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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/2009/066428 "MULTIBIX"
(WORD) IN CLASS 30 IN THE NAME OF MANJI FOOD INDUSTRIES LIMITED
AND OPPOSITION PROCEEDINGS THERETO BY WEETABIX LIMITED

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

Background

On 23rd September 2009 Manji Food Industries Limited (hereinafter referred to as the "Applicants") lodged an application for registration of trade mark KE/T/2009/066428 "MULTIBIX" (WORD) (hereinafter referred to as the Mark). The mark was applied for in class 30 in respect of "biscuits". 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 30th April 2010 on page 20.

On 17th June 2010, Weetabix 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. Weetabix Limited ("the Opponent") is part of the Latimer Group Limited, a company incorporated by Lion Capital a consumer focused investment firm in the United Kingdom. The Opponent has been creating delicious breakfast cereals since 1932.
2. The Opponent's flagship cereal, **WEETABIX** is officially the favourite breakfast in its country of origin - the United Kingdom, accounting for approximately eight percent (8%) of the country's total cereal sales with annual sales worth over Ninety Five Million Pounds (£95,000,000) according to the ACNielsen in May 2008.

3. The Opponent's unique range of breakfast cereals is popular beyond the borders of its country of origin. The Opponent exports its breakfast cereals to over eighty (80) countries worldwide, from the Middle East and South America, to Europe and South East Asia.
4. The Opponent is the sole lawful proprietor in Kenya and throughout the world of the Trade Mark **WEETABIX** expressed as a word and hereinafter also referred to as the Opponent's Mark.
5. Currently, the Opponent also sells other cereal products in Kenya including WEETABIX, OATIBIX, ALPEN, READYBREK, WEETABIX MINI'S and WEETOS.
6. The Opponent's flagship Trade Mark is comprised in the following Kenya Trade Mark Registration:

Number	Trade Mark	Class	Registration Date	Date Advertised	Goods
6339	Weetabix	42	28 th June 1954	5 th October 1954	Cereal foods and wheatmeal biscuits

7. The Opponent manufactures its products in Kenya through its local affiliate, to wit, the Breakfast Cereals Company of Kenya Limited, who is the sole licensee of the Opponent to use the **WEETABIX** Trade Mark.
8. The Opponent's Trade Mark **WEETABIX** is used and registered in most countries worldwide, including the United Kingdom, the countries comprising the European Union, Kenya, amongst others.
9. The Opponent's Trade Marks are also comprised in the following additional Kenya Trade Mark Registrations:

Number	Trade Mark	Class	Goods
	ALPEN		
	VIBIXA		

10. The Opponent's Trade Mark **WEETABIX** is used and registered in most countries worldwide, including the United Kingdom, the countries comprising the European Union, Kenya, amongst others:

Number	Trade Mark	Class	Goods
66702	WEETOS	30	Breakfast Cereals; cereal preparations for human consumption
66701	OATBIX	30	Breakfast Cereals; cereal preparations for human consumption
66704	READY BREK	30	Breakfast Cereals; cereal preparations for human consumption
66703	BIX	30	Breakfast Cereals; cereal preparations for human consumption

11.The Opponent has also registered the following Trade Marks, amongst others, under the Madrid System:

Number	Trade Mark
726023	BANANABIX
726023	MINIBIX
726025	FRUTIBIX
726027	CHOCOBIX
942545	WEETABIX
	CRUNCHIES
946212	OATIBIX
946227	WEETABIX MINIS
1011488	WEETABIX

12.The Opponent equally has the following Trade Marks, amongst its other Trade Marks, in the United Kingdom:

Number	Trade Mark
531457	WEETABIX
584545	VIBIXA
869286	HONABIX
2011590	FRUTIBIX
2060869	24 WEETABIX
1328533	SNOWYBIX
1506435	CRUNCHIBIX
1011488	CHOCOBIX
2136198	MINIBIX
2141634	GOLDENBIX
2183816	BARLABIX
2187312	BANANABIX
2238415	WEETABIX CRISPY BIX
2246878	WITHOUTABIX
2246880	WITHABIX
2302259	MINIBIX ON THE GO
2406115	OATIBIX

13.The Opponent equally has the following Trade Marks, amongst its other Trade Marks, in the United States:

Number	Trade Mark	Class
73428435	FROM THE MAKERS OF WEETABIX	30
79047270	WEETABIX	30
79050133	MINIBIX	30

14.The suffix **BIX** is an element and common component of various Trade Marks belonging to the Weetabix Ltd.

15.The Opponent's Trade Marks have for many years been extensively used in many countries throughout the world, by it and its licensees, in relation to breakfast cereal. Through this extensive use, the Opponent's Trade Marks have acquired a distinction in appearance, concept and style of operation which have rendered them world famous and of high quality.

16.The Trade Mark **WEETABIX** forms part of the Opponent's trade name. The opponent has registered the domain name <http://www.weetabix.co.uk/>. This site is accessible in Kenya.

17.The Opponent's has expended colossal amounts of money, time and effort in the publication, promotion and marketing of the breakfast cereals products sold under the **WEETABIX** Trade Mark, and other affiliated Trade Marks. The Opponent also allocates a considerable amount of money and internal resources to protecting its **WEETABIX** Trade Mark and all other Trade Marks associated with it.

18. As a result of such operations, use and advertisement (amongst other factors), **WEETABIX**, and the entire Opponent's Trade Marks are extremely well known throughout the world. **WEETABIX** and all the affiliated Trade Marks belonging to the Opponent therefore merit protection under Section 15A of the Trade Marks Act Cap 506 of the Laws of Kenya.

19.In Kenya, the product **WEETABIX** has been continuously manufactured and sold in the country for over thirty (30) years.

20.The Applicant has attempted to cash in, for the benefit of the Applicant, on the substantial reputation and goodwill, which has been

built up on and in connection with the **WEETABIX** and the other Opponent's Trade Marks.

21. The Trade Mark registration in Kenya **WEETABIX** covers breakfast cereals related products and the dominant feature of this mark from both a visual and sound perspective is the suffix **-BIX**.

