

KENYA INDUSTRIAL PROPERTY INSTITUTE

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Our Ref: T.M.A. NO. 118004

Date: 27th September 2024

Your Ref: 951499

AGIP
P. O. Box 20140 - 00100
Nairobi

Dear Sirs

T.M.A. NO. 118004 IN THE NAME OF INTERNATIONAL FOODSTUFFS CO. LLC

Reference is made to the above-mentioned matter and to your letter dated 15th November 2021.

It is noted that in a letter dated 27th August 2021, the Registry of Trade Marks rejected your above trade mark for the reason that the mark was similar to Trade Mark Application TMA No. 84171 "SPLASH" (the cited trade mark). In your letter of 15th November 2021, you stated that you did not agree with the above opinion for the following reasons, *inter alia*:

- (a) Your above trade mark and the cited trade mark would not be considered to be confusingly similar under the provisions of the Trade Marks Act; and
- (b) You offered to restrict the goods with respect to which your mark is sought to be registered to *chocolate, biscuits, confectionery, ice cream and candy*.

It appears that your trade mark was refused registration due to the provisions of section 15 (1) of the Trade Marks Act. Section 15 (1) of the Act prohibits registration of a trade mark that is similar or identical to a trade mark that is already in the Register of Trade Marks, registered with respect to goods or services of a similar or identical description.

In *Eli Lilly & Co v Natural Answers*,¹ the Court held that the similarity between the marks in appearance and suggestion, the similarity of the products, the area and manner of concurrent use of the products, the degree of care likely to be exercised by consumers, the strength of the complainant's mark, any evidence of actual confusion and the defendant's intent (or lack thereof) to palm-off its product as that of another, are some

¹ 233 F.3d 456 (7th Cir. 2000).

of the factors that should be considered while determining the issue of similarity of trade marks. I shall consider the following factor to enable me to determine the issue of similarity in this matter:

The area and manner of concurrent use of the products

It is apparent that upon restricting the goods with respect to which the above trade mark is sought to be registered, then the likelihood of confusion of the respective trade marks will be reduced.

Section 15 (1) provides that to determine whether or not an application for registration of a trade mark is similar to a registered trade mark, consideration should be had to the similarities between the two trade marks in appearance and suggestion while the description of the goods or services in respect of which the earlier trade mark has been registered should be compared to the description of the goods or services in respect of which the application is sought to be registered. Bentley and Sherman² state that when determining whether or not a trade mark application is similar to an earlier mark, the comparison ought to be between the goods or services for which the earlier mark has been registered and the goods or services to which the application relates. An interpretation of the specification and characterization of the goods or services is then required to determine if the goods are of a similar description.

In *American Steel Foundries v Robertson*³, it was stated that nothing prevents the use of similar or identical trade mark by different proprietors provided that the respective goods or services are of a different description. The only property in a trade mark is the business or trade in connection with which the trade mark is used. Goods or services are generally considered to be similar when offered under a similar trade mark and where the purchasers may be likely to believe that the goods or services originate from the same source and where the channels used for the goods are similar.⁴

² Bentley L, and Sherman B, *Intellectual Property Law* (3rd edn, Oxford University Press), 859

³ 269 U. S. 372 (1926).

⁴ WIPO: *Intellectual Property Handbook: Policy, Law and Use*: (2nd edn, WIPO Publication 2004) 86.

In conclusion, your application T.M.A No. 118004 is hereby allowed to proceed to publication. This approval is on the condition that you file the prescribed Form TM 19 to amend the specification of goods as indicated in your letter of 15th November 2021, upon payment of the prescribed fee.

Kindly note that the contents of this letter 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. In the event that opposition proceedings are filed, the Registrar of Trade Marks shall consider the proceedings on merit.

Yours faithfully

A handwritten signature in dark ink, appearing to read 'Eunice Njuguna', with a large circular flourish at the end.

Eunice Njuguna
Assistant Registrar of Trade Marks