

# 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 T.M.A. No. 120927 IN THE NAME OF IP HOLDINGS UNLTD LLC

## RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

### BACKGROUND

On 18<sup>th</sup> January 2022, IP Holdings Unltd LLC, (hereinafter referred to as “the



Applicant”) filed an application to register the mark, T.M.A No. 120927.

The application was filed in respect to goods in classes 18 and 25 of the International Classification of Goods and Services as follows:

- Class 18: Backpacks; carry-on bags; clutch bags; duffel bags; gym bags; overnight bags; school bags, shoulder bags, rucksacks, satchels and wallets.
- Class 25: Jerseys, sweatshirts, tops, vests, shirts, polo shirts, t-shirts, tracksuits, pants, outerwear, jackets, trousers, shorts, undergarments, knitwear, socks, headwear and 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 letter dated 24<sup>th</sup> May 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:



**TM No. 94615** in classes 18 and 25 in the name of Red Rhino Traders, existing on the Register of Trade Marks since 1<sup>st</sup> November 2016.

On 17<sup>th</sup> August 2022, the Applicant filed written submissions against the Trade Marks Examiner's refusal notice indicating inter alia that the Refusal notice should be withdrawn and the proposed mark allowed to proceed to advertisement and then registration. That the Applicant's mark and the cited mark should be capable of co-existing on the Register of trade marks and in the marketplace without any confusion. That the Applicant has concurrently used the Proposed mark in the course of trade in the Kenyan market and has in no way prejudiced the Registered proprietor in its use of the cited mark.

### **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:



Whether the Applicant's mark T.M.A. 120927, is so similar to the cited



mark T.M.94615, so as to cause a likelihood of confusion contrary to the provisions of Sections 14 and 15(1) of the Trade Marks Act.

## ANALYSIS OF THE ISSUE

Section 14 of the Trade Marks Act provides that:

*“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 Mark 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 nearly 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.”*

The Applicant in its submissions indicated that the Applicant’s mark and the cited mark are not confusingly similar. That there could be a degree of similarity between the two marks in that both marks comprise the likeness of a rhino, albeit with slight differences. The Applicant submitted that the proposed mark contains a different background and overall colour scheme. That the proposed mark does not contain any “RED” or “RHINO”. That the proposed mark is set against a white backdrop and that the rhino likeness in the proposed mark is surrounded by an oval black ring that encircles the image of the black rhino likeness.

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.”

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 or services.

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

In determining the issue of similarity of the marks in appearance, it is critical 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,

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

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

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

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 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”.

Parker J in *Re Pianotist Co.’s Application*<sup>6</sup> 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.”

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

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

<sup>6</sup> (1906) 23 RPC 774

In considering the Applicants mark and the cited mark, the Applicants mark is



(device) while the cited mark is



(word and device).

Having considered the Applicant's mark and the cited mark as relates to the visual similarity, I am of the view that looking at the marks as a whole, the marks are visually not similar.

In the cited mark, there are also some words, "RedRhino Furaha ya Wananchi" which are not present in the Applicant's mark.

#### b) The similarity of goods

In *Jellinek's Application*<sup>7</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> 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

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<sup>7</sup> (1946) 63 RPC 59 at 70

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 services in classes 18 and 25 of the International Classification of Goods and Services. The cited mark on the other hand has also been registered in respect to goods and services in classes 18 and 25 of the International Classification of Goods and Services.

The Applicant's application relates to the following goods:

- Class 18: Backpacks; carry-on bags; clutch bags; duffel bags; gym bags; overnight bags; school bags, shoulder bags, rucksacks, satchels and wallets.
- Class 25: Jerseys, sweatshirts, tops, vests, shirts, polo shirts, t-shirts, tracksuits, pants, outerwear, jackets, trousers, shorts, undergarments, knitwear, socks, headwear and footwear.

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

- Class 18: Leather and imitations of leather; trunks and travelling bags; handbags.
- Class 25: Clothing, footwear, headgear.

In Kerly's Law of Trade Marks and Trade Names 12<sup>th</sup> Edition, at paragraph 10-12, the test whether or not goods or services are "of the same description" would seem to be supplied by the question - Are the two sets so commonly dealt in by the same trade that his customers, knowing his mark in connection with one set and seeing it used in relation to the other, would be likely to suppose that it was so used also to indicate that they were his? That the matter should be looked at from a business and commercial point of view.

The Applicant submitted that the Applicant's goods of interest are clearly distinguishable from the goods covered by the cited mark. That the goods are not in competition and they target different consumers and are by their nature quite different.

As relates to the Applicant's goods in class 18 in comparison to the cited mark's goods in class 18, I am of the view that some goods are similar.

As relates to the Applicant's goods in class 25 in comparison to the cited mark's goods in class 25, I am of the view that the cited mark's specification of goods is broad and covers the goods which the Applicant seeks to register. In my opinion, the goods are similar.

### **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>8</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>9</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”.

This was also reiterated in *Australian Woolen Mills Ltd vs. F.S. Walton & Co. Ltd*<sup>10</sup> 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 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:

1. The Trade Marks Examiner’s refusal notice dated 24<sup>th</sup> May 2022 is hereby revoked;  
and

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<sup>8</sup> (2004)

<sup>9</sup> (PTY) Ltd (1993)

<sup>10</sup> (1937)



2. The Applicant's application for registration of the mark T.M.A No. 120927 shall proceed to publication in the Industrial Property Journal in respect to classes 18 and 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 28<sup>th</sup> day of June 2024**

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**CONCILIA WERE**

**ASSISTANT REGISTRAR OF TRADE MARKS**