

REPUBLIC OF KENYA

KENYA INDUSTRIAL PROPERTY INSTITUTE

IN THE MATTER OF THE TRADE MARKS ACT, CAP 506 AND
IN THE MATTER OF TRADE MARK APPLICATION NO. KE/T/2012/75574 DAWA MOJA EXTRA
IN THE NAME OF CHANDARIA PHARMACEUTICALS (K) LTD
AND OPPOSITION THERETO BY DAWA LTD AND
SONAL HOLDINGS LTD

RULING

INTRODUCTION

This is an opposition matter filed by Dawa Ltd (hereinafter the first opponent) and Sonal Holdings Ltd (hereinafter the second opponent), against the registration of trade mark application number KE/T/2012/0075574 DAWA MOJA EXTRA (word), in the name of Chandaria Pharmaceuticals (K) Ltd. (hereinafter the applicant).

PROCEDURAL HISTORY

On 16 July 2012, the applicant filed an application for the registration of the mark DAWA MOJA EXTRA, in class 5 for Pharmaceutical products. The application was duly examined and, by a letter dated 15 August 2012, approved for advertisement. Subsequently the application was advertised in the Industrial Property Journal of August 2012.

Thereafter, on 31 October 2012, the first opponent filed a notice of opposition dated 28 October 2012 against the registration of the trade mark.

The grounds on which the opposition was based were, *inter alia*, that the first opponent was the proprietor of various trade marks comprising the word DAWA which had been entered on the Register and under which it was manufacturing and offering for sale pharmaceutical products, that some of the marks were owned by Medisel (Kenya) Ltd, the parent company and majority stakeholder of the first opponent, that it had vigorously marketed and promoted the said trade marks, that as a result of the use of the marks, they

had become well known and synonymous with the first opponent, that the first opponent was the exclusive proprietor of the term DAWA for pharmaceutical products registered by the Pharmacy and Poisons Board of Kenya, that the mark DAWA MOJA EXTRA was visually so similar to the first opponent's marks that confusion and deception was likely to arise in the minds of the public and that the likelihood of deception disentitled the mark from protection in a court of justice.

The first opponent further stated that the goods covered by the opposed mark were of an identical character to those on which its marks were used, that these were goods that were offered over the counter, that the applicant had no valid or legal claim to the mark DAWA MOJA EXTRA, that registration and or use of the opposed mark was likely to impair, interfere with or take unfair advantage of the distinctive character of the first opponent's marks and that there was a likelihood that members of the public would be confused or deceived into mistakenly buying the applicant's goods bearing the opposed mark thinking that they were goods manufactured by the first opponent or vice versa.

For these reasons, the first opponent sought to have registration of the mark refused under the provisions of sections 12, 14, 15(1), 15A, and 20 of the Trade Marks Act and to have costs awarded in its favour.

On 26 October 2012, a Notice of Opposition was filed by the second opponent. The grounds on which the opposition was based were, firstly, that it was the first to adopt and use the term 'MOJA' in trade marks in relation to pharmaceutical products, secondly, that through extensive promotion, the term MOJA was now distinctive with respect to products being used and that the public greatly associated the term with their companies and, lastly, that use of the term by the applicant was highly likely to cause confusion in the market as to the source of the products.

By letters dated 14 November 2012, the first and second opponents' Notices of Opposition were separately forwarded to the applicant with advice to file its counter-statement within 42 days from the date of receipt of the letters.

On 18 January 2013, the applicant filed its counter statement dated 17 December 2012 to the Notice of Opposition filed by the first opponent. In the counter-statement the

applicant stated, *inter alia*, that the first opponent had not described in detail the trade marks entered in the Register owned by either the first opponent or Medisel, that the first opponent was not a subsidiary of Medisel since the two had separate and distinct legal personalities, that nowhere in the Register did the mark DAWA MOJA EXTRA appear, that it was not possible to have words of common notoriety and with universal application registered as trade marks, that the term DAWA was a Kiswahili word used extensively in the East African region meaning medicine, that nowhere had it been shown that the opposed trade mark was identical or resembled any mark already on the Register and that since the mark was neither identical nor did it resemble any of the opponent's marks, it could not deceive the public in connection with the trade in question.

