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

AND

**IN THE MATTER OF TRADE MARK APPLICATION NO. 119119, “MEMBER’S MARK”
(WORD) IN THE NAME OF WALMART APOLLO, LLC**

EX-PARTE RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

PROCEDURAL BACKGROUND

On 8th September 2021, Walmart Apollo, LLC, (hereinafter referred to as “the Applicant”) filed an application to register the mark “MEMBER’S MARK”, T.M.A No. 119119. The application was filed in respect to Goods in classes 29, 30 and 32 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 6th July 2022, the Trade Marks Examiner requested the Applicant to disclaim the right to the exclusive use of the word “MARK” separately and apart from the mark as a whole before the same could be allowed to proceed to publication.

Through a letter dated 3rd October 2022, the Applicant filed written submissions in response to the Examiner’s disclaimer request stating inter alia as follows:

- a. **THAT** based on the many definitions of the word “MARK”, it cannot be said with certainty that the word is being used in a descriptive or laudatory manner.
- b. **THAT** the word “MARK” is in no way descriptive of “meat, fish, poultry and game” (class 29), coffee, tea, cocoa, and artificial coffee” (class 30), or

“beers; non-alcoholic beverages; mineral and aerated waters” (class 32), and neither is it descriptive of the characteristic of these goods.

- c. **THAT** when considering the meaning of the word “MARK”, it is apparent that the word “MARK” does not describe the type, character, or quality of the goods, and there is no factual or objective relationship between this word and the goods covered by the application.
- d. **THAT** the imposition of a disclaimer of the word “MARK” for the Applicant’s goods is not justified.
- e. **THAT** there is insufficient cause for the disclaimer given that Section 17(b) of the Trade Marks Act states that a disclaimer may be entered against a trade mark which incorporates “matter common to the trade... or otherwise of a non-distinctive character”.
- f. **THAT** a disclaimer entered in respect of this application could encourage third parties to adopt components of the mark in an attempt to take advantage of the considerable goodwill established by the Applicant and throughout the world in respect of their brand and products.
- g. **THAT** the mark has been examined in numerous examining offices worldwide, and that those offices have deemed the mark to be duly registrable without the need for disclaimers of “MARK”.

RULING

I have studied the documents on record and considered the Applicant’s written submissions against the Examiner’s disclaimer request. The Examiner had in the examination report dated 6th July 2022 requested the Applicant to disclaim the right to the exclusive use of the word “MARK” separately and apart from the mark as a whole.

I am therefore of the view that the issue for determination is whether the Applicant’s mark should proceed to publication in the Industrial Property Journal with or without a disclaimer of the word “MARK” separately and apart from the mark as a whole.

The Registrar of Trade Marks is empowered under Section 17 of the Trade Marks Act to require a proprietor of a trade mark to make such a disclaimer as the Registrar

may consider necessary for the purposes of defusing the rights of such a proprietor under registration. The Section provides two particular circumstances when the Registrar may hold the proprietor not to be entitled to the exclusive rights that registration would otherwise confer upon him. These are:

If a trade mark-

- a) Contains any part not separately registered by the proprietor as a trade mark;
or
- b) Contains matters common to the trade or to the provision of services of that description or otherwise of a non- distinctive character.

The Supreme Court, in The Registrar of Trade Marks vs Ashok Chandra Rakhit Ltd on 15 April, 1955 stated that “real purpose of requiring a disclaimer is to define the rights of the proprietor under the registration so as to minimize, even if it cannot wholly eliminate, the possibility of extravagant and unauthorized claims being made on the score of registration of the trade marks”.

In *Paco Holdings Ltd and opposition thereto by Paco Rabanne Parfums [1999]*, the Registrar’s Principal Hearing Officer was of the view that the entry of the disclaimer should be regarded as an admission by the proprietor that the disclaimed matter is not to be regarded distinctive as in itself, of the trade origin of the proprietor’s goods or services.

