

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. 118397 "TRUEMPOWER" (WORD) IN THE
NAME OF TRANS UNION LLC SERVICES LIMITED
EX-PARTE HEARING UNDER RULE 32 OF THE TRADE MARK RULES
RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

Procedural Background

On 26th July 2021, the Registrar of Trade Marks received an application for registration of T.M.A. No. 118397 "TRUEMPOWER" (word) mark in classes 35,36,42 and 45 in the name of Trans Union LLC Limited (hereinafter referred to as the Applicant). The application was duly examined and on 14th January, 2022, the Examiner sent a refusal notice to the Applicant for the reason that there is a similar mark with the following details:

"T.M.No. 79760-MPOWER (Word and Device) registered in classes 9,36,38,41 and 42 and has been subsisting in the Register since 23rd August 2013.

On 31st January, 2022, the Applicant through its Advocates, CFL Advocates filed written submissions against the refusal to register their client's mark. The Applicant's Advocates submitted that the Registrar of Trade Marks should rescind the decision to reject registration of their mark for a number of reasons including:

1. That upon taking into account Section 15(1) of the Trade Marks Act, when assessing the similarity of trade marks, 'A global appreciation' approach must be taken as per the court's reasoning in paragraphs 22 and 23 of the court's decision in Sabel v Puma [1998] E.T.M.R. (Marked as Annexure I), where the court stated the following:

"In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion 'depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified'. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

That the global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. "

2. That additionally, the test to be used when determining whether there is a likelihood of confusion and deception was enunciated by Parker J. in the *PIANOTIST CO. APPLICATION* (7906) 23 R.P.C. 774 (Marked as Annexure 2), where the court stated as follows:

"...You must take two words. You must judge them, both by their look and 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 marks is used in the normal way as a trade mark of the goods of the respective owners of the marks..."

3. That a side by side comparison reveals that there are obvious visual and phonetic differences between the cited trade mark and the applied for trade mark. The differences include:
- a) the applied for trade mark is a word mark while the cited trade mark is stylized;
 - b) the applied for trade mark begins with the prefix "TRUE" while the cited trade mark begins with the letter "m"; which is not only visually but also phonetically dissimilar to the cited trade mark.
4. That based on the above visual and phonetic differences, when perceived as a whole is not similar to the cited trade mark.
5. That additionally, it was stated in the case of *Rod Leichtmetallrader GmbH v OHIM* at paragraph 28 (Marked as Annexure 3), that the beginning of a trade mark is the part that primarily attracts the consumer's attention and is therefore remembered more clearly than the rest of the trade mark. In this case, the beginning letters as contained in the trade marks are not the same, and thus there is a significant visual and phonetic difference.
6. That further, in the case of *Bimbo SA v OHIM*, Case C-591 /72P (Marked as Annexure 4), the European Court of Justice stated that:
- "The global assessment of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks at issue, must be based on the overall impression given by the marks, account being taken, in particular, to their distinctive and dominant components."*
7. That the House of Lords of the United Kingdom also stated in the case of *Aristoc Ltd v Rysta Ltd* (1943) 60 RPC 87 at 108 (Marked as Annexure 5), that in assessing the similarity of marks, the first impression of the marks Should be considered.