The applicant further stated that it had not been demonstrated how the opponent would suffer prejudice if the mark was registered, that the attempt by the opponent to block registration of the mark was a thinly disguised move to perpetuate unfair trade practices by avoiding any form of competition and that section 15(2) of the Trade Marks Act allowed the Registrar or Court to register identical or nearly resembling marks in special circumstances. For these reasons it prayed that registration of the mark DAWA MOJA EXTRA be allowed and that costs be awarded in its favour.

The counter-statement was forwarded to the first opponent's agent by a letter dated 30 January 2013 in which it was requested to file its statutory declaration within 42 days of receipt of the letter.

On 30 January 2013, the applicant filed its counter-statement dated 17 December 2012 to the Notice of Opposition filed by the second opponent. In the counter-statement, the applicant stated, *inter alia*, that the Notice of Opposition filed by the second opponent had not described in detail the trade marks owned by the second opponent, that the marks SONA MOJA and DAWA MOJA bore no resemblance, that the word MOJA was a Kiswahili word used extensively in the East African region meaning the numeral one and could not be “patented or used as a trademark globally” (sic), that it had not been demonstrated how registration of the mark would cause prejudice to the second opponent, and that the attempt to block registration of the mark was a thinly disguised move to perpetuate unfair trade practices.

For these reasons, the applicant prayed that “registration of the mark “DAWA MOJA” (sic) be allowed” and that costs of the proceedings be awarded in its favour.

The counter-statement was forwarded to the second opponent by a letter dated 5 February 2013 in which it was requested to file its statutory declaration within 42 days of receipt of the letter.

On 13 March 2013, the first opponent filed its statutory declaration sworn on its behalf by Rajeev Chatrath. In the declaration, Mr. Chatrath deponed, *inter alia*, that he was a director of the first opponent and authorised to swear the affidavit, that the first opponent reiterated that it was the proprietor of various trade marks comprising the term DAWA, all of which had been entered in the Register and under which it had manufactured and offered for sale pharmaceutical products, that some of the marks were owned by Medisel (Kenya) Ltd, its parent company, that the mark DAWA MOJA EXTRA which the applicant was attempting to register was visually so similar to its marks that confusion and deception was likely to arise in the minds of the public if the mark was registered, that the goods covered by the opposed mark and the first opponent's marks were identical and that the applicant had no valid or legal claim to the mark DAWA MOJA EXTRA.

For these reasons, the first opponent prayed that the application be dismissed with costs.

Attached to the declaration were a number of annextures comprising

Annex 1 - Copies of various registration certificates and letters from the Pharmacy and Poisons Board, Import Declaration Forms from the Kenya Revenue Authority, certificates of renewal of TM Nos. 36066 DAWAGENTA (word), 36189 DAWA (word and logo) and 36777 DAWADOXYN (word) all in the name of Medisel (Kenya) Ltd., and certificate of registration of TM No. 62964 DAWAHIST (word) in the name of Dawa Ltd.;

Annex 2 - Copies of various financial documents;

Annex 3 - Copies of various promotional materials being calendars for 2013.

The statutory declaration was forwarded to the applicant by a letter dated 14 March 2013 in which it was requested to file its statutory declaration within 42 days of receipt of the letter.