22. The Applicant's Trade Mark "**MULTIBIX**" is substantially, deceptively and confusingly similar to the opponent's prior registered **WEETABIX** Trade Mark in amongst others the following way:-

- (a) The suffix **BIX** in **MULTIBIX** is phonetically very similar to the suffix **-BIX** in **WEETABIX** and all the other marks cited above;
- (b) Both the prefix **MULTI** and the suffix **BIX** in the Offending Mark **MULTIBIX** are phonetically similar to the prefix **OATI** and the suffix **BIX** in the Opponents Trade Mark **OATIBIX**;
- (c) The Opponent has a trade mark application for the Trade Mark **BIX** in Kenya the Trade mark **WEETABIX CRISPY BIX** in the United Kingdom and will be highly prejudiced by the registration of the **MULTIBIX** trade mark.

23. Accordingly there is a very real likelihood that consumers would confuse the goods sold under the **MULTIBIX** Trade Mark as being yet another line product in the **WEETABIX** range of goods. The Applicant's Trade Mark is so similar to the Opponent's **WEETABIX** Trade Mark that use in connection with breakfast cereals products covered by the Applicant's application would be likely to lead to deception or confusion as to the correct source of the products supplied under it.

24. The extent to which the word mark "**MULTIBIX**" and its dominant component "**-BIX**" have been used in connection with the breakfast cereal products manufactured and supplied by the Opponent, is such that a substantial portion of the relevant public automatically link the suffix to the Opponent when it is used as a Trade Mark in connection with breakfast cereal products. Members of the relevant public would therefore be likely to assume that the Applicant's products sold under this mark are just other products in the Opponent's **-BIX** series.

25. The use and registration of a mark incorporating the "**BIX**" component as a suffix in such a prominent manner would be likely to lead to the perception that there is a material trade link between the Applicant

and/or the products covered under the Applicant's MULTIBIX Mark on the one hand and the Opponent and its **WEETABIX** and **OATIBIX** products on the other hand.

26. The Applicant has no claim in law or in equity to own or use the Offending Mark, in that the Applicant knowing of the fame of the Opponent's Trade Mark **WEETABIX** and its affiliated Marks, together with the popularity of the same and of the products connected therewith and sold there under, has wrongfully tried to appropriate the Opponent's Trade Marks (together with the entire concept of the mark **WEETABIX**) therefore applied to register the Offending Mark in its own name.
27. The Offending Mark which the Applicant is attempting to register covers goods that are identical to those of the Opponent.
28. The conduct of the Applicant in making the opposed Application, and generally, is in bad faith.
29. For the reasons set out above amongst others, the Offending Mark is not a "Trade Mark" of the Applicant as defined in Section 2 (1) of the said Act and the Applicant was not and is not entitled under Section 20 (1) of the said Act to apply for the registration thereof and would be unlawful under Section 14 of the Act.
30. For the above reasons and taking into account all the circumstances of the case, the registration of the Applicant's Trade Mark ought, in the discretion of the Registrar, to be refused.

The Notice of Opposition was duly forwarded to the Applicants who on 12th August 2010 filed their Counter Statement. The Applicants stated the following as the grounds on which they would rely in support of their application:

1. The words Weetabix (opponents) and Multibix (applicants) are distinct and separate words not capable of deceiving or confusing a reasonable man.
2. The words Weetabix (opponents) and Multibix (applicants) have suffix "BIX" as common between them. This does not make them deceptive or confusing. Such an argument was rejected by the Privy Council in the famous case of Coca Cola Company of Canada, Limited -VS- Pepsi Cola Company of Canada, Limited, 1 ALL. E.R. at 615, (see case)

both having "Cola" as a common word.

3. Weetabix, opponents Trade Mark and applicants proposed Trade Mark, Multibix are totally distinct and different in appearance, concept and total get up of their packing in colour, name and concept so as not to cause any deception or confusion. See photocopies of the packaging, which are annexed hereto.
4. The opponent is making a false allegation that the applicant is attempting to cash in or pass off its Multibix product as that of the opponent.
5. The allegation that consumers are likely to be confused or deceived because Multibix may be passed on as a product of Weetabix is false. Such an argument was indeed rejected in the following cases:
 - a. Coca Cola Company of Canada Limited -VS- Pepsi Cola Company of Canada, Limited, 1 ALL. E.R. at 615;
 - b. Civil Appeal No.278 of 2002 British American Tobacco Kenya Limited >and Cut Tobacco Kenya Limited; and
 - c. Civil case No.1447 of 1999 Unilever PLC Versus Bidco Oil Industries.
6. The British American Tobacco Kenya Limited case dealt with Trade Mark of **Sportsman** cigarette against Cut Tobacco's **Horseman** cigarette and the get up of the packages.
7. Unilever's case dealt with Trade Mark of **Blue Band** as opposed to **Bidco's Gold Band** and the get up of the packing.
8. The applicant has not attempted to appropriate opponent's Trade Mark or attempted to register goods that are identical to those of the opponent.
9. There is no bad faith on the part of the applicant in exercising its rights under the Trade Marks Act.
10. Paragraphs 1 to 9 above are in answer to paragraphs 14, 15, 17, 18, 29, 21, 22, 23, 24, 25, 26, 27, 28 and 30.
11. The word BIX is not found in Oxford Dictionary or Blacks Law Dictionary. It has not been registered as a Trade Mark.

12. We, the applicants do not admit paragraphs 2, 3, 5, 8, 9, 10, 11, 12, 13, 16 and 19 of Opponent's Notice of Opposition and will put the opponent to strict proof thereof.

13. We, the applicants admit paragraphs 1, 4, 6, and 7 of applicants Notice of opposition.

The Counter Statement was forwarded to the Opponents who on 20th December 2010 filed their Statutory Declaration. The Statutory Declaration was sworn by one Richard Martin, the Opponents' Finance Director who declared as follows *inter alia* :

1. THAT Weetabix Limited is part of the Latimer Group Limited and was incorporated on 13 August 1932. The Opponent has been creating delicious breakfast cereals since 1932.

2. THAT the Opponent's flagship cereal, **WEETABIX** is officially the favourite breakfast in its country of origin – the United Kingdom, accounting for approximately eight percent (8%) of the country's total cereal sales with annual sales worth over Ninety Five Million Pounds (£95,000,000) according to the ACNielsen in May, 2010. A copy of the aforesaid sales data is annexed and marked "**RM1**"

3. THAT the Opponent's unique range of breakfast cereals is popular beyond the borders of its country of origin. The Opponent exports its breakfast cereals to over eighty (80) countries worldwide, from the Middle East and South America, to Europe and South East Asia.

