

KENYA INDUSTRIAL PROPERTY INSTITUTE



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THE TRADE MARKS ACT CAP 506 OF THE LAWS OF KENYA
AND
IN THE MATTER OF TRADE MARK NO. KE/T/2011/071011 "SUPA MANDAZI"
(WORDS AND DEVICE) IN CLASS 30 IN THE NAME OF TRICLOVER INDUSTRIES
(K) LIMITED AND OPPOSITION PROCEEDINGS THERETO BY GLOBAL
INVESTMENT DEVELOPMENT LIMITED

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

Background

On 8th April 2011, Triclover Industries (K) Limited (hereinafter referred to as the "Applicants") filed an application for registration of trade mark No. KE/T/2011/071011 "SUPA MANDAZI" (WORDS AND DEVICE) (hereinafter referred to as the Mark). The mark was applied for in class 30 in respect of "Baking Powder". The Registrar of Trade Marks duly examined the mark in accordance with the provisions of the Trade Marks Act Cap 506 of the Laws of Kenya and the mark was approved and published in the Industrial Property Journal on 31st December 2011 on page 20.

On 6th February 2012, Global Investment Development Limited (hereinafter referred to as "the Opponents") filed a Notice of Opposition against registration of the mark. The grounds of opposition were as follows:

1. We are the proprietors of Trade Mark No. 15660 "Chapa Mandashi" for baking powder in class 30 schedule III (hereinafter the Trademark)
2. We have for upwards of 35 years extensively used the trademark as the names of and in connection with baking powder manufactured by ourselves and the said trademark denotes both the trade and the public goods manufactured by us and distinguishes and has long distinguished such goods from the like goods of other manufacturers and traders. The trademark has acquired considerable goodwill and

reputation.

3. That by reason of the goodwill and reputation acquired by our trademark already in use, use of the proposed mark now sought by the applicant to be registered would be deceptive or confusing.
4. The proposed use of the trademark which the applicant has applied to register is calculated to deceive and/or lead to the applicant's goods being passed or mistaken for goods manufactured or sold by us and the application ought to be refused IN THE ALTERNATIVE (even if such is not the intention) the effect of the intended registration will be to cause confusion in the minds of the buying public.
5. Part of the proposed trademark, "Mandazi" which the applicant is attempting to register is virtually identical or so closely resembles or further is phonetically similar to part of our trade mark, "Mandashi" hence confusion and deceptions is likely to arise in the minds of the public so as to disentitle the Mark Supa Mandazi Trademark application No. KE/T/2011/0071011 to protection in a court of justice.
6. The Logo of the proposed trademark is similar and/or identical to our registered logo as it depicts a tray full of 'Buns' making it confusingly similar and/or identical and further, the labeling, the directions of use, ingredients, the manufacturer as well as the bar codes are put using the same side, format and scheme as that of Chapa Mandashi.
7. FURTHER, the goods covered by the proposed trademark of Super Mandazi are the same goods or goods of the same description as those covered by our trademark. This is likely to lead to confusion or deception of the public arising through the sale of such goods under the proposed trademark.
8. There is a likelihood that the members of the public may mistakenly purchase the applicant's goods bearing the mark represented in the proposed trademark thinking that they are goods manufactured by ourselves or vice versa.
9. The proposed use of the trademark which the applicant has applied to register is calculated to deceive and/or lead to the applicant's goods being passed or mistaken for goods manufactured or sold by us and the application ought to be refused IN THE ALTERNATIVE (even if such is not the intention) the effect of the intended registration will be to cause confusion in

the minds of the buying public.

10. The overall get-up of the applicant's proposed trademark is confusingly similar to ours.
11. The proposed trade mark Application No. KEIT/2011/0071011 therefore be refused registration under sections 14 and 15 of the Trade Marks Act.

