
**IN THE MATTER OF THE TRADE MARKS ACT, CAP 506 OF THE LAWS OF
KENYA**

AND

**IN THE MATTER OF T.M.A NO. 102469 “Hollandia” (STYLIZED WORD) IN
CLASSES 29 AND 32 IN THE NAME OF EUROPEAN REFRESHMENTS AND
OPPOSITION PROCEEDINGS THERETO BY HAPPY COW LIMITED**

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

Background

On 6th June 2018 European Refreshments (hereinafter referred to as “the Applicant”) filed an application to register the mark T.M.A No. 102469 “*Hollandia*” (stylized word). The application was filed in respect to goods in classes 29 and 32 of the International Classification of Goods and Services. The goods were as follows:

Classes	Goods
29	Milk, flavored milk evaporated milk, protein milks, soya milk, milk and yoghurt based beverages, yoghurt, drinking yoghurts, yoghurts drinks, flavoured yoghurt drinks, maize (mageau) drink, mageau based drinks.
32	Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

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. By a letter dated 15th August 2018, the Trade Marks Examiner issued a refusal notice stating that the mark is similar to another mark existing in the Trade Marks register with the following particulars:

TM. No. 92033 “**HOLLANDER**” (word) in class 29 in respect to Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats. The mark is registered in the name of Happy Cow Limited and is subsisting in the register for a period of 10 years as from 28th April 2016. I wish to emphasize that in the Examiner’s letter, the Examiner indicated, “it has been refused registration (especially so in class 29)”.

The Applicant through a letter dated 14th November 2018, filed written submissions against the Examiner’s refusal notice and requested the Registrar to consider the submissions and allow the Applicant’s application to proceed to publication. The Trade Marks Examiner considered the submissions and through a letter dated 25th November 2018, issued an approval allowing the application to proceed to publication in the Industrial Property Journal for good in classes 29 and 32. The Application was published in the Industrial Property Journal of 31st January, 2019 at page 42.

On 23rd May 2019, Happy Cow Limited (hereinafter referred to as “the Opponent”) filed a notice of opposition against registration of the Applicant’s trade mark citing inter alia, the following grounds:

1. The Opponent is the sole and lawful proprietor of the trade mark “**HOLLANDER**” in Kenya and Uganda. The Opponent’s “**HOLLANDER**” trade mark is registered in Kenya under class 29 of the NICE Classification as trade mark registration number 92033.

2. The Opponent is engaged in the production and distribution of an extensive range of dairy products, which include cheeses, yoghurts, cream, kefir, fresh milk, butter, ghee, custards among others in Kenya and Uganda. The Opponent uses its “HOLLANDER” trade mark on its dairy products which are sold in various shopping outlets across Kenya such as Carrefour, Quick Mart, Shoprite, Tuskys, Peter Mulley’s among others.
3. The Opponent’s “HOLLANDER” trade mark originates from the Opponent’s strong links and association with Holland, since its inception in 1996. These links are backed by the Opponent importing most of its equipment and ingredients (besides the milk and packaging) from the Netherlands as well as the Opponent receiving Dutch dairy experts who provide regular technical support, which enables the Opponent produce high quality dairy products. This association is similarly reflected in other company trade marks which include trade mark registration number 61371 “RED HOLLAND” and trade mark application number 104661 “CHEESE MARKERS FROM HOLLAND”.
4. The “HOLLANDER” trade mark was therefore designed specifically for the Opponent and for use on its products. The Opponent is in the process of converting to “HOLLANDER” as its primary brand name in place of its existing brands.
5. The Opponent’s “HOLLANDER” trade mark was registered in Kenya with effect from 28th April, 2016. The Offending mark was filed by the Applicant on 6th June, 2018 and is not trading in the Kenyan market.
6. The Opponent is aware that the trade mark application number 102469 “HOLLANDIA” in class 29 was refused registration upon examination of the application, on grounds that it was confusingly similar to the “HOLLANDER” trade mark and later allowed registration following an appeal, by the Applicant, to the refusal notice. Some of the incorrect arguments for this appeal include:

- a) *HOLLANDER being a dictionary definition of someone being a native from the Netherlands.* The correct dictionary definition of a native of the Netherlands would be Dutch.
- b) *Both marks being accepted for registration in Uganda without any objection or any reference to each other.* The Opponents mark was in fact rejected for registration in Uganda on the basis that the mark was confusingly similar to that of “**HOLLANDIA**”. Similarly, the Opponent’s mark “**HOLLANDER**” was also rejected in Nigeria (home country of “**HOLLANDIA**”) on the same basis: that the marks were confusingly similar.

Accordingly, the Opponent wishes to object the appeal as well as the approval for registration of the Offending mark on the grounds set out in this Notice.

- 7. The Opponent already enjoys substantial goodwill in its reputation under the “**HOLLANDER**” trade mark having launched the same in various markets in Kenya and Uganda.
- 8. The Offending mark is confusingly similar to the Opponent’s “**HOLLANDER**” trade mark phonetically, visually and conceptually; and will certainly cause significant confusion and deception in the market, as to the source of goods. Such likelihood of confusion and deception disentitles the Opponent’s “**HOLLANDER**” trade mark protection in law.
- 9. Visually, the Offending mark “**HOLLANDIA**” consists of the dominant portion of the Opponent’s “**HOLLANDER**” trade mark. It is likely that consumers will immediately note the common visual feature. Additionally, both marks are word based and are in black font, only being differentiated by Italics which is not sufficient to differentiate a mark.
- 10. When pronounced, the word **HOLLAND** is prominent in the Opponent’s “**HOLLANDER**” trade mark. The mark “**HOLLANDIA**” is likely to be pronounced “**HOLLANDER**”. When used as part of a sentence at the point of sale or distribution, the offending mark is likely to sound like the dominant part of the Opponent’s “**HOLLANDER**” trade mark.

11. A number of languages are spoken in Kenya and it is likely that there will be various accents and also mispronunciations when the marks “HOLLANDER” and “HOLLANDIA” are pronounced. This factor is likely to increase confusion at the point of sale.
12. The Offending mark is a reproduction of the major part of the Opponent’s “HOLLANDER” trade mark.
13. The Offending mark is conceptually similar to the Opponent’s “HOLLANDER” trade mark as they are both coined terms to reflect association with Holland.
14. The Offending mark is sought to be registered in relation to goods in class 29, goods that are identical to the goods for which the Opponent’s “HOLLANDER” trade mark is registered in Kenya.
15. The Offending mark is therefore likely to be associated with the Opponent’s “HOLLANDER” trade mark in the course of trade.
16. Application number 102469 “HOLLANDIA” is a mark that is identical with or so nearly resembles the Opponent’s “HOLLANDER” trade mark, a trade mark that is the subject of an earlier registration 92033 and that is registered in respect of the same goods or description of goods in class 29. Application 102469 is therefore contrary to Section 15(1) of the Trade Marks Act (Chapter 506, Laws of Kenya).
17. Application number 102469 “HOLLANDIA” consists of matter, the use of which would, by reason of its being likely to deceive or cause confusion, be disentitled to protection in a Court of Justice and contrary to law. Application number 102469 “HOLLANDIA” is therefore contrary to Section 14 (1) Trade Marks Act (Chapter 506, Laws of Kenya).
18. Arising from what is stated in the preceding paragraphs, there is likelihood that members of public may be confused or deceived into

mistakenly purchasing the Applicant's goods bearing the Offending mark thinking that they are goods manufactured by the Opponent.

19. The Applicant is very likely to take unfair advantage of the Opponent's goodwill and reputation in the market to advance its products.