On 4 April 2013, the second opponent filed its statutory declaration sworn on its behalf by Javan Omondi. In the statutory declaration, Mr. Omondi averred, *inter alia*, that he was the general manager of the second opponent and had authority to make the declaration on its behalf, that to an ordinary consumer the applicant's trade mark DAWA MOJA EXTRA generally resembled the second opponent's trade mark SONA MOJA, phonetically, visually and conceptually, that while the term MOJA was a common Kiswahili language word, it was settled in the trade marks world that where an entrepreneur had independently selected a term for use in relation to pharmaceutical products and alienated the term from common usage then the person should be left to enjoy exclusivity, that the applicant was being mischievous in selecting the term MOJA and leaving out other numbers in the range 2 to 9, that consumers associated the term MOJA with the second opponent's products, that since the two marks were used for the same products and sold through identical channels of trade there was a high chance consumers would be confused as to the source to the detriment of the second opponent's reputation, that it was erroneous for the applicant to claim that their mark was not in the register when a search revealed that the mark DAWA MOJA EXTRA subsisted on the Register from 16 July 2012 with a filing number TMA No. 75574, that allowing the two marks to coexist as the applicant contended would ignore the role that the trade mark registration system was intended to play, that the applicant had acted in bad faith in selecting a closely resembling mark and that since the second opponent had already received a certificate of trade mark registration, the delay in waiting through opposition proceedings would cost them losses in terms of sales volumes and revenues.

For these reasons, the second opponent prayed that the applicant's mark be refused registration "with cost to the applicant" (sic).

On 14 May 2013, the applicant filed its statutory declaration regarding the opposition by the first opponent. In the statutory declaration sworn on its behalf by Hetul Chandaria, the deponent averred, *inter alia*, that he was a director of the applicant and duly authorised to make the declaration on behalf of the applicant, that there was no relationship whatsoever between Medisel (K) Ltd. and Dawa Ltd., that the two companies had separate and distinct legal personalities, that it was grossly misleading for the first opponent to aver that Medisel

(K) Ltd was the parent company and majority stakeholder in Dawa Ltd, that the trade marks owned by Medisel (K) Ltd and which bore the word DAWA had been erroneously and mischievously sneaked in the Schedule as belonging to the first opponent to defeat the ends of justice and give the opponent undue advantage, that the first opponent had not advanced any new legal basis or evidence to controvert the applicant's application, that the notice of opposition was in bad faith and bad in law and that for those reasons he prayed that the applicant's application be allowed and the first opponent bear costs of the proceedings.

Attached to the Declaration were a number of exhibits comprising:

Exhibit HC1 - copy of a letter from the Dept of the Registrar General dated 11 April 2013 to James Mwenda, Advocates regarding Dawa Limited; and

Exhibit HC2 - a copy of a letter from the Dept of the Registrar General dated 10 April 2013 to Ramesh K Patel, Advocates regarding Medisel (Kenya) Limited.

On the same date, the applicant also filed its statutory declaration regarding the opposition by the second opponent. In the statutory declaration, also sworn by Hetul Chandaria on its behalf, Mr. Chandaria deponed, *inter alia*, that he was a director of the applicant and authorised to swear the affidavit, that there was no causal connection, link, semblance and/or similarity between the marks DAWA MOJA EXTRA and SONA MOJA, that MOJA being a universal term could not be used as a distinct term neither could it confer a proprietor unique distinctiveness or advantage, that there were many precedents of companies that had used the word MOJA in their merchandise and that the mark DAWA MOJA EXTRA was a distinct prefix that only resonated well in the applicant's application due to the fact that there was no similar mark on the Register.

The deponent further averred that the second opponent had no vested right in the word MOJA since their claim to exclusivity was devoid of any merit, that the claim by the second opponent was "a reckless misadventure to forestall any healthy competition", that the second opponent had not advanced any new legal basis or evidence to controvert the applicant's application, that the notice of opposition was made in bad faith, was bad in law and a travesty of justice and that it was for those reasons that the deponent prayed that the applicant's application be upheld and the opponent bear the costs of the proceedings.

By letters dated 20 May 2013, the applicant's statutory declarations were forwarded to the first opponent's agents and to the second opponent respectively, with instructions to file their statutory declarations in reply, if any, within 30 days of receipt of the letters.

On 14 June 2013, the first opponent filed its Statutory Declaration in Reply sworn on its behalf by Ajay Patel. In the declaration, Mr. Patel deponed, *inter alia*, that he was the Managing Director of the first opponent, that the first opponent repeated the contents of its Statutory Declaration and Notice of Opposition, and that it averred that the applicant's Statutory Declaration was a sham "riddled of conjectures".