8. That based on the cases cited by the Applicant's Advocate, it was further submitted that as a matter of first and overall impression, the applied for trade mark and the cited trade mark are not visually or phonetically similar because of the substantial differences highlighted above.
9. That with regard to conceptual similarity, it was submitted that the two trade marks are not conceptually similar because to consumers in Kenya, the word "TRUEMPOWER" has no particular meaning in relation to the services covered by the applied for trade mark.
10. That the proprietor of the cited trade mark disclaimed the right to the exclusive use of the word "POWER" separately and apart from its trade mark as a whole. Pursuant to page 62 of the Kenya Industrial Property Institute Trade Marks Manual of Examination Procedures ("KIPI Manual"), the function of a disclaimer is to prevent proprietors from claiming exclusive rights to parts of trade marks that are non-distinctive or common to a particular trade.
11. That based on the above, it was submitted that since the proprietor of the cited mark entered a disclaimer for the word "POWER" separately and apart from its trade mark as a whole, then the word is not exclusively registered for use by the proprietor of the cited trade mark. Therefore, the fact that the common element "POWER" is contained in both the applied for trade mark as well as the cited trade mark should not stand as a bar to the registration of the applied for trade mark.
12. That it was further submitted that when applied the Applicant's services, the word "POWER" is arbitrary. According to the KIPI Manual at page 35, a term is arbitrary if, although common in linguistic use, when used to identify particular goods or services, it does not suggest or describe a significant ingredient, quality or characteristic of the goods or services. An example of such a word as provided in the KIPI Manual is APPLE for computers.
13. That additionally, when applied to the Applicant's services, the word "POWER" adopts an incongruous meaning when combined with the prefix "TRUEM" because the words do not normally collocate in normal English speech patterns and do not have a particular meaning when combined.
14. That in the case of Discovery Holdings Ltd v Sanlam Ltd and Others (8995/2012) [2014] ZAWCHC 109 at paragraph 47 (Annexed hereto and marked as Annexure 6), the Western Cape Division of the High Court of South Africa held that trade marks consisting of words which have dictionary meanings could still be considered distinctive if the words were used in connection with goods or services unrelated to their dictionary meanings such as "APPLE" for computers and "OMEGA" for watches.

15. That the services intended to be registered with respect to the Applicant's trade mark are provided under paragraph 20 below. Based on the specification of the services, it is submitted that the word "POWER" has no direct reference to the character or quality of the services and is not, according to its ordinary signification, a geographical name or surname. Additionally, there is no association between the word "POWER" and the services intended to be registered with respect to our client's trade mark. Therefore, a consumer unaware of our client's trade mark would not be able to form a reasonable association between the word "POWER" and the said services. Therefore, our client's mark meets the requirements of section 12 of the Trade Marks Act on distinctiveness.
16. That as regards the public's perception of the word "POWER" and the effect of such perception on the distinctiveness of the word as used in our client's trade mark, we submit that the relevant public is reasonably circumspect, well informed and observant. Therefore, to consumers of our client's services, the word "POWER" has no meaning which is immediately perceived by the public as providing information about the services intended to be registered with respect to the applied for trade mark.
17. That further, in *Proctor & Gamble Company v Simon Grogan*, 0-176-08 (marked as Annexure 7), Counsel Anna Carboni, referred to the "CAREMIX" case of Altecnic Ltd's Trade Mark Application [2002] R.P.C 639 which explained the International Classification of goods and services as primarily administrative, in the following terms:
- "The classification of goods and services shall serve exclusively administrative purposes and, therefore, goods or services may not be regarded as being similar to each other on ground that they appear in the same class under the Nice Classification... This makes the classification of goods irrelevant to the question of similarity of goods and services".*
18. That therefore, it was submitted that just because some of the services covered by the Applicant's trade mark and the cited trade mark are classified under classes 36 and 42, should not mean that the disclaimer requirement as applied to the cited trade mark should also apply to our client's trade mark. The contents of paragraphs 11 to 18 above should apply in this case.
19. That without prejudice to any other arguments made herein, we submit that any similarity between the goods and services intended to be covered by the Applicant's trade mark and the cited trade mark is offset by the substantial visual and phonetic differences as highlighted in paragraphs 4 and 5 above.
20. That the average consumer of the services such as those covered by the Applicant's mark is reasonably circumspect, well informed and observant because of the nature of the services.