4. THAT the Opponent is the sole lawful proprietor in Kenya and throughout the world of the Trade Mark **WEETABIX** expressed as a word and hereinafter also referred to as the Opponent's Mark.

5. THAT the Opponent also sells other cereal products in Kenya including WEETABIX, OATIBIX, ALPEN, READYBREK, WEETABIX MINI'S and WEETOS. Copies of the documentation evincing distribution of the aforesaid products are annexed herewith and marked "**RM2**".

6. THAT the Opponent's Trade Marks are comprised in the following amongst others Kenya Trade Mark Registrations:-

Number	Trade Mark	Class	Registration Date	Date of Advertisement	Class of Goods
6339	WEETABIX	42	28.06.1954	5.10.1954	Cereal foods and wheatmeal biscuits
66701	OATIBIX	30	26.10.2009	31.05.2010	Breakfast cereals; cereal preparations for human consumption
66702	WEETOS	30	26.10.2009	31.05.2010	Breakfast cereals; cereal preparations for human consumption
66703	BIX	30	26.10.2009	31.05.2010	Breakfast cereals; cereal preparations for human consumption

Annexed herewith are the certificates of registration and marked “**RM3**”.

7. THAT the Opponent manufactures its products in Kenya through its local affiliate, to wit, The Breakfast Cereal Company of (Kenya) Limited, under licence of the Opponent to use the **WEETABIX** Trade Marks. Annexed herewith are copies of business stationery marked “**RM4**”

8. THAT the Opponent’s Trade Mark **WEETABIX** is used and registered in most countries worldwide, including the United Kingdom, the countries comprising the European Union, Kenya, amongst others. Annexed herewith are copies of the Certificates of Registration and marked “**RM5**”.

9. THAT the Opponent has also registered the following Trade Marks, amongst others, under the Madrid System, which incorporate the “BIX” component, and in respect of breakfast cereals and cereals preparations made for human consumption.

a.	Number	Trade Mark	Class	Goods	Designated Countries
b.	726023	BANANABIX	30	Cereal preparations for human consumption, all including fruit, included in this class.	United Kingdom, China, Czech Republic, Estonia, Georgia, Iceland, Lithuania, Poland, Romania, Russian Federation and

c.	726024	MINIBIX	30	Cereal preparations for human consumption, all including fruit, included in this class.	Turkey. United Kingdom, Switzerland, Liechtenstein, Iceland, Lithuania and United States of America.
d.	726025	FRUTIBIX	30	Cereal preparations for human consumption, all including fruit, included in this class.	United Kingdom, China, Czech Republic, Estonia, Georgia, Iceland, Liechtenstein, Lithuania, Poland, Romania, Russian Federation and Turkey.
e.	726027	CHOCOBIX	30	Cereal preparations for human consumption, all including fruit, included in this class.	United Kingdom, China, Czech Republic, Georgia, Iceland, Liechtenstein, Poland, Romania, Russian Federation and Turkey.
f.	942545	WEETABIX CRUNCHIES	30	Cereal preparations for human consumption, all including fruit, included in this class.	United Kingdom and Ireland.
g.	946212	OATIBIX	30	Cereal preparations for human consumption, all including fruit, included in this class.	United Kingdom and United States of America.
h.	946227	WEETABIX MINIS	30	Cereal preparations for human consumption,	United Kingdom and United States of America.

			all including fruit, included in this class.
i.	1011488	WEETABIX	30 Cereal Iran, Islamic Republic preparations of Iraq, Montenegro, for human and Oman. consumption, all including fruit, included in this class.

Annexed herewith are copies of the Certificates of Registration and marked "**RM6**".

10.THAT the Opponent equally has the following Trade Marks, amongst its other Trade Marks, in the United Kingdom which incorporate the "BIX" component and in respect of breakfast cereals and cereals preparations made for human consumption:

	NUMBER	TRADE MARK	CLASS
1.	531457	WEETABIX	01, 02, 03, 05, 28, 29, 30, 31, 32
2.	584545	VIBIXA	30
3.	869286	HONABIX	30
4.	2011590	FRUTIBIX	30
5.	2060869	24 WEETABIX	30
6.	1328533	SNOWYBIX	30
7.	1506435	CRUNCHIBIX	30
8.	1011488	CHOCOBIX	30
9.	2136198	MINIBIX	30
10.	2141634	GOLDENBIX	30
11.	2183816	BARLABIX	30
12.	2187312	BANANABIX	30
13.	2238415	WEETABIX CRISPY BIX	30
14.	2246878	WITHOUTABIX	30
15.	2246880	WITHABIX	30
16.	2302259	MINIBIX ON THE GO	30
17.	2406115	OATIBIX	30

Annexed herewith are copies of the Certificates of Registration and marked "**RM7**".

11.THAT the Opponent equally has the following Trade Marks, amongst its other Trade Marks, in the United States which incorporate the

“BIX” component and in respect of breakfast cereals and cereals preparations made for human consumption:

	NUMBER	TRADE MARK	CLASS
1	73428435	FROM THE MAKERS OF WEETABIX	30
2	79047270	WEETABIX	30
3	79050133	MINIBIX	30

Annexed herewith are copies of the Certificates of Registration and marked “**RM8**”.

12.THAT the suffix “**BIX**” is an element and common component of various Trade Marks belonging to Weetabix Limited but in any event, a common component of its various composite Trade Marks as an identifier to designate ‘breakfast cereals and cereals preparations for human consumption’ as emanating from the Opponent and appears on almost all of the Opponents products.

13.THAT “**BIX**” is a registered Trade Mark in Kenya as indicated in paragraph 10 above. Further that the Applicant did not oppose the registration of the Trade Mark “**BIX**” during the Statutory Opposition Period; hence acquiesced to the Registration.

14.THAT the Opponent's Trade Marks have for many years been extensively used in many countries throughout the world by them and by their predecessors in title and their licensees, in relation to breakfast cereal incorporating the common element “**BIX**”. Through this extensive use, the Opponent's Trade Marks have acquired a distinction in appearance, concept and style of operation which have rendered them world famous and of high quality.

15.THAT the Trade Mark **WEETABIX** forms part of the Opponent's trade name. The Opponent has registered the domain name <http://www.weetabix.co.uk/>. This website is accessible in Kenya. Annexed herewith are copies of the screenshots of the webpage marked “**RM9**”.

