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

**IN THE MATTER OF TRADE MARK APPLICATION NO. 119387 “Milkman” (WORD)  
IN THE NAME OF INTERNATIONAL FOODSTUFFS CO. LLC.**

**EX-PARTE RULING BY ASSISTANT REGISTRAR OF TRADE MARKS**

**PROCEDURAL BACKGROUND**

On 24<sup>th</sup> September 2021, International Foodstuffs Co. LLC., (hereinafter referred to

Milkman  
ملکمان

as “the Applicant”) filed an application to register the mark “ ”, T.M.A No. 119387. The application was filed in respect to Goods in Class 30 of the International Classification of Goods and Services as follows:

Class 30: Chocolate confectioneries, sugar confectionery candy, biscuits/cookies, malt biscuits, cakes, pasta, macaroni, noodles, spaghetti, vermicelli, yeast, baking powder, dressing for salad mayonnaise, vinegar, ketchup, sauces(condiments), ices, dough ice creams, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, bread, pastry, honey, treacle, ices, salt, mustard, wheat flour, flour made from cereals, cereal preparations, chutneys, spices. meat gravies, bakery ingredient, spices, food beverages (Grain-based and Herbal), gravies, herbal tea, honey, popcorn.


The application was duly examined in accordance with the provisions of the Trade Marks Act, Cap 506 of the Laws of Kenya. By a report dated 28<sup>th</sup> January 2022 the Trade Marks Examiner issued a refusal notice against registration of the said mark on the grounds that it is similar to another mark existing on the Trade Marks Register with the following particulars:

TM No. 97512- “MILKMAN MILK LOLLIPOPS (word & device)” in class 30 in the name of MZURI SWEETS LTD, existing on the register since 7<sup>th</sup> June, 2017.

On 25<sup>th</sup> April 2022, the Applicant filed written submissions against the Examiner’s report dated 28<sup>th</sup> January 2022 indicating inter alia as follows:

- a. **THAT** the proposed mark appears to have been refused registration on relative grounds in terms of Section 15(1) of the Trade Marks Act with respect to goods in Class 30.

- b. **THAT** the Applicant wishes to amend its application to limit the goods in Class 30 to Biscuits and Chocolate.
- c. **THAT** that the Applicant's amendment to their Trade mark Application will differentiate the Applicant's goods on the register as well as in trade. The proprietor of the cited mark has limited their specification of goods as follows:

TMA No. 97512 (the Cited Mark)	TMA No. 119387 (the Proposed Mark)
	<p data-bbox="1007 741 1150 775">Milkman</p> <p data-bbox="1018 792 1114 831">ملکمان</p>
Class 30 – <u>Confectionery</u>	Class 30 – <u>Biscuits and Chocolate</u>

- d. **THAT** the WIPO Intellectual Property Handbook provides that the classification of goods cannot be decisive for the test of similarity. Even identical marks are unlikely to create confusion as to the origin of goods, if goods are different.
- e. **THAT** the International Trademark Association Guidelines for Trademark Examination 2007 considers that when determining whether similar marks will likely lead to confusion among the purchasing public, a comparison must be made on the similarity or dissimilarity and type of goods described in a mark.
- f. **THAT** in the Matter of an application to register TMA 65334 & Beyond in Class 39 in the name of Beyond Holdings, the Registrar determined that despite the marks in question been similar, the services in respect of the mark '& Beyond' differed from the registered mark 'Beyond'. The Registrar relied on its ruling 'In the Matter of TMA 066576 "PIMA"', which considered that the provisions of Section 15(1) of the Act are not concerned with similarity of class but the similarity of goods and services.
- g. **THAT** in the matter of an application to register TMA 65981 Sony Holding (words and device) and 65982 Sony Holdings (word) in the Name of Sony

Holdings Limited, the Registrar found the registered goods of the Opponent's trademark compared to the registered goods of the Applicant's trademark to not be of a similar description. The Registrar quoted Bentley and Sherman when determining whether the Applicant's and Opponent's mark were similar and stated 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... an interpretation of the specification and characterization of the goods or services is then required to determine if the goods are of a similar description.

- h. **THAT** though the cited mark and the proposed mark share a level of similarity as they both incorporate the word "Milkman", when viewed as a whole, the marks have differences. That in the side by side comparison, the cited mark contains additional words i.e. "Milk" and "Lollipops" as well as additional characters. On the other hand, the proposed mark contains only the word "Milkman" as well as an Arab transliteration of the same.
- i. **THAT** in *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. (C-342/97)* it was stated that 'in order to assess the degree of similarity between the marks concerned, the national court must determine the degree of visual, aural or conceptual similarity between them and where appropriate, evaluate the importance to be attached to those different elements, taking into account the category of goods and services in question and the circumstances in which they are marketed.
- j. **THAT** in the matter of TMA No. 90958 "F-PACE" in the name of Jaguar Land Rover Limited, the Assistant Registrar indicated that even though the trade marks F-PACE and PACE contain a similar element "PACE", they would not be considered to be confusingly similar.

