

# KENYA INDUSTRIAL PROPERTY INSTITUTE



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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 TRADE MARK APPLICATION NO. 118498

### “CIPLADON” (WORD) IN CLASS 5 IN THE NAME OF CIPLA LIMITED

### EX-PARTE RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

#### BACKGROUND

On 30<sup>th</sup> July 2021, Cipla Limited (hereinafter referred to as “the Applicant”) filed an application to register the mark “CIPLADON” (word), T.M.A No. 118498. The application was filed in respect to goods in class 5 of the International Classification of Goods and Services as follows:

Pharmaceuticals, medical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for human beings and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

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 5<sup>th</sup> November 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. 68703 “CIPLADINE” (word) in class 5 in the name of Lords Healthcare Ltd.**

On 30<sup>th</sup> May 2022, the Applicant filed written submissions in response to the Examiner's refusal notice stating inter alia as follows:

That the mark for which registration has been applied under T.M.A. No. 118498 "CIPLADON" is a unique word. That in order for the Registrar to properly test the similarity of the two marks, the Applicant's mark and the existing mark must be compared as a whole. If both marks are compared and judged by their appearance and the different stylizations taken into account, it will be noted and appreciated that the two marks are not sufficiently similar for any confusion of the public to be likely to arise when the two marks are used in trade for the specific services covered under the specification.

The Applicant submitted that when the two marks are compared as a whole from their visual appearance, there is no close visual similarity between the two marks and hence no confusion of the public will result from the co-existence of the two marks on the Kenya trade marks Register or their use on the goods covered by their respective specifications.

In addition, that the goods for which the Applicant's mark is proposed to be used being medicines are the kind which require a high degree of circumspection and caution and must therefore be selected with deliberation. Furthermore, the kinds of customers who are likely to purchase the goods covered by the Applicant's mark are well informed customers who ordinarily take care when making purchases. That this diminishes the likelihood of confusion or deception of the public.

The Applicant prayed that the application be allowed to proceed to publication in the Industrial Property Journal.

## **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 "CIPLADON" (word) so similar to the cited mark**

**“CIPLADINE” (word) 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.”

In *Arsenal Football Club v. Matthew Reed*<sup>1</sup> the following was stated:

“..... 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 *ECJ case of Canon Kabushiki v. Metro-Goldwyn-Mayer Inc.*<sup>2</sup> the Court stated that:

“...For the trade mark to be able to fulfil its essential role....it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality.”

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<sup>1</sup> (2003) CMLR 481

<sup>2</sup> (1999) RPC 117

To enable me determine the issue of similarity under the above-mentioned provision of Section 15(1) of the Trade Marks Act, I shall address my mind to the following factors:

- a) The similarity of the marks in appearance; and
- b) The similarity of the goods.

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 as used in a normal way as a trade mark for the goods of the respective owners of the marks.”

**a) Similarity of the marks in appearance**

In determining the issue of similarity of the marks in appearance, it is important to consider that the marks should be compared in their entirety. The overall or net impression of the two marks should be highly regarded.

In *Clarke v Sharp*<sup>3</sup> 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*<sup>4</sup> 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

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<sup>3</sup> (1898) 15 RPC 141 at 146

<sup>4</sup> (1999) ECR I-3819

informed, reasonably observant and circumspect.”

In *Sabel BV v Puma AG*<sup>5</sup>, 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”.

The Applicant seeks to register the mark “CIPLADON” (word). The cited mark on the other hand is “CIPLADINE” (word). There are identical letters in both marks being “CIPLA”. There are also notable differences in the two words being “DON” in the Applicants mark and “DINE” in the cited mark. In considering visual similarity, I am of the view that the marks compared as a whole, are not visually similar. On phonetic similarity, I am of the opinion that the pronunciation given to both marks is different.

I wish to note that there are other marks in the Register of Trade Marks with the word “CIPLA” such as T.M. 76842 “CIPLA” in international class 5 in the name of Cipla-Medro (PTY) Limited and T.M. 81480 “CIPLACEF” in international class 5 in the name of Cipla Kenya Limited.

#### **b) the similarity of the goods**

In *Jellinek’s Application*<sup>6</sup>, 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 (2<sup>nd</sup>

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<sup>5</sup> Rudolf Dassler Sport [1998] RPC 199 at 224

<sup>6</sup> (1946) 63 RPC 59 at 70

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.”

The Applicant proposes to register its mark in respect to goods in class 5 of the International Classification of Goods and Services. The cited mark on the other hand has also been registered in respect to goods in class 5 of the International Classification of Goods and Services.

The Applicant's application relates to the following goods:

Class 5: Pharmaceuticals, medical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for human beings and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

The cited mark on the other hand relates to goods as follows:

Class 5: Pharmaceuticals and other preparations for medical purposes.

In 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 of goods relating to the cited mark being pharmaceuticals and other preparations for medical purposes is a broad specification that covers most of the goods that the Applicant seeks to register in class 5.

In the Book Kerly's Laws of Trade, 14<sup>th</sup> Edition, paragraph 17-018, under the sub title "Standard of Care to be Expected", the learned author states that: "Consumers' attention varies depending on the particular goods that are in consideration... Where some elements of the mark are common, consideration should be as to whether or not the respective consumers would be in a position to distinguish between the marks."

In the case of *The Registrar of Trade Marks v Woolworths limited [1999] FCA 1020*, the Court stated that in determining the degree of care likely to be exercised by customers, the circumstances in which the respective marks are used, the goods or services are bought and sold and the character of the respective purchasers of the goods or services should all be considered.

### **Likelihood of Confusion**

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*<sup>7</sup> 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 SA*<sup>8</sup> 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”.

In *Australian Woolen Mills Ltd vs. F.S. Walton & Co. Ltd*<sup>9</sup>, it was indicated 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.”

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.

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<sup>7</sup> (2004)

<sup>8</sup> (PTY) Ltd (1993)

<sup>9</sup> (1937)



Based on the analysis made on the similarity of the marks in appearance, similarity of the goods, the consumers of the goods 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.

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 5<sup>th</sup> November 2021 (in respect to the mark "CIPLADON" (word), T.M.A No. 118498, 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 "CIPLADON" (word), T.M.A No. 118498 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 2<sup>nd</sup> day of July 2024**



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**CONCILIA WERE**  
**ASSISTANT REGISTRAR OF TRADE MARKS**