20. The Offending mark should therefore be refused registration under section 14 and 15 of the Trade Marks Act (Chapter 506, Laws of Kenya) since allowing the same in favour of the Applicant is likely to interfere or take unfair advantage of the Opponent's trade mark **"HOLLANDER"**.

21. Consumers rights with respect to clear and concise distinction in identity of the parties' products will be adversely affected by the uncanny similarity in the trade marks and there is real likelihood that the average consumer in Kenya will confuse the parties' products or their origin.

WHEREFORE the Opponent prayed:

- a) that Trade Mark Application number 102469 "HOLLANDIA" in class 29 be refused registration under section 14 and 15 of the Trade Marks Act (Chapter 506, Laws of Kenya); and
- b) that the costs of these proceedings be awarded to the Opponent.

The notice of opposition was duly forwarded to the Applicant vide a letter dated 6th June 2019 and the Applicant filed its counter statement on 18th July 2019 stating inter alia, as follows:

- 1. Save as where otherwise admitted herein, the Applicant does not admit any of the allegations made in the Notice of Opposition and puts the Opponent to strict proof thereof.
- 2. The Applicant is a wholly owned subsidiary of The Coca-Cola Company ("TCCC") which is the world's leading beverage company. Established in the year 1919, TCCC, either itself or through its subsidiaries, affiliates, licensees etc. is today present in more than 200 countries around the

world and owns and uses a number of well-known brands for different kinds of beverages such as COCA-COLA, FANTA and SPRITE to name a few.

3. The **“HOLLANDIA”** trade mark was registered in Nigeria on 4th June 1998 and has been used in Nigeria by the Applicant’s wholly owned subsidiary Chi Limited for more than twenty (20) years. The mark since then has been constantly used for numerous products and has gained noteworthy fame and reputation. Such substantial fame and reputation has also likely spilled over in the rest of Africa in view of extensive and consistent use. Therefore, **“HOLLANDIA”** has already acquired distinctiveness as a well-known brand.
4. The Applicant’s mark **“HOLLANDIA”** is intended to be used and launched under the umbrella of products and marks owned by The Coca-Cola Company or its subsidiaries and/or affiliates which further defeats any arguable possibility of confusion with the Opponent’s **“HOLLANDER”** trade mark, contrary to the allegations made in paragraph 4.1 of the Notice of Opposition.
5. The Applicant categorically denies the allegations contained in paragraph 3.8 of the Notice of Opposition that the mark **“HOLLANDIA”** is confusingly similar to **“HOLLANDER”** in any way. Phonetically, the two marks are pronounced very differently. While the two marks share a common prefix **“HOLLAND”** which is frequently used informally to refer to the whole of the country of the Netherlands, it should be borne in mind that this element is not the trade mark under comparison. The difference in the two trade marks lies in the very distinctive suffixes i.e. **“IA”** and **“ER”** which are pronounced differently. When looked at as a whole, each mark has a different pronunciation and does not enjoy any exclusive rights over the name **“HOLLAND”**.
6. It is not unusual for trade marks to share certain common sounds but it does not necessarily make them similar. The following trade marks which

are registered in Kenya share a common sound/element yet they were not deemed to be confusingly similar:

No.	FIRST MARK	SECOND MARK
a)	TM No. 24530 "LIMARA" in Class 3	TM No. 74510 "AMARA" in Class 3
b)	TM No. 73662 "ENDURANCE" in class 12	TM No. 1063553 "ENDURACE" in class 12
c)	TM No. 71185 "ECO" in class 30	TM No. 63612 "EKKO" in class 30
d)	TM No. 67484 "AMOLIN" in class 5	TM No. 19403 "AMOXIL" in class 5
e)	TM No. 65334 "& BEYOND (WORD)" in classes 39 and 43	TM No. 903560 "BEYOND" in class 39

7. Contrary to the Opponent's claims in paragraph 3.9 of the Notice of Opposition, the two marks are visually different and are incapable of causing confusion in the market. The two marks bear very different, distinct and stylistic fonts as shown below:

Applicant's Mark	Opponent's Mark
	HOLLANDER

8. Contrary to the Opponent's claims in paragraph 3.13 of its Notice of Opposition, conceptually, the Applicant contends that there is no similarity between the two marks. According to the Oxford Dictionary 10th Edition, the word "**HOLLANDER**" means "*A native of the Netherlands*" While "**HOLLANDIA**" is merely a coined word with no known meaning in English. The alleged conceptual similarity is therefore nil.

9. In the absence of all known parameters of similarity, i.e. *visual, phonetic or conceptual*, jurisprudentially the two marks cannot be said to be similar. They should therefore be allowed to co-exist.
10. The Applicant asserts that it is a stranger to the contents of paragraph 3.6.2 and the Opponent is put to strict proof thereof.
11. Contrary to the Opponent's claims in paragraph 3. 7 of the notice of opposition, the Applicant is not aware of any goodwill or reputation associated with the Opponent's mark in the market and will put the Opponent to strict proof thereto. The Applicant denies that the Opponent has acquired a reputation in Kenya as the Opponent has not used the "HOLLANDER" mark in Kenya in relation to any of the goods or services since its trade mark registration in 2016 and as such there is no likelihood of confusion and/or deception arising in the minds of the public, as a result of the Applicant's use and registration of the Trade Mark.
12. The contents of paragraph 3.11 of its Notice of Opposition are merely speculative. The Applicant is not aware of any Kenyan accents that would lead to a mispronunciation of "HOLLANDER" and "HOLLANDIA" and will put the Opponent to strict proof thereto. It is virtually impossible to mispronounce the operative portions of the two marks- "NDER" and "NDIA".

WHEREFORE, for the reasons stated above, the Applicant prayed that:

- a) the Opponent's Notice of Opposition to the registration of the Applicant's trade mark be dismissed;
- b) the registration of the Applicant's trade mark be allowed; and
- c) the costs of these proceedings be awarded to the Applicant.

The counter statement was duly forwarded to the Opponent vide a letter dated 24th July 2019. On 9th October 2019, the Opponent filed its statutory declaration

sworn by Catherine Kibue, a Director of Happy Cow Limited, who stated that she was authorized by the Opponent to make the statutory declaration on its behalf and stated as follows:

1. That the facts set out in the statutory declaration are either within her personal knowledge or are taken from continuous records of the Applicant (Opponent in my view) that are accurately maintained under their supervision and control and to which she has full access.
2. That she makes the declaration from her personal knowledge of the trading activities of the Opponent, information available to her and the records of the Opponent which are available to her in her capacity as the Director of the Opponent.
3. THAT she confirms that she has read the Opponent's Notice of Opposition dated 23rd May, 2019 the Opponent's Counter Statement dated 18th July, 2019 and that she is aware of the full background of these opposition proceedings.
4. THAT the Opponent was founded in 1994 and is a fully-fledged dairy processor focused on producing a diverse portfolio of quality, value added dairy products. The Opponent's portfolio mainly consists of cheese and fermented milk products, distributed to leading retail and food service institutions nationwide and across East Africa.
5. The Opponent is engaged in production and distribution of an extensive range of dairy products, which include cheeses, yoghurts, cream, kefir, fresh milk, butter, ghee, custards among others in Kenya.
6. THAT the Opponent is the sole lawful and registered proprietor of trade mark "HOLLANDER" in Kenya. The Opponent registered its trade mark "HOLLANDER" in Kenya on 28th April 2016 under class 29 of the NICE Classification as trade mark registration no. 92033. The Declarant

attached annexure CK1 being a certified copy of certificate of registration of trade mark **“HOLLANDER”**.

