied for or in respect of the registration itself; and
 - ii. by reference to the relevant public’s perception of the mark.
 12. In terms of the goods and services Proposed Mark is sought to be protected in class 32 in respect of beer; porter; ale; lager; stout; non-alcoholic beverages.
 13. In terms of the relevant public, the proposed goods generally seek to target beer drinkers.
 14. That bottle shape registrations, which exist in a myriad of such marks, are considered proper subject matter of a trade mark registration in Kenya and in other countries;
 15. The Proposed mark clearly shows a bottle shape that is different from the norm; and
 16. That the bottle shape that is the subject of the Proposed mark has two almost circles sitting on top of each other. This peculiarity makes the Proposed mark unique and therefore registrable.
 17. That in terms of Article 15 of TRIPS “any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those

of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks” (Emphasis added). Implicit in this definition is that three dimensional marks are registrable.

18. That a number of 3-D trade marks have been registered in Kenya and subsist on the KIPI registry of trade marks.
19. That the Applicant does not rely on acquired distinctiveness through use but relies on inherent distinctiveness of the Proposed mark.
20. That it ought to be noted that the perception of the relevant public is not necessarily the same for a shape mark consisting of the appearance of the product itself or its packaging, as it is for a word mark, a figurative mark or a shape mark that does not have that appearance.
21. That the Proposed mark is sufficiently distinctive and capable of distinguishing the goods sold by the Applicant from the goods originating from different sources.
22. That according to the EUIPO Guidelines, in assessing the value of the goods, account may be taken of criteria such as the nature of the category of goods concerned, the artistic value of the shape or other characteristic in question, its dissimilarity from other shapes in common use on the market concerned, a substantial price difference compared with similar goods, and the development of a promotion strategy that focuses on accentuating the aesthetic characteristics of the product in question.
23. That additionally, for the examination of these trade marks, a case-by-case approach is necessary. In most of these cases, a proper examination will only be possible where there is evidence that the aesthetic value of the shape or other characteristic can, in its own right, determine the commercial value of the product and the consumer's choice to a large extent.
24. That the Examiner was in error in failing to give proper consideration as to whether there was any evidence that the aesthetic value of the shape or any other characteristic could determine the commercial value of the product and/or the consumer's choice. Without such evidence, the Examiner ought

to have accepted the Applicant's application for registration of the Proposed mark.

25. The Applicant submitted that the Applicant's Proposed Mark is sufficiently distinctive and ought to be accepted and registered as a 3-D trade mark as it is not just a common shape of a bottle but is sufficiently distinctive, in so far as consumers identify the source of the goods as originating from the Applicant and not any other entity.

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 the Applicant's mark has the essential elements for registration as provided for under Section 12 (a, b, c and d), is distinctive and therefore registrable as a trade mark.

Section 2(1) of the Trade Marks Act provides that:

"mark" includes a distinguishing guise, slogan, device, brand, heading, label, ticket, name, signature, word, letter or numeral or any combination thereof whether rendered in two-dimensional or **three-dimensional form** (emphasis mine). It is therefore not in doubt that a mark rendered in three dimensional form may qualify to be a trade mark. Trade marks serve to distinguish the goods or services of one undertaking from the other undertakings.

Rule 21 (4) of the Trade Marks Rules provides that an application for registration of a trade mark that is three dimensional shall include a statement to that effect. I note that the Applicant did not include a statement to that effect in its form TM 2. The Applicant has in its submissions indicated that the Proposed mark is a three dimensional mark.

Section 12(1) of the Trade Marks Act stipulates as follows:

"In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars—

- (a) the name of a company, individual or firm, represented in a special or particular manner;
- (b) the signature of the Applicant for registration or some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- (e) any other distinctive mark, but a name, signature or word or words, other than such as fall within the descriptions in paragraphs (a), (b), (c), and (d), shall not be registrable under this paragraph except upon evidence of its distinctiveness.”

Section 12 (2) of the Trade Marks Act provides that ‘distinctive’ means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connexion subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration and in relation to services means to distinguish services with the provision of which the proprietor is or may be connected in the course of business, from services the provision of which he is not so connected.

The primary function of a registered trade mark is that of an indicator of origin and hence acts a guarantee of the quality for the consumer. This view was set out in the case of ***Arsenal Football Club v. Matthew Reed (2003) CMLR 481*** in the following words:

“..... the essential function of a trade mark is to guarantee the identity of origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin.”