The first opponent's Statutory Declaration in Reply was forwarded to the applicant by a letter dated 21 June 2013 in which it was informed that the parties would soon be invited to fix a mutually convenient date for the hearing.

The second opponent would appear not to have filed any Statutory Declaration in Reply. Thereafter, on 13 August 2013, the parties were invited to the Registry for purposes of fixing a hearing. Hearing was fixed for 31 October 2013. However, on 28 October, counsel for the first and second opponents wrote to the Registrar stating that they would be unable to attend the hearing as they had fixed other matters for that date on the presumption that the issue would proceed by way of written submissions. The applicant, by a letter dated 29 October 2013, indicated that they were against the deferral of the matter as they wished to have the matter disposed of at the earliest possible opportunity.

HEARING

On 31 October 2013, the parties appeared before me for the hearing of the matter. Counsel holding brief for the opponent's agents submitted that the advocate handling the matter was not available and they would be seeking an adjournment. The applicant's agents vehemently opposed the application based on the fact that the hearing date had been taken by consent and his client would have even preferred an earlier date. He submitted that they were reading mischief, bad faith and a concerted effort by opposing counsel to delay the matter.

In my ruling, I noted my surprise at the action taken by counsel for the opponents in fixing other matters for the date and assuming that the matter would proceed by way of written

submissions. However, in light of the fact that it would have been unfair to the opponents to proceed in the absence of their lawyer, I ruled that hearing would proceed by way of written submissions with strict timelines to be observed. Costs of the day's proceedings were awarded to the applicant, Chandaria Pharmaceutical, and mention of the matter was set for 5 December 2013 to review the status.

FIRST OPPONENT'S WRITTEN SUBMISSIONS

In its written submissions filed on 13 November 2013, the first opponent started by setting out the background to the matter including the grounds on which its Notice of Opposition was based and the procedure with regard to filing of pleadings. It then stated that its opposition was based on two grounds: firstly, that the mark DAWA MOJA EXTRA was similar and phonetically resembled various registered and unregistered marks belonging to it contrary to the provisions of sections 14 and 15(1), Trade Marks Act and, secondly, that the mark DAWA MOJA EXTRA did not qualify for registration as a trade mark in respect of goods in class 5 and that the applicant had no valid or legal claim to the mark under the provisions of section 21 of the Act.

It submitted further that its case was that the opposed mark resembled its marks phonetically and visually and was likely to cause confusion. In support of its arguments, the first opponent relied on *Rowntree Co. Ltd v Paulin Chambers Co. Ltd* [1968] SCR 134, *Benson & Hedges (Canada) Ltd. v St Regis Tobacco Corp.* [1969] SCR 192, *the Pianotist Case*, and *British Sugar PLC v James Robertson and Sons Ltd* [1996] RPC 281.

It argued that a consumer going to the market looking for its products and not finding any and coming across the appellant's mark would proceed to buy the product thinking it was the first opponent's.

It further argued that being pharmaceutical products, a mistake could prove fatal.

On the issue of claim to ownership of the mark, the first opponent submitted that it was a well-settled requirement that before a person could file for registration of a mark that person had to have a valid and legal claim as the owner of such mark. In this instance, the first opponent argued that the application as advertised showed that the applicant had disclaimed the right to the exclusive use of all three words in the opposed mark meaning that the mark had no distinctive element as required under the provisions of section 12 of

the Act. In support of this argument, the first opponent relied on *British Sugar PLC v James Robertson & Sons Ltd*.

On the issue of distinctiveness, the first opponent argued that under Kenyan Trade Marks Law, an application had to be distinctive and adapted to distinguish the goods or services of the applicant in accordance with section 12 of the Act. In support, the first opponent relied on *In re TMA No. 68415, Strategic Industries Ltd v Rebecca Fashion Ltd* (2013).

For these reasons, the first opponent submitted that the opposed mark should not have been approved for publication and should not be allowed to proceed to registration as it failed the distinctive and similarity tests of trade mark registration.