7. The Opponent’s **“HOLLANDER”** trade mark originates from the Opponent’s strong links and association with Netherlands, since its inception in 1994. These links are backed by the Opponent importing most of its equipment and ingredients (besides the milk and packaging) from the Netherlands as well as the Opponent receiving Dutch dairy experts who provide regular technical support, which enables the Opponent produce high quality dairy products. This association is similarly reflected in other company Trade Marks which include Trade Mark registration number 61371 **“RED HOLLAND”** and Trade Mark application number 104661 **“CHEESE MARKERS FROM HOLLAND”**. The Declarant attached annexure CK2 being certified copy of communication between the Opponent and affiliates from Netherlands and Netherlands Embassy, certificate of registration for trade mark **“RED HOLLAND”** and certified copy of trade mark application for registration of **“CHEESE MARKERS FROM HOLLAND”** together with approval notice.
8. THAT the **“HOLLANDER”** trade mark was therefore designed specifically for the Opponent and for use on its products. The Opponent is in the process of converting to **“HOLLANDER”** as its primary brand name in place of its existing brands.
9. THAT the Opponent uses its **“HOLLANDER”** trade mark in branding its dairy products which it markets and distributes for sale in various shopping outlets across Kenya such as Carrefour, Quick mart, Shoprite, Tuskys, Peter Mulley’s among others. The Declarant attached annexure CK3 being certified copies of invoices for sale of the Opponent’s products, certified copies of purchase orders for labels for the Hollander mark to be used on the Opponent’s products and certified copies for invoices for packaging and branding materials.

10. THAT the marketing and sale of the Opponents products under its “HOLLANDER” trade mark has been carried out in Kenya and consequently enjoys the good will and reputation that has been garnered by the Opponent as a well-known and recognized processor and supplier of dairy products in Kenya since its inception in 1994.
11. THAT the Opponent is aware that on 6th June, 2018 the Applicant applied for registration of trade mark, Trade Mark application number 102469 “HOLLANDIA” in class 29 (the “Offending Mark”), and that the Offending Mark was refused registration upon examination of the application, on grounds that it was confusingly similar to the “HOLLANDER” Trade Mark. The Declarant attached annexure CK4 being certified copy of the refusal notice for the Offending Mark dated 15th August, 2018.
12. THAT the Opponent is aware that the Offending Mark was later approved for advertisement following an appeal, by the Applicant, to the refusal notice. The Declarant attached annexure CK5 being certified copy of the Approval notice together with a copy of the Appeal dated 14th November, 2018.
13. THAT the Opponent wishes to object the appeal as well as the approval for registration of the Offending mark on the grounds set out in the Opponent’s Notice of Opposition dated 23rd May, 2019 together with this declaration.
14. That the Opponent’s mark was rejected for registration in Uganda on the basis that it is confusingly similar to the mark “HOLLANDIA”. Similarly, the Opponent’s mark “HOLLANDER” was also rejected in Nigeria, which is the home country of the Offending mark, on the same basis that it was confusingly similar to the mark “HOLLANDIA”. The Declarant attached annexure CK6 being the certified copy application for registration of trade mark Hollander in Uganda and Nigeria and refusal notices respectively.

Response to Applicant's Counter statement

15. THAT in response to paragraph 3 of the Applicant's Counter statement, the Opponent reiterates the contents of its Notice of Opposition and this declaration.

16. THAT the Opponent asserts that it is a stranger to the contents of paragraph 4.1 of the Applicant's Counter statement and the Applicant is put to strict proof thereof.

17. THAT in response to paragraph 4.2 of the Applicant's Counter statement the Opponent denies that the Offending Mark has acquired distinctiveness as a well-known brand in Kenya.

18. THAT in response to paragraph 4.3 of the Applicant's Counter statement the Opponent asserts and reiterates the contents of paragraph 3.14 and 4.1 of its Notice of Opposition. The Opponent further denies the averments by the Applicant under paragraph 4.3 and asserts that the Offending Mark is applied for registration of goods in class 29, which goods are similar to the goods for which the Opponent registered its "HOLLANDER" trade mark. The Opponent is aware that the Offending Mark has been used by Chi Limited, the Applicant's subsidiary, in dairy products which products are similar and identical to the ones on which the Opponent uses its "HOLLANDER" trade mark in the Kenyan market. Particularly, the products that Applicant's subsidiary has used the Offending Mark in the below listed products:

- Hollandia Yoghurt
- Hollandia Evaporated Milk
- Hollandia ChocoMalt Drink
- Hollandia Soya Milk
- Hollandia Milk
- Hollandia ready to eat custard

The Declarant attached annexure CK7 being photos of similar goods bearing the Hollander and Offending mark. These photos and products on which the marks are used are accessible in the Opponent's website at <https://happycowkenya.com/portfolio/yoghurt/> and the Applicant's subsidiary Chi Limited at <https://www.houseofchi.com/brands/hollandia-yoghurt/>).

19. THAT the goods covered by the Offending mark which the Applicant is attempting to register are identical to and/ or are goods of the same character, nature or description as to the goods which the Opponent's "HOLLANDER" trade mark is use. More specifically, the goods are dairy products and are sold in the same trade channels such as supermarkets and general trade shop outlets and particularly placed on the same shelves for dairy products. These goods are also sold to the same customers hence likely to cause confusion and deception arising in the minds of all members of the public if the Offending mark is allowed to proceed to registration and use in the Kenyan market.
20. THAT in response to paragraph 4.4 of the Applicant's Counter statement, the Opponent asserts that the Offending mark which the Applicant is attempting to register so closely resembles the Opponent's mark phonetically, visually and conceptually and will certainly cause significant confusion and deception in the market as to the source of goods. The Opponent further reiterates the contents of paragraph 3.8, 3.10, 3.11 and 3.12 of its Notice of Opposition.
21. THAT in response to paragraph 4.5 of the Applicant's Counter statement, the Declarant is advised by the Opponent's Advocates on record whose advice she verily believes to be true that Section 14 and 15 of the Trade Marks Act, Laws of Kenya prohibits registration of trade mark which would for any reason cause deception or likelihood of confusion to members of the public due to similarity or close resemblance to an already registered trade mark.

22. THAT in response to paragraph 4.6 of the Applicant's Counter statement, the Opponent reiterates the contents of paragraph 3.9 of its Notice of Opposition. Additionally, the Offending mark and the Opponent's "HOLLANDER" mark appear on the same products which are dairy products such as yoghurts hence would cause confusion to purchasers. The products would appear related and produced by the same processor.

23. THAT in response to paragraph 4. 7 of the Applicant's Counter statement, the Opponent denies the Applicant's averments and reiterates the contents of paragraph 3.13 of its Notice of Opposition. The Opponent further contends that the Hollander definition the Applicant is referring to is a dated definition that is no longer in current use. The Opponent contends that the word Hollandia is not a coined term and has been defined as follows:

Hollandia: Hungarian and Polish translation of 'The Netherlands'.(source <https://en.bab.la/dictionary/Hungarian-english/hollandia>; <https://en.bab.la/dictionary/polish-english/holandia>).

24. THAT the Opponent further reiterates conceptual similarity as both names refer to association with The Netherlands in one way or another, particularly in the context of the Netherlands being globally renowned for good quality dairy products which have a positive connotation; as well as both the Opponent and Applicant's subsidiary, from where the Offending Mark originates, having Dutch founders.

25. THAT in response to paragraph 4.8 of the Applicant's Counter statement, the Opponent reiterates the contents of the Opponent's Notice of Opposition and this declaration.

