

KENYA INDUSTRIAL PROPERTY INSTITUTE

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Our Ref: T.M.A. NO. 130136

Date: 27th September 2024

Your Ref: TM233122

Wanam Sale
Advocates
P. O. Box 43123 - 00100
Nairobi

Dear Sirs

T.M.A. NO. 130136 IN THE NAME OF ONELOOP (PTE) LTD

Reference is made to the above-mentioned matter and to your letter dated 27th November 2023.

It is noted that in a letter dated 23rd October 2023, the Registry of Trade Marks required you to enter a disclaimer of the word "ONE", each separately and apart from the marks as a whole, as a condition for registration of the above trade mark. The trade mark is sought to be registered with respect to various goods and services in classes 9, 36 and 42 of the Nice Classification of Goods and Services for Purposes of Registration of Marks.

In your letter dated 27th November 2023, you stated that the application for registration of the above trade mark should be allowed to proceed to publication without a disclaimer of the right to the exclusive use of the word "ONE" separately and apart from the mark as a whole for the following reasons, *inter alia*:

- (a) The trade mark has been used extensively globally, including Kenya, thereby gaining goodwill in the market;
- (b) The trade mark is part of the Applicants' name and should therefore be allowed to proceed to publication without a disclaimer;
- (c) The word "ONE" forms an integral part of the Applicants' trade mark, and when considered as a whole, the trade mark is distinctive and is capable of distinguishing the Applicants' goods and services in the market; and

(d) The trade mark has been allowed to proceed to publication without a disclaimer in various jurisdictions including Zanzibar, China, Tanzania and Nigeria.

The word in contention in this matter is “ONE”, the lowest cardinal number.¹ This means that this is an ordinary element that should be available for any person to use in whichever trade the person may engage. Where a trade mark comprises such an element, the mark would neither be described as strong nor would it be deemed to be distinctive. While I am aware that a mark should be considered as a whole without splitting it into various elements, it is apparent that the above trade mark consists of the word “ONE”, the element in contention herein. Indeed, a cursory consideration of the Register of Trade Marks in Kenya indicates that the Register contains various trade marks consisting of the word “ONE” and in the names of different persons with respect to goods and services in classes 9, 36 and 42 of the Nice Classification.

Therefore, I agree with the Registry of Trade Marks that the right to the exclusive use of the word “ONE” should be disclaimed for the following reasons:

- (a) A disclaimer in an application for registration of a trade mark is required under the provisions of section 17 of the Trade Marks Act where an element constituting a trade mark is common to the particular trade related to the goods or services in respect of which a mark is sought to be registered or where the element is of a non-distinctive nature. In the *Australian Airlines*² case, 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; and
- (b) One of the rights that are obtained upon registration of a trade mark is the right to enforce the trade mark against persons who may infringe upon the registered mark. See *Hag II*³ and *WIPO*⁴. This may only be undertaken by a person who has

¹ Pearsall, Judy and Hanks, Patrick (eds): *The New Oxford Dictionary of English* (Oxford University Press 2012) 995.

² [1989] 16 IPR 270.

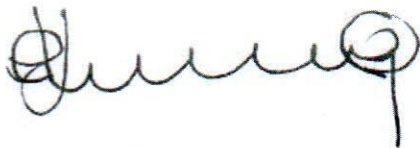
³ [1990] CMLR 571, 608.

⁴ *WIPO: Intellectual Property Handbook: Policy, Law and Use*: (2nd edn, WIPO Publication 2004) 85.

the exclusive use of all the elements of a trade mark. Having observed above that that the Register contains various trade marks consisting the word "ONE" and in the names of different persons with respect to goods and services in classes 9, 36 and 42 of the Nice Classification, it would be unjust to allow the Applicants to obtain the right to the exclusive use of the word "ONE", thereby sanctioning the Applicants to take legal action against anyone who has been using or intends to use the word "ONE", with respect to similar goods in classes 9, 36 and 42 of the Nice Classification.

For the above reasons, you are required to kindly comply with the contents of the letters dated 29th August 2019 and 9th September 2019 from the Registry of Trade Marks to enable the Registrar of Trade Marks to proceed accordingly.

Yours faithfully

A handwritten signature in black ink, appearing to read 'Eunice Njuguna', with a stylized flourish at the end.

Eunice Njuguna
Assistant Registrar of Trade Marks