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

AND


**IN THE MATTER OF TRADE MARK APPLICATION NO. 118397 “TRUEMPOWER”
(WORD) IN CLASSES 35,36,42 AND 45 IN THE NAME OF TRANS UNION LLC**

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

BACKGROUND

On 26th July 2021, Trans Union LLC (hereinafter referred to as “the Applicant”) filed an application to register the mark “TRUEMPOWER” (word), T.M.A No. 118397. The application was filed in respect to services in classes 35, 36, 42 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 14th January 2022, 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.A. No. 79760  (word & device) in classes 9, 36, 38, 41 and 42 in the name of Roamtech Solutions Limited.

On 31st January 2022, the Applicant filed written submissions in response to the Examiner’s refusal notice stating inter alia as follows:

1. That there are obvious visual and phonetic differences between the cited trade


mark and the Applicant's trade mark. The differences include:

- a) The Applicant's trade mark is a word mark while the cited trade mark is stylized;
 - b) The Applicant's trade mark begins with the prefix "TRUE" while the cited trade mark begins in the letter "m"; which is not only visually but also phonetically dissimilar to the cited trade mark.
2. That the two trade marks are not conceptually similar because to consumers in Kenya, the word "TRUEMPower" has no particular meaning in relation to the services covered by the Applicant's trade mark.
 3. That the proprietor of the cited trade mark disclaimed the right to the exclusive use of the word "POWER" separately and apart from its trade mark as a whole and therefore, the word is not exclusively registered for use by the proprietor of the cited mark.
 4. That when applied to the Applicant's services, the word "POWER" is arbitrary. Additionally, when applied to the Applicant's services, the word "POWER" adopts an incongruous meaning when combined with the prefix "TRUEM" because the words do not normally collocate in normal English speech patterns and do not have a particular meaning when combined.
 5. That the services covered by the Applicant's trade mark in classes 35 and 45 are not similar to or in any way related to the goods and services covered under classes 09, 38 and 41 of the cited trade mark. As regards the services covered by the Applicant's trade mark in classes 36 and 42, that the services are capable of being differentiated from those covered by the cited trade mark in the same classes since as stated above, the services intended to be covered by the Applicant's trade mark in those classes specifically relate to monitoring consumer credit reports and providing related services.

6. That without prejudice to any other arguments made herein, any similarity between the goods and services intended to be covered by the Applicant's trade mark and the cited trade mark is offset by the substantial visual and phonetic differences.
7. That the average consumer of the services, such as those covered under the Applicant's trade mark, is reasonably circumspect, well informed and observant because of the nature of the services.
8. That based on a global appreciation of the visual and phonetic aspects of the trade marks, the differences between the goods/services covered by the trade marks and the nature and kind of consumer of the goods and services in question, the Registrar should therefore compare and analyze the trade marks as a whole in the same way that an average consumer would perceive the marks rather than highlight and focus on one common element in the trade marks as a basis for concluding that the Applicant's trade mark and the cited trade mark are similar.

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 "TRUEMPOWER" (word) is so similar to the cited mark

T.M. 79760  (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, 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

¹ (1898)15 RPC 141 at 146

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 analyse the Applicant’s mark and the cited mark to determine whether they are similar in terms of their appearance. In considering the Applicant’s mark and the cited mark, the Applicants mark is “TRUEMPOWER” (word) while the cited mark is



(word and device). Looking at the aspect of visual similarity, I am

of the view that there are both points of similarity and differences in both marks. The word “TRUE” is only present in the Applicant’s mark. The word “MPOWER” in the Applicant’s mark is indicated in capital letters while in the cited mark it is indicated in small letters. The visual similarity is reduced by the fact that the cited mark’s “



is stylized especially with respect to the “O” element. Looking at

² (1999) ECR I-3819

³ Rudolf Dassler Sport [1998] RPC 199 at 224

the marks as a whole, I am of the view that the two marks are not visually similar. In considering the phonetic similarity relating to the Applicant's mark and the cited mark, I am of the view that the two marks when pronounced, are not similar. In looking at the aspect of conceptual similarity, I am of the opinion that the Applicant's mark and the cited mark are conceptually not similar.

2) The similarity of the goods/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 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

⁴ (1946) 63 RPC 59 at 70

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 this case, the Applicant seeks to register its mark in respect services in classes 35, 36, 42 and 45 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 9, 36, 38, 41 and 42 of the International Classification of Goods and Services.

The Applicant’s services in classes 35 and 45 and the cited mark’s goods and services in classes 9, 38 and 41 are different. As relates to class 36, the specification of services relating to the cited mark is a broad specification that may cover some of the services that are proposed to be registered by the Applicant. Similarly, as relates to class 42, the scope of the specification of some services relating to the cited mark, may cover some services that the Applicant seeks to register. The Applicant has clarified that its services specifically apply to monitoring consumer credit reports and providing related services.

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.”

The Applicant submitted that without prejudice to any other arguments made herein, any similarity between the goods and services intended to be covered by the Applicant’s trade mark and the cited trade mark is offset by the substantial visual and phonetic differences. They further argued that the average consumer of the services, such as those covered under the Applicant’s trade mark, is reasonably circumspect,

⁵ (2004)

⁶ (PTY) Ltd (1993)

⁷ (1937)

well informed and observant because of the nature of the services.

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 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 14th January, 2022 is hereby revoked; and
- b) The Applicant's application for registration of the mark **T.M.A No. 118397 "TRUEMPOWER" (WORD)** is hereby allowed to proceed to publication in the Industrial Property Journal in respect to services in classes 35, 36, 42 and 45 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 28th day of June 2024



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CONCILIA WERE

ASSISTANT REGISTRAR OF TRADE MARKS