The Notice of Opposition was duly forwarded to the Applicants who on 5th April 2012 filed their Counter Statement. The Applicants stated the following as the grounds on which they would rely in support of their application:

1. The Applicant deals in different blends of petroleum jelly, lotion, hair gels and also packs food additives like baking powder, laundry starch, coconut oil, icing sugar, glycerin among others. The Applicant sells its products in Kenya and in other African countries like Ethiopia, Uganda, Rwanda Burundi and Congo.
2. The Applicant markets its products in its well-known and accepted logo/brand name 'Clovers' placed in a Red Oval. Besides the specific Mark for each of the Applicant's products, the said logo/brand is dominant in all the Applicant's products and as such the Applicant's products are clearly distinguished by this logo/brand and cannot be confused with any other products in the Market.
3. The Applicant admits the contents of paragraph 1 of the Opponents' Statement of Grounds for Opposition.
4. The Applicant, while putting the Opponent to strict proof, denies the contents of paragraph 2, 3, & 4 of the Grounds of Opposition. The Applicant contends that its Trade Mark would not deceive and/ or lead to the Applicant's goods being passed or mistaken for goods manufactured or sold by the Opponent.
5. In response to paragraph 5 of the Grounds of Opposition, the Applicant vehemently denies that the word 'MANDAZI' in its mark

and 'MANDASHI' in the Opponent's mark are visually identical or closely resemble each other or are phonetically similar. Further the word 'MANDAZI' and 'MANDASHI' have different letters that is 'Z' for 'MANDAZI' and 'SH' for 'MANDASHI', which do not bear similar pronunciations and as such cannot be phonetically confused. Furthermore, the word 'MANDASHI' is produced in all blue and placed horizontally in the Mark whereas 'MANDAZI' is produced in white and placed diagonally in the Mark and as such rules out any visual confusion.

6. In response to paragraph 6 of the Grounds of Opposition, the Applicant, while inviting the Opponent to strict proof, avers that the Opponent's logo and its logo are in no way similar. Furthermore, the tray full of 'Buns' is not the Opponent's logo as claimed in paragraph 6 of the Grounds of Opposition. In as much as the labeling, directions, ingredients, the manufacturer as well as the bar codes do not form part of a Mark, the same are not placed on the same side, format and/ or scheme in respect of the two Marks. They are either in different sides of the respective Marks and or are inverted.

7. In comparison with the Opponent's Trade Mark, the Applicant's Mark cannot give rise to deception and/ or confusion for the following reasons:

- 7.1. Phonetically:

- 7.1.1. SUPA MANDAZI has the first word as 'SUPA' which cannot in any way be pronounced in the same way or even nearly in the same way as CHAPA 'MANDASHI's first word 'CHAPA'.
- 7.1.2. As stated before, SUPA MANDAZI's second word 'MANDAZI' is not pronounced in the same was as CHAPA 'MANDASHI' s second word "MANDASHI" because of the respective letters i.e. 'Z' and 'SH'. Besides and without prejudice to the foregoing, Baking Powders are used for preparing Mandazis and as such it is the norm rather than the exception to have Marks in respect of Baking Powders having generic words like MANDAZI, 'MANDASHI', MANDAZY or ... ANDAZI as a component of the respective Trade Marks.

7.2. Visually;

7.2.1 The Opponent's Mark 'CHAPA MANDASHI' is produced in blue coloured letters and placed in one line horizontally at the top of the Mark, whereas, the Applicant's Mark, SUPA MANDAZI' is produced in white coloured letters and placed in two lines diagonally in the Mark.

7.2.2 The Opponent's Mark has a blue rectangle and a yellow border while the Applicant's Mark has Yellow and Blue lines running diagonally through the Mark. Blue and Yellow colours are however common in Baking Powders in the Market and as such cannot be a monopoly of any person.

7.2.3. The Opponent's Mark is accompanied by a logo presented in a semblance of letter 'K' with a symbol of dropping red liquid both placed in a white rectangular shape whilst the Applicant's Mark is accompanied by a logo with the word 'clovers' enclosed in a horizontally compressed red Oval.

