

# KENYA INDUSTRIAL PROPERTY INSTITUTE



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Our Ref: T.M.A. NO. 119729

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

Your Ref: 0039109.00110

Hamilton Harrison & Mathews Advocates  
P.O. Box 30333 - 00100  
Nairobi

Dear Sirs

**T.M.A. NO. 119729 IN THE NAME OF MASTERMIND TOBACCO (K) LIMITED**

Refer to the above-mentioned matter and to your letter dated 29<sup>th</sup> March 2022.

It is noted that in a letter dated 23<sup>rd</sup> February 2022, the Registry of Trade Marks required you to enter a disclaimer of the right to the exclusive use of the device of a human being, 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 29<sup>th</sup> March 2022, you indicated that you were opposed to entry of a disclaimer with respect to the device of a human being for the following reasons, *inter alia*:

- (a) The Applicants' trade mark is distinctive of the goods in class 34 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; and
- (b) The Applicants are the holders of TMA No. 34496, TMA No. 34498 and TMA No. 34450, which contain the device of a human being that have been entered in the Register of Trade Marks with respect to goods in class 34 of the Nice Classification. The trade marks have been registered with effect from 1986 without a disclaimer of the right to the exclusive use of the device of a human being each, separately and apart from the mark as a whole.

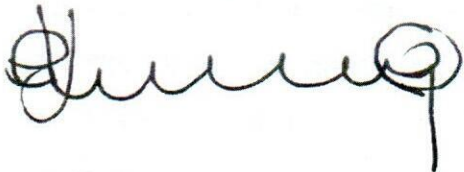
Upon consideration of this matter, I agree with the contents of your letter dated 29<sup>th</sup> March 2022 for the following reasons:

- (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; and
- (b) In *Discovery Holdings Limited v Sanlam Ltd & 2 Others*,<sup>1</sup> 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”.

Therefore, I conclude that:

- (a) Your application T.M.A No.119729 is hereby allowed to proceed to publication in accordance with the provisions of the Trade Marks Act; and
- (b) The Examination Report dated 23<sup>rd</sup> February 2022 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 human being separately and apart from the mark as a whole, is hereby revoked.

Yours faithfully



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

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<sup>1</sup> Case No. 8995/2012.