Attached to the first opponent's submissions were a number of authorities. However, a number of the cases referred to in the submissions were not provided and it was therefore not possible to read through them in order to ascertain the context in which the quotes relied on by the first opponent were made. This practice of referring to a case but not providing it for perusal is one that counsel should desist from adopting as it greatly reduces the helpfulness of the authorities.

SECOND OPPONENT'S WRITTEN SUBMISSIONS

In its written submissions dated 13 November 2013 and filed on the same date, the second opponent started by recounting the grounds on which its opposition was premised and the order in which pleadings had been filed.

It submitted that its grounds of opposition were primarily that the opposed mark was similar and resembled its mark SONA MOJA phonetically and thus should have been refused registration pursuant to the provisions of sections 14 and 15(1), Trade Marks Act and, secondly, that the opposed mark did not qualify for registration as a trade mark under the provisions of section 12 and the applicant had no valid or legal claim under the provisions of section 21 of the Act.

The second opponent contended that if the opposed mark was registered, anybody buying goods from the second opponent or the applicant was likely to be confused as to the origin of the goods he or she was buying.

The remaining submissions made by the second opponent were identical to those made by the first opponent. There is therefore no need to repeat them here.

APPLICANT'S WRITTEN SUBMISSIONS IN REPLY TO THE FIRST OPPONENT

In its undated and unsigned submissions filed on 28 November 2013 regarding the first opponent's opposition, the applicant started by setting out the definitions of a trade mark and a mark as provided in section 2 of the Trade Marks Act. It then submitted, *inter alia*, that the opponent was not a subsidiary of Medisel (K) Ltd, that the mark DAWA MOJA EXTRA did not appear in the Register and was thus not a registered trade mark, that it was not possible to have words of common notoriety and universal application registered as trade marks, that the term DAWA was a common Kiswahili word that could not "be patented or used as a trademark globally", that the applicant's application was in respect of an invented trade mark, that the opposed mark was neither identical nor did it resemble any of the opponent's marks, and that section 15(2) of the Act allowed the Registrar to register identical trade marks in special circumstances. The applicant further submitted that the first opponent had not lodged its Notice of Opposition with clean hands, that the first opponent had not complied with the provisions of rule 47(2) of the Trade Marks Act in that it had not proved similarity of the opposed mark vis-a-vis other marks in the Register, and that the use of the term DAWA by the first opponent was not a vested right under the Constitution.

For these reasons the applicant prayed that the application be approved for registration with costs in its favour.

Attached to the submissions were a number of documents purporting to be the list of the applicant's authorities. However, they were neither properly titled, dated or referenced and their authenticity and reliability is therefore doubtful.

At this point, I should also note that the applicant's submissions were, almost word for word, a repetition of the applicant's counter-statement dated 17 December 2012 and filed on 18 January 2013. It therefore contained next to nothing in reply to the first opponent's written submissions.

APPLICANT'S WRITTEN SUBMISSIONS IN REPLY TO THE SECOND OPPONENT

On the same date, 28 November 2013, the applicant filed its written submissions in reply to the second opponent's written submissions. Like the submissions regarding the first

opponent, they were neither signed nor dated.

In its submissions, the applicant submitted, *inter alia*, that the opposed mark did not resemble the second opponent's SONA MOJA mark and was thus unlikely to cause confusion, that the word MOJA was a common term in the Kiswahili language, that the second opponent was "playing mischief" by asserting that the term MOJA was exclusively associated with its products, and that the opponent had not demonstrated how it stood to suffer prejudice if the opposed mark was registered.

The applicant further submitted that the second opponent's attempt to block registration was a thinly disguised move to perpetuate unfair trade practices by avoiding any form of competition, and that it had invested an enormous amount of capital and equipment in the business subject matter of the application and stood to suffer irreparable harm if the opponent's claims were upheld.

For these reasons it requested that the opposed mark proceed to registration with costs of the proceedings in its favour.

Attached to the submissions were an identical list of documents as those attached to the submissions regarding the first opponent, purporting to be authorities in support of its submissions but without any dates, signatures or other authenticating features.