8. In response to paragraphs 7 and 8 of the Grounds of Opposition, the Applicant admits that the goods covered by the two Marks fall within the same description but denies that this can lead to deception or confusion. Besides, buyers order or identify goods by their names, in this case 'CHAPA MANDASHI' or 'SUPA MANDAZI' which as aforesaid are phonetically different.

9. The overall get-up of the Applicant's Mark is not confusingly similar for reasons aforesaid, and as such the Applicant puts the Opponent to strict proof thereof.

10. Despite the Applicant's Mark having been in the Market for almost one year, no infringement proceedings have ever been filed by the Opponent. This proves that the opposition is an afterthought lodged for purposes of fighting a *bona fide* competitor under the guise of alleged confusion in the Market.

11. If the Opponent's opposition is allowed, the Applicant will be unfairly restrained from registering its Trade Mark, which Mark is already in use.

12. The Applicant therefore prays that the Opponent's Opposition be dismissed with costs, taking into account the foregoing grounds.

The Counter Statement was forwarded to the Opponents who on 31st May 2012 filed their Statutory Declaration. The Statutory Declaration was sworn by one Nitin Shah, a Director of the Opponents. Mr. Shah reiterated the contents of the Opponents' ground of opposition as indicated in the aforementioned Notice of Opposition, denied the contents of the Applicants' Counter-statement and prayed that TMA No. 71011 "SUPA MANDAZI" should not be entered in the Register of Trade Marks for the reason that the same is identical to the Opponents' registered mark TMA No. 15660 "CHAPA MANDASHI" which is a well-known mark in Kenya.

The Opponents' Statutory Declaration was forwarded to the Applicants who on 16th July 2012 filed their Statutory Declaration. The Statutory Declaration was sworn by one Muzahir Bhajjee, the Applicants' Finance Manager who reiterated the contents of the Applicants' Counter-statement, denied the contents of the Opponents' statutory declaration and prayed that the TMA No. 71011 "SUPA MANDAZI" should be entered in the Register of Trade Marks for the reason that the same is distinctive of the goods of the Applicants and is not identical to the Opponents' registered mark TMA No. 15660 "CHAPA MANDASHI".

The Applicants' Statutory Declaration was forwarded to the Opponents who on 23rd August 2012 filed their Statutory Declaration In Reply. The Statutory Declaration was sworn by the said Nitin Shah, a Director of the Opponents, who denied the contents of the Applicants' Statutory and prayed that the Applicants' mark should not be entered in the Register of Trade Marks in Kenya.

Ruling

I have considered the Notice of Opposition filed by the Opponents, the Counter-Statement filed by the Applicants and the evidence adduced by the parties by way of their respective Statutory Declarations. I have also considered the written submissions filed herein by Boniface M. Muumbi & Advocates and Magut Kirigo & Sang Advocates for the Opponents and the Applicants respectively. The main contention of the Opponents herein is that the Applicants' mark is so similar to their registered mark TMA No. 15660 "CHAPA MANDASHI" (WORDS AND DEVICE) as to cause confusion contrary to the provisions of the Trade Marks Act. I am of the

view that the following is the issue that should be determined in these opposition proceedings:

Is the Applicants' mark "SUPA MANDAZI" (WORDS AND DEVICE) so similar to the Opponent's mark "CHAPA MANDASHI" (WORDS AND DEVICE) as to cause a likelihood of confusion in contravention of the provisions of section 15(1) of the Trade Marks Act?

Section 15 (1) of the Trade Marks 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 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 be able to determine whether or not marks are similar, several factors need to be considered. In the case of *Eli Lilly & Co V Natural Answers Inc* 233, F. 3d 456, [USA] the following were indicated as some of the factors to consider:

- (a) the similarity between the marks in appearance and suggestion;
- (b) the similarity of the products;
- (c) the area and manner of concurrent use of the products;
- (d) the degree of care likely to be exercised by consumers;
- (e) the strength of the complainant's mark;
- (f) any evidence of actual confusion;
- (g) the defendant's intent (or lack thereof) to palm off its product as that of another.

