

# KENYA INDUSTRIAL PROPERTY INSTITUTE



KIPI Centre, Kabarsiran Avenue, Off Waiyaki Way, Lavington  
P.O. Box 51648-00200, Nairobi.  
Tel: 020-6002210/11, 6006326/29/36, 2386220  
Mobile: 0702002020, 0736002020  
E-mail: info@kipi.go.ke  
Facebook: @kipikenya, Twitter: @kipikenya  
www.kipi.go.ke

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## REPUBLIC OF KENYA

### IN THE MATTER OF THE TRADE MARKS ACT CAP 506 OF THE LAWS OF KENYA

#### AND

### IN THE MATTER OF TRADE MARK NO. 113655, “VALENTINO CAKE HOUSE” (WORD & DEVICE) IN THE NAME OF PETER KITONYO MWANZA

### AND EXPUNGEMENT PROCEEDINGS THERETO BY VALENTINE CAKE HOUSE LIMITED

### RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

#### INTRODUCTION

This is an application filed by Valentine Cake House Limited the Applicant for expungement, (hereinafter referred to as “the Applicant”) for expungement of T.M. No. 113655 “VALENTINO CAKE HOUSE” (word & device) registered in the name of Peter Kitonyo Mwanza, the registered proprietor, (hereinafter referred to as the Respondent).

#### BACKGROUND

On 2<sup>nd</sup> September 2020, Peter Kitonyo Mwanza filed an application to register their trade mark T.M.A. No. 113655 “VALENTINO CAKE HOUSE” (word & device). The application was filed in respect to goods in class 30 of the International Classification of Goods and Services as follows:

Class 30: Bread, cakes, cookies and preparations made from cereals.

The application was duly examined by the Registrar of trade marks in accordance with the provisions of the Trade Marks Act, Cap 506 of the Laws of Kenya and the mark was

approved for publication. The application was then published in the Industrial Property Journal No. 2021/03 of 31<sup>st</sup> March, 2021 at page 59. Upon expiry of the sixty-day statutory period, the mark was duly entered in the Register of trade marks and a Certificate of Registration issued to the Respondent.

On 4<sup>th</sup> August 2021, Valentine Cake House Limited through the firm of Kiingati Ndirangu & Associates filed an application for expungement of the mark “VALENTINO CAKE HOUSE” (word & device) from the Register of trade marks. The application comprised Form TM 25 together with statement of case. The grounds set out in the Form TM 25 were inter alia as follows:

- a) That the Applicant has an unregistered trade mark VALENTINE CAKE HOUSE which has been in use in relation to baking pastries and confectioneries since the year 2005.
- b) The Proprietor has caused to be registered VALENTINO CAKE HOUSE under Trade Mark Number 113655 dealing with baking of pastries and confectioneries.
- c) The application by the Proprietor for registration of the trade mark VALENTINO CAKE HOUSE was made in bad faith and with intent of passing off the goods of the Proprietor as those of the Applicant.
- d) The Proprietor’s mark “VALENTINO CAKE HOUSE” is so identical and similar to the products distributed, marketed and branded by the Applicant as VALENTINE CAKE HOUSE as to cause confusion and deception to the purchasing public.
- e) The Applicant has widely advertised and promoted its products under the mark VALENTINE CAKE HOUSE for over 15 years and the pastry products under the mark VALENTINE CAKE HOUSE are associated with the Applicant.
- f) The products bearing the Applicant’s Mark have been sold throughout Kenya for many years (since 2005) before the application to register the Offending Mark VALENTINO CAKE HOUSE was filed by the Proprietor. Consequently, the Applicant’s Mark was well known to the Kenyan public by the time of the Proprietor’s application for registration and the Applicant’s Mark was well known in Kenya as representing the above goods sold and distributed by the Applicant.