Page 62 of the KIPI Trade Marks Manual of Examination Procedures states that the purpose of a disclaimer is to prevent proprietors of a mark to claim exclusive rights to the parts of marks that are non-distinctive or common to the particular trade.

In the *Australian Airlines case*¹, the court observed that a disclaimer does not render a mark that is not registrable, due to lack of distinctiveness, to become registrable as required by law. The purpose of a disclaimer is to delineate the rights of the trade mark holder and not to confer a monopoly of the disclaimed elements.

A disclaimer actually informs the other traders in a similar trade that they are free to use the disclaimed element(s) of the mark.

¹ [1989] 16 IPR 270.

When considering a trade mark for registration, distinctiveness under the Act is an essential element that the trade mark sought to be registered should possess. It is therefore important to consider the distinctive character of the Applicant's mark in relation to the Goods in classes 29, 30 and 32 of the International Classification of Goods and Services, which the Applicant seeks to register.

The Applicant has indicated in the submissions that it cannot be said with certainty that the word "MARK" is being used in a descriptive or laudatory manner and that the word "MARK" does not describe the type, character, or quality of the goods, and there is no factual or objective relationship between this word and the goods classes 29, 30 and 32.

Having considered the Goods in classes 29, 30 and 32, it is my view that the word "MARK" is not descriptive of the said Goods that the Applicant seeks to register.

Lord Parker in W & G du Cros' Application [1913] 30 RPC 660 stated that the right to registration should largely depend on whether other traders in the course of their business and without any improper motive desire to use the same or a similar trade mark upon or in connection with their own goods and services.

I have perused the Register of Trade Marks and note that there are other trade marks consisting of the word "MARK" which have been registered. The Registrar of Trade Marks has previously asked for a disclaimer of the word "MARK" in respect to goods in classes 29, 30 and 32. I wish to cite a few of the said marks that are registered subject to disclaimer of the word "MARK" as follows:

No.	T.M NO.	Trade Mark	Class(es)
1.	61560	KEBS STANDARDIZATION MARK 1 192 6 (word & device) Registered with a disclaimer of the word "MARK".	1,2,3,4,5,6,7,8,9,10, 11,12,13,14,15,16, 17,18,19,20,21,22, 23, 24, 25, 26, 27, 28, 29,30 , 31, 32 , 33 and 34.
2.	103967	Phulka ATTA MARK 1 BAKEX Eat Healthy, Stay Healthy (word & device). Registered with a disclaimer of the word "MARK".	30

3.	99816	WINNIE'S PURE HEALTH ATTA MARK 1 (word & device) Registered with a disclaimer of the word "MARK".	30
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It is clear from the above information that it is common practice for proprietors of marks in classes 29, 30 and 32 to use the word "MARK". This signifies that the word is common to the trade in classes 29, 30 and 32.

The Applicant has indicated that the Applicant's mark "MEMBER'S MARK" has been successfully registered without the need for a disclaimer of the word "MARK" in several countries. The fact that the Applicant's mark consisting of the word "MARK" has been registered in other countries without the requirement for disclaimer of the word "MARK" is merely persuasive but not binding upon the Registrar of Trade Marks in Kenya.

Having considered the Applicant's submissions, the records at the Registry of Trade Marks and taken into account all the circumstances of this case, I hereby rule as follows:

1. The Applicant's application for registration of the mark "MEMBER'S MARK", T.M.A No. 119119 shall not proceed to publication in the Industrial Property Journal without a disclaimer of the word "MARK" separately and apart from the mark as a whole.
2. The Examiner's report dated 6th July 2022 requiring the Applicant to disclaim the right to the exclusive use of the word "MARK" separately and apart from the mark as a whole is hereby upheld.

Ruling delivered at Nairobi this 14th day of November 2024



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CONCILIA WERE
ASSISTANT REGISTRAR OF TRADE MARKS