26. THAT in response to paragraph 4.9 of the Applicant's Counter statement, the Opponent reiterates the contents of paragraph 15 of this declaration.

27. THAT in response to paragraph 4.10 of the Applicant's Counter statement, the Opponent reiterates the contents of paragraphs 5,6, 10 and 11 of this declaration. The Opponent's "HOLLANDER" trade mark enjoys the good

- will and reputation that has been garnered by the Opponent as a well-known and recognized processor and supplier of dairy products in Kenya since 1994. The use of the Offending mark in the Kenyan market will interfere with the Opponent's reputation in its dairy products.
28. THAT in response to paragraph 4.11 of the Applicant's Counter statement, the Opponent reiterates the contents of paragraph 3.11 of its Notice of Opposition.
29. THAT the Offending mark is identical with or so nearly resembling the Opponent's "HOLLANDER" trade mark, which trade mark is subject of an earlier registration number 92033 and is registered in respect of the same goods or description of goods in class 29. Application for registration of the Offending mark is therefore contrary to Section 15(1) of the Trade Marks Act, Laws of Kenya.
30. THAT the Declarant is advised by the Opponent's advocates on record, whose advice she verily believes to be true that Application number 102469 "HOLLANDIA" consists of matter, the use of which would, by reason of its being likely to deceive or cause confusion, be disentitled to protection in a Court of Justice and contrary to law. Application number 102469 "HOLLANDIA" is therefore contrary to Section 14(1) Trade Marks Act (Chapter 506, Laws of Kenya).
31. THAT arising from what is stated in the preceding paragraphs and the Opponent's Notice of Opposition, there is likelihood that members of public may be confused or deceived into mistakenly purchasing the Applicant's goods bearing the Offending mark thinking that they are goods manufactured by the Opponent.
32. The Applicant is very likely to take unfair advantage of the Opponent's goodwill and reputation in the market to advance its products.
33. THAT the Declarant is advised by the Opponent's advocates on record, whose advice she verily believes to be true, the Offending mark should

therefore be refused registration under section 14 and 15 of the Trade Marks Act (Chapter 506, Laws of Kenya) since allowing the same in favour of the Applicant is likely to interfere or take unfair advantage of the Opponent's trade mark "HOLLANDER".

34. THAT consumers' rights with respect to clear and concise distinction in identity of the parties' products will be adversely affected by the uncanny similarity in the trade marks and there is real likelihood that the average consumer in Kenya will confuse the parties' products or their origin.

35. THAT the Declarant makes this statutory declaration in accordance with the provisions of the Kenya Oaths and Statutory Declarations Act and states that all the contents herein are true to the best of her knowledge, information and belief.

Reasons wherefore the Opponent prayed:

- a) THAT Trade Mark Application number 102469 "HOLLANDIA" in class 29 be refused registration under Section 14 and 15 of the Trade Marks Act (Chapter 506, Laws of Kenya); and
- b) THAT the costs of these proceedings be awarded to the Opponent.

The Opponent's statutory declaration was forwarded to the Applicant vide a letter dated 15th October 2019 who filed its statutory declaration on 23rd January 2020. The statutory declaration was sworn by Una Sheils, the Director of European Refreshments who stated inter alia, as follows:

- 1. The Declarant is a Director of European Refreshments, (the "Applicant") and duly authorized by the Applicant to make this statutory declaration on its behalf in support of the Applicant's application to register Trade Mark Application Number 102469 "HOLLANDIA" in Class 29 (the "Applicant's Mark").
- 2. Save as otherwise indicated herein, the Declarant makes this Statutory Declaration from her personal knowledge including knowledge of the

rights and trading activities of the Applicant and the documents and records of the Applicant which are available to and accessible by her. Where the Declarant has been advised of facts by someone else, she verily believes the same to be true and accurate, having specifically requested confirmation of the accuracy and truth of the facts from the source of the information.

3. That the Declarant is advised by the Applicant's Agent on record, Iseme Kamau & Maema Advocates "Applicant's Advocates", which advice she verily believes to be true that this Statutory Declaration is filed in accordance with the provisions of the Trade Marks Act (Chapter 506. Laws of Kenya).
4. That the Declarant has read and understood the contents of the Opponent's Notice of Opposition to the registration of the Applicant's Mark dated 23rd May 2019 and the Statutory Declaration in support sworn on 8th October 2019, filed by the Opponents. That the Declarant confirms that she is aware of the full background to these proceedings and wishes to respond to the issues raised therein as follows:
 - i. Any omission to counter or deny any allegations in the Opponent's Declaration should not be construed as an admission of the allegation by the Applicant.
 - ii. The contents of paragraph 8 of the Opponent's Declaration are irrelevant for purposes of these proceedings as they relate to the equipment and ingredients purchased from The Netherlands and the training received by the Opponent for cheese and yoghurt manufacturing which is not the subject of these proceedings. The Declarant is advised by the Applicant's Advocates which information she verily believes to be true that: -
 - a. the Opponent does not market its products on the basis of the equipment used or materials purchased from The Netherlands;
 - b. the training on cheese and yoghurt manufacture is not proprietary and in fact, is available to any manufacturer of similar products; and

- c. there is no co-relation between *“Hollander”* brand, the equipment used, ingredients used or the referred training.
- iii. In response to paragraph 9 of the Opponent’s Declaration, the Declarant reiterates the contents of paragraph 4.2.3 and states that the brand *“Hollandia”* was coined by the Applicant for use in respect of goods in classes 29 and 32 in 1998, long before the Opponent as an entity existed.
- iv. It is apparent that the Opponent appears to have borrowed from the Applicant’s adaptation of the word Holland to come up with its brand *“Hollander”*.
- v. Further, the assertion that the Opponent is in the process of converting *“Hollander”* into its primary brand name is not relevant for purpose of the present proceedings since these proceedings are limited to the current use of *“Hollandia”* and *“Hollander”* and not any of the Opponent’s other brands. In any event, the relevant date for purposes of these proceedings is 6th June 2018 when the Applicant filed its application.
- vi. In response to paragraph 10 of the Opponent’s Declaration, the Declarant has gone through all the attachments in annexure CK3 and note that over 90% of the highlighted entries show *“Happy Cow”* as the main brand which has other sub-brands such as *“Happy Cow Hollander”* *“Happy Cow Red Holland”*, *“Happy Cow_Hollander”* and *“Happy Cow Paneer”*. It is blatantly clear from these annexures that the dominant brand is *“Happy Cow”* and not *“Hollander”*. As such, the annexures in CK3 should be disregarded as they point to a different brand which is not the subject of these proceedings, that is, *“Happy Cow”*.
- vii. The argument under paragraph 11 of the Opponent’s Declaration that *“Hollander”* enjoys goodwill and reputation in the Kenyan market or that it has become a well-known mark does not hold water as shown above.
- viii. In response to paragraph 15 of the Opponent’s Declaration, the Declarant is advised by the Applicant’s Advocates that the failure by the Opponent to appeal against the decisions to reject the registrations of its marks in Nigeria and Uganda cannot be visited on the Applicant and is inconsequential for purposes of the present proceedings. It indeed was

within the Opponent's right to appeal against those decisions in the same manner that it has lodged these proceedings.