FIRST OPPONENT'S SUBMISSIONS IN REPLY

In its reply dated 4 December 2013, the first opponent reiterated the averments contained in its written submissions filed on 13 November 2013 and submitted further that the applicant had arrived at an invalid conclusion for the reasons that opposition proceedings were provided for use by parties whose rights would be infringed by registration of a new mark, that the exercise of that right was not itself worth punishment, that the applicant had not met the prerequisite threshold, that the allegations of huge losses had not been proved by way of documentary evidence, that the authorities relied on were remotely related to the issues for determination, and that the applicant had not responded to the issues raised by the first opponent. Regarding the authorities annexed to the applicant's submissions, the opponent submitted that the proper way to cite authorities was to produce the case law or indicate the proper citation as provided by the legal reporting body.

For these reasons, the first opponent submitted that registration of the opposed mark would be contrary to the provisions of sections 12, 14, 15(2) and 21 and the mark should not be allowed to proceed to registration.

SECOND OPPONENT'S SUBMISSIONS IN REPLY

In its reply dated 4 December 2013, the second opponent reiterated its written submissions dated 13 November 2013 and averred that it had shown that it had a mark by the name SONA MOJA and that the mark deserved protection by the Registrar.

It submitted further that it was serious about the opposition and was not “playing mischief”, that the opponent was not in the business of “hoodwinking” other institutions, that the so called huge losses had not been proved, that the applicant had not responded to the issues raised and that the authorities referred to had not been properly produced. For these reasons, it reiterated that the application should not have been approved for publication and should not be allowed to proceed to registration.

ISSUES TO BE DETERMINED

The two opponents herein oppose the registration of the applicant's trade mark DAWA MOJA EXTRA primarily on the grounds, firstly, that the mark was not registrable due to lack of distinctiveness and, secondly, that it was confusingly similar to their marks.

The applicant, on the other hand, argued that the opposed mark did not resemble any of the opponents' marks and that, in any case, the opponents' marks consisted of common Kiswahili words that were of common notoriety which could not be registered as trade marks.

Having read through all the material on record, I find that the issues that arise for determination in this opposition are the following:

- Does the applicant have a legal claim to submit an application for registration of the opposed mark?
- Is the opposed mark a registrable trade mark under the Trade Marks Act?
- Would the opposed mark be disentitled to protection in a court of justice by reason of its being likely to deceive or cause confusion?
- Would registration of the opposed mark be contrary to the provisions of section 15?

1. Ownership of the Opposed Mark

The first opponent raised the issue of ownership of the opposed mark, stating in paragraph 12 of its Notice of Opposition, that the applicant had “no valid or legal claim to the mark “DAWA MOJA EXTRA” and are not the creators or proprietors of the same.” The applicant in its counter-statement did not respond directly to this statement, relying instead on section 15(2) of the Trade Marks Act to argue that paragraphs 12 - 16 of the Notice of Opposition could not stand.

The relevant law is to be found in section 20(1) of the Trade Marks Act which provides that

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.

In this instance, the first opponent challenged the applicant's ownership of the mark, claiming that the applicant had not established its ownership. However, this assertion was disputed by the applicant, which argued in its written submissions that its application was in respect of an invented trade mark, distinct from the word DAWA. On this issue, I am not persuaded that the first opponent has adduced sufficient evidence to prove that the applicant did not indeed come up with the opposed mark.

I therefore find that the applicant was entitled to submit the application for registration of the mark based on its claim to be the proprietor of the mark.

2. Registrability of the Opposed Mark

This issue was raised by the first opponent who asserted that the opposed mark did not qualify for registration as a trade mark under the provisions of the Trade Marks Act as it was not distinctive of the applicant's goods.