16.THAT the Opponent has expended colossal amounts of money, time and effort in the publication, promotion and marketing of the breakfast cereals products sold under the **WEETABIX** Trade Mark, and other affiliated Trade Marks. The Opponent also allocates a considerable amount of money and internal resources to

protecting its **WEETABIX** Trade Mark and all other Trade Marks associated with it. Annexed herewith are copies of the promotional material and marked "**RM10**". Further that some of the promotions are styled with the **-BIX** suffix such as the "WIN A BIX", "TRY A BIX" and "VALUEBIX".

17.THAT as a result of such operations, use and advertisement (amongst other factors), **WEETABIX**, and the entire Opponent's Trade Marks are extremely well known throughout the world. **WEETABIX, OATIBIX** and all the affiliated Trade Marks belonging to the Opponent therefore merit protection under Section 15A of the Trade Marks Act Cap 506 of the Laws of Kenya.

18.THAT in Kenya, the product **WEETABIX** has been continuously manufactured and sold in the country for over thirty (30) years.

19.THAT The Applicant has sought attempt to cash in, for the benefit of the Applicant, on the substantial reputation and goodwill which has been built up on and in connection with the **WEETABIX** and the other Opponent's Trade Marks.

20.THAT The Trade Mark registration in Kenya **WEETABIX** covers breakfast cereals related products and the dominant feature of this mark from a both visual and sound perspective is the suffix **-BIX**.

21.THAT The Applicant's Trade Mark "**MULTIBIX**" is substantially, deceptively and confusingly similar to the Opponent's prior registered **WEETABIX** Trade Mark in amongst others the following way:-

- (a) The suffix **-BIX** in **MULTIBIX** is phonetically very similar to the suffix **-BIX** in **WEETABIX** and all the other marks cited above.
- (b) Both the prefix **MULTI** and the suffix **BIX** in the Offending Mark **MULTIBIX** are phonetically similar to the prefix **OATI-** and the suffix **BIX** in the Opponents Trade Mark **OATIBIX**.
- (c) The Opponent has a Trade Mark registration for the Trade Mark **BIX** in Kenya and the Trade mark **WEETABIX CRISPY BIX** in the United Kingdom and will be highly prejudiced by the registration of the **MULTIBIX** Trade Mark.

22.THAT the Applicant's Trade Mark "**MULTIBIX**" get-up is substantially, deceptively and confusingly similar to the Opponent's prior registered **WEETABIX** Trade Mark.

23.THAT accordingly there is a very real likelihood that consumers would confuse the goods sold under the **MULTIBIX** Trade Mark as being yet another line product in the **WEETABIX** range of goods. The Applicants Trade Mark is so similar to the Opponent's **WEETABIX** Trade Mark that use in connection with breakfast cereals products covered by the Applicant's application would be likely to lead to deception or confusion as to the correct source of the products supplied under it.

24.THAT the extent to which the word mark "**MULTIBIX**" and its dominant component "**-BIX**" have been used in connection with the breakfast cereal products manufactured and supplied by the Opponent, is such that a substantial portion of the relevant public automatically link the suffix to the Opponent when it is used as a Trade Mark in connection with breakfast cereal products. Members of the relevant public would therefore be likely to assume that the Applicant's products sold under this mark are just other products in the Opponents -BIX series.

25.THAT The use and registration of a mark incorporating the "**BIX**" component as a suffix in such a prominent manner would be likely to lead to the perception that there is a material trade link between the Applicant and/or the products covered under the Applicant's **MULTIBIX** Mark on the one hand and the Opponent and its **WEETABIX** and **OATIBIX** products on the other hand.

26.THAT The Applicant has no claim in law or in equity to own or use the Offending Mark, in that the Applicant knowing of the fame of the Opponent's Trade Mark **WEETABIX** and its affiliated Marks, together with the popularity of the same and of the products connected therewith and sold there under, has wrongfully tried to appropriate the Opponent's Trade Marks (together with the entire concept of **WEETABIX**) therefore applied to register the Offending Mark in its own name.

27. THAT The Offending Mark which the Applicant is attempting to register covers goods that are identical to those of the Opponent as detailed hereunder:

	Trade Number	Mark	Trade Mark	Class	Goods
Opponent's	6339		WEETAB BIX	42	Cereal foods and wheatmeal biscuits
Opponent's	66703		BIX	30	Breakfast cereals; cereal preparations for human consumption
Opponent's	66701		OATIB BIX	30	Breakfast cereals; cereal preparations for human consumption
Applicant's	66428		MULTIB BIX	30	Biscuits

28.THAT the conduct of the Applicant in making the opposed Application, and generally, is in bad faith.

29.THAT For the reasons set out above amongst others, the Offending Mark is not a "Trade Mark" of the Applicant as defined in Section 2 (1) of the said Act and the Applicant was not and is not entitled under Section 20 (1) of the said Act to apply for the registration thereof and would be unlawful under Section 14 of the Act which I am advised by my aforesaid agents prohibits the registration 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.

30.THAT the Opponent's response to the Applicant's Counter Statement is as follows:-

- (a) The Applicant's admission of the use of the "-**BIX**" suffix, which is a Trade Mark of the Opponent, is prima facie in bad faith and actuated with malice.
- (b) The Applicant's admission in paragraph 11 of the Counter Statement that the word "**BIX**" is not found in the Oxford's Dictionary or the Blacks Law Dictionary reinforces the fact that the same is a Trade Mark of the Opponent which is entitled to protection under law, the same is now registered in Kenya as indicated in paragraph 10 above.
- (c) The Applicant's averment in paragraph 3 of the Counter Statement that their Trade Mark has a distinct get up that will not cause any deception to confusion is misplaced. The Applicant's Trade Mark forming the subject matter of this Opposition is a word mark 'MULTIB**BIX**' which is similar to the Opponent's word Marks: WEETAB**BIX**, OATIB**BIX** and **BIX**. The Opponent further prays that all the packaging attached to the Counter Statement be struck out as irrelevant to the present Opposition.