- ix. That contrary to the Opponent's claims in paragraph 19 of the Opponent's Declaration that the Applicant and Opponent's goods are similar, the Applicant tabulated a side by side comparison of a sample of the "**Hollandia**" and "**Hollander**" products with the aim of showing the distinctive features of each brand.
- x. In addition to the differences shown between the "Hollandia" and "Hollander" brands, the Declarant indicated that she had gone through the Opponent's website using the link <https://happycowkenya.com/portfolio/others/#> and noted that contrary to the Opponent's allegations in paragraph 19 of the Opponent's Declaration, the Applicant does not manufacture or carry any products that are identical or similar to those of the Opponent. In fact, the Opponent only manufactures a limited range of products under the "Hollander" brand being cheeses and yoghurts. This is contrasted with the wide range of the Applicant's products that can be seen on their website [https:// www.houseofchi.com/brands/](https://www.houseofchi.com/brands/). The Opponent's claims on product similarity is therefore manifestly misconceived.
- xi. In response to paragraphs 20-33 of the Opponent's Declaration, the Declarant reiterated the contents of paragraphs 4.4- 4.11 of the Applicant's Counter Statement.

The Applicant therefore prayed that: -

- a) the opposition be dismissed and the registration of the Applicant's mark is registered and;
- b) the costs of these proceedings be granted to the Applicant.

Vide a letter dated 30th January 2020, the Applicant's statutory declaration was forwarded to the Opponent who filed its statutory declaration in Reply on 13th

March 2020. The Declaration was sworn by Catherine Kibue, who inter alia stated as follows;

1. That she is a Director of Happy Cow Limited, the Opponent herein and duly authorized by the Opponent to make this statutory declaration in Reply on its behalf.
2. That the facts set out in this statutory declaration in Reply are either within her personal knowledge or are taken from continuous records of the Opponent that are accurately maintained under their supervision and control and to which she has full access.
3. That she makes this declaration from her personal knowledge of the trading activities of the Opponent, information available to her and the records of the Opponent which are available to her in the capacity as the Director of the Opponent.
4. That the Declarant swears this Statutory Declaration in response to the Applicant's statutory declaration dated 20th January, 2020 ("Applicant's statutory declaration"). The Declarant wishes to rely on the contents of the Opponent's statutory declaration dated 8th October 2019 ("First statutory declaration").
5. THAT in response to paragraph 4.2 of the Applicant's statutory declaration, the Opponent reiterates the contents of paragraph 8 of its First statutory declaration which explains the origin of the HOLLANDER trade mark as well as the Opponent's dairy products and its association with the Netherlands. This association is further reiterated in paragraph 25 of the First statutory declaration which establishes conceptual similarity of the trade marks HOLLANDER and HOLLANDIA. The Opponent further reiterates this association with the Netherlands given that both the founders of the Opponent and the Applicant's subsidiary, Chi Limited are Dutch. The Declarant attached annexure CK1 being publications on the founder of Chi Limited available on the links <https://www.thecable.ng/chi-limited-pushes-coca-colas-global-market->

[value-to-204-8bn;](#)

<https://www.thisdaylive.com/index.php/2020/01/05/some-of-those->

[who-defined-the-last-decade-in-business/;](#)

and

https://en.wikipedia.org/wiki/Chi_Limited together with certified copies of documentation on founder of the Opponent.

6. That the statement in paragraph 4.3 of the Applicant's statutory declaration that the name HOLLANDIA was coined by the Applicant in 1998 before the Opponent existed is inaccurate and deceptive. The Opponent was founded in 1994 and has been a well-known and recognized processor and supplier of dairy products in Kenya since inception in 1994. The Opponent further reiterates paragraph 24 of its First statutory declaration and states that HOLLANDIA is not a coined term. The Declarant attached annexure CK2 being a certificate of incorporation of the Opponent.
7. That the contents of paragraph 4.4 of the Applicant's statutory declaration is a mere allegation which the Applicant has not proven. The Opponent has explained the origin of its trade mark HOLLANDER in paragraph 8 of the First statutory declaration and its trade mark has no connection whatsoever with the Applicant's mark.
8. In response to paragraph 4.5 of the Applicant's statutory declaration the Opponent asserts that HOLLANDER is its primary brand and lawfully registered under the Trade Marks Act, Cap 506 of the Laws of Kenya (Trade Marks Act). The Declarant is advised by the Opponent's advocates whose advise she verily believes, that use of a confusingly similar mark will disentitle protection of the Opponent's primary brand name and frustrate future use of the trade mark HOLLANDER by the Opponent.
9. In response to paragraph 4.6 of the Applicant's statutory declaration, the Opponent states as follows:
 - a) The invoicing system by the Opponent includes the name of the company, which is Happy Cow, as well as the name of the product sold;

- b) The end consumers primarily interact with the product which predominantly bears the trade mark HOLLANDER and have no interaction with invoices made to retailers. Nonetheless, till receipts from markets explicitly state HOLLANDER, which is the name of the brand. The Declarant attached annexure marked CK3 being certified copies of till receipts from markets.
- c) HOLLANDER is the dominant feature on the packaging of Opponent's products and the branding by the Opponent. The company name Happy Cow only appears to signify the origin of the product as required by law. The Declarant attached annexure marked CK4 being certified copies of photographs of ATM milk dispensers from different outlets in Kenya.

10. In response to paragraph 4. 7 of the Applicant's statutory declaration, the Opponent reiterates the contents of paragraph 11 of its First Statutory Declaration and states that Happy Cow Limited is a well-known and recognized processor and supplier of dairy products in Kenya since its inception in 1994. The Opponent's trade mark HOLLANDER has consequently garnered the good will and reputation of the company having been in the market for 26 years. The Opponent's products bearing the name HOLLANDER are currently on shelf and are trading country wide in Kenya as established in paragraph 10 of its First statutory declaration. This contrasted to the Applicant's products bearing the offending mark HOLLANDIA which are currently not in the Kenyan market.

11. In response to paragraph 4.8 of the Applicant's Statutory Declaration, the Opponent reiterates the contents of paragraph 12,13,14 and 15 of its First statutory declaration. The Opponent notes that the Applicant mischievously misled the Registrar in its appeal to the initial rejection of registration of the Offending Mark HOLLANDIA. The Applicant incorrectly argued that the trade marks HOLLANDER and HOLLANDIA have both been accepted for registration in Uganda without any objection or reference to each other. The Opponent clarifies that of the two trade marks only HOLLANDIA is registered in Uganda. The trade mark HOLLANDER was not accepted for registration in Uganda on the premise that it was confusingly similar to HOLLANDIA. The Declarant attached annexure marked CK5 being certified copy of the Applicant's appeal dated 14th November, 2018.

12. In response to paragraph 4.9 of the Applicant's statutory declaration, the Opponent reiterates the contents of paragraph 19 of its First statutory declaration and states as follows:

- a) That the Opponent's trade mark HOLLANDER is registered in class 29 which covers goods such as meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats;
- b) That the Opponent is entitled to exclusive use and protection of its trade mark for all goods in class 29, including goods such as those sold by the Applicant which are milk and milk products. Use by the Applicant of a confusingly similar trade mark disentitles the Opponent such protection;
- c) That the Declarant is advised by the Opponent's advocates whose advice she believes to be true that, the Opponent need not have used the trade mark in all the goods under class 29 at the time of these proceedings for the trade mark to be protected under the Trade Marks Act. Further that, registration of a trade mark secures protection for future use of the trade mark in relation to goods in the class in which the trade mark is registered as provided in section 20 and 29 of the Trade Marks Act; and
- d) That comparison made by the Applicant under paragraph 4.9 of the Applicant's statutory declaration is on get-up and packaging materials for their products, which is not subject matter of these proceedings.

13. The contents of paragraph 4.10 of the Applicant's statutory declaration are totally denied and the Opponent reiterates the contents of paragraph 19 of its First statutory declaration and the Paragraph above. The Opponent states that both the Opponent and the Applicant similar and identical milk and milk products protected under class 29.

