

KENYA INDUSTRIAL PROPERTY INSTITUTE



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REPUBLIC OF KENYA

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

AND

IN THE MATTER TRADE MARK APPLICATION NO. 113546 “PISTON HUSTLING SINCE 1978” (WORD & DEVICE) IN CLASS 25 IN THE NAME OF UMOJA RUBBER PRODUCTS

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

BACKGROUND

On 27th August 2020, Umoja Rubber Products Limited (hereinafter referred to as “the



Applicant”) filed an application to register the mark (word & device), T.M.A No. 113546. The application was filed in respect to goods in class 25 of the International Classification of Goods and Services covering footwear.

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 9th December 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. 97193

(word & device) (hereinafter referred to as the Cited Mark) in classes 25 and 41 in the name of NBA PROPERTIES INC, existing in the Trade Marks Register.

On 14th January 2021, the Applicant filed written submissions in response to the Examiner's refusal notice stating inter alia as follows:

1. That the 2 marks are visually, phonetically, and conceptually different. While the Cited Mark has "DETROIT" in addition to "PISTONS", the Applicant's mark has "HUSTLING SINCE 1978" alongside the word "PISTON". The logos are also different and distinctive, to the extent that black is the dominant color in the Applicant's mark and the words are in white, while in the Cited Mark the logo is largely white with the words and lines in black. The oval shape inside the circle in the Cited Mark is also a distinguishing feature. Based on this, the average consumer is unlikely to be confused or deceived by the two marks.
2. That courts have upheld the need to consider the overall impression created by trade marks in many cases. In emphasizing on the need for considering the overall impression of a mark, the Applicant's advocates relied on leading authorities that were adopted by the court in ***Mabati Rolling Mills Limited v. Royal Mabati Factory Limited (2020) eKLR, the court adopted leading authorities on the subject as follows:- Sabel BV v. Puma AG, Rudolf Dassler Sport, Case C-251/95 and Amritdhara Pharmacy v. Satya Deo Guptaar 1963 Sc 449.***

In *Amritdhara Pharamcy v. Satya Deo Guptaar 1963 Sc 449* the court held that, "The question whether a trademark is likely to deceive or cause confusion by its resemblance to another already registered is a matter of first impression and one for decision in each case and has to be decided by taking an overall view of all the circumstances. The standard of comparison to be adopted in judging the

resemblance is from the point of view of a man of average intelligence and imperfect recollection.”

3. That it is not unusual for trade marks to share certain common elements but this does not necessarily make them similar. It would not be appropriate to ignore the fact that the Cited Mark is protected as “DETROIT PISTONS” or that the Applicant’s mark includes additional distinguishing elements like “HUSTLING SINCE 1978”. The Applicant relied on the case of ***Unilever PLC v. Bidco Oil Industries (2004)*** eKLR where the court held that, *“The trade mark which is registered in the name of the plaintiff and which must be protected is “Blue Band” and not “Band”. The word Band on its own is not protected and is not a trade mark. It is the combination of the words “Blue Band” that is a trade mark. That being so, can there be a property in the word “Band” capable of being protected. In my mind the answer must be no. The trade mark which can be infringed is “Blue Band” and not the word Band. I also hold that there is no satisfactory proof that the same words “Gold Band” or “Bidco Gold Band” so nearly resemble the registered trade mark of the Plaintiff’s products as to be likely to deceive or cause confusion in the minds of the public”.*
4. That it would be unfair to deny the Applicant the right to register its mark when no prejudice is likely to be suffered by the owner of the Cited Mark should the Applicant’s mark be allowed to proceed to advertisement and registration. In any case, if the owner of the Cited Mark is aggrieved by the Applicant’s application it will have the opportunity to oppose the application when it is advertised in the KIPJ Journal. It is premature to refuse the Applicant’s application at this stage when the owner of the Cited Mark may, as a matter of fact, have no objection to its registration.

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

(word & device), is so similar to



the cited mark TM No. 97193

(word & device) as to cause a

likelihood of confusion contrary to the provisions of Sections 14 and 15(1) of the Trade Marks Act.