- (d) That the Opponent seeks to strike out all the annexed Case Law in paragraph 5, 6 and 7 of the Applicant's Counter Statement as irrelevant on the basis that the same were the subject of an Infringement and/or passing off cause of action and not an Opposition. Further that a Counter Statement as per Rule 48 of the Trade Marks Rules should only set out the grounds an Applicant is relying on in support of his application and not case law which should be adduced at hearing as per Rule 54 of the Trade Marks Rules.
- (e) That in light of the above that the Applicant's Counter Statement fails in law for not setting out the grounds in support of its Application and should be struck out accordingly.

31.THAT for the above reasons and taking into account all the circumstances of the case, the registration of the Applicant's Trade Mark ought, in the discretion of the Registrar, to be refused.

The Opponents' Statutory Declaration was forwarded to the Applicants who on 21st April 2011 filed their Statutory Declaration. The Statutory Declaration was sworn by one Vijay Budhdev, the Applicants' General Manager who declared as follows:

1. **THAT** Manji Food Industries Limited made an Application for Registration of Trade Mark Number 66428. The Registrar of Trade Marks allowed the same for publication in the Intellectual Property Journal Edition No.2010/04 of 30th April, 2010 on page 20(Copy is annexed hereto and marked as "**V.B. 2**").
2. **THAT** Manji Food Industries Limited applied for the Trade Mark **MULTIBIX** (Single Word) under the **biscuit category**. The Registrar allowed the Registration. (See application and approval marked hereunder as "**V.B. 3** and **V.B. 3 'A'**", respectively.)
3. **THAT** Weetabix Limited applied for registration of BIX as a Trade Mark as an afterthought and in order to defeat Manji Food Industries Limited's Mark (See copies of Application of Weetabix Limited annexed and marked as "**V.B. 4**").
4. **THAT** Multibix and Weetabix are different in appearance, concept, style and get-up hence not capable of being confusing or passed-off. Further, they refer to different products.

5. **THAT** following the Registrar of Trade Mark's approval, Manji Food Industries Limited embarked on substantial marketing and promotion of Multibix, thereby incurring heavy expenses.
6. **THAT** Multibix was accepted in the market. Multibix is in a different segment, that is, a biscuit while Weetabix is in breakfast cereals.
7. **THAT** Manji Food Industries Limited do not admit paragraphs 10, 16, 17, 18, 19, 20, 21, 22, 23, 25, 26, 27, 28, 29, 30, 31, 34 and will put Weetabix Limited to strict Proof thereof.
8. **THAT** I make this Affidavit in support of Manji Food Industries Limited's Application for the registration of Trade Mark Number 66428.

The Applicants' Statutory Declaration was forwarded to the Opponents who on 24th August 2011 filed their Statutory Declaration In Reply. The Statutory Declaration was sworn by the said Richard Martin, the Opponents' Finance Director who declared as follows:

1. That in response to paragraphs 1, 2, 3 and 4 of the Applicants' Statutory Declaration, the Opponent avers that the same are matters of record.
2. THAT in response to paragraph 5 of the Applicant's Statutory Declaration, that I am advised by my aforementioned Advocates that approval and publication of the Offending Mark herein does not amount to completing registration and that the essence of publication of Applications is to give an opportunity to any interested party to oppose it which right the Opponent has exercised herein.
3. THAT further that as per the 9th Edition of the Nice classification, class covers the following products:-
Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice.
Both the Opponents and Applicants Trade Marks fall within the same class 30; and have their class of goods as:-

	Trade Mark Number	Trade Mark	Class	Goods
Opponent's	6339	Weetabix	42	Cereal foods and wheatmeal biscuits
Opponent's	66703	BIX	30	Breakfast cereals; cereal preparations for human consumption
Opponent's	66701	OATIBIX	30	Breakfast cereals; cereal preparations for human consumption
Applicant's	66428	MULTIBIX	30	Biscuits

Hence regardless of the Applicants averment that its products are only 'biscuit category' the products in question herein are identical.

4. **THAT** further the Applicants have packaged and advertised their products as breakfast cereals as per the attached exhibit '**RM I**' comparing the packaging of the Opponent's products and the Applicants with similar components.
5. **THAT** in response to paragraph 6 of the Applicant's Statutory Declaration, the Opponent denies the averment that the Trade Mark 'BIX' registered by the Opponent is an afterthought. The Opponent reiterates the contents of the Notice of Opposition paragraphs 6 wherein the Opponent has detailed the Trade Marks which are registered in its name and which registrations were filed earlier than the Applicant's. The Trade Marks that the Opponent is relying on are not limited to Applications filed after the filing of the Offending Mark; that notwithstanding, the Opponent avers that the Trade Marks filed after the Offending Mark are strong brands of the Opponent which have been in use for a substantial period of time.
6. **THAT** there is no mistaking the fact that throughout the proceedings herein, the Opponent has indicated the constant use of the suffix - BIX in most of its Marks. Needless to state, the Opponents very name has the suffix - BIX and thus it is not an afterthought to register it.
7. **THAT** in any event, the Registration of the Trade Mark BIX has not been contested by any party.
8. **THAT** in Kenya, the product WEETABIX has been continuously manufactured and sold in the country for over thirty (30) years. The

Opponent also allocates a considerable amount of money and internal resources to marketing and protecting its Weetabix Trade Mark and all other Trade Marks associated with it. Annexed herewith are copies of the promotional material and marked "RM2". As a result of such operations, use and advertisement (amongst other factors), WEETABIX and the entire Opponent's trade marks are extremely well known throughout the world. WEETABIX, OATBIX and all the other affiliated trade marks belonging to the Opponent therefore merit protection under Section 15A of the Trade Marks Act Cap 506 of the Laws of Kenya.

9. **THAT** in response to paragraph 7 of the Applicant's Statutory Declaration the Opponent reiterates that the Applicant's Trade Mark forming the subject matter of this Opposition is a word mark 'MULTIBIX' which is similar to the Opponent's word Marks: WEETABIX, OATBIX and BIX. The phonetic, visual and conceptual similarity of the Offending Mark and Opponent's Marks is substantial as to cause actual confusion amongst the consumers. The Opponent further reiterates the contents of paragraph 7 and the fact that products are in the same class calls for the distinctive brands and Trade Marks to avoid confusion or association of the Offending Mark with the Opponent's.
10. **THAT** the immense goodwill and reputation of the Opponent's Well Known Marks and products is being diluted by the Applicant's products being sold in a name that is confusingly similar to the Opponent's. Attached herewith and marked "RM3" is a market survey report evincing the confusion of the Applicant's and Opponent's products and the perceived association of origin of both products to the Opponent herein.
11. **THAT** in response to paragraph 8 of the Applicant's Statutory Declaration, the Opponent reiterates that approval of a Trade Mark at the examination stage does not vest on the Applicant proprietary rights in the brand, it is the issuance of the Certificate of Registration that vests on a proprietor bonafide proprietary rights. Any expenses incurred by the Applicant was at own expense and risk.
12. **THAT** in response to paragraph 9 of the Applicant's Statutory Declaration the Opponent maintains that registration of its Trade Marks covers '*wheat meal biscuits*' and as such the Applicant herein or any other party is precluded from registering Trade Marks that are closely resembling to the Opponent's in respect of goods in

class 30.