14. That in response to paragraph 4.11 of the Applicant's statutory declaration, the Opponent reiterates paragraphs 5-13 of this statutory declaration and the entirety of its First statutory declaration dated 8th October, 2019.

15. That the Declarant makes this statutory declaration in support of the Notice of Opposition to the registration of the offending mark HOLLANDIA (word) being trade mark application number 102469 in class 29 in the name of the Applicant and further to the Opponent's First statutory declaration dated 8th October, 2019.

16. That the Declarant makes this statutory declaration in accordance with the provisions of the Kenya Oaths and Statutory Declarations Act and states that all the contents herein are true to the best of her knowledge, information and belief.

WHEREFORE the Opponent prayed:

- a) THAT Trade Mark Application number 102469 "HOLLANDIA" in class 29 be refused registration under Section 14 and 15 of the Trade Marks Act; and
- b) THAT the costs of these proceedings be awarded to the Opponent.

The Opponent's statutory declaration in Reply was forwarded to the Applicant vide a letter dated 16th March 2020 and the parties informed that they would be invited to fix a suitable hearing date for the matter. The matter was later fixed for hearing on 18th November 2020. The parties filed a consent to file written submissions before the hearing date and highlight the said submissions on 18th November 2020. Thereafter, Parties filed a consent that the highlighting of the written submissions be dispensed with and that the Registrar proceeds to communicate to the Parties the date for delivery of a decision in respect to these proceedings.

RULING

I have considered the notice of opposition filed by the Opponent, the counter statement filed by the Applicant as well as the statutory declarations filed by both parties. I have also considered the written submissions filed by Muriu, Mungai & Company Advocates for the Opponent and the written submissions filed by Iseme, Kamau & Maema Advocates for the Applicant. I am of the view that the following is the issue for determination in these opposition proceedings:

- a) Is the Applicant's mark "Hollandia" (stylized word) so similar to the Opponent's mark "HOLLANDER" (TM No. 92033) as to cause a likelihood of confusion contrary to the provisions of Sections 14 and 15 (1) of the Trade Marks Act?

ANALYSIS OF THE ISSUE

Is the Applicant's mark "Hollandia" (stylized word) so similar to the Opponent's mark "HOLLANDER" (TM No. 92033) as to cause a likelihood of confusion contrary to the provisions of Sections 14 and 15 (1) of the Trade Marks Act?

Section 14 of the Trade Marks Act provides as follows:

"No person shall register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design."

Section 15(1) provides that:

"Subject to the provisions of subsection (2), no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or in respect of services, is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of the same services or description of services."

A trade mark acts as a badge/indicator of origin and assists the consumers to purchase their products with great confidence. It therefore acts as a guarantee of the quality for the consumer. This view was set out in the case of *Arsenal Football Club v. Matthew Reed (2003) CMLR 481* in the following words:

"..... the essential function of a trade mark is to guarantee the identity of origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin."

In the ECJ case of *Canon Kabushiki v. Metro-Goldwyn-Mayer Inc.*¹ the Court stated that:

“...For the trade mark to be able to fulfil its essential role....it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality.”

Trade marks serve to distinguish the goods or services of one undertaking from the other undertakings.

To enable me determine the issue of similarity under the above-mentioned provision of Section 15(1) of the Trade Marks Act, I shall address my mind to the following factors:

- a) The similarity of the marks in appearance; and
- b) The similarity of the goods.

a) Similarity of the marks in appearance

The Opponent in its notice of opposition has indicated that the Offending mark is confusingly similar to the Opponent’s “HOLLANDER” trade mark phonetically, visually and conceptually. That visually, the Offending mark “HOLLANDIA” consists of the dominant portion of the Opponent’s “HOLLANDER” trade mark and that it is likely that consumers will immediately note the common visual feature. The Opponent has also indicated that both marks are word based and are in black font, only being differentiated by Italics which is not sufficient to differentiate a mark. That when pronounced, the word HOLLAND is prominent in the Opponent’s “HOLLANDER” trade mark. The mark “HOLLANDIA” is likely to be pronounced “HOLLANDER”. That when used as part of a sentence at the point of sale or distribution, the offending mark is likely to sound like the dominant part of the Opponent’s “HOLLANDER” trade mark. That in addition, a number of languages are spoken in Kenya and it is likely that there will be various accents and also mispronunciations when the marks “HOLLANDER” and “HOLLANDIA” are

¹ (1999) RPC 117)

pronounced. This factor is likely to increase confusion at the point of sale. The Opponent noted that the Offending mark is a reproduction of the major part of the Opponent's "HOLLANDER" trade mark. On the aspect of conceptual similarity, the Opponent indicated that the Offending mark is conceptually similar to the Opponent's "HOLLANDER" trade mark as they are both coined terms to reflect association with Holland.

On the other hand, the Applicant categorically denies the allegations contained in the notice of opposition that the mark "HOLLANDIA" is confusingly similar to "HOLLANDER" in any way. That phonetically, the two marks are pronounced very differently. That while the two marks share a common prefix "HOLLAND" which is frequently used informally to refer to the whole of the country of the Netherlands, it should be borne in mind that this element is not the trade mark under comparison. The difference in the two trade marks lies in the very distinctive suffixes i.e. "IA" and "ER" which are pronounced differently. When looked at as a whole, each mark has a different pronunciation and does not enjoy any exclusive rights over the name "HOLLAND". That it is not unusual for trade marks to share certain common sounds but it does not necessarily make them similar. The Applicant indicated that the two marks are visually different and are incapable of causing confusion in the market. The two marks bear very different, distinct and stylistic fonts. Conceptually, the Applicant indicated that there is no similarity between the two marks. The Applicant was of the view that in the absence of all known parameters of similarity, i.e. *visual, phonetic or conceptual*, jurisprudentially the two marks cannot be said to be similar. They should therefore be allowed to co-exist.

In *Clarke v Sharp*² it was stated as follows:

"One must bear in mind the points of resemblance and the points of dissimilarity, attaching fair weight and importance to all, but remembering that the ultimate

² 1898)15 RPC 141 at 146

solution is to be arrived at, not by adding up and comparing the results of such matters, but by judging the general effect of the respective wholes”.

Bentley and Sherman in their book “Intellectual Property Law, state that;

“...the test is to be applied from the viewpoint of the average consumer, and that person will usually assess two signs globally, looking at the overall impression.”

The principles governing the comparison of the trade marks are well entrenched in the case of **Pianotist Co’s Application** wherein it was held in part by Lord Parker that,

“You must take the two words. You must judge them by their look and by their sound...”

The European Court of Justice in **Sabel BV v Puma AG**, stated that the visual, aural or conceptual similarity of the marks must be assessed by reference to:

“the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components...the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role...the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details...”

I will consider the Applicant’s mark and the Opponent’s mark to determine whether they are similar in terms of their appearance.

Visual similarity

The Applicant’s mark is “Hollandia” (stylized word). The mark consists of a capital “H” and “ollandia” in small case, making it “Hollandia” as a whole. The Opponent’s mark on the other hand is “HOLLANDER” (word) written in capital letters. Looking at the two marks, there are both points of similarity and differences. The common element in the two marks “HOLLANDER” and

“Hollandia” is the prefix “HOLLAND”. This in my view, forms the dominant component of each of the marks in question. There are also visible differences in the Applicant’s mark and the Opponent’s mark. The Opponent’s mark “HOLLANDER” (word) ends with the suffix “ER”. The Applicant’s mark “Hollandia” (stylized word) on the other hand has a suffix “ia”.