- g) The Applicant has created immense goodwill in Kenya and East Africa in the mark VALENTINE CAKE HOUSE and the Proprietor is seeking to ride on and take unfair advantage of the Applicant's goodwill.
- h) At the time when the Proprietor filed for registration of TM No. 113655 to register the Offending Mark VALENTINO CAKE HOUSE the Proprietor was aware of the existence of the mark VALENTINE CAKE HOUSE and its use on the pastry products sold and distributed by the Applicant and the fact that such goods bearing those marks had been sold in Kenya for many years prior to the filing of the said application. It was therefore no mere coincidence that the Proprietor registered the Offending Mark as a mark bearing a confusingly similar resemblance to the Applicants' Mark.
- i) The Proprietor was an employee of the Applicant in the year 2014 and was therefore fully aware of the existence of the mark VALENTINE CAKE HOUSE.
- j) The Proprietor's application to be registered was occasioned by a demand letter dated 25<sup>th</sup> June, 2020 issued by the Applicant to the Proprietor for the Proprietor to stop passing off his goods as those of the Applicant.
- k) The Applicant has no valid and justifiable claim to the offending mark and is not entitled to protection in a court of justice.
- l) The registration of the offending mark was fraudulent and unjustifiable.
- m) The offending mark is likely and has actually deceived and caused confusion to the members of the public due to its similarity visually and phonetically to the Applicants' mark.
- n) By reason of such use and the fact that the Offending Mark is confusingly similar to the Applicant's Mark when an application to register the Offending Mark was filed by the Applicant and the fact that the Offending Mark is to be used in pastry and related products there is a likelihood that confusion and deception will arise in the minds of members of the public in Kenya, who are likely to mistakenly assume that there is a connection in the course of trade between the Applicant's products and the Proprietor's products.
- o) The registration, use and existence of the Offending Mark was and still is therefore likely to impair, interfere with or take unfair advantage of the distinctive character

and reputation of the Applicants' Mark.

- p) The registration of the Offending Mark and its continued registration in the register was and still is contrary to the provisions of Articles 6 bis and 10 bis of the Paris Convention on Protection of Industrial Property and consequently the entry of the said mark on the Kenya register is an entry wrongly made and wrongly remaining in the Kenya register of trade marks having regard to the fact that Kenya has acceded to the above Convention and also having regard to the provisions of Sections 14, 15(1), 15A(1), and 15A(4) of the Trade Marks Act.
- q) The action of the Proprietor in registering the Offending Mark VALENTINO CAKE HOUSE which is visually and phonetically so similar to the mark VALENTINE CAKE HOUSE and which relates to the same goods as those covered by the marks VALENTINE CAKE HOUSE was mala fides and constitute unfair competition. For this reason and the other reasons set out in grounds above the Offending Mark should not have been registered. It is not entitled to remain on the Register and is not entitled to protection of a Court of Justice having regard to Sections 14, 15(1), 15A and 35 of the Trade Marks Act and Articles 6 bis and 10 bis of the Paris Convention for Protection of Industrial Property.
- r) Having regard to the grounds set out above the Offending Mark which is now registered as TM No 113655 was registered without sufficient cause and without due consideration of the likelihood of confusion and deception arising from its registration and it is not entitled to remain in the register.
- s) By reason of the matters stated above the Offending Mark should be expunged completely from the Register by way of expungement and rectification under Section 35(1) of the Trade Marks Act.

The Form TM 25 together with statement of case were duly forwarded to the Respondent vide a letter dated 18<sup>th</sup> August 2021. The Respondent was required to file its counter statement within 42 days from the date of receipt of the Form TM 25 and statement of case. The Respondent filed an application for extension of time for a period of 30 days. The extension of time was granted up to 28<sup>th</sup> November 2021 for the Respondent to file its counter statement. The Respondent did not file its counter

statement within the required timelines. The Registrar of Trade Marks vide a letter dated 17<sup>th</sup> February 2022 granted the Respondent a further period of 30 days to take a date in liaison with the Applicant's Advocates for the hearing of the matter. The Respondent did not make any response. The Registrar vide a letter dated 15<sup>th</sup> June 2022 requested the Applicant to file a statutory declaration to enable the Registrar consider the application.

