THE TRADE MARKS ACT CAP 506 OF THE LAWS OF KENYA

AND

TMA NO 58890 IN THE NAME OF INTER-CONSUMER PRODUCTS LIMITED AND OPPOSITION THERETO BY L'OREAL

RULING BY THE ASSISTANT REGISTRAR OF TRADE MARKS

Background

On 28th March 2006, Inter-Consumer Products Limited (hereinafter referred to as the Applicants) filed an application to register their trade mark TMA NO 58890 "Nice & Lovely Herbal Oil Moisturizer" (WORDS) (hereinafter referred to as the Mark) before the Registrar of Trade Marks. The mark was applied for in class 3 in respect of; "Soaps, moisturizers, hair oils, hair relaxers, hair conditioners, body lotions, cleansers and petroleum jelly".

The Registrar 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 published in the Industrial Property Journal of 31st May 2007, on page 30.

On 7th April 2007, L'Oreal (hereinafter referred to as the Opponents) filed a Notice of Opposition against the registration of the Mark. The grounds of opposition were as follows:

1. We are the sole lawful proprietors in Kenya and throughout the world of the trade mark DARK & LOVELY and variants thereof (hereinafter referred to as "Our Trade Mark"). Our Trade Mark is comprised in numerous worldwide registrations and applications, including particularly the Kenyan trade marks, particulars of which are set out below:

1.1 Trade Mark Registration No. 39813 DARK & LOVELY in Class 3, filed with effect from 17th June 1992 for a specification of goods reading "Hair relaxers, shampoo conditioners, cosmetics, hair lotion and all goods under Class 3". This registration is still in force and is next due for renewal on 17th June 2013.

1.2 Trade Mark Application No. 47045 DARK & LOVELY CHOLESTEROL PLUS in Class 3, filed with effect from 25th February 1998 for a specification of goods reading "Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices and all goods under Class 3".

1.3 Trade Mark Registration No. 49774 DARK AND LOVELY Special Form II in Class 3, filed with effect from 26th January 2000 for a specification of goods reading "Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices and all goods included under Class 3". This registration is still in force and is next due for

renewal on 26th January 2010.

1.4 Trade Mark Application No. 50488 DARK AND LOVELY RESTORE & SHINE OIL MOISTURIZER CREME in Class 3, filed with effect from 15th August 2000 for a specification of goods reading "Soap; perfumery; essential oils, cosmetics, hair lotions including hair shampoos, hair conditioners, hair colorants, and hair dyes and all goods included under Class 3".

1.5 Trade Mark Registration No. 55797 DARK AND LOVELY DL PRECISE & Device in Class 3, filed with effect from 30th March 2004 for a specification of goods reading "Hair care and hair colour products and all goods included under Class 3". This registration is still in force and is next due for renewal on 30th March 2014.

1.6 Trade Mark Registration No. 55798 DARK AND LOVELY ULTRA CHOLESTEROL in Class 3, filed with effect from 30th March 2004 for a specification of goods reading "Hair care and hair colour products and all goods included under Class 3". This registration is still in force and is next due for renewal on 30th March 2014.

2. Our Trade Mark was first devised and adopted many years before the opposed application was filed on 28th March 2006. Our Trade Mark has for many years been extensively used, advertised and promoted by us in Kenya as well as many other African countries, and countries around the world, on and in connection with those goods as mentioned above.

3. In addition to the Kenyan trade mark referred to in paragraph 1 hereof, Our Trade Mark has for many years past been registered in numerous countries around the world, long before the Opposed Application was filed and as a result of the extensive use and advertisement (amongst other factors), Our Trade Mark has already become extremely well-known around the world, including in Kenya, as distinguishing our goods from the goods of all others. Our Trade Mark is still so well-known and distinctive.

The goods specified in the Opposed Application are the same goods and/or same description of goods as Our Trade Mark.

5. (a) The Offending Mark is so similar to Our Trade Mark as to be effectively identical to Our Trade Mark.

(b) The Offending Mark so nearly resembles Our Trade Mark, that use by the Applicant of the Offending Mark is likely to deceive and/or cause confusion between the goods of the Applicant on the one hand and our goods on the other hand: In addition, use of the Offending Mark is likely to cause members of the public to infer that we have in some way approved or licensed the Applicant or its goods or that there is some connection between the Applicant and ourselves.