13. **THAT** in response to paragraph 10 of the Applicant's Statutory Declaration the Opponent avers that the aforementioned paragraphs in the Opponent's Statutory Declaration have been all substantiated in the attached exhibits.

THAT for the above reasons and taking into account all the circumstances of the case, the registration of the Applicant's Trade Mark ought, in the discretion of the Registrar, to be refused.

After close of the pleadings, the parties herein agreed on a hearing date. However, it was later agreed that the matter would proceed by way of written submissions. The Opponents filed their written submissions on 17th February 2012 and the Applicants filed their written submissions on 5th April 2012.

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 Simba & Simba Advocates and Guram & Company Advocates for the Opponents and the Applicants respectively. I am of the view that the following are the issues that should be determined in these opposition proceedings:

- 1. Is the Applicants' mark "MULTIBIX" so similar to the Opponent's mark "Weetabix" as to cause a likelihood of confusion in contravention of the provisions of section 14 of the Trade Marks Act?**
- 2. Is the Opponents' mark "WEETABIX" a well-known mark in Kenya and therefore deserving of protection under section 15A of the Trade Marks Act?**

The following is a consideration of the two aforementioned issues:

- 1. Is the Applicants' mark "MULTIBIX" so similar to the Opponent's mark "Weetabix" as to cause a likelihood of confusion in contravention of the provisions of section 14 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."

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 strength of the complainant's mark;
- (b) Similarity between the marks in appearance and suggestion;
- (c) The degree of care likely to be exercised by consumers; and
- (d) The area and manner of concurrent use of the products.

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

"One of the key issues in both trade mark opposition and infringement proceedings is whether the use of one mark is likely to cause confusion or deception with another mark. In determining whether a mark is likely to do so tribunals consider a number of factors. These include whether:

- 1. the marks appear on the same or similar goods or services;
- 2. the price of the goods or services on which the marks appear is expensive or cheap;
- 3. consumers purchase the goods or services carefully or on impulse; and
- 4. the goods or services appear in the same or similar retail outlets.

In the New Zealand case of *Pioneer Hi-Bred Corn Co. v. Hy-Line Chicks Pty Ltd*, 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.

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

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."

In the case of *De Cordova and others v Vick Chemical Coy* (1951) 63 RPC 103, 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 marks clearly before him, for orders are not placed, or are often not placed, under such conditions. 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 Australian case referred to as *the Registrar of Trade Marks V Woolworths Limited*, the Court stated as follows:

"The effect of spoken description must be considered. What confusion or deception may be expected is to be based upon the behavior of ordinary people. As potential buyers of goods, they are not to be credited with high perception or habitual caution. Exceptional carelessness or stupidity may be disregarded. ... In considering whether there is a likelihood of deception or confusion all surrounding circumstances have to be taken into consideration. These include the circumstances in which the marks will be used, the circumstances in which the goods or services will be bought and sold and the character of the probable acquirers of the goods and services."

In the Australian case referred to as *Australian Woollen Mills Ltd v F.S. Walton & Co. Ltd*, the Court stated as follows:

"An attempt should be made to estimate the effect or impression produced on the mind of potential customers by the markthe impression or recollection, which is carried away and retained, is necessarily the basis of any mistaken belief that the challenged mark or device is the same. The effect of spoken description must be considered. If a mark is in fact or from its nature likely to be the source of some name

or verbal description by which buyers will express their desire to have the goods, then similarities both of sound and of meaning may play an important part. The usual manner in which ordinary people behave must be the test of what confusion or deception may be expected".

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."

As regards the degree of care likely to be exercised by consumers, the relevant person is the average consumer who is considered to be reasonably well informed and reasonably observant and circumspect although taking account of the fact such a person will rarely have an opportunity to make a direct comparison, but rather to rely on the imperfect recollection of the consumer. See the case of Sabel BV v. Puma AG (Case C-251/95), 1998 R.P.C. 199, 1998 E.T.M.R. 1 (1997).

The goods under consideration and in respect of which the Opponents' mark is registered and in respect of which the Applicant's mark is sought to be registered are goods in class 30 of the International Classification. In my view, purchase of the said goods would be compared to "a fifty pence purchase in the station kiosk". This is because the said goods are every day goods and cannot be said to be very expensive. In the Kenyan market, the said goods would be purchased by educated or non-educated parents, children or house-helpers. 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 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.

Strength of the mark

The term "BIX" is a creation of the Opponents and has no particular meaning in the English language. This fact is admitted by the Applicants in paragraph 11 of their Counter Statement. I am of the view that the said word has nothing to do with the goods in respect of which the mark has been registered and is not descriptive of the said goods. "BIX" is an arbitrary word that has been registered under the Trade Marks Act and is

not descriptive of the goods in respect of which the same is registered. The trade mark "WEETABIX" has not been registered with a disclaimer of the right to the exclusive use of the said word "BIX". Further, "WEETABIX" is part of the Opponents' corporate identity and has been used in the Kenyan for over thirty (30) years now.

In the book WIPO Intellectual Property Handbook by the World Intellectual Property Organization, it is stated as follows on page 73:

"Descriptive signs are those that serve in trade to designate the kind, quality, intended purpose, value, place of origin, time of production or any other characteristic of the goods for which the sign is intended to be used or is being used."

In the said book World Intellectual Property Organisation Handbook 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".

In the South African case known as Plascon-Evans Paints V Van Riebeeck Paints the marks in contention were "Mikacote" and "Micatex" and the judge stated as follows at page 645 while finding that there was infringement of the mark "Micatex" by the proprietor of the mark "Mikacote":

"In the case before us the evidence establishes that the word "MICA" is not one generally used in the paint trade to describe paint products".