On 16<sup>th</sup> September 2022, the Applicant filed its statutory declaration sworn by Matthew Gathua (Declarant), the Director of Valentine Cake House Limited who inter alia stated as follows:

1. THAT I am the Director of Valentine Cake House Limited, the Applicant herein, fully conversant with the facts of this case and duly authorized hence competent to make this declaration.
2. THAT I make this declaration in support of the expungement proceedings instituted by the Applicant against the trade mark VALENTINO CAKE HOUSE registered as TM No. 113655 (hereinafter "the Mark") in the Trade Marks Register and in the name of Peter Kitonyo Mwanza.
3. THAT I have been advised by our advocates on record that the mark VALENTINO CAKE HOUSE ought not to have been registered and ought not to remain on the register as the registration contravenes the provisions of Sections 14, 15A(1) and 15A(4) of the Trade Marks Act (hereinafter the Act).
4. THAT the mark VALENTINO CAKE HOUSE was registered under class 30 on 14<sup>th</sup> July, 2021.
5. THAT the Applicant was incorporated in 2005 under the name VALENTINE CAKE HOUSE LIMITED and has ever since then been having an unregistered trade mark VALENTINE CAKE HOUSE. The Declarant annexed a copy of certificate of incorporation marked as "MG 1".
6. THAT prior to the year 2005 I was baking cakes, pastries and confectionaries under the trade mark VALENTINE CAKE HOUSE.
7. THAT upon incorporation of the Company I continued trading under the same mark. I also selected the marketing theme of colour purple to distinguish our brand from

others.

8. THAT then I embarked on aggressive marketing of the brand through KISS FM since the year 2005. We have spent substantial resources in marketing and building the brand as this required giving a lot of giveaways.
9. THAT we continued building the brand by carrying out aggressive marketing and promotions through the social media platforms, radio, television, billboards among others. We have maintained active marketing throughout the years.
10. THAT in recognition of our brand and product quality we have received various accolades and awards. These include Cake Festival 2017; SOMA Award; Samantha Bridal; Wedding Cake Designer of the year 2019; Gold with Distinction Award (overall) 2016; Gold Standard Award Wedding Class Award 2017, Top 100 Mid-sized Companies 2019; Best Professional Bakers Award among others. The Declarant annexed photographs of various trophies they have won and certificates of recognition marked as “MG 2”.
11. THAT we have over the years opened various branches standing at 27 branches as at the time of filing this case. The Declarant annexed photographs of some shops marked as “MG 3”.
12. THAT the Applicant has been the sole manufacturer and distributor of the pastry products bearing the mark VALENTINE CAKE HOUSE in Kenya.
13. THAT the Applicant being the sole manufacturer and distributor of pastry products under the trade mark VALENTINE CAKE HOUSE in Kenya, has sufficient interest in this matter to give it locus standi within the provisions of Section 35 of the Act to bring these expungement proceedings.
14. THAT the Applicant has been making, advertising, selling and distributing its pastry products since the year 2005 under the purple colour scheme.
15. THAT the trade mark VALENTINE CAKE HOUSE is a well-known mark that involves the business of baking pastry and confectioneries, with greater focus on cakes.
16. THAT the Applicant has widely advertised and promoted the products under the trademark VALENTINE CAKE HOUSE and the trade mark is associated with the Applicant.
17. THAT the Applicant has established tremendous goodwill in the mark VALENTINE

CAKE HOUSE bearing the purple colour scheme and pastry products bearing the said mark are associated solely with the Applicant.