The Notice of Opposition was duly forwarded to the Applicants who on 5th October 2007 filed their Counter-Statement. The Applicants stated the following as the grounds on which they would rely in support of their application:

1. Without prejudice to anything hereinafter stated, the above referenced Opposition by L'Oreal of 14 Rue Royale 75008 Paris France 9 ("the Objector") is incurably defective as it offends mandatory provisions of the law applicable to the said opposition and ought to be dismissed forthwith for the following reasons;

a) The said Notice of opposition was, without any sufficient reason, filed long after the expiry of the statutory period prescribed by the Trade Marks Act Cap 506 ("the Act") and rule 46 of the Trade Marks Rules ("the Rules");
b) The said Opposition is predicated upon a non-existent advertisement in connection with an application for a trade mark in express contravention of the provisions of rule 46 of the Rules.

And by reason of the contravention of the said mandatory provisions of the law regulating Notice of Opposition, the said Opposition cannot and ought not to be entertained nor considered.

2. The foregoing not withstanding, the intended registration of the trade mark" Nice & Lovely Label" device does not infringe:

a) The rights of the Objector (real or perceived) in respect of trade marks number 55797 DARK & LOVELY PRECISE DL and 55798 DARK & LOVELY ULTRA CHOLESTROL.
b) The rights of the Carsons Products Company, a Delaware (U.S.A) Corporation which is the proprietor of the Trade Marks numbers 47045 DARK & LOVELY CHOLESTROL PLUS, 50488 DARK & LOVELY RESTORE & SHINE OIL MOISTURISER CREME and 49774 DARK & LOVELY for which the Objector has no right to lodge or pursue any objections.

And the mark "Nice & Lovely" Label device is not confusingly similar to any of the said existing trade marks.

3. The opposition by the Objector (the competence of which is not admitted) is an unlawful attempt in contravention of section 7 (2) of the Act to secure the exclusive use of ordinary words in the English language. In particular, for example the Applicant is aware that Certificates of Registration of the following Trade Marks of the Opponent:

a) DARK & LOVELY PRECISE DL No. 55797
b) DARK & LOVELY ULTRA CHOLESTROL No. 55798

both expressly state on the face thereof that "registration if this mark shall have no

right to the exclusive use if the words 'Dark' 'Lovely'.... Each separately and apart from the mark as a whole".

4. Further to the matters stated in paragraph 3 above, the said opposition by the Objector (the competence of which is not admitted) is an unlawful attempt in contravention of section 7 (2) of the Act to secure the exclusive use of ordinary words in the English language used with the conjunction "and" or ampersand "&"which is in itself not registrable as such registration would be untenable.

5. The Objector is not genuine or truthful in its Notice of Opposition as the Trade Mark Application No 39813 "DARK & LOVELY" referred to in paragraph 1.1 of its Notice of Opposition has not been registered by the Registrar of Trade Marks and was expressly rejected for registration on the grounds that the Mark was in use by a foreign corporation other than the Objector and the Applicant puts the Objector to strict proof of the registration of the Trade Mark Application No. 39813 DARK & LOVELY.

6. The following marks NICE & LOVELY, FAIR & LOVELY, YOUNG & LOVELY, SOFT & LOVELY, PURE & LOVELY are registered in the Republic of Kenya by various companies in Kenya, including the Applicant and there is no legitimate reason why registration of the mark" NICE & LOVELY" Label device should be considered differently from the said marks as an infringement of any marks registered in the name of the Objector.
7. The Applicant denies each and every allegation made at paragraphs 5,6,7,8 and 9 of the Notice of opposition and states: THAT

a) There are no grounds upon which the Objector can sustain an allegation that the Applicant's trade mark is so similar to its trade marks to be effectively identical to its mark.
b) There are no grounds upon which the Objector can sustain an allegation that the Applicant's mark so nearly resembles the Objector's as to be likely to deceive and/or cause confusion between the goods of the Applicant and the goods of the Objector nor are there any grounds for members of the public to infer that the Objector has approved or licensed the Applicant or any of the matters alleged in the said paragraphs.
c) It is clear that there can be no confusion between the words "NICE" & "DARK"; as these words are neither similar nor identical and this difference (even at most casual observation thereof) distinguishes the trade mark from the existing trade marks of the Objector.
d) The Objector's rights do not extend to the right to the exclusive use of the word "Lovely" and by necessary implication, the use of the conjunction "and" or ampersand "&" as any attempt to secure such rights would be an unlawful extension of the use of the marks already

registered to the Objector.

8. Further to the foregoing the Applicant currently uses the "NICE & LOVELY LABEL" device mark on a group of products distinct from those allegedly used by the Objector, namely men's designer perfumes; whilst the objector uses the mark "Dark and Lovely" on hair care products. There is therefore no reasonable possibility of confusion and/or infringement in the minds of the public when purchasing such products for very distinctly different purposes. The purpose which the Trade Mark is used by the Applicant for its goods is to distinguish the goods of the Applicant from goods with which the Applicant is not connected and have different names.
9. In any event and without prejudice to any of the foregoing paragraphs, the Trade Mark has been in use well before the period prior to January 2004 and the Applicants products bearing the trade mark have been widely available to the public in shops and stores, acquiring valuable goodwill in the process. At no time in the duration of the products under their Trade name did the Objector object to such concurrent use. The circumstances of the use of the terms "AND LOVELY" (whose use is not exclusively reserved to the objector) constitute an honest concurrent use of the said terms within the

meaning of Section 15(2) of the Act and the Registrar is empowered to exercise his discretion to authorize registration of the Trade mark which incorporates the terms "AND LOVELY" and/or "[Ampersand "&" LOVELY".