The Applicant indicated that the Proprietor of the cited mark will not suffer any prejudice if the proposed mark is accepted to proceed to advertisement subject to amending the specification of goods as set out in the amendment application.

The Applicant requested that the Refusal Notice to be reconsidered and withdrawn and that the Applicant's proposed mark be allowed to proceed to acceptance and advertisement.

### **RULING**

I have studied the documents on record and considered the Applicant's written submissions against the Examiner's refusal notice. I am of the view that the issue for determination is whether or not the Applicant's mark, T.M.A No. 119387 is so similar to the cited mark TM No. 97512.

Section 15(1) of the Trade Mark Act provides as follows:

'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 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.’

To make a determination on the above issue, I shall consider the following factors;

1. Similarity of the marks in appearance; and
2. Similarity of the goods.

### **1. Similarity of the marks in appearance**

In determining the issue of similarity of the marks in question, it is critical to consider that the marks should be compared in their entirety. The overall or net impression of the two marks should be highly regarded.

In *Clarke v Sharp*<sup>1</sup> 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 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”.

In *Sabel BV v Puma AG*<sup>2</sup>, it was 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 cited mark to determine whether the two are similar in terms of their appearance.

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<sup>1</sup> (1898)15 RPC 141 at 146

<sup>2</sup> Rudolf Dassler Sport [1998] RPC 199 at 224

Applicant's Mark	Cited Trade Mark
<p>T.M.A. No. 119387</p> 	<p>T.M.A No. 97512</p> 

It is clear from the two representations that there is a similar word, Milkman, which is present both in the Applicant's mark and the cited mark. There are also some visible differences between the Applicant's mark and the cited mark.

In considering the phonetic similarity of the marks herein in question, I find that the pronunciation given to the word "Milkman" is similar in both marks. The words "Milk Lollipops" are only present in the cited mark and not the Applicant's mark.

## 2. Similarity of the goods.

In *Jellinek's Application*<sup>3</sup>, *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 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 (2<sup>nd</sup> 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 85 indicates the following:

"Trade marks are registered for goods in certain classes which have been established for purely administrative purposes. The classification of goods cannot therefore be

<sup>3</sup> (1946) 63 RPC 59 at 70

decisive for the question of similarity. Sometimes, totally different goods are listed in the same class (for instance computers, eye glasses, fire extinguishers and telephones in class 9), while similar goods can clearly be listed in different classes (adhesives may fall into classes 1, 3, 5 and 16).

**The WIPO Intellectual Property Handbook: Policy Law and Use**, at page 86, which the Applicant has cited, 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.”

Applicant herein seeks to register Goods under Class 30 of the International Classification of Goods and Services as follows:

Chocolate confectioneries, sugar confectionery candy, biscuits/cookies, malt biscuits, cakes, pasta, macaroni, noodles, spaghetti, vermicelli, yeast, baking powder, dressing for salad mayonnaise, vinegar, ketchup, sauces(condiments), ices, dough ice creams, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, bread, pastry, honey, treacle, ices, salt, mustard, wheat flour, flour made from cereals, cereal preparations, chutneys, spices. meat gravies, bakery ingredient, spices, food beverages (Grain-based and Herbal), gravies, herbal tea, honey, popcorn.

The cited mark on the other hand is registered with respect to goods in class 30 of the International Classification of Goods and Services in respect to Confectionery.

In ***American Steel Foundries v Robertson* 269 U.S. 372 (1926)**, it was stated that nothing prevents the use of a similar or identical trade mark by different proprietors provided that the respective goods and services are of a different description. The only property in a trade mark is the business or trade in connection with which the trade mark is used. Goods or services are generally considered to be similar when offered under a similar trade mark and where the purchaser may be likely to believe that the goods and services originate from the same source and where the channels used for the goods are similar.

I have taken note of the fact that the Applicant has made a proposal to amend its specification of goods to limit the goods in Class 30 to Biscuits and Chocolate.

According to the Cambridge online Dictionary, confectionery has been defined to mean “sweets or chocolate”, “a place where sweets or chocolate are made or sold”. The Collins online Dictionary has defined confectionery to mean sweets and chocolates or sweets and other confections collectively.

It is my view that the cited mark’s specification of goods covers a broader description of goods in class 30 which encompasses the Applicant’s proposed goods.

## DECISION

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

1. The Trade Marks Examiner's refusal notice dated 28<sup>th</sup> January 2022 is hereby upheld.

Milkman

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2. The Applicant's application for registration of the mark T.M.A No. 119387 hereby fails and registration of the said mark shall not be allowed to proceed.

**Ruling delivered at Nairobi this 3<sup>rd</sup> day of December 2024**



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**CONCILIA WERE**

**ASSISTANT REGISTRAR OF TRADE MARKS**