In the case of ***Koninklijke Philips Electronics v. Remington Products Ltd (2002)*** the ECJ stated that the distinctive character of a mark must be assessed in relation to the goods or services in respect of which registration is applied for. The ECJ also

stated that only marks having a distinctive character by their nature or by the use made of them are capable of distinguishing their goods from the goods of other undertakings and thereby capable of registration.

For the mark to be capable of being registered, it has to be distinctive. The Applicant's mark must be capable of distinguishing its goods from the goods of other undertaking(s) in the same trade. To be distinctive, a three-dimensional trade mark must be for a shape that "departs significantly from the norm or customs of the industry" as per the CJEU's decision in *Lindt (Chocoladefabriken Lindt & Sprüngli AG v. OHIM, Case C-98/11 P (CJEU May 24, 2012))*. This therefore means that if a three-dimensional trade mark does not differ sufficiently from the "norm," the idea is that it will be seen by consumers of the goods in question not as an indication of origin but rather as the product itself.

However, it is considered that even if a shape fails this test, it is possible to obtain a registration if it can be proven that the public has been educated to view the shape as a trade mark (i.e., that the shape has acquired distinctiveness as a result of the use made of it).

It has been stated in *Mag Instrument Inc. v OHIM (Shape of a Mag light) [2004] ECR I-9165* that:

"It must always be determined whether such a mark permits the average consumer of that product, who is reasonably well informed and reasonably observant and circumspect, to distinguish the product concerned from those of other undertakings without conducting an analytical examination and without paying particular attention."

Further, in *Mag Instrument Inc. v OHIM (Shape of a Mag light) [2004] ECR I-9165*, it is noted at paragraph 30 that:

"...The criteria for assessing the distinctive character of three-dimensional marks consisting of the shape of the product itself are no different from those applicable to other categories of trade mark. None the less, for the purpose of applying those criteria, the relevant public's perception is not necessarily the same in the case of a three-dimensional mark consisting of the shape of the product itself as it is in the case of a word or figurative mark consisting of a sign which is independent from the

appearance of the products it denotes. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element and it could therefore prove more difficult to establish distinctiveness in relation to such a three dimensional mark than in relation to a word or figurative mark”.

It is to be noted that the Applicant seeks to register its mark with respect to goods in class 32, namely: beer; porter; ale; lager; stout, non-alcoholic beverages. The Applicant submitted that the Proposed mark is not just a common shape of a bottle but is sufficiently distinctive, in so far as consumers identify the source of the goods are originating from the Applicant and not any other entity.

In the earlier indicated case of ***Mag Instrument Inc. v OHIM (Shape of a Mag light) [2004] ECR 1-9165, at paragraphs 31 and 32*** it was stated that:

“...the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character for the purposes of Article 7(1) (b) of Regulation No 40/94. Only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin, is not devoid of any distinctive character for the purposes of that provision (Emphasis mine).

It has been held in ***R J Lea Limited’s Application [1913] 1Ch 446***, Hamilton LJ said that:

“Further, the Act says ‘adapted to distinguish’, the mere proof or administration that a mark does in fact distinguish does not ipso facto compel the judge to deem that mark to be distinctive; it must be further ‘adapted to distinguish’ which brings within the purview of his discretion the wider field of the interests of strangers and of the public.”

In the submissions the Applicant had highlighted the fact that the Applicant does not rely on acquired distinctiveness through use but relies on inherent distinctiveness of the Proposed mark. It is my view that the Applicant’s mark is devoid of any distinctive

character for the purposes of Section 12 and does not serve the trade mark function. The Applicant's mark does not depart significantly from the norm or customs of the industry.

The registration of the Applicant's bottle design in Europe under the EUIPO system as evidenced by "Annex 6", in my view, can only be used as persuasive evidence and proves use of the mark in the European Union. I am guided by the Kenyan Trade Marks Act in making this decision.

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



1. That the Applicant's mark T.M.A No. 111293 lacks the essential elements for registration as required under Section 12 of the Trade Marks Act and is not distinctive.
2. The Trade Mark Examiner's refusal notice dated 28th May 2020 is hereby upheld.
3. The application shall not be allowed to proceed to publication in the Industrial Property Journal.

Ruling delivered at Nairobi this 27th day of June 2024

.....
CONCILIA WERE
ASSISTANT REGISTRAR OF TRADE MARKS