The following is a consideration of some of the aforementioned factors:

The Strength of the Complainants' Mark:

The complainants in these opposition proceedings are the Opponents. The Opponents' mark "CHAPA MANDASHI" (WORDS and DEVICE) is comprised of elements that are common to the trade in respect of goods under class 30 of the International Classification of Marks and specifically baking powder. The said elements include the words "BAKING", "POWDER", and "MANDASHI" as well as a device of a container full of "BUNS". Under the provisions of the Trade Marks Act, the said elements should not be registered in the name of any particular person to the

exclusion of all the other persons in a similar trade. It is for this reason that section 17 provides that where a trade mark contains matters that are common to the trade or are otherwise of a non-distinctive nature, the Registrar of Trade Marks ought to require the applicant to disclaim the right to the exclusive use of the said elements. The aforementioned elements are not a creation of the Opponents and any person should be able to use them without interfering with the rights of the Opponents, since the same are not distinctive of the goods in class 30 and especially baking powder.

In the book WIPO Intellectual Property Handbook by the WIPO Intellectual Property Handbook: Policy, Law and Use, it is stated as follows on page 87:

“The third most important point is that highly distinctive marks (coined or arbitrarily used marks) are more likely to be confused than marks with associative meanings in relation to the goods for which they are registered”.

Having adopted a mark with descriptive elements, for use in goods under class 30 of the International classification, the Opponents risk having many other persons in the same trade who would desire to use similar elements. In their pleadings, the Opponents claim that they have used their trade mark “CHAPA MANDASHI” (WORDS and DEVICE) for more than thirty-five (35) years in Kenya. However, in trade mark practice, use of a trade mark that is comprised of the above-mentioned elements which are common to the trade does not accord the trade mark distinctiveness as required under the provisions of the Trade Marks Act. In the case of *British Sugar Plc v James Robertson & Sons Limited*, the court stated as follows:

“I have already described the evidence used to support the original registration. It was really no more than evidence of use. Now it is all too easy to be beguiled by such evidence. There is an unspoken and illogical assumption that “use equals distinctiveness”. The illogicality can be seen from an example: no matter how much use a manufacturer made of the word “Soap” as a purported trade mark for soap the word would not be distinctive of his goods. He could use fancy lettering as much as he liked, whatever he did would not turn the word into a trade mark. Again, a manufacturer may coin a new word for a new product and be able to show massive use by him and him alone of that word for the product. Nonetheless the word is apt to be the name of the product, not a trade mark.... It is precisely because a common laudatory word is naturally capable of application to the goods of any trader that one must be careful before concluding that merely its use, however substantial, has

displaced its common meaning and has come to denote the mark of a particular trader."

The court then quoted the Canadian case known as Canadian Shredded Wheat Co Ltd v Kellogg Co of Canada Ltd ((1938) 55 RPC 125) in the Privy Council where Lord Russell said as follows at page 145:

"A word or words to be really distinctive of a person's goods must generally speaking be incapable of application to the goods of anyone else."

In the South African case of Adcock Ingram Products Ltd V Beecham (PTY) Ltd, the court stated as follows:

"the plaintiff must prove in the first instance that the defendant has used or is using in connection with his own goods a name, mark, sign or get up which has become distinctive in the sense that by the use of the plaintiff's name or mark, in relation to goods they are regarded by a substantial number of members of the public or in the trade, as coming from a particular source known or unknown. In other words, the Plaintiff must prove that the feature of his product on which he relies has acquired a meaning or significance, so that it indicates a single source for goods on which that feature is used."

In the book Intellectual Property, Sixth Edition by David I Bainbridge, the author states on page 744:

"... descriptive words are likely to lack distinctiveness in most cases such that it will be difficult, if not impossible, for a trader to demonstrate that he has a goodwill associated with the word or words in question."

