

KENYA INDUSTRIAL PROPERTY INSTITUTE



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Our Ref: T.M.A. NO. 119619

Date: 20th September 2024

Your Ref: FOIPA/TW/2021/44(3)

Fred Otswongo & IP Associates
P.O. Box 54708 - 00100
Nairobi

Dear Sirs

**T.M.A. NO. 119619 "TELCOM" IN CLASS 9 IN THE NAME OF ABDIFATAH
MOHAMED ABDI**

Refer to the above-mentioned matter and to your letter dated 8th April 2022.

It is noted that in a letter dated 11th February 2022, the Registry of Trade Marks objected to the registration of the above trade mark for the reason that the mark is confusingly similar to TMA No. 95650 "TELKOM", which has been entered in the Register of Trade Marks with respect to goods and services in classes 9, 16 and 38. In your letter of 8th April 2022, you requested the Registrar of Trade Marks to allow the mark to proceed to registration for the following reasons, *inter alia*:

- (a) When compared as a whole, the two trade marks in consideration are not similar visually or phonetically; and
- (b) The Applicants' trade mark is sought to be registered with respect to goods in class 9 of the Nice Classification, while TMA No. 95650 "TELKOM" is well known for land line telecommunication, delivery of mails and courier in the market.

It appears that your above mark was refused under the provisions of section 15 (1) of the Trade Marks Act. The section 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 Sherman¹ 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. To determine whether or not the two trade marks are similar several factors should be considered. The following is a consideration of some of the factors:

(a) The area and manner of concurrent use of the products

The Applicants' mark is sought to be registered with various goods in class 9 while TMA No. 95650 "TELKOM" has been entered in the Register of Trade Marks with goods in class 9, among others.

In *American Steel Foundries v Robertson*², 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.³

I am of the view that the goods with respect to which the Applicants' mark are sought to be registered and the goods in class 9 with respect to which TMA No. 95650 "TELKOM" has been registered are of a similar description, in contravention of the provisions of section 15 (1) of the Trade Marks Act.

(b) Similarity between the marks in appearance and suggestion

The Applicants' trade mark is "TELCOM" while TMA No. 95650 is "TELKOM". It is apparent that the only difference between the trade marks is the letters "C" and "K". Further, the pronunciation of the two trade marks is identical.

¹ Bentley L, and Sherman B, *Intellectual Property Law* (3rd edn, Oxford University Press), 859

² 269 U. S. 372 (1926).

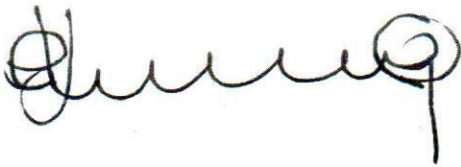
³ WIPO: *Intellectual Property Handbook: Policy, Law and Use*: (2nd edn, WIPO Publication 2004) 86.

In *SA LTJ Diffusion v SA Sadas Vertbaudet*,⁴ the European Court of Justice held that a sign is to be regarded as identical with a trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they could go unnoticed by the average consumer.

My view is that just adding letter "C" instead of letter "K" in the Applicants' mark makes the difference between the two marks to be "so insignificant that they so insignificant that they could go unnoticed by the average consumer".

For the above reasons, I agree with the contents of the letter dated 11th February 2022 from the Registry of Trade Marks. Your above trade mark cannot proceed to publication.

Yours faithfully

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

Eunice Njuguna
Assistant Registrar of Trade Marks

⁴ 2C-291/00.