

KENYA INDUSTRIAL PROPERTY INSTITUTE



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Our Ref: T.M.A. No. 87000

Date: 26th July 2024

Your Ref: 6147439

Coulson Harney LLP
P.O. Box 10643 - 00100
Nairobi

Dear Sirs

TRADE MARK APPLICATION NO. 87000 IN THE NAME OF DPSM IP ASSETS

I refer to the above-mentioned matter and your letter dated 10th November 2015.

It is noted that in a letter dated 13th August 2015, the Registry of Trade Marks required you to enter a disclaimer of the right to the exclusive use of the device of a fish and numeral "3", each separately and apart from the mark as a whole, as a condition for approval of the above trade mark for publication and registration. In your letter of 10th November 2015, you indicated that while you agreed to enter a disclaimer of the right to the exclusive use of numeral "3", you were opposed to entry of a disclaimer with respect to the device of a fish for the following reasons, *inter alia*:

- (a) The Applicants' trade mark is distinctive of the goods in class 5 of the Nice Classification of Goods and Services for Purposes of Registration of Marks (the Nice Classification), in respect of which the mark is sought be registered;
- (b) The Applicants' trade mark has been used with respect to goods in class 5 of the Nice Classification in various jurisdictions globally, thereby attaining distinctiveness; and
- (c) The Applicants' trade mark has been entered in the Register of Trade Marks in various other jurisdictions globally without the requirement of a disclaimer.

Upon consideration of this matter, I agree with the contents of your letter dated 10th November 2015 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;
- (b) In *Discovery Holdings Limited v Sanlam Ltd & 2 Others*,¹ the Court stated that a trade mark can be descriptive where "it can literally describe the product or it can describe the purpose or utility of the product"; and
- (c) The device of a fish does not describe the character of goods in class 5 of the Nice Classification, in respect of which your trade mark is sought to be registered.

Therefore, I conclude that:

- (a) Your application T.M.A No.87000 is hereby allowed to proceed to publication in accordance with the provisions of the Trade Marks Act;
- (b) The Examination Report dated 13th August 2015 that was issued by the Registry of Trade Marks, relating to the requirement to enter a disclaimer of the right to the exclusive use of the device of a fish separately and apart from the mark as a whole, is hereby revoked;
- (c) You are required to enter a disclaimer of the right to the exclusive use of numeral 3, separately and apart from the mark as a whole.

Yours faithfully



Eunice Njuguna
Assistant Registrar of Trade Marks