Section 14 of the Trade Marks Act provides as follows:

“No person shall register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.”

Section 15 (1) of the Trade Marks 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 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 of similarity, I shall consider the following factors;

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

Parker J in *Re Pianotist Co.'s Application*, (1906) 23 RPC 774 case stated as follows:

“You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.”

1) The similarity between the marks in appearance

In making a determination on the issue of similarity of 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.

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:

¹ (1898)15 RPC 141 at 146

² (1999) ECR I-3819

³ Rudolf Dassler Sport [1998] RPC 199 at 224

“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”.

In considering the Applicant’s mark and the cited mark, there are outstanding points of visual similarities and differences. There is an identical word in both marks being “PISTON”. However, the word “PISTON” in the Applicant’s mark is stylized differently from that in the Cited Mark. In addition, the word “PISTON” in the Cited Mark has an “S” at the end making it “PISTONS” in full. In the Applicant’s mark, there are additional words “HUSTLING SINCE 1978”, and the word “DETROIT” in the Cited Mark. Both marks have a circle but the backgrounds within the circles are different.

In considering the phonetic similarity, I am of the view that only the word “PISTON” would be pronounced in the same way. As a whole, the pronunciation given to the two marks is not similar.

2) The similarity of goods and services

In *Jellinek’s Application*⁴, 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

⁴ (1946) 63 RPC 59 at 70

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.”

In **Scandercor Developments AB v. Scandecor Marketing AV & 1 other action (2001) UKHL 21**, the court held in part that, *“A trade mark is a badge of origin or source, and that a trade mark plays the role of distinguishing goods originating from one business entity from all other business sources”*.

In this case, the Applicant seeks to register its mark in respect goods in class 25 of the International Classification of Goods and Services. On the other hand, the Cited Mark is registered in respect to goods and services in classes 25 and 41 of the International Classification of Goods and Services. It is clear that the specification of the Applicant’s and the Cited Mark’s goods in class 25 as far as footwear is concerned are identical.

Likelihood of Confusion

Section 14 of the Trade Marks Act provides as follows:

“No person shall register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.”

In the case of ***Sabel vs. Puma AG*** the ECJ said in part that:

“...The likelihood of confusion must be appreciated globally taking into account all factors relevant to the circumstances of the case... That global appreciation of the visual, aural or conceptual similarity of the marks in question must be based upon the overall impression given by the marks bearing in mind in particular their distinctive and dominant components...”

In the case of ***Reed Executive PLC v Reed Business Information Ltd***⁵ the court stated that the person to be considered is the ordinary consumer who is neither too careful nor too careless, but is reasonably circumspect, well informed and observant. An allowance for defective recollection must be considered and this varies depending on the goods concerned.

In Reckitt & Colman SA (PTY) Ltd vs. SC. Johnson & Son SA⁶ it was stated that, “a rule of long standing requires that a class of persons who are likely to be the purchasers of goods in question must be taken into account in determining whether there is a likelihood of confusion or deception”.

This was also reiterated in ***Australian Woolen Mills Ltd vs. F.S. Walton & Co. Ltd***⁷ that the relevant person is the average consumer and the usual manner in which the consumer would behave in the market place should be “the test of what confusion or deception may be expected.”

Based on the analysis made on the similarity of the marks in appearance, similarity of the goods, consumers of the said goods and services and other facts considered in the

⁵ (2004)

⁶ (PTY) Ltd (1993)

⁷ (1937)

case, it is my view that there would be no likelihood of confusion if both marks were allowed to co-exist in the market.

DECISION

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

- a) The Trade Marks Examiner's refusal notice dated 9th December, 2020 is hereby revoked; and
- b) The Applicant's application for registration of the mark T.M.A No. 113546



is hereby allowed to proceed to publication in the Industrial Property Journal in respect to goods in class 25 of the International Classification of Goods and Services.

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 11th day of July 2024

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CONCILIA WERE

ASSISTANT REGISTRAR OF TRADE MARKS