In the case of Thomson Holidays Limited v Norwegian Cruise Line Limited, it was stated as follows:

"Furthermore, the more distinctive the earlier mark, the greater will be the likelihood of confusion, and therefore marks with a highly distinctive character, either per se or because of the recognition they possess on the market, enjoy broader protection than marks with a less distinctive character".

In the case of Canon Kabushiki Kaisha and Metro-Goldwyn-Mayer Inc, it was stated as follows:

" Since the protection of a mark depends on there being a likelihood of confusion...marks with a highly distinctive character, either per se or because of the recognition they possess on the market, enjoy broader protection than marks with a less distinctive character. ...It follows that, registration of a mark may have to be refused, despite a lesser degree of

similarity between the goods or services covered, where the marks are very similar and the earlier mark, in particular its reputation is highly distinctive”.

In the aforementioned case of *Sabel V Puma*, the court stated as follows: “In that respect, it is clear ...that the appreciation of the likelihood of confusion depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified. The likelihood of confusion must therefore 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 on 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 in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion.”

In conclusion, I am of the view that the Opponents’ mark is a strong mark.

Similarity between the marks in appearance

The Opponents claim that their mark “WEETABIX” is similar to the Applicants’ mark “MULTIBIX”. The said claim is denied by the Applicants who state that the two marks, when considered as a whole, are distinct. The two marks under consideration are the Opponents’ mark “WEETABIX” and the Applicants’ mark “MULTIBIX”. It is apparent that the Opponents’ mark “WEETABIX” has been registered in Kenya since the 28th Day of June 1954. Further, the Opponents are the proprietors of the marks OATBIX, BIX, BANANABIX, MINIBIX, FRUTIBIX, CHOCOBIX, WEETABIX CRUNCHIES and WEETABIX MINIS in the Kenyan market.

The two marks are word marks “WEETABIX” and “MULTIBIX”. In the Pianotist’s Application, Parker J stated as follows:

“You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks”.

In regard to the issue of similarity in appearance and suggestion, the learned author of the book Kerly's Law on Trade Marks and Trade Names, Fourteenth Edition states as follows on page 247, paragraph 9-038: "The global appreciation of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based upon the overall impression created by them, bearing in mind, in particular, their distinctiveness and dominant components. The perception in the mind of the average consumer of the category of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark and does not proceed to analyze its various details."

The common element between the two marks "WEETABIX" and "MULTIBIX" is the suffix "BIX" which is also a registered mark of the Opponents. The term "BIX" is not an English word and is a creation of the Opponents, which I had earlier indicated that it is a strong mark. The Applicants' mark is comprised of the word "MULTI" and the said suffix "BIX". I am therefore of the view that the two marks are similar in appearance.

Similarity between the goods

In the aforementioned case of Canon Kabushiki Kaisha and Metro-Goldwyn-Mayer Inc, the European Court of Justice stated as follows: "A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.

...In assessing the similarity of the goods or services concerned, ... all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end user and their method of use and whether they are in competition with each other or are complementary."

In this Canon case, a German company made an application for registration of the mark "Cannon" for video taped films, production, lease

of films for cinemas and television. Canon Kabushiki Kaisha the registered proprietors of the mark "Canon" opposed registration of the said mark claiming that the two marks were too similar to coexist in the Register of Trade Marks for similar goods.

In the aforementioned case of Thomson Holidays Limited v Norwegian Cruise Line Limited, while ruling in favor of the proprietor of the mark "FREESTYLE" in an infringement matter, Lord Justice Waller stated as follows:

"It follows that what is being compared is use of identical marks upon different types of package holidays provided through the same trade channels in the same way, and often in the same brochure. In those circumstances, there must be a risk that the average consumer, with imperfect recollection of the normal and fair use by the proprietor of "FREESTYLE", would conclude that the Norwegian's cruises came from the same company or from an economically linked company.

...the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, constitutes a likelihood of confusion".

I disagree with the Applicants when they state that the respective goods of the Opponents and the Applicants are different. It is my view that the goods in respect of which the Opponents have registered their aforementioned marks are goods of the same description as the goods in respect of which the Applicants are seeking to register their mark "MULTIBIX". This means that both the goods of the Applicants and the Opponents would be sold in the same trade channels thus enhancing the likelihood of confusion or deception. It has long been held that the closer the relationship between particular goods, the more likely any similarity in their respective trade marks would prove deceptive. For this reason, and having held that the marks are similar, then it follows that registration of the Applicants' mark "MULTIBIX" would be against the provisions of the Trade Marks Act.

Having considered all the relevant factors in regard to similarity of the marks and having considered the two word marks and all the circumstances of these opposition proceedings as stated by Parker J in the aforementioned Pianotist's Application, I have come to the conclusion that the two marks "WEEETABIX" and "MULTIBIX" are similar and that entry of both marks in the Register of Trade Marks would be a contravention of the provisions of sections 14 and 15(1) of the Trade Marks Act.

2. Is the Applicants' trade mark "WEETABIX" a well-known mark in Kenya and therefore deserving protection under the provisions of section 15A of the Act?

Section 15A of the Trade Marks Act provides as follows:

1. References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO Agreement as a well-known trade mark are to a mark which is well-known in Kenya as being the mark of person who is a national of a convention country; or is domiciled in or has a real and effective industrial or commercial establishment in, a convention country, whether or not that person carries on business or has any goodwill in Kenya.
2. ...
3. ...
4. A trade mark shall not be registered if that trade mark or an essential part thereof, is likely to impair, interfere with or take unfair advantage of the distinctive character of the well-known trade mark.

The Paris Convention for the protection of Industrial Property provides as follows:

Art 6bis: The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation.

The TRIPS Agreement provides as follows under Article 16:

- 1...
2. ... In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark.
3. Article 6bis of the Paris Convention (1967) shall apply, mutatis mutandis, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.

One of the reasons that these opposition proceedings have been filed by the Opponents herein is that registration of the Applicants' mark "MULTIBIX" would be contrary to the provisions of section 15A of the Trade Marks Act since the Opponents' mark "WEETABIX" is a well known mark in Kenya.