According to the WIPO Intellectual Property Handbook: Policy, Law and Use³,

“The second important point when testing the similarity of trademarks is that they should be compared as a whole, and that more weight should be given to common elements which may lead to confusion, while differences overlooked by the average consumer should not be emphasized. Notwithstanding this basic rule of comparing trademarks as a whole and not dividing them into parts, the structure of the signs is important. Common prefixes are normally more important than common suffixes; if two signs are very similar or identical at the beginning, they are more likely to be confused than if the similarity is in their endings. Long words with common or similar beginnings are more likely to be confused than short words with different initial letters.”

The Applicant’s mark is structured in an italicized manner with the term “Holland” being the first, followed by the suffix “ia”. As indicated above, while it has been widely recognized that trade marks should be compared as a whole without splitting them into their respective elements, the structure of the trade mark is quite key when considering similarity of the trade marks⁴. If the prefixes are identical or similar, then confusion or deception is likely to occur as compared to where the similar or identical elements were suffixes⁵.

It has been determined that since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the

³ Paragraph 2.468

⁴ WIPO Intellectual Property Handbook: Policy, Law and Use

⁵ *ibid*

characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer.

As earlier indicated, looking at the two marks, there are both points of similarity and differences. However, in my view, the visual similarities outweigh the differences.

Phonetic Similarity

As relates to the pronunciation given to the two marks, “HOLLANDER” and “Hollandia”, I will make a comparison between the Applicant’s mark and the Opponent’s mark which are both word marks. The Applicant’s mark consists of the word “Hollandia” while the Opponent’s mark is “HOLLANDER”. Whereas the two trade marks share a common prefix “HOLLAND”, the only difference between the two is that the impugned mark ends with the suffix “ia” whereas the Opponent’s mark ends with the suffix “ER”. The suffixes “ia” and “ER” are pronounced differently, so that when they are considered as a whole, each of the two trade marks under review have a different pronunciation. However, it is my view that ordinary consumers in Kenya are likely to pronounce the words “HOLLANDER” and “Hollandia” in a similar manner.

Conceptual Similarity

On the conceptual similarity, I am of the view that there is conceptual similarity between the two marks in question.

b) The similarity of the goods

*Bentley and Sherman*⁶ 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.

⁶ Bentley L, and Sherman B, Intellectual Property Law (3rd edn, Oxford University Press) 859

The Opponent has in the notice of opposition indicated that the Offending mark is sought to be registered in relation to goods in class 29, goods that are identical to the goods for which the Opponent's "HOLLANDER" trade mark is registered in Kenya and the Offending mark is therefore likely to be associated with the Opponent's "HOLLANDER" trade mark in the course of trade.

From the records at the Registry of Trade Marks, the Opponent's mark "HOLLANDER" is registered in respect to goods in class 29 of the International Classification of Goods and Services consisting of meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats.

The Applicant on the other hand, seeks to register goods in classes 29 and 32 of the International Classification of Goods and Services as follows:

Class(es)	Goods
29	Milk, flavored milk evaporated milk, protein milks, soya milk, milk and yoghurt based beverages, yoghurt, drinking yoghurts, yoghurts drinks, flavoured yoghurt drinks, maize (mageau) drink, mageau based drinks.
32	Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

In *Jellinek's Application*⁷, Romer J proposed a three-fold test when assessing whether goods and services are similar to other goods and services, namely the nature and composition of the goods, the respective uses of the goods, and the trade channels through which the goods are bought and sold. It was indicated

⁷ (1946) 63 RPC 59 at 70

that no one factor was considered conclusive and it was not considered necessary for all three factors to apply.

In the **Intellectual Property Law** book by *Lionel Bentley and Brad Sherman* (2nd Edition) at page 859 the authors state as follows:

‘The question of whether goods or services are similar depends on the facts of the case. When deciding whether or not a trade mark application falls foul of the relative grounds for refusal, the comparison is normally between the goods or services to which the application relates.... This requires the Court to interpret the specification and then to characterize the goods or services and see if they fall within the specification.’

The WIPO Intellectual Property Handbook: Policy Law and Use, at page 86 states that:

“...identical marks are unlikely to create confusion as to the origin of the goods if the goods are very different. As a general rule, goods are similar if, when offered for sale under an identical mark, the consuming public would be likely to believe that they came from the same source. All the circumstances of the case must be taken into account, including the nature of the goods, the purpose for which they are used and the trade channels through which they are marketed, but especially the usual origin of the goods, and the usual point of sale.”

In its first statutory declaration, the Opponent has indicated that the goods covered by the Offending mark which the Applicant is attempting to register are identical to and/ or are goods of the same character, nature or description as to the goods which the Opponent’s “HOLLANDER” trade mark is used. More specifically, the goods are dairy products and are sold in the same trade channels such as supermarkets and general trade shop outlets and particularly placed on the same shelves for dairy products. These goods are also sold to the same customers hence likely to cause confusion and deception arising in the minds of all members of the public if the Offending mark is allowed to proceed to

registration and use in the Kenyan market. In the Opponent's statutory declaration in Reply, the Opponent indicated that it is entitled to exclusive use and protection of its trade mark for all goods in class 29, including goods such as those sold by the Applicant which are milk and milk products.

On the other hand, the Applicant in its statutory declaration at Paragraph 4.10. indicates that contrary to the Opponent's allegations in paragraph 19 of the Opponent's declaration, the Applicant does not manufacture or carry any products that are identical or similar to those of the Opponent. In fact, that the Opponent only manufactures a limited range of products under the "Hollander" brand being cheeses and yoghurts. This is contrasted with the wide range of the Applicant's products that can be seen on their website <https://www.houseofchi.com/brands/>.

In the English case of *British Sugar PLC v. James Robertson & Sons Ltd*⁸, Jacob J stated the following:

'Thus I think the following factors must be relevant in considering whether there is or is no similarity:

- (i) The respective uses of the respective goods or services;
- (ii) The respective users of the respective goods or services;
- (iii) The physical nature of the goods or acts of service;
- (iv) The respective trade channels through which the goods or services reach the market;
- (v) In the case of self-service consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves; and
- (vi) The extent to which the respective goods or services are competitive.'

In Kerly's Law of Trade Marks and Trade Names 12th Edition, at paragraph 10-12, the test whether or not goods or services are "of the same description" would

⁸ 1996 R.P.C. 281

seem to be supplied by the question -Are the two sets so commonly dealt in by the same trade that his customers, knowing his mark in connection with one set and seeing it used in relation to the other, would be likely to suppose that it was so used also to indicate that they were his? That the matter should be looked at from a business and commercial point of view.

In John Crowther & Sons (Milnsbridge) Ltd's Appn⁹, this passage from the decision of the British Assistant Comptroller was cited:

"...the reported cases show that I have to take account of a number of factors, including in particular the nature and characteristics of the goods, their origin, their purpose, whether they are usually produced by one and the same manufacturer or distributed by the same wholesale houses, whether they are sold in the same shops over the same counters during the same seasons and to the same class or classes of customers, and whether by those engaged in their manufacture and distribution they are regarded as belonging to the same trade".

As earlier indicated, the Opponent's mark "HOLLANDER" is registered in respect to goods in class 29 of the International Classification of Goods and Services consisting of meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats.