21. That it is submitted that in this case, there is no real tangible danger of confusion because on a global appreciation of the factors relevant to the case, the significant differences are more than sufficient to remove any likelihood at confusion as was stated in *Berlei (U.K) Limited Vs Bali Brasserie Co. Inc* [1969] RPC 472.
22. That based on the global appreciation of the visual and phonetic aspects of the trade marks, the differences between the goods/services covered by the trade marks and the nature and kind of consumer of the goods and services in question. The Registrar should therefore compare and analyze the trade marks as a whole in the same way that an average consumer would perceive the marks rather than highlight and focus on one common element in the trade marks as a basis for concluding that the Applicant's trade mark and the cited trade mark are similar.
23. That in light of these submissions that you should rescind the Registrar's decision to refuse the registration of trade mark number 118397 in classes 35,36,42 and 45 in the name of the Applicant.

ASSISTANT REGISTRAR OF TRADE MARKS DECISION

I have considered the written submissions made on behalf of the Applicant while taking note of the Examiner's refusal notice and I am of the view that the main issue for my determination in this matter is whether or not the Applicant's applied for mark "TRUEMPOWER" in classes 35,36,42 and 45 is so similar to the cited mark "MPOWER" in classes 9,36,38,41 and 42 as to cause a likelihood of confusion contrary to the provisions of sections 14 and 15 (1) of the Trade Marks Act?

Section 14 of the Trade Marks Act provides as follows:

"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 Marks Act provides as follows:



"Subject to the provisions of sub-section (2), no trade mark shall be registered in respect of any goods or description of goods that is identical with or 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 cited sections above are to the effect that the Registrar shall ensure that no registration is entered in the Register that is identical or so similar to another mark that is already in the Register in respect of the same goods or description of goods of another person already on the Register.

Parker J, in Re Pianotist Co.’s Application, (1906) 23 RPC 774 case as cited by the Applicant’s Advocate above stated in part 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.”

In order for me to judge the two marks as per the above dicta, I will commence by a side-by-side representation of the applied-for mark and the cited mark:

Cited Mark	Applied-for Mark
<div>MPOWER</div> <div></div> <div>In classes 9,36,38,41 and 42 of the Nice Classification</div>	<div>TRUEMPOWER</div> <div></div> <div>In classes 35,36,42 and 45 of the Nice Classification</div>

In light of the above two provisions, the cited case above and the Applicant’s submissions, I must first establish whether or not the marks in question are similar in appearance, what Parker J, refers to as visual similarity.

Looking at the representation of the Applicant’s applied for mark in light of the cited mark, I find that a comparison on the face of the record reveals the following:

1. That the applied-for mark is a word only mark while the cited mark is a word and device mark.
2. That the applied for mark is written in capital letters whilst the cited mark is in small letters and that the letter O is represented in the form of a power symbol and a mobile phone device.

3. That the cited mark is represented in colour blue and the power symbol appears in colour yellow.
4. That the cited mark is registered in classes 9,36,38,41 and 42 whereas the applied for mark is in classes 35,36,42 and 45.

On the issue of visual similarity, I find that the marks may be slightly comparable due to the use of the letter “m” and the word “power” in both marks but overall, looking at the marks as a whole, they are not visually identical or similar.

Phonetic Similarity

In considering the phonetic similarity of the marks herein in question, I must consider the sound or pronunciation of both marks. I take note that phonetic similarity is mainly determined by the sound of marks or how the marks are pronounced. The words ‘TRUEMPOWER’ and ‘MPOWER’ have both the words ‘EMPOWER’ and ‘MPOWER’ that are pronounced identically; however, the first part of the applied-for mark alters the pronunciation by the addition of the syllable ‘TRU’ or the word ‘TRUE’. Arguably, it may not necessarily be possible to pronounce a device but when they are depicted as letters, then they can be pronounced as if they were represented as the actual letter.

In this current scenario and based on the foregoing, I find that the two marks may be pronounced similarly at the end of the two words but are not phonetically similar when pronounced as a whole.

Conceptual Similarity

The conceptual similarity of marks mainly involves the assessment of marks on the basis of the ideas or concepts that both marks leave behind in the mind of an average consumer or the meanings generally conveyed by both marks.

When I look at “TRUEMPOWER” and “MPOWER”, I find that the applied-for mark could have very well added the words “TRUE” before the common “MPOWER” that appears in both marks. The applied-for mark does not immediately trigger a specific meaning in my mind as compared to the cited mark that may suggest the goods or services the mark is registered for.