18. THAT sometimes in the year 2020, the Applicant discovered the presence of the trade mark VALENTINO CAKE HOUSE in the market, which also trades under a purple colour scheme whose business involves the making, selling and distributing similar products as the Applicant with a specialty in cakes.
19. THAT the Applicant, through its former advocate in the firm of Maina Rogoi & Co. Advocates issued a demand letter to the Proprietor to Cease and Desist using the trade mark VILLA VALENTINO CAKE HOUSE. The Declarant annexed a cease and desist letter dated 25<sup>th</sup> June 2020 marked as “MG 4”.
20. THAT following the said demand letter the Proprietor proceeded to register the Trade Mark VALENTINO CAKE HOUSE.
21. THAT the trade mark VALENTINO CAKE HOUSE is so similar and identical to the Applicant’s trademark VALENTINE CAKE HOUSE as to cause confusion and deception and has in fact caused confusion and deception in the eyes of the purchasing public. The Declarant annexed a screenshot of a query by one of the Applicant’s customers on social media marked as “MG 5”.
22. THAT the trade mark VALENTINO CAKE HOUSE is visually and phonetically similar to the trademark VALENTINE CAKE HOUSE that confusion and deception is likely to arise in the minds of the consumers.
23. THAT the goods covered by the trade mark VALENTINO CAKE HOUSE in class 30 are goods of the same character, nature and description as the goods which the trademark VALENTINE CAKE HOUSE is used.
24. THAT as a result, the Applicant has lost customers who purchase the Defendant’s products and services thinking that they are the Applicant’s.
25. THAT the aforesaid likelihood of confusion and deception disentitles the trademark VALENTINO CAKE HOUSE protection in our courts of justice.
26. THAT at the time of filing the application for registration of the trademark VALENTINO CAKE HOUSE the Proprietor was aware of the existence of the trade mark VALENTINE CAKE HOUSE and was seeking to create confusion and to gain unfair advantage by registering a trademark that closely resembles VALENTINE CAKE

HOUSE.

27. THAT the Proprietor was an employee of the Applicant in the year 2014/2015 and he thus registered the trade mark VALENTINO CAKE HOUSE with full knowledge of the business of the Applicant. The Declarant annexed copies of the Proprietor's pay slips marked as "MG 6".
28. THAT the application for registration of the trademark VALENTINO CAKE HOUSE was made in bad faith and with the intent of passing off the goods of the Proprietor as those of the Applicant.
29. THAT on the premise the Proprietor is not entitled to use or retain the registration of the trademark VALENTINO CAKE HOUSE.
30. THAT the registration and/ or use of the trademark VALENTINO CAKE HOUSE is likely to take and is in fact taking unfair advantage of the trademark VALENTINE CAKE HOUSE.
31. THAT the continued existence of the trademark VALENTINO CAKE HOUSE in the register is contrary to the provisions of Articles 6 bis and 10 bis of the Paris Convention of Industrial Property and its entry to the Kenya Industrial Property Institute (KIPI) register was erroneous and contrary to Sections 14, 15A (1) AND 15A (4) of the Act.
32. THAT in the circumstances it is just and fair that the application for expungement herein be allowed.
33. THAT I make this declaration conscientiously believing the same to be true and of my personal knowledge, save for what is declared on information and belief, sources and grounds whereof have been disclosed and in accordance with the Oath and Statutory Declarations Act.

### **RULING**

I have considered the application filed by the Applicant together with evidence adduced by way of the statutory declaration filed. I have also taken note of the Respondent's failure to file their counter statement as well as not defending the registration of its trade mark.



I have analysed the provisions of Rule 83 (b) of the Trade Marks Rules which stipulates as follows:

“The Registrar shall not rectify the register or remove the mark from the register merely because the registered proprietor has not filed a counter statement”

It is my considered view that Rule 83(b) of the Trade Marks Rules requires the Registrar of Trade Marks to consider the grounds on which the application to rectify the register is based in order to make a determination on whether the rectification is justified or not. There is thus need to consider the grounds filed which explain the basis for the expungement request.

As per the Applicant’s Form TM 25 and statement of case filed, the Applicant is seeking the expungement of the Trade Mark No. 113655 “VALENTINO CAKE HOUSE” (word & device) from the Register of trade marks. It is the Applicant’s view that the Offending Mark should be expunged completely from the Register by way of expungement and rectification under Section 35(1) of the Trade Marks Act.