In reply, the applicant made somewhat confused and confusing submissions which, if anything, went to support the case made by the opponent. For instance, in its counter-statement dated 17 December 2012, it stated that “It is not possible in law, to have words that are of common notoriety and have universal application such as “MAJI” (sic), “DAWA” etc. registered as trademarks” and that “The term “DAWA” is a Kiswahili word used extensively in the East African region, and has acquired common notoriety and universal

application, to mean medicine.” It also submitted, in paragraph 6 of the counter-statement, that the application was in respect of an invented trademark under the Act, “distinctive from the word “DAWA”. This would appear to have been a reference to the fact that the opposed mark is composed of three words rather than just one word. The applicant would also appear to have relied on the registration of other marks containing the words “DAWA” or “MOJA” to support its submission that its mark was registrable and there was no exclusivity in those words.

The requirements for registrability of a trade mark are set out in sections 12 and 13 of the Trade Marks Act for marks in Part A and Part B of the Register respectively. Thus, for a mark to be registered in Part A it must be distinctive in the sense of being adapted to distinguish goods of the proprietor of the mark from other goods, while for registration in Part B it must be capable of so distinguishing the goods.

In this instance, I am in agreement with the arguments made by the two opponents that the mark does not meet the requirements for registration under either Part A or Part B.

With regard to Part A, the Act provides that the mark should contain at least one of the following particulars:

- a) the name of a company, individual or firm, represented in a special or particular manner;
- b) the signature of the applicant for registration or some predecessor in his business;
- c) an invented word or invented words;
- d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- e) any other distinctive mark, but a name, signature or word or words, other than such as fall within the descriptions in paragraphs (a), (b), (c) and (d), shall not be registrable under this paragraph except upon evidence of its distinctiveness.

It is clear that the mark DAWA MOJA EXTRA does not fall into any of these categories, neither has the applicant provided any evidence as to its distinctiveness. Indeed, as the applicant itself submitted, the word DAWA is an ordinary Kiswahili word meaning medicine as is the word MOJA which means one. There is therefore nothing about the mark that is

adapted to distinguish it for use with regard to goods in class 5.

Likewise, with regard to Part B, the Trade Marks Act provides that in order for the Registrar to determine whether a mark is capable of distinguishing, the Registrar shall have regard to the extent to which -

- a) the trade mark is inherently capable of distinguishing; and
- b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing.

In this instance, as I have noted earlier, the trade mark is not inherently capable of distinguishing and there is no evidence that it has become, by reason of use or other circumstances, capable of distinguishing.

I therefore find that the opposed mark DAWA MOJA EXTRA is not registrable under the provisions of the Trade Marks Act.

3. Deceptiveness or Likelihood of Confusion

This is an issue that both opponents raised. The first opponent argued that the opposed mark was deceptively similar to a number of marks that it listed in its Notice of Opposition, some of which it stated were owned by a different company, Medisel (K) Ltd. The second opponent on the other hand relied on its ownership of the mark SONA MOJA, arguing that it was the first to adopt and use that term in relation to pharmaceutical products. The opponents further argued that in light of the fact that the mark would be applied on identical goods, this would enhance the likelihood of confusion.

In reply, the applicant argued, *inter alia*, that its mark was neither identical to nor did it deceptively resemble the opponents' marks. It also argued that the words DAWA and MOJA were common Kiswahili words to which the opponents could not claim exclusivity.

The question that arises is whether the opposed mark would be disentitled to protection in a court of justice 'by reason of its being likely to deceive or cause confusion'.

The applicable provision of law is found in section 14, Trade Marks Act which 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.

To determine this issue, the well-known test laid out by Parker, J. in *the Pianotist* case, that is, that the marks have to be judged, both by their look and by their sound, is applicable.

In this instance and with regard to the opposition by the first opponent, however, an additional factor that arises for consideration is the nature of the marks that the first opponent is relying on. It cannot have been the intention of the legislature that section 14 be used by an opponent to preclude applicants from incorporating descriptive or non-distinctive terms in a mark on the ground that this would cause confusion. Only when a distinctive mark, or the distinctive element of a mark, is copied in a confusingly similar or deceptive manner, can section 14 be relied upon.