In the aforementioned book WIPO Intellectual Property Handbook by the WIPO Intellectual Property Handbook: Policy, Law and Use, it is stated as follows on page 87:

"When trade marks with a common element are compared, it also has to be established whether there are other trade marks on the register and used by different owners that have the same common element. If so, the consumer will have become accustomed to the use of this element by different proprietors, and will no longer pay special attention to it as a distinctive element of the mark."

The following table indicates that in addition to the Opponents' trade mark, the Register of Trade Marks contains other trade marks that are comprised of the aforementioned common elements, all registered in

respect of goods in the said international class 30, all being goods of a similar description:

	TMA No	Date of Application	Trade Mark	Class	Goods	Proprietor
1.	49207	9 th September 1999	"SUPA MANDAZI" (WORDS and DEVICES)	30	Baking powder	Popular Tastes Industries
2.	59072	27 th April 2006	"SUPER MANDAZI NYANZA BISCUITS" (WORDS and DEVICES)	30	Yeast, Baking powder	Harish Kotecha
3.	61611	19 th July 2007	"MAMA NDAZI" (WORD and DEVICES) black and white	30	Yeast baking powder, mustard, sauces and vinegar	Universal Ponds (K) Ltd
4.	64101	19 th September 2008	"PIKANDAZI" (WORD and DEVICES) Colours blue, yellow, white and brown	30	Baking powder	Universal Ponds (K) Ltd

In the South African case referred to as Bata Limited V Face Fashions and Michael Terrence Gormley the court stated as follows:

"...If full effect is given to this argument it would result in the appellant having a virtual monopoly to use the word "Power" on clothing. According to the evidence, however, there are numerous trade mark registrations in South Africa in respect of clothing which incorporate or include the word "Power". It is an ordinary word in everyday use, as distinct from an invented or made-up word, and it cannot follow that confusion would probably arise if it is used in combination with another word."

From the foregoing, it is clear that the Opponents' mark is not a strong mark and is therefore incapable of being confused with the Applicants' mark as applied for. Having adopted common and descriptive words to distinguish their goods, the Opponents then run a risk of failing to uphold a monopoly of the said words, which other traders in the same kind of business would desire to use and are actually using in respect of similar goods or goods of a similar description under class 30 of the International Classification of Goods and Services.

The Degree of Care Likely to be Exercised by Consumers

In the Book Kerly's Laws of Trade, 14th Edition, paragraph 17-018, under the sub title "Standard of Care to be Expected", 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 Opponents' mark would be deceived."

I am aware that the products that are dealt with both by the Opponents and the Applicants under their respective marks are leavening agents, which means they are added to buns before deep frying in hot oil to produce carbon dioxide and cause the buns to 'rise'. In my view, these are luxurious goods, which although not very expensive like a computer for example, are not every day goods that are to be found in all the Kenyan homes. They are not what would be referred to as essential goods like milk or salt. They are very important to the purchasers and are usually selected with a lot of deliberation. In my view, they are not products that would be considered to be bought by "unusually stupid people, fools or idiots, or a moron in a hurry" who may be easily deceived.

In the case of Reed Executive PLC v Reed Business Information Ltd, 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."

Purchase of leavening agents is neither a "fifty pence purchase in the station kiosk" nor is it "a once-in-a-lifetime expenditure of £50000". It is a purchase made by consumers who are discerning and are very careful having in mind that buying that which one did not intend to purchase could result in the undesired effect of having unleavened buns.

The above-mentioned degree of care means that it would be most unlikely that the purchasers of the Opponents' products would be confused into buying the Applicants' products.