10. If in any event, as implied in the Notice of Opposition the Objector is entitled to a claim for the exclusive use of the terms "AND LOVELY"; or indeed "[Ampersand Le. "&"] LOVELY", then the Applicant being a registered user of marks including the terms "AND LOVELY" is entitled to a similar reciprocal claim to protection of the use of the terms to the detriment of the Objector.
11. The Objector is only the proprietor of the existing registered trade marks referred to in paragraphs 1.5 and 1.6 of the Notice of Opposition i.e. TM No. 55797 DARK & LOVELY DL PRECISE and TM No. 55798 DARK & LOVELY ULTRA CHOLESTROL respectively.
12. Subject to the distinction made in paragraph 8 above, the goods specified in the Application are of the same general description (in relation to the description of the formulation) as those specified in relation to the Objector's Trade marks.
13. The Opponents' trade marks mentioned in paragraph 1 of the Notice of Opposition have been available to the public in connection with hair care products.

The Counter statement was forwarded to the Opponents who on 26th February 2008 filed a statutory declaration sworn by Mr Jose Monteiro, the Chief Trade Mark counsel of the Opponents who declared *inter alia* as follows:

1. My company first adopted the trade mark "DARK & LOVELY" through its predecessor in interest at least as early as 1972 and the trade mark has been in continuous use ever since. My company began using the trade mark in Kenya at least as early as 2001 and such use continues to this day. Between 1995 and 2005, my company's predecessor in interest, Carson Products, traded with goods under the trade mark "DARK & LOVELY" in Kenya from the United Kingdom and the United States of America. My company and its predecessor have at all material times been the lawful owner of the trade mark "DARK & LOVELY" (and variants thereof, such as "DARK and LOVELY") which are hereinafter referred to as "our Genuine Trade Mark". In total, our genuine Trade Mark has been used in Kenya for the last 20-25 years.

4. 1 In particular, it will be noted that my company is the owner of the following trade mark applications and registrations in Kenya.

Trade Mark Application No. 49774 DARK & LOVELY Special Form II in Class 3, filed with effect from 26th January 2000 for a specification of goods reading "Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices and all goods under Class 3". The registration is still in force and is next due for renewal on 26th January 2010.

4.2 Trade Mark Application No. 39813 DARK & LOVELY in Class 3, filed with effect from 17th June 1992 for a specification of goods reading "Hair relaxers, shampoo conditioners, cosmetics, hair lotion and all goods under Class 3".

4.3 Trade Mark Application No. 47045 DARK & LOVELY CHOLESTEROL PLUS in Class 3, filed with effect from 25th February 1998 for a specification of goods reading "Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices and all goods under Class 3".

4.4 Trade Mark Application No. 50488 DARK AND LOVELY RESTORE & SHINE OIL MOISTURIZER CREME in Class 3, filed with effect from 15th August 2000 for a specification of goods reading "Soap; perfumery; essential oils; cosmetics, hair lotions including hair shampoos, hair conditioners, hair colorants, and hair dyes and all goods included under Class 3".

5. My Company uses Our Genuine Trade Mark on a wide range of goods the likes of which fall within the ambit of International Class 3. The extent of My Company's use of Our Genuine Trade Mark is evident from the sales of goods branded with Our Genuine Trade Mark, in Kenya, for the years 2004 through 2006 were as follows:

Year	South African Rands
2004	1500,111
2005	5800,111

2006 1400,000

6. My Company has been using, marketing and otherwise advertising Our Genuine Trade Mark and goods branded with Our Genuine Trade Mark throughout the world in a huge scale. For example in Kenya, during the period equivalent to that reflected above, our expenditure on advertising and promotions was as set out below:

Year	South African Rands
2004	102,000
2005	468,000
2006	44,000

7. In the context of My Company's advertising and promotional expenditure, it should be noted that promotion and advertising occurs in various media formats. A publicly visible example of our advertising includes our outdoor billboard campaign and set out below are details of the locations where we erected outdoor billboards in Kenya over the last number of years:

Location	Start Date	End Date
1) Globe Cinema Roundabout, Nairobi	1 July 2000	31 December 2004
2) Village Market, Gigiri, Limuru Rd, Nairobi	1 July 2000	31 December 2002
3) Likoni Ferry, Mombasa	1 July 2000	31 December 2002
4) Nairobi Rd, Nakuru, Nairobi	1 July 2000	31 December 2002
5) Outering Rd, Nairobi	1 July 2000	31 December 2002
6) Machakos Bus Stop, Nairobi	1 July 2000	31 December 2004
7) Devali Building CBD, Mombasa	1 July 2000	31 December 2004
8) Movable "Citilite" billboard, Nairobi	1 March 2004	31 December 2004

The said statutory declaration was forwarded to the Applicants who on 25th April 2008 filed a statutory declaration sworn by Mr Anthony Mwangi, the Finance Director of the Applicants who declared *inter alia* as follows:

1. I reiterate, on behalf of the Applicant, the content of the Applicant's response dated and filed with the Kenya Industrial Property Institute on 5th October 2007 and annexed hereto as the exhibit marked "AM-I" and have been advised by the Applicant's counsel on record which advise I verily believe to be true, that the Objector's opposition is technically

incompetent, misconceived, bad in law and without merit.

2. The Applicant is a stranger to the content of paragraphs 1.2, 2 and 3 of the Objector's statutory declaration.
3. As regards paragraph 4 of the Objector's Statutory Declaration, while the Applicant does not make any admissions as to the registration, currency, status or extent of use of the various variants of the "DARK AND LOVELY" marks referred to therein, I verily believe that the intended registration of the trade mark "NICE & LOVELY *HERBAL OIL MOISTURISER*" does not infringe on any right of the Objector that may exist in the trade marks referred to therein, as the only similarities exist in the use of the word "Lovely" for the following reasons:

(1) The Applicants mark NICE [Ampersand i.e. "&"] LOVELY *HERBAL OIL MOISTURISER* is distinctly dissimilar from the mark DARK AND LOVELY and the variants thereof.

(2) The Objector is not entitled to a monopoly on the use of the word "LOVELY"; the words" AND LOVELY" and/or "[Ampersand i.e. "&"] LOVELY" and no such monopoly has been established

(3) I am aware of my own personal knowledge that the Applicant's mark sought to be registered has existed in concurrent lawful use with the Objector's marks along with various other marks owned by other persons and entities which contain the word "LOVELY"; the worlds "AND LOVELY" and/or "[Ampersand i.e. "&"] LOVELY" including, without limitation

(a) Nice & Lovely (b) Fair & Lovely (c) Young & Lovely (d) Soft & Lovely (e) Pure & Lovely

(4) Further, I verily believe that NICE & LOVELY *HERBAL OIL MOISTURISER* is neither confusingly similar to the marks alleged to have been registered by the Objector nor does it nearly resemble any of the said marks so as to be likely to deceive or cause confusion between the goods of the Applicant and the goods of the Objector. Shown to me and annexed hereto are certified copies of the Certificate of Registration of the Objector's trade marks marked " AM 2A" & /I AM 2B". I have been advised by the Applicant's counsel on record that the said objection by the Objector seeks to monopolize the use of ordinary words of the English language in contravention of the express provisions of section 7(2) of the Trade Marks Act.

(5) The Applicant has no knowledge of, is a stranger to the contents of paragraphs 5, 6 and 7 of the Objector's Statutory Declaration and further maintains that the contents thereof do not materially alter or otherwise prejudice the matters set out herein.

(6) With regard to paragraph 8 of the Objector's Statutory Declaration, I reiterate the matters stated hereinabove and verily believe that the Applicant's Nice &

Lovely Herbal Oil Moisturizer mark has also gained valuable goodwill and reputation within the Republic of Kenya and elsewhere, which valuable goodwill and reputation and the investment to bring it into being shall be adversely affected by the Objector's attempts to monopolize the use of the term "Lovely"; the terms "and Lovely" and/or "[Ampersand i.e. *"&"]* LOVELY"

(7) With regard to paragraph 9 of the Objector's Statutory Declaration, it is not true and the Applicant denies that the application for the registration of the trade mark "NICE & LOVELY *HERBAL OIL MOISTURISER*" is an attempt (deliberate or otherwise) by the Applicant to either copy the Objector's mark or take advantage of the Objector's alleged reputation and goodwill for the reasons cited above and further, to the extent that the said mark is quite distinct from any of the Objector's marks.

(8)With regard to paragraph 10, 11 and 12 of the Objector's Statutory Declaration reiterates the contents of preceding paragraphs and maintains that it has a bona fide legal claim to register the trade mark "NICE & LOVELY HERBAL OIL MOISTURISER". In any event, I am aware of my own personal knowledge that the Applicant currently uses the "NICE & LOVELY HERBAL OIL MOISTURISER" mark on a group of products