Section 35(1) of the Trade Marks Act provides that any person aggrieved by the non-insertion in or omission from the register of an entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the court or, at the option of the applicant and subject to the provisions of section 53, to the Registrar, and the court or the Registrar may make such order for making, expunging or varying the entry as the court or the Registrar may think fit.

I am of the view that the following are the issues for determination in these expungement proceedings:

1. Is the Applicant an aggrieved person in accordance with the provisions of Section 35(1) of the Trade Marks Act?

2. Did the Respondent have a valid and legal claim to the mark “VALENTINO CAKE HOUSE” (word & device) before applying to register the same?
3. Was the Respondent’s mark “VALENTINO CAKE HOUSE” (word & device) registered without sufficient cause?

**1. Is the Applicant an aggrieved person in accordance with the provisions of Section 35(1) of the Trade Marks Act?**

The Applicant has in its Form TM 25 indicated that:

- a) the application by the Proprietor for registration of the trade mark VALENTINO CAKE HOUSE was made in bad faith and with intent of passing off the goods of the Proprietor as those of the Applicant.
- a) the Applicant has created immense goodwill in Kenya and East Africa in the mark VALENTINE CAKE HOUSE and the Proprietor is seeking to ride on and take unfair advantage of the Applicant's goodwill.

In *Saudia Arabian Airlines Corporation v Saudia Kenya Enterprises Limited*<sup>1</sup> it was stated that anyone in the same trade and dealing in the same articles as one who has wrongfully registered a trade mark is *prima facie* an aggrieved person. That anyone in the same trade who can show he wishes to trade in the same articles and would be hampered or impeded in his business or developing it by the existence of the registration of that mark is an aggrieved person.

In *Powell v Birmingham Vinegar Brewery Co Ltd*<sup>2</sup>, the Court held that an aggrieved person includes any person who may have his legal rights limited due to the fact that a mark ought not to be on the register of Trade Marks remains on the register.

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<sup>1</sup> [1986] eKLR

<sup>2</sup> (1894) A.C. 8

In the “*Daiquiri Rum*” *Trade Mark*<sup>3</sup>, Lord Pearce stated as follows:

“In my opinion, the words ‘person aggrieved’ were intended by the Act to cover all trade rivals over whom an advantage was gained by a trader who was getting the benefit of a registered trade mark to which he was not entitled...”

The learned author of Kerly’s Law on Trade Marks and Trade Names, 10<sup>th</sup> Edition, states as follows at page 203, paragraph 11-02

“The persons who are aggrieved are...all persons who are in some way or other substantially interested in having the mark removed ...from the register; including all persons who would be substantially damaged if the mark remained, and all the trade rivals over whom an advantage was gained by a trader who was getting the benefit of a registered trade mark to which he was not entitled.”

In *Health World Ltd v Shin-Sun Australia Pty Ltd*<sup>4</sup>, the Court defined an aggrieved person to include the person who would be concerned about the purity of the Register of Trade Marks that contains an accurate record of trade marks which are capable of performing their statutory duty of indicating “the trade origins of the goods to which it is intended that they be applied.” The persons aggrieved are unlike the persons who would want to make an application to rectify the Register of Trade Marks as busybodies who have no interest in the purity of the Register and would make such an application to gratify “an intellectual concern”.

In *Paine and Co. v Daniells & Sons Breweries*<sup>5</sup>, it was stated that where the attention of the court is drawn to the registration of a mark whose entry to the register cannot be justified in law, then the applicant qualifies as an aggrieved person. (Emphasis added).

The Applicant has in its statutory declaration indicated that the Proprietor in registering the Offending Mark “VALENTINO CAKE HOUSE” which is visually and phonetically so

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<sup>3</sup> [1969] RPC 600 at 615

<sup>4</sup> [1946] HCA 29; (1946) 75 CLR 487

<sup>5</sup> Reports of Patent, Design and Trade Mark Cases, Volume 10, Issue 8, 29 March 1893, Pages 71 83.

similar to the mark “VALENTINE CAKE HOUSE” and which relates to the same goods as those covered by the mark VALENTINE CAKE HOUSE was mala fides and constitute unfair competition.