The term “MPOWER” may be a short form of the word “EMPOWER” and may be suggestive of the services in classes 36,41 and to some extent 42. In class 9 however, it is to depict the power symbol in relation to the goods therein.

In contradistinction, I have to dissect the applied-for mark for me to figure out what it may mean or the idea it leaves behind. The word “TRUEMPOWER” may as combined,

mean that it will truly empower the targeted people in relation to the services proposed in classes 35 ,36,42 and 45.

I therefore find that the two marks may be conceptually similar but not identical.

Likelihood of Confusion

The question of the likelihood of confusion, in this case, depends upon a consideration of the marks viewed in their entirety as per the dicta in the Pianotist Case. These similarities are not apparent in appearance, in sound as well as conceptually.

In *Clarke v Sharp* (1898)15 RPC 141 at 146, 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 considering the marks as wholes and whether they would cause confusion and deception, I have looked at the marks that are on the Trade Marks Register that have been registered with somewhat similar terms as the marks in question as follows:

T.M No.	Trade Mark	Class	Disclaimer
113918	E EMPOWER	36,41	disclaim the right to the exclusive use of the letter “E and the word “EMPOWER” separately and apart from the mark as a whole.
78403	MPOWER	38	disclaim the right to the exclusive use of the letter “M”, the word “POWER” and the devices of mobile phone and lightning symbols separately and apart from the mark as a whole.
95654	mPOWER	5,44	disclaim the right to the exclusive use of the letter “M” separately and apart from the mark as a whole.
114232	NPOWER	9	disclaim the right to the exclusive use of the letter “N” and the word “POWER” separately and apart from the mark as a whole.

The above-tabulated marks in the Register reveal that there are marks that are already in the Register with the words “EMPOWER” and “MPOWER” in some of the classes that the applied-for mark and the cited mark appears.

I take note that the word “MPOWER” has been registered by other proprietors other than the registered proprietor of the cited mark, one of which is registered in class 38 that is also a class registered under the cited mark.

The Applicant has submitted that the services that it proposes to use in relation to its applied-for mark are different from those of the cited mark and that any similarity between the goods and services in relation to the two marks is offset by the substantial visual and phonetic differences highlighted in its submissions.

I find that the goods and services looked at as a whole are not identical nor similar and I therefore find that an average consumer in the respective classes will be able to differentiate the two marks taking further into account the visual and phonetic differences.

In view of Section 14 of the Trade Marks Act in relation to likelihood of confusion and deception, in *Reed Executive Plc v Reed Business Information Ltd* (2004) EWCA Civ 159 (CA), the court stated that “The person to be considered in considering the likelihood of confusion is the ordinary consumer, neither too careful nor too careless, but reasonably circumspect, well informed and observant.

The Applicants argued, and I similarly find, that the consumers of the goods and services between the two marks are likely to be reasonably circumspect, well informed and observant.

I find that the fact that there are other similar or identical marks that are co-existing with the cited mark already rule out the possibility of a likelihood of confusion or deception to the public as contemplated by Section 14 of the Trade Marks Act.

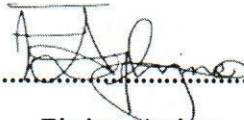
Final Decision

For the reasons set out above, I hereby rule as follows:

1. That the Applicant’s mark T.M.A. No. 118397 is hereby allowed to proceed to publication in accordance with the provisions of the Trade Marks Act and Trade Marks Rules with respect to classes 35,36,42 and 45;
2. That the Examiner’s Refusal Notice dated 14th January 2022 is hereby revoked; and

3. That the Applicant herein is further advised to note that the contents of this ruling 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 Opposition proceedings on merit, this decision notwithstanding.

Ruling delivered at Nairobi this30th day of ...September..... 2024

A handwritten signature in black ink, appearing to read 'Elvine Apiyo', is written over a horizontal dotted line.

Elvine Apiyo

Assistant Registrar of Trade Marks