Similarity between the marks in appearance and suggestion

The Applicants' mark is comprised of the device of "buns" as well as the words "Clovers", "SUPA", "MANDAZI", "BAKING", "POWDER", "PERFECT", "FOR" and "BAKING". The mark is in several colours including white, blue, red, black, yellow and brown. The Opponents' mark is comprised of the device of "a tray full of buns" and the words "CHAPA", "MANDASHI", "BAKING" and "POWDER". The Opponents' mark is in colours white, blue and yellow. From the pleadings that were filed by both the Opponents and the Applicants, their respective marks are used in the Kenyan market as composite marks. As aforementioned, the Applicants have sought to register a composite mark, which is comprised of several elements including the word "Clovers", a part of their company name, Triclover Industries (K) Limited. It is my view that the two marks, when compared as a whole and taking all the surrounding circumstances into consideration, are not similar in appearance.

To determine whether or not marks are similar, one ought to consider the overall impression left in the mind of the purchaser. In the case of *Sabel v Puma*, the European Court of Justice stated as follows:

"In determining whether there is a likelihood of confusion, the court must focus on the overall impression made by the respective signs. It is not permissible to isolate one element out of a graphic ensemble and to restrict examination of the likelihood of confusion to that element alone. However, an individual component may be recognized as having a particularly distinctive character which characterizes the sign as a whole, and, consequently, a likelihood of confusion may be found to exist if another party's sign resembles the whole of the sign so characterized. Even in such a case,

however, the two signs must be compared in their entirety and the comparison must not be confined to their individual (characterizing) elements."

In the Case of SA LTJ Diffussion V SA Sadas Vertbaudet, the European Court of Justice held that a sign is to be regarded as identical with a trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they could go unnoticed by an average consumer. Further, it is apparent that the Opponents use their registered trade mark in the Kenyan market together with a stylised letter "K" in dark blue, which is indicated on the Opponents packages as a registered mark. As aforementioned, the Applicants is comprised of the word "Clovers" written in white and on a red background.

In the USA case referred to as Pharmacia Corp., Pharmacia Ab, Pharmacia Enterprises S.A. and Pharmacia & Upjohn Co. V. Alcon Laboratories, Inc., the court stated as follows:

"The prominent display of the Pharmacia and Alcon house marks, along with the distinctive packaging used by each company, further weigh against likely confusion. ... house marks are significant in determining overall impression....house mark "significantly reduces, if not altogether eliminates," any likelihood of consumer confusion"

I am of the view that the differences in the two marks as used in the Kenyan market are not insignificant and would be readily noticed by the consumers of the respective goods for the Opponents and the Applicants.

In regard to this issue, David I. Bainbridge, the learned author of the book Intellectual Property, Sixth Edition states as follows on page 632:

"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."

For the above-mentioned reason, in the English case referred to as Reed Executive PLC v Reed Business Information Ltd, the court was of the view that there was no likelihood of confusion between an earlier-registered mark "Reed" and the latter mark, "Reed Business Information" since the two were not identical, though they were similar and were both in respect of similar services in class 35 of the International Classification of Goods and Services. Jacob LJ stated as follows:

"So is 'Reed Business Information' identical to 'Reed'? I think not. Reed is a common surname. The average consumer would recognize the additional words as serving to differentiate the defendant from Reeds in general.... Putting it another way, I do not think that the additional words "Business Information" would go unnoticed by the average consumer."

Similarly, in the case of Compass Publishing BV v Compass Logistics Limited, it was held that "COMPASS LOGISTICS" was not identical to "COMPASS", "as the differences were apparent and the public would distinguish them without prior coaching."

The respective marks of the Opponents and the Applicants are not identical. The marks are comprised of different elements that would not go unnoticed by the purchasers of the respective products are, as earlier indicated, persons who are discerning and are expected to know exactly what they would be intending to buy.

Any Evidence of Actual Confusion

I am aware that these are not infringement but opposition proceedings. However, as earlier indicated, in the case of Eli Lilly & Co V Natural Answers Inc, evidence of actual confusion was indicated as one of the issues to consider while determining whether or not marks are similar. Further, in the article known as A Tale of Confusion: How Tribunals Treat the Presence and Absence of Evidence of Actual Confusion in Trade Mark Matters, the author, Paul Scott states that in opposition and expungement proceedings, Tribunals consider several factors including whether or not "actual incidents of confusion or deception have occurred".