The World Intellectual Property Organisation has developed the Joint Recommendations Concerning Provisions on the Protection of Well-Known Marks. Various authors and courts have also indicated the factors to consider while determining whether or not a mark is well known. In his book titled Famous and Well-known Marks, Fredrick Mostert indicates that the degree of recognition of the mark, the degree of inherent or acquired distinctiveness of the mark, the degree of exclusivity of the mark and the nature and extent of use of the same or similar marks by third parties are important factors to consider in determining whether or not a mark is well-known in any country. In the UK case referred to as Oasis Ltd's Trade Mark Application, the Court stated as follows:

"In considering detriment under this heading, it appears to me to be appropriate to consider:

- (1) the inherent distinctiveness of the earlier trade mark;
- (2) the extent of the reputation that the earlier mark enjoys;
- (3) the uniqueness or otherwise of the mark in the market place;
- (4) the range of goods or services for which the earlier mark enjoys reputation; and
- (5) whether or not the earlier trade mark will be any less distinctive for the goods or services for which it has a reputation than it was before."

I now proceed to consider some of the aforementioned factors that would enable me to determine whether or not the Opponents' mark "WEETABIX" is a well known mark in Kenya.

(a) The inherent distinctiveness of the mark "WEETABIX"

The Ninth Edition of the Black's Law Dictionary defines a famous mark as a "trade mark that is not only is distinctive but also has been used and heavily advertised or widely accepted in the channels of trade over a long time, and is so well known that consumers immediately associate it with one specific product or service".

In the German Federal Supreme Court case referred to as, QUICK [1959] GRUR 182, the court stated as follows:

"The owner of a distinctive mark has a legitimate interest in continuing to maintain the position of exclusivity he acquired through large expenditures of time and money and that everything which impairs the originality and distinctive character of his distinctive mark, as well as the

advertising effectiveness derived from its uniqueness, is to be avoided. Its basic purpose is not to prevent any form of confusion but to protect an acquired asset against impairment."

In the said book WIPO Intellectual Property Handbook by the World Intellectual Property Organisation 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."

While considering the issue of the strength of the mark "WEETABIX", I stated that the mark is distinctive, the same being an arbitrary mark when adopted for use or registration in respect of goods under class 30 of the International Classification of Goods and Services. Further, the Register of Trade Marks indicates that apart from the various marks that belong to the Opponents with the suffix "BIX", there are no other marks in respect of a similar or identical description of goods that have been entered in the Register of Trade Marks. I am therefore of the view that the mark is distinctive and unique to the goods of the Applicants and hence qualifies to be considered as a well-known mark in Kenya.

(b) The extent of the reputation that the earlier mark enjoys

In the UK case referred to as L-Oreal SA and Others v Bellure NV and others, the Court stated as follows while discussing the issue of reputation:

"In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it."

In the case of ConAgra Inc v McCain Foods (Aust) Pty Ltd, the Federal Court of Australia stated as follows:

"...it is still necessary for a plaintiff to establish that his goods have the requisite reputation in the particular jurisdiction, that there is a likelihood of deception among consumers and a likelihood of damage to his reputation. ... reputation within the jurisdiction may be proved by a variety of means including advertisements on television, or radio or in magazines and newspapers within the forum. It may be established by showing constant travel of people between other countries and the forum, and that people within the forum (whether residents there or

persons simply visiting there from other countries) are exposed to the goods of the overseas owner.”

In the New Zealand Court of Appeal Case known as *N V Sumatra Tobacco Trading Company Versus British American Tobacco (Brands) Incorporated*, the Court stated as follows in regard to well-known marks: “All that an opponent needs to show is “awareness”, cognisance” or “knowledge” of the mark. This means that the opponent will first have to identify the relevant market, then point to evidence showing that a substantial number of persons in that market have awareness, cognisance or knowledge of its mark. What is a substantial number of persons depends on the nature and size of the market and is relative both to the number of persons involved in and their impact on that market.”

I am of the view that the Applicants have submitted adequate evidence to indicate that the mark “WEETABIX” has gained such a reputation in the Kenyan market for the mark to be considered well known in Kenya. The said reputation has been gained through promotion and marketing of the said mark on the various media in Kenya and the trade mark “WEETABIX” has come to be only associated with the goods offered for sale by the Opponents.

(c) The duration and geographical area of the registrations, of the mark “WEETABIX”

One of the factors indicated in the aforementioned Joint Recommendations Concerning Provisions on the Protection of Well-known Marks by the World Intellectual Property Organization states:

“the duration and geographical area of any registrations, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark”.

In the aforementioned statutory declaration sworn by Richard Martin and filed on behalf of the Opponents, it is indicated that the Opponents’ mark “WEETABIX” together with the aforementioned variants has been registered in numerous jurisdictions of the world. The Opponents have also attached a number of certificates to indicate that their said mark is registered and subsisting in the Register of Trade Marks in the respective jurisdictions. Further, there is an indication as to the various countries where the Applicants’ goods bearing the mark “WEETABIX” have been marketed. In Kenya, the trade mark “WEETABIX” was entered in the Register of Trade Marks with effect from 28th June 1954. This means that the said mark “WEETABIX” has been in the Register of Trade Marks in Kenya for the last fifty-eight (58) years. Further, records at the Registry of

Trade Marks indicate that the Opponents have registered several other marks that comprise the suffix "BIX" and which are still subsisting in the Register of Trade Marks. Further, and as earlier indicated, the mark has been used in the Kenyan market for over thirty (30) years now. In my view, the above-mentioned registrations and use in several jurisdictions including Kenya indicate that the mark is well known.

In conclusion and after considering all the relevant factors, it is my opinion that the mark "WEETABIX" is quite well known in Kenya and deserves protection under the provisions of section 15A of the Trade Marks Act.

Conclusion

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

- (a) on a balance of probabilities, the Opponents have succeeded in these opposition proceedings;
- (b) the Applicants' trade mark no. KE/T/2009/066428 "MULTIBIX" (WORD) shall not proceed to registration; and
- (c) I award the costs of these proceedings to the Opponents.

Eunice Njuguna
Assistant Registrar of Trade Marks

31st Day of August 2012

I certify that this is a true copy of the original

A handwritten signature in dark ink, appearing to read 'Eunice Njuguna', with a large, stylized loop at the end.

Eunice Njuguna
Assistant Registrar of Trade Marks

31st Day of August 2012