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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. 117710 COLDRIL (WORD) IN THE

NAME OF SHELYS PHARMACEUTICALS LIMITED

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

BACKGROUND

On 9th June 2021, Shelys Pharmaceuticals Limited (hereinafter referred to as “the Applicant”) filed an application to register the mark “COLDRIL” (word), T.M.A No. 117710. The application was filed in respect to goods in class 5 of the International Classification of Goods and Services as follows:

Pharmaceutical preparations and substances.

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 29th July 2021, 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:

T.M. No. 60087 “COLDRID” (word & device) in class 5 in the name of Medley Pharmaceuticals Ltd.

On 19th October 2021, the Applicant filed written submissions in response to the Examiner’s refusal notice stating inter alia that although some similarities exist in the sense that both trade marks incorporate the element “COLD”, trade marks must, for the purpose of assessing confusion be perceived and viewed as whole,

and regard must be as to whether similarities, if any, are of a confusing nature. The Applicant's proposed mark and the Cited trade mark are visually, phonetically and conceptually dissimilar when viewed as a whole and in their entirety considering the differences in the suffix "RID" for the Cited mark on the one hand and "RIL" for the Applicant's proposed trade mark on the other hand.

That there is a disclaimer endorsement to the right to exclusive use of the word "COLD" in respect of the Cited mark. As such, the disclaimed element should not form a basis for the refusal of the Applicant's proposed mark.

In addition, that the Applicant has been making use of the proposed mark since 2005 which is before the entitlement date of the Cited mark being 1st November, 2006. The Applicant submitted that on the basis of its prior use of the proposed mark, the Applicant is entitled to the registration of the proposed mark in terms of Section 10(b) of the Trade Marks Act. That the Applicant for over a period of twenty (20) years, has been making use of the proposed mark in its packaging and has been obtaining revenue from the same, this is without a single reported instance of confusion.

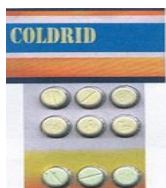
That the Applicant's mark and the Cited mark are capable of co-existence on the trade marks register and in the trade and requested the Registrar to waive its provisional refusal and accept the Applicant's trade mark for registration.

I have studied the documents on record and considered the Applicant's submissions against the Examiner's refusal notice.

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."

In considering the two marks, the Applicant's mark is "COLDRIL" (word) while the



Cited mark is (word & device).

On visual similarity, it is apparent that there is an identical word "COLD" in both the Applicant's mark "COLDRIL" and in the Cited mark, "COLDRID". The Applicant's mark also incorporates the letters "RIL" after the word "COLD". On the other hand, the Cited mark incorporates the letters "RID" after the word "COLD" and in addition incorporates the colours black, orange, white, blue and yellow together with devices of tablets. It is evident that the marks have both points of similarity and differences.

In the Indian case of *Glaxo Group Ltd. And Anr. v. Neon Laboratories Ltd [2004] F.S.R. 46 (HC)*, the Judge stated as follows:

"Judging the marks as a matter of first impression and applying the test of an ordinary person with average intelligence and an imperfect recollection the case must be answered in the plaintiff's favor. There is a very high possibility of a mispronunciation leading a person to mistake one mark for the other. A perfect pronunciation, a clear enunciation of the words may indicate the difference. But words such as these are not always so pronounced. Moreover, it is useful to mention, as has been noticed in several decisions, that words tend not to be properly enunciated and in particular the ending of words is often slurred. Even if either of the marks is pronounced correctly there is an equally high possibility of the person hearing the same to mistake one for the other."

As relates to the phonetic similarity, I am of the view that since words tend not to be properly enunciated and in particular, the ending of words is often slurred, it is not remote that the two marks may be pronounced in a similar way.

The Applicant proposes to register its mark in respect to Pharmaceutical preparations and substances. The Cited mark on the other hand is registered in

respect to Pharmaceuticals. In considering the aspect of similarity of goods and making a comparison between the Applicant's and the Cited mark's goods in class 5, the Applicant's goods are in my view, similar to those of the Cited mark. The specification relating to the Cited mark is a broad specification that covers the goods that the Applicant seeks to register. The goods are of the same description and in most instances are sold through the same trade channels.

In *Cadila Healthcare Ltd. V. Cadila Pharmaceuticals, 2001 (2) PTC 541 SC*, the court observed that confusion between medicinal products can be life threatening, and also emphasized the necessity for stricter standards in matters involving pharmaceutical products. The Court also made the important observations in this regard that physicians and pharmacists are trained people, yet they are not infallible, and doctors are under tremendous pressure placed by society and thus, there should be clear indicators for distinguishing medical products; that even if the drugs in dispute belong to 'Schedule L' which are directly sold to the hospitals or clinics, the possibility of creation of confusion between both the drugs cannot be dispensed with even though it is prescribed by a medical practitioner. Moreover, purchasers of goods may not have knowledge of English or the language in which the trademark is written, and slight differences in spellings of different words may sound phonetically the same.

The Applicant also submitted that their products are intended to be sold on a prescription basis and hence there would be no likelihood of confusion. The Applicant further argued that on the basis of its prior use of the proposed mark, the parties' marks can co-exist on the Trade Marks Register.

I have considered the evidence of use adduced by the Applicant and the statistics on sales made by the Applicant for the duration between the year 2015 and 2021 which has the effect of showing that the Applicant has prior rights based on prior use that need to be considered. However, I wish to note that Annexure D which consists of Registration of Drugs Certificates, one for the Coldril Syrup and another for Coldril Capsules, had a date of registration being 9th June 2005 and expiry being 9th June 2010.

The Registrar of Trade Marks in the matter of an application to the Registrar *TMA*

No. 57652 Maxime in class 5 in the name of Lords Healthcare Limited and Opposition thereto by Bristol Myers Squibb Company stated that:

“The Pharmacy and Poisons Board acts as a watchdog and has a regulatory role to ensure that all the medicines and poisons imported, manufactured, distributed, sold, possessed or purchased in Kenya are vetted and are fit for human consumption.....A license under the Pharmacy and Poisons Act does not confer intellectual property rights in any way to the license holder.”

It is therefore apparent that having a license under the Pharmacy and Poisons Act does not confer Intellectual Property rights on the holder of the license.

From the records at the Registry of trade marks, there are other registered marks consisting of the word “COLD” registered in class 5 including T.M. 47778 “COLDTAB”, T.M.121247 “COLDACT” and T.M. 86065 “COLD FREE”.

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

1. The Trade Mark Examiner’s Refusal Notice dated 29th July 2021 (in respect to the mark “COLDRIL” (word), T.M.A No. 117710, in class 5 of the International Classification of Goods and Services) is hereby revoked; and
2. The Applicant’s application for registration of the mark “COLDRIL” (word), T.M.A No. 117710 in class 5 of the International Classification of Goods and Services shall be 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 26th day of June 2024



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CONCILIA WERE
ASSISTANT REGISTRAR OF TRADE MARKS