In their pleadings, the Applicants stated that by the time the opponents commenced the current opposition proceedings, the goods of the Applicants had been offered in the Kenyan market for a period of almost one year with the Opponents filing no infringement proceedings against the Applicants. In reply to the Applicants' contention, the Opponents stated that this was an admission on the part of the Applicants that they were infringing on the Opponents' mark. It is my view that the products of

the Opponents and the Applicants have co-existed in the Kenyan market without any evidence of actual confusion. In the aforementioned case of *British Sugar Plc v James Robertson & Sons Limited*, British Sugar Plc, the court stated as follows:

“British Sugar did not lead any evidence of actual confusion, although the Robertson product has been available for 4 months. No one, whether from the public itself, small shopkeepers, wholesalers or supermarkets, have reported confusion to either side. No buyer suggested to Robertson's, when the product was presented, that there might be confusion. I think there is none.”

In the said case of *British Sugar Plc v James Robertson & Sons Limited*, the court stated that the fact that the products of both Plaintiff and the Defendant were available side by side for four months and there was no evidence of confusion, the court was convinced that there would not be any likelihood of confusion in the future. Following the said finding of the court, I am also of the view that since the leavening agents bearing the Opponents' and the Applicants' respective marks have been used side by side in the same market without any evidence of confusion, then it means that no confusion would be likely to occur once the Applicants' mark is registered.

In the aforementioned article, *A Tale of Confusion: How Tribunals Treat The Presence and Absence of Evidence of Actual Confusion in Trade Mark Matters*, the author, Paul Scott states as follows:

“In the New Zealand case of *Hannaford & Burton*, which was a rectification action, the two marks being compared were Polaroid and Solaviod. They appeared on sunglasses. The owner of Polaroid applied to remove Solaviod. Its reason was that at the time of registration, Solaviod was likely to cause confusion or deception. The Privy Council, in overruling the Court of Appeal, held the mark was not likely to do so. Its reasons included the fact the marks did not look and sound alike and conveyed different ideas. An important factor was that there was no evidence of actual confusion. This was important in the circumstances. Both brands had enjoyed large sales over a long period (several years). They had competed for a long period. Both brands were sold in over 1200 retail outlets throughout New Zealand. Both brands were sold side by side in these outlets. Thus, in these circumstances the lack of confusion evidence was significant.”

The case of *Hammond J in VB Distributors Ltd v Matsushita Electric Industrial Co Ltd* followed *Hannaford & Burton* in holding: “...one of the

most accurate tests of likely confusion is whether confusion occurred between the application date and the long delayed hearing date."

Having being sold side by side and there having been no evidence of confusion between the products of the Opponents and those of the Applicants, then I am of the view that confusion is not likely to occur now or in the future.

In the Bali case, Lord Upjohn noted as follows:

"But such a conclusion may bend to the evidence if such evidence show quite clearly that though to the judicial ear confusion would be obvious, yet over a long period no case of confusion has occurred; but even in such case the judicial ear has the final say, for in the end it is a question of impression and common sense."

After considering all the surrounding circumstances of these opposition proceedings, I have come to the conclusion that the Opponents' and the Applicants' marks are not similar as to cause confusion contrary to the provisions of section 15(1) of the Act.

Conclusion

For the above-mentioned reasons, I have come to the conclusion that:

- (a) on a balance of probabilities, the Opponents have not succeeded in these opposition proceedings;
- (b) the Applicants' trade mark no. KE/T/2011/071011 "SUPA MANDAZI" (WORDS AND DEVICE) shall proceed to registration; and
- (c) I award the costs of these proceedings to the Applicants.



Eunice Njuguna
Assistant Registrar of Trade Marks

7th Day of February 2014

I certify that this is a true copy of the original

Eunice Njuguna
Assistant Registrar of Trade Marks
19th Day of March 2014