I have already noted above that the words DAWA and MOJA are, as the applicant persuasively submitted, common Kiswahili words meaning “medicine” and “one” respectively. They are therefore wholly devoid of any distinctiveness for goods in class 5 and thus available for use by the applicant. Their use as part of a mark would not, therefore in my opinion, render them as being likely to deceive or cause confusion.

The choice by the first opponent of the word DAWA for use as a trade mark for pharmaceutical products was therefore poor in that it is not distinctive and the use of such a descriptive word is not such as would disentitle another mark incorporating that word to protection in a court of justice.

With regard to the opposition by the second opponent, the mark relied on by the second opponent is SONA MOJA. Applying the test laid down in *the Pianotist*, I find that there is insufficient similarity either visually or phonetically between the marks SONA MOJA and DAWA MOJA EXTRA to cause deception or confusion such as would disentitle the latter from protection in a court of justice. Any confusion that might arise from the shared use of the word MOJA in this instance would arise from the second opponent's choice of an ordinary word to which it cannot have exclusivity in the context of class 5 goods.

I accordingly find that the opposed mark would not be disentitled to protection in a court of justice and it is thus eligible for registration.

With regard to the first opponent's claims to ownership of the marks registered in the name

of Medisel (Kenya) Ltd, I find that the first opponent did not provide any proof to support its assertion of a relationship between itself and Medisel (Kenya) Ltd. Indeed, this assertion was rebutted by the applicant's statutory declaration dated 22 April 2013 and the exhibits attached thereto. Those exhibits showing the true ownership of the two companies were not adequately responded to by the first opponent in its statutory declaration in reply which amounted to no more than a blanket denial of the averments. I accordingly find that the first opponent did not file its opposition "with clean hands" and indeed, attempted to mislead the Registrar in this regard.

4. Similarity to a Mark on the Register

This issue was raised by both the first and second opponents. The first opponent, in its Notice of Opposition, provided a list of some eight (8) marks of which it claimed to be the proprietor, currently subsisting on the Register. However, in its Statutory Declaration, it only included copies of certificates of four marks, three of which are registered in the name of Medisel (Kenya) Ltd, among its attached exhibits. There was therefore no evidence as to the subsistence or ownership of TM Nos. 31204, 31205, 37248 and 67935. The second opponent, for its part, claimed ownership of the mark SONA MOJA but provided no evidence to show that the mark was registered.

Section 15(1) of the Trade Marks Act 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.

An examination of the marks relied on by the first opponent reveals that of the eight, only one TM No. 36189 DAWA (word and device) comprises the word DAWA while the others incorporate DAWA- in their marks. I have already noted above that the word DAWA for goods in class 5 is descriptive in nature and incapable of being appropriated by any one proprietor. Any similarity arising from inclusion of that word in the opposed mark does not,

therefore offend against the provisions of section 15.

With regard to the mark SONA MOJA, I likewise find that the shared element, which is the word “MOJA”, is not distinctive in nature and, in any case, that the dominant element of the second opponent's mark is the word SONA, which does not appear in the opposed mark. I therefore find that registration of the opposed mark would not be contrary to the provisions of section 15 of the Trade Marks Act.

In conclusion, I note that even though the first opponent mentioned section 15A in its Notice of Opposition, no submissions were made supporting this provision as a ground of opposition neither was any evidence provided in this regard and I therefore take it that the first opponent abandoned this as a ground of opposition.

DECISION

For the reasons set out above, the Registrar finds as follows:

1. That the applicant was entitled to apply for registration of the mark as owner;
2. That the opposed mark is not registrable under the provisions of the Act;
3. That registration of the opposed mark would not be likely to deceive or cause confusion to members of the public contrary to the provisions of section 14;
4. That registration of the opposed mark would not be contrary to the provisions of section 15;
5. That the mark shall not proceed to registration; and
6. The parties herein shall bear their own costs save for the costs of the hearing held on 31 October 2013 which are awarded to the applicant.

Ruling dated at Nairobi this 30th day of April 2014.

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DR. HENRY KIBET MUTAI
REGISTRAR OF TRADE MARKS