

THE TRADE MARKS ACT CAP 506 OF THE LAWS OF KENYA

AND

**IN THE MATTER OF TRADE MARK APPLICATION NO. 129665 SEA GAS (WORD AND
DEVICE) IN CLASSES 4,35 and 39 IN THE NAME OF MY GAS HOLDINGS LIMITED**

EX-PARTE HEARING UNDER RULE 32 OF THE TRADE MARK RULES

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

Procedural Background

On 24th August 2023, the Registrar of Trade Marks received an application for registration of T.M.A. No. 1129665 “SEA GAS” (WORD & DEVICE) in classes 4,35 and 39 in the name of My Gas Holdings Limited, hereinafter referred to as the “Applicant”. The application was duly examined and on 5th October 2023 and the Examiner issued a provisional refusal notice stating that the applied-for mark is similar to an existing mark in the Register with the following particulars:

“T.M. No. 85754 “SEA GAS” in class 4 in the name of Proto Energy Limited of P.O.Box 50384-00100 Nairobi and that the same is due for renewal on 19/12/2024.”

On 16th November 2023, Proto Energy Limited of P.O. Box 50384-00100 Nairobi wrote a letter of consent stating that they are the registered proprietor of the cited mark Number 85754 SEAgas(Word and Device) in class 4 and that they consent to the registration of the applied for mark SEA GAS(word and device) in the Applicant’s name in classes 4,35 and 39.

On 29th November 2024, the Applicant’s Advocate wrote a letter seeking the Registrar to withdraw the refusal notice on the basis that:

“The registered proprietor of the cited mark issued a letter of no objection dated 16th November 2023 stating that it has no objection to the registration of the applied for mark and that the Applicant now seeks that the Registrar withdraws the refusal notice dated 5th October,2023 and proceed to publish its applied for mark.”

Assistant Registrar’s Decision

I have read the letter of no objection dated 16th November 2023 written by Proto Energy Limited, the registered proprietor of the cited mark under T.M. No.85754 stating that it has no objection to the registration of the applied for trade mark “SEA GAS”.

Section 15(2) of the Trade Marks Act stipulates that:

“In case of honest concurrent use, or of other special circumstances which in the opinion of the Registrar make it proper so to do, the court or the Registrar may permit the registration of trade marks that are identical or nearly resemble each other, in respect of the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as the court or the Registrar may think it right to impose.”

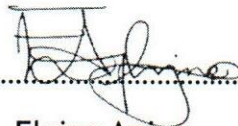
Section 15(2) of the Trade Marks Act anticipates situations such as in this instant case where there are two marks that are identical or similar and are allowed to co-exist in the Register. I find that this case before me falls within special circumstances since the registered proprietor whom the law seeks to safeguard has opted to allow the Applicant register an identical mark for more or less identical goods save for the Applicant's additional classes in Class 35 and 39 for related services.

I find that although Section 15(2) of the Trade Marks Act allows for co-existence of identical or similar marks that is occasioned by honest concurrent use or other special circumstances as in this case, the Registrar is further given the discretion to impose conditions and limitations to such registrations as he may think right to impose. It is on this premise that I rule as follows:

1. That the Applicant's trade mark SEA GAS (word and Device) shall proceed to publication in accordance with the provisions of the Trade Marks Act and Trade Marks Rules with respect to classes 4, 35 and 39 on condition that the Applicant shall limit the registration of its mark to the colours depicted on Form TM 2 in order to sufficiently distinguish the cited mark and the applied for mark vide Form TM 19.
2. That the Applicant is not restricted to limit the colours as depicted on Form TM 2 only but is at liberty to add or alter the colours as it desires for as long as its application specifically states that there shall be a limitation to colour in accordance with Section 19 of the Trade Marks Act; and

3. That the Refusal Notice dated 5th October 2023 is hereby revoked on the basis of the registered proprietor's no objection letter dated 16th November, 2023.

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

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

Elvine Apiyo

Assistant Registrar of Trade Marks