In its Form TM 25, the Applicant has indicated that the offending mark is likely and has actually deceived and caused confusion to the members of the public due to its similarity visually and phonetically to the Applicant’s mark.

It is my view that the Applicant herein has an interest in seeking to ensure the purity of the Register of Trade Marks in Kenya. Guided by the above cited decisions, legal reasoning and the grounds relied on by the Applicant, I find that the Applicant is an aggrieved person and has the locus standi to initiate these expungement proceedings under the provisions of Section 35(1) of the Trade Marks Act.

**2. Did the Respondent have a valid and legal claim to the mark “VALENTINO CAKE HOUSE” (word & device) before applying to register the same?**

The Respondent is the registered proprietor of T.M. No. 113655 “VALENTINO CAKE HOUSE” (word & device) which the Applicant seeks to expunge from the Register of Trade Marks. The Applicant is of the view that the trade mark VALENTINO CAKE HOUSE is so similar and identical to the Applicant’s trade mark VALENTINE CAKE HOUSE as to cause confusion and deception and has in fact caused confusion and deception in the eyes of the purchasing public. In addition, the Applicant has stated that the trade mark VALENTINO CAKE HOUSE is visually and phonetically similar to the trade mark VALENTINE CAKE HOUSE that confusion and deception is likely to arise in the minds of the consumers. That the goods covered by the trade mark VALENTINO CAKE HOUSE in class 30 are goods of the same character, nature and description as the goods which the trade mark VALENTINE CAKE HOUSE is used and that as a result, the Applicant has lost customers who purchase the Defendant’s products and services thinking that they are the Applicant’s.

In assessing the similarity of the marks in question, the Respondent's mark is "VALENTINO CAKE HOUSE" (word & device), while the Applicant's trade mark is "VALENTINE CAKE HOUSE" (word & device). I have taken into consideration the Applicant's use of its mark from the year 2005 and the evidence attached thereof in support of use.

In the *Pianotist's Application 3 (1906) 23 R.P.C 774 at 777*, Parker J stated that when determining similarity between two trade marks, it is important to consider the way the two trade marks look and sound, the goods in respect of which the two trade marks would be applied as well as the nature of the purchasers of the respective goods.

It was also held in *Allen Brothers, Inc. v AB Foods LLC No. 06 C 1269*, that in comparing two marks to determine their similarity, courts must make the comparison "in light of what happens in the marketplace and not merely by looking at the two marks side-by-side."

Further, in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V 5 C-342/97*, it was stated that in order to assess the degree of similarity between the marks concerned, the court must determine the degree of visual, aural or conceptual similarity between the marks and, where appropriate, evaluate the importance to be attached to those different elements, taking into account the category of goods or services in question and the circumstances under which they are marketed.

### **Strength of the Earlier Mark**

The Applicant in its Statutory Declaration provided evidence, which indicates that the Applicant has been using its trade mark in Kenya before the Respondent's mark was filed for registration on 2<sup>nd</sup> September, 2020. Annexure "MG1" is a Certificate of Incorporation for VALENTINE CAKE HOUSE LIMITED", which was incorporated in 2005. Annexures "MG2" consist of various accolades and awards issued to the Applicant in the years 2014, 2016, 2017, 2018 and 2019.

On the other hand, while the Respondent did not file any evidence of use of its trade mark in these proceedings, it is apparent that the application for registration of its trade mark was filed on 2<sup>nd</sup> September, 2020. This is about fifteen (15) years after the Applicant had put to use its trade mark in the Kenyan market. I am therefore persuaded that the Applicant's trade mark is the earlier mark in these proceedings.

