

# KENYA INDUSTRIAL PROPERTY INSTITUTE



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Our Ref: TMA No. 110223

Date: 20<sup>th</sup> September 2024

Your Ref: JG/48/2019/2841

Gichachi & Company  
Advocates  
P.O. Box 79659-00200  
Nairobi

Dear Sirs

**TMA. NO. 110223 “DARK AND LOVELY AU NATURALLE” IN CLASS 3 THE NAME OF  
L’OREAL**

I refer to the above matter and to your letter dated 12<sup>th</sup> October 2020.

It is noted that in a letter dated 21<sup>st</sup> September 2020, the Registry of Trade Marks required you to enter a disclaimer of the right to the exclusive use of the words “DARK”, “LOVELY” and “NATURAL”, 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 12<sup>th</sup> October 2020, you indicated that while you agreed to the disclaimer of the word “NATURAL”, you did not agree to entry of a disclaimer with respect to the words “DARK” and “LOVELY” for the following reasons, *inter alia*:

- (a) The Applicants are the owners of various other trade marks that are registered with respect to goods in class 3 of Nice Classification of Goods and Services for Purposes of Registration of Marks (the Nice Classification), without a disclaimer of the words “DARK” and “LOVELY”; and
- (b) If the Applicants’ trade mark is entered in the Register of Trade Marks with a disclaimer, it may lead to dilution of the mark in the Kenyan market by third parties.

The elements in contention in this matter are the English word “DARK” and “LOVELY”, which form part of the Applicants’ trade mark that is sought to be registered with respect to various goods in class 3 of the Nice Classification. These are ordinary and common terms when used with respect to goods in class 3 of the Nice Classification.

Indeed, a cursory consideration of the Register of Trade Marks indicates that the Register contains about 25 trade marks all bearing the term "DARK", while the Register contains about 52 trade marks all bearing the term "LOVELY". These trade marks have been registered in the name various persons, including the Applicants with respect to goods in class 3 of the Nice Classification. These means that both terms are descriptive when used or registered with respect to any of the goods under class 3 of Nice Classification. These trade marks are ordinarily registered with a disclaimer of the of the words "DARK" and "LOVELY". For instance, TMA No. 122588 "NICE AND LOVELY GOOD JELLY" in the name of the Applicants has been registered with respect to goods in class 3 with a disclaimer of the words "NICE", "LOVELY" and "GOOD". TMA NO. 113533 "GLOW" and "LOVELY" in the name of Unilever Plc has been registered with a disclaimer of the words "GLOW" and "LOVELY". TMA NO. 91807 "CARE N LOVELY" in the name of Safari Products Limited has been registered with a disclaimer of the words "CARE" and "LOVELY" as well as the letter "N".

In *British Sugar Plc v James Robertson & Sons Limited*,<sup>1</sup> the Court stated that if a trader used the word "SOAP" to market his soap, the former can never become a trade mark, notwithstanding the massive sales that may have been made in the respective market. The Court confirmed that the term "SOAP" would never become a badge of origin for the trader as required by the law of trade marks. Similarly, I am of the view that the terms "DARK" and "LOVELY" would never be a trade mark to distinguish the Applicants' goods in class 3 of the Nice Classification from similar products that belong to other traders in Kenya.

Therefore, I agree with the Registry of Trade Marks that you should enter a disclaimer of the right to the exclusive use of the words "DARK" and "LOVELY", each separately and apart from your above trade mark as a whole, 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*<sup>2</sup> case, the court observed that a disclaimer does not render a mark that is not registrable, due to lack of

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<sup>1</sup> 1996 R.P.C 281 (Chancery Division) (U.K).

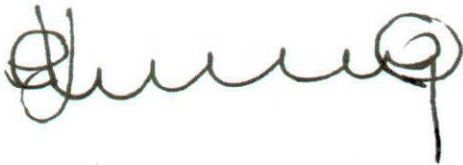
<sup>2</sup> [1989] 16 IPR 270.

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<sup>3</sup> and WIPO<sup>4</sup>. This may only be undertaken by a person who has the exclusive use of all the elements of a trade mark. Having determined that the Register of Trade Marks contains various trade marks that bear the terms "DARK" and "LOVELY" in the name of different persons, it would be unjust to allow the Applicants to obtain the right to the exclusive use of the words "DARK" and "LOVELY", thereby sanctioning the Applicants to take legal action against anyone who has been using or intends to use any of the word with respect to similar goods in class 3 of the Nice Classification.

For the above reasons, you are required to kindly comply with the contents of the letter dated 21<sup>st</sup> September 2020 from the Registry of Trade Marks to enable the Registrar of Trade Marks to proceed accordingly.

Yours faithfully

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

**Eunice Njuguna**  
**Assistant Registrar of Trade Marks**

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<sup>3</sup> [1990] CMLR 571, 608.

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