The Applicant on the other hand seeks to register its mark in class 29 of the International Classification of Goods and Services consisting of milk, flavored milk evaporated milk, protein milks, soya milk, milk and yoghurt based beverages, yoghurt, drinking yoghurts, yoghurts drinks, flavoured yoghurt drinks, maize (mageau) drink, mageau based drinks and class 32 of the International Classification of Goods and Services consisting of Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

⁹ (1948) 65 RPC 369 at 372

In making a comparison between the Applicant's and Opponent's goods in class 29, the Applicant's goods are in my view, similar to those of the Opponent. The Opponent's specification of goods relating to milk and milk products is a broad specification that covers most of the goods that the Applicant seeks to register for class 29. The goods are of the same description and in most instances are sold through the same trade channels. In the Kenyan retail stores, these goods are usually placed side by side on shelves. It is my view therefore, that the Applicant's goods in class 29 are similar to the Opponent's goods as registered in class 29.

As relates to goods in class 32 consisting of Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages, it is my view that there is no similarity in goods relating to the Applicant's goods and the Opponent's goods.

Likelihood of Confusion

Section 14 of the Trade Marks Act provides that:

"No person shall register as a trade mark or part of a trade mark any matter, the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice or would be contrary to law or morality or any scandalous design."

In the case of *Sabel vs. Puma AG*¹⁰ the ECJ said in part that:

"...The likelihood of confusion must be appreciated globally taking into account all factors relevant to the circumstances of the case.....That global appreciation of the visual, aural or conceptual similarity of the marks in question must be based upon the overall impression given by the marks bearing in mind in particular their distinctive and dominant components....."

¹⁰ (Case C-251/95)

It is important that I consider the average consumer's test. It has been established in various cases that the average consumer:

- a) normally perceives a mark as a whole and does not proceed to analyze its various details;
- b) rarely has the chance to make a direct comparison between two marks but relies on imperfect recollection of that which is in his mind; and
- c) level of attention varies depending on the category of goods or services.

*In Reckitt & Colman SA (PTY) Ltd vs. SC. Johnson & Son SA (PTY) Ltd*¹¹, it was stated that, “a rule of long standing requires that a class of persons who are likely to be the purchasers of goods in question must be taken into account in determining whether there is a likelihood of confusion or deception”.

David I. Bainbridge, the author of the book Intellectual Property, Sixth Edition at page 632 states as follows:

“As a likelihood of confusion is presumed where there is a complete identity of the sign, and the earlier trade mark and the goods or services, the grounds of refusal...should be reserved for those cases where a significant number of consumers would presume that there was complete identity given that it has been established that consumers do not usually make a direct comparison between the sign and the earlier trade mark.”

The Opponent has indicated in its submissions that the usual consumer of fast moving consumer goods is not necessarily a discerning customer, one keen to pay attention to the visual and verbal nuances that a trade mark practitioner of proprietor would. That even when they may pay attention to such nuances, the inevitable imperfections of human memory would invariably impede on such customer's ability to differentiate the Applicant's impugned mark “Hollandia” from “HOLLANDER”.

¹¹ (1993)

The WIPO Intellectual Property Handbook: Policy, Law and Use¹² states that:

“Since the average consumer generally does not at first glance recognize differences between the marks that he might spot if he took his time to study the mark and the product offered under it more carefully, the first impression that he gains must be decisive. This is especially true for mass-consumption goods offered in self-service stores.”

At Paragraph 2.466¹³ it is stated that:

“Furthermore, unsophisticated, poorly-educated consumers and also children are more liable to be confused. The purchaser of a sophisticated and costly machine, car or aircraft will no doubt be more attentive than the consumer in the self-service store. In those fields, therefore, very similar trademarks do coexist, which would probably be easily confused if applied to mass-consumption goods.”

The class 29 goods in question in this matter are fast moving consumer goods which are usually sold in the same channels of commerce. In considering the level of sophistication of the market, the nature of the consuming public are ordinary consumers who are not expected to exercise extra care and diligence when purchasing the goods in question. This is because the said goods are every day goods and which in my view do not fall in the category of ‘very expensive’ goods. In the Kenyan market, the said goods would be purchased by educated or non-educated persons or children. These are not goods that are selected with a lot of care and consideration has to be made of the likely purchasers of such goods. Further, the said goods would be offered for sale in the Kenyan retail stores. These goods are usually placed side by side on the same shelves in supermarkets or in the kiosks. I am of the view that a large number of the above-mentioned purchasers would not exercise a “very careful or intelligent examination of the mark” before purchasing the said goods.

¹² Paragraph 2.465

¹³ The WIPO Intellectual Property Handbook: Policy, Law and Use

In the New Zealand case of *Pioneer Hi-Bred Corn Co. v. Hy-Line Chicks Pty Ltd*¹⁴, the Court stated as follows:

“In considering the likelihood of deception or confusion, all surrounding circumstances have to be taken into consideration, including the circumstances in which the applicant’s mark may be used, the market in which his goods may be bought and sold and the character of those involved in the market.

In Kerly’s Law of Trade Marks, 14th Edition, paragraph 17-018 at page 590, the learned author states as follows:

“... as common experience shows, consumers’ attention will vary depending on the kind of goods which they are buying, and not all classes of consumers will exercise the same level of care in choosing products... the general principles are as follows:

1. It must not be assumed that a very careful or intelligent examination of the mark will be made;
2. But, on the other hand, it can hardly be significant that unusually stupid people, fools or idiots, or a moron in a hurry may be deceived;
3. If the goods are expensive, or important to the purchasers, and not of a kind usually selected without deliberation, and the customers generally educated persons, these are all matters to be considered;
4. If some parts of the mark are common, one must consider whether people who know the distinguishing characteristics of the Opponent’s mark would be deceived.”

In the case of *De Cordova and others v Vick Chemical Coy*¹⁵, it was stated as follows:

“The likelihood of confusion or deception in such cases is not disproved by placing the two marks side by side and demonstrating how small is the chance of error in any customer who places his order for goods with both the marks clearly before him, for orders are not placed, or are often not placed, under such conditions.

¹⁴ (1979) R.P.C.

¹⁵ (1951) 63 RPC 103

It is more useful to observe that in most persons the eye is not an accurate recorder of visual detail, and that marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole.”

In the case of *Reed Executive PLC v Reed Business Information Ltd*¹⁶, the court stated as follows:

“The person to be considered in considering the likelihood of confusion is the ordinary consumer, neither too careful nor too careless, but reasonably circumspect, well informed and observant. There must be allowance for defective recollection, which will of course vary with the goods in question. A fifty pence purchase in the station kiosk will involve different considerations from a once-in-a-lifetime expenditure of £50000.”

Having considered the provisions of the law, the authorities cited, the similarity of the Applicant’s and the Opponent’s marks and the similarity of the Applicant’s goods in comparison to the Opponent’s goods as relates to goods in class 29, the nature of goods and services in consideration, among other factors, I am of the view that there will be likelihood of confusion that may arise if the Applicant’s and the Opponent’s trade marks are allowed to co-exist in the market as far as goods in class 29 are concerned.

I wish to note that I have taken into consideration the authorities that have been cited by both parties. The jurisprudence that has been set by the Registrar of Trade Marks in Kenya through the various cases cited, needs to be analysed on a case by case basis and the different circumstances of each of the decisions made, must be considered.

DECISION

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

¹⁶ [2004] EWCA Civ 159

- (a) The Applicant's Trade Application No. 102469 "**Hollandia**" (stylized word) shall not be allowed to proceed to registration in respect to goods in class 29 of the International Classification of Goods and Services. The Application shall only be allowed to proceed to registration in respect to goods in class 32, as indicated in the application Form TM 2;
- (b) The Applicant is required to file form TM 19 to amend its application by deleting class 29 from its specification of goods before the application can proceed to registration; and
- (c) I make no order as to costs.

Ruling delivered at Nairobi this 29th day of May 2023



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CONCILIA WERE
ASSISTANT REGISTRAR OF TRADE MARKS