From the evidence adduced by the Applicant herein, it cannot in my view, be a mere coincidence that the Respondent registered a trade mark that was confusingly similar to that of the Applicant and with respect to an identical description of goods as those in relation to which the Applicant has used its trade mark in Kenya. Further, the Applicant has adduced evidence by way of Annexure "MG6" being pay slips which show that the Respondent was an employee of the Applicant in the years 2014/2015 and as such, he had inside knowledge of the Applicants' business and trade mark. This fact was not controverted by the Respondent, as he did not file a counter statement or evidence to defend registration of its trade mark.

Having considered the relevant factors, while comparing the two marks, I am of the view that the Respondent's and Applicant's trade marks are confusingly similar in appearance.

In considering the goods, the Respondent's mark is registered in respect to goods in class 30 of the International Classification of Goods and Services covering Bread, cakes, cookies and preparations made from cereals. The Applicant indicated that it has an unregistered trade mark VALENTINE CAKE HOUSE which has been in use in relation to baking pastries and confectioneries since the year 2005.

It is therefore clear that the goods relating to the Applicant's marks and the Respondent's mark are goods of a similar nature and description.

The provisions of Section 20(1) of the Trade Marks Act provide as follows:

"A person claiming to be the proprietor of a trade mark used or proposed to be

used by him who is desirous of registering it shall apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the register”.

The author of the book Kerly’s Law on Trade Marks, 12<sup>th</sup> Edition, page 28 at paragraph 4-02 states inter alia:

“...it would seem to be settled that the claim must be in some sense a justified one, if the registration is to stand; whether by virtue of the section or under its general jurisdiction, the court will expunge a registration if the applicant for it could not in good faith make this claim”.

In essence, before making an application for registration of a mark before the Registrar of Trade Marks, an Applicant must have a valid and legal claim as the proprietor or owner of the mark.

Kerly’s Law on Trade Marks, 14<sup>th</sup> Edition, page 8 paragraph 2-002 states as follows: “A trade mark is (or should) a badge of origin. In other words, it indicates the source of the trade origin of the goods or services in respect of which it is used. A trade mark may do other things as well, but it must act as a badge of origin.”

Based on the evidence adduced by the Applicant, I hold that the Respondent did not have a valid and legal claim to the mark “VALENTINO CAKE HOUSE” (word & device) before applying to register the same in accordance with the provisions of Section 20(1) of the Trade Marks Act.

**3. Was the Respondent’s mark “VALENTINO CAKE HOUSE” (word & device) registered without sufficient cause?**

It is the Applicant’s view that the Offending Mark which is now registered as TM No. 113655 was registered without sufficient cause and without due consideration of the likelihood of confusion and deception arising from its registration and it is not entitled to remain in the register. The Applicant stated that the Offending Mark should be

expunged completely from the Register by way of expungement and rectification under Section 35(1) of the Trade Marks Act. The Applicant also indicated that the offending mark is likely and has actually deceived and caused confusion to the members of the public due to its similarity visually and phonetically to the Applicants' mark.

Having made an analysis on issue 2 above on whether the Respondent had a valid and legal claim to the mark "VALENTINO CAKE HOUSE" (word & device) before applying for registration and having considered the issue raised on deception and confusion, I am of the view that the Respondent's mark was registered without sufficient cause.

### **DECISION**

For the reasons set out above and having taken into account all the circumstances of the case, I rule as follows:

- 1) The Applicant has succeeded in these expungement proceedings;
- 2) The Applicant is an aggrieved person and has the locus standi to initiate these expungement proceedings;
- 3) The Respondent's mark "VALENTINO CAKE HOUSE" (word & device) was entered in the Register of Trade Marks without sufficient cause;
- 4) The Register of Trade Marks is hereby rectified by expunging Trade Mark No. 113655 "VALENTINO CAKE HOUSE" (word & device) from the Register of Trade Marks;
- 5) I make no order as to costs.

**Ruling delivered this 30<sup>th</sup> day of August 2024**



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**CONCILIA WERE**  
**ASSISTANT REGISTRAR OF TRADE MARKS**