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

AND

**IN THE MATTER OF T.M.A NO. 109473 “S ROMANY” (WORD) IN CLASS 6 IN THE
NAME OF MICHEAL GITHAIGA MWANGI**

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

BACKGROUND

On 3rd October 2019, Michael Githaiga Mwangi (hereinafter referred to as the Applicant) filed an application for registration of the mark “S-ROMANY” (word) in respect to class 6 of the International Classification of Goods and Services.

Class 6: Malpha hinges, Drawer Rails, Chrome fittings.

Through a letter dated 8th February 2020, the Trade Marks Examiner issued a refusal notice against registration of the said mark citing the reason that the mark is similar to another mark existing in the Register with the following particulars:

TM No.64739 “ROMANY” in class 6 and in the name of Classic Ironmongers Ltd.

On 19th February 2021, the Applicant filed written submissions against the Examiner’s refusal notice citing the following:

- 1) The mark for which registration was applied on 3rd day of October 2020 under Trade Mark Application No. 109473 S-ROMANY (the “Applicant’s Mark”) is proposed for use in respect of goods in class 6.

- 2) The mark which has been cited against the Applicant's mark is Trade Mark No. 64739 ROMANYS (the "Cited Mark") in class 6 in the name of Classic Ironmongers Ltd of P.O Box 17915, Nairobi.
- 3) The Cited Mark has been in entitlement since 12th January 2009 and expires in 12th January 2029.
- 4) The Examiner through the letter dated 8th February 2020 objected to the registration of the Applicant's Mark on the grounds that it is similar to the Cited Mark.
- 5) The Applicant received the letter sometime in June time by which the 90 days' period to reply had lapsed.
- 6) The Applicant applied for extension of time on the 11th September 2020 but only learned of the endorsement on the 27th January 2021 despite numerous calls and visits to the Kenya Industrial Property Institute (KIPI).
- 7) The Applicant therefore humbly requests that the Registrar exercise his/her discretion and admit the considered response/submissions in respect to the objection.

THE LAW

- 8) The supposition in this matter is that the objection to register the Applicant's mark was made pursuant to section 15 (1) of the Trade Marks Act which provides that *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 with 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.*

This therefore means that the similarity must be of the mark and the goods or services for which the mark is applied.

The issues for determination before the Registrar are therefore:

- a) Similarity of marks
- b) Similarity of goods

Similarity of marks:

- 9) To examine their similarity, the Applicant's Mark and the Cited Mark must be compared as a whole and not by their individual constituent elements. The visual, oral and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks. If the comparison is done taking into account all the relevant factors, it will be clear that the overall visual and conceptual appearance of the Applicant's mark and the cited mark is not similar.
- 10) The Applicant's mark is the word **S-ROMANY** written as one letter (S) hyphen (-) (**ROMANY**) while the Cited mark is composed of the word **ROMANYS** which is one word. The Applicant submitted that the Examiner should not have ignored the letter (s) at the beginning of the Applicant's mark and then consider the word (**romany**) in the two marks in order to arrive at a conclusion of their similarity on that basis alone.
- 11) The Applicant submitted that the Examining Officer erred in fact and law by ignoring and dividing up the separate constituent letters of the two marks and in merely considering individual elements of the two trade marks and arriving at a conclusion on that criterion alone.
- 12) The principle that both marks must be compared as a whole is now well established and settled by the various decisions of the Registrar of trade marks and is accepted in the Kenya Industrial Property Institute (KIPI) Manual of Examination Procedures ("the KIPI Manual").

In paragraph 566 of the KIPI Manual, it is stated: *"It is well established that trademarks appeal to the ear as well as to the eye, in the ordinary course of commerce, they are spoken and just as frequently their appearance alone may influence a customer's choice. In judging whether two marks are confusingly similar therefore, it is not sufficient to have regard only to one of their aspects"*.

Trade mark is a whole thing and should be considered as such. In Kerly's Law of Trade Marks and Trade Names 12th edition it is stated that "The trade mark is the whole thing - the whole picture on each has to be considered"

The Applicant cited the Pianotist Case (1906) 23 R.P.C 774, Sabel BV vs. Puma Ag. Rudolf

Dassler Sport (1998) R.P.C 199, 223-224 and Medion AG vs. Thomson Multimedia Sales Germany 7 Austria GmbH (2006) E.T.M.R in support of his case.

That in view of the above authorities and the visual and phonetic differences between the two marks when compared holistically, it is the Applicant's submission that its mark will not cause any confusion to the public and/or customers. Neither, will it make the public to wrongly believe that the respective goods come from the same economically linked undertakings.

Similarity of Goods:

- 13) One of the requirements under section 15 (1) of the Trade Marks Act is that, in order to sustain a citation of similar mark. both marks must be for the same goods or description of goods. In the present case, although the Applicant's mark is proposed to be applied to goods in class 6 the Applicant submits that the goods covered by the Applicant's mark and those covered by the Cited mark are not identical and they are not used for similar purposes. Specifically, the Applicant's mark is limited to the following goods; malpha hinges, drawer rails and chrome fittings.

Paragraph 5-05 of Kerly's Law of Trade Marks and Trade Names it is stated that *classification is primarily a matter of convenience in administration...what is of real importance in determining the rights of parties as has been pointed out, are the specification of goods and services entered on the Register and the validity of the registration. The fact that certain goods may fall within the same class is no evidence that they are "of the same description," which is important criterion in considering the restrictions on registration imposed by section 12 of the Act (equivalent to section 15 of the Kenya Trade Marks Act).*

- 14) The Applicant submitted that although both marks cover goods in class 6, it does not necessarily follow that confusion and deception of the public and/or consumers is likely to occur on the basis of that alone. The goods covered by both marks, being different in nature and being intended to be applied for very distinct purposes, are likely to be purchased out of deliberate choice and careful consideration. This leads to the conclusion that members of the public who buy

or will buy those goods are likely to take extra caution when buying such goods and are unlikely to be confused or deceived into thinking that the goods are sold by the same manufacturer.

- 15) Section 7 and 15 (1) of the Trade Marks Act recognize that the proprietor of a registered mark is only protected in connection with the goods in respect of which the mark is registered and no more. To hold otherwise would be contrary to the law that has provided for the registration of trade marks in classes and recognizes a different description of goods even though the goods may fall in the same class. The Applicant submitted that the specification of goods for the Applicant's mark is very different from the specification of goods for the Cited mark.
- 16) Kerly's Law of Trade Marks and Trade Names paragraph 17-16 proceeds to state that *the question is not whether if a person is looking at the two trademarks there would be a probability/possibility of confusion, the question is whether the person who sees the proposed trade mark in the absence of the other trade mark and view of only his general recollection of what the nature of the other trade mark was, would be liable to be deceived and think that the other trade mark before him is the same as the other of which he has a general recollection.*

The Applicant submitted that the Applicant's mark is unique, distinct and different and that no confusion is likely to occur.

In conclusion, the Applicant indicated that from the above submissions considering the overall appearance of the Applicant's mark compared to the Cited mark as well as the consumer's consideration of the goods covered by both marks, it is clear that the registration of the Applicant's mark will not cause any confusion to the public.

Secondly, the Applicant's mark is inherently adapted to distinguish the goods of the Applicant from those of other traders in the course of trade and the overall differences in the two marks are sufficient to distinguish the Applicant's from the cited notwithstanding that the description of the applicant's goods is specific and limited to malpha hinges, drawer rails and chrome fittings.

The Applicant prayed that the Applicant's TMA No. 109473 S-ROMANY (Word/device)

be allowed to proceed for advertisement in the next issue of the Kenya Industrial Property Journal.

RULING

I have studied the documents on record and considered the Applicant's submissions filed by Macharia Waiganjo & Nyakoe Advocates against the Examiner's refusal notice.

I am of the view that the issue for determination is whether the Applicant's mark T.M.A No. 109473, "S-ROMANY" (word) is similar to the cited registered mark T.M No. 64739 "ROMANYS" (word & device).

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.'

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.

1. Similarity of the marks in appearance

In making a determination on the similarity of the marks, it is important to consider that the marks that are up for consideration should be compared in their entirety. The overall or net impression of the two marks should be taken into consideration.

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 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 (which the Applicant has cited in his submissions), 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 registered mark to determine whether the two are similar in terms of their appearance.

The cited registered mark TM No. 64739 is **ROMANYS** (word and device). The Applicant’s mark on the other hand is **S-ROMANY** (word).

In terms of the visual similarity, the cited registered mark comprises of the word “ROMANYS” with a device. The Applicant’s mark on the other hand is the word “S-ROMANY”. There is an identical word “ROMANY” in both the Applicant’s mark and the registered cited mark. In addition, there is a letter “S” which is also visible in

¹ (1898)15 RPC 141 at 146

² (1999) ECR I-3819

³ Rudolf Dassler Sport [1998] RPC 199 at 224

both marks, save for the fact that in the Applicant's mark, the letter "S" is at the beginning of the mark, while in the registered cited mark, the letter "S" is at the end of the word "ROMANY". I am of the view that there are both points of similarity and differences between the marks in question.

When a mark contains a dominant component, the likely impact that is made on the mind of the customer must be considered. In most instances, marks are remembered by their general impressions or striking features rather than by the photographic recollection of the whole. It is important to strike a balance between the impact created by the dominant component of the mark and also consideration of the mark as a whole.

In making an analysis on the phonetic similarity, I am of the view that the pronunciation is only similar as far as the pronunciation of the word 'ROMANY' is concerned but different when the mark is pronounced as a whole.

On the conceptual similarity, I am of the view that the concept that is behind the two marks is the same and therefore the marks are conceptually similar.

2. Similarity of the goods

Romer J in *Jellinek's Application*⁴, 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

⁴ (1946) 63 RPC 59 at 70

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 his mark in respect to goods in class 6 of the International Classification of Goods and Services in respect to Malpha hinges, Drawer Rails, Chrome fittings.

The cited mark on the other hand has been registered in respect to goods in class 6 of the International Classification of Goods and Services covering Ironmongery.

In Kerly’s Law of Trade Marks and Trade Names 12th 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.

According to the Merriam Webster Online dictionary, the term “ironmongery⁵” means something made of metal. It may also be considered as hardware. The Cambridge online dictionary defines ironmongery as tools and equipment used in homes or gardens⁶.

From the analysis made on the Applicant’s specification of goods and the specification relating to the registered cited mark, it is my view that the specification relating to ironmongery is a wider specification covering the scope of goods that the Applicant seeks to register. It is therefore my opinion that the goods which the Applicant seeks to register are similar to those of the cited registered mark.

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 8th February 2020, is hereby upheld.
2. The Applicant’s application for registration of the mark “S-ROMANY” (word), T.M.A No. 109473 hereby fails and registration of the said mark shall not be allowed to proceed.

Ruling delivered at Nairobi this 30th day of June 2023



CONCILIA WERE

ASSISTANT REGISTRAR OF TRADE MARKS

⁵ “Ironmongery.” Merriam-Webster.com Dictionary, Merriam-Webster, <https://www.merriam-webster.com/dictionary/ironmongery>. Accessed 30 Jun. 2023.

⁶ <https://dictionary.cambridge.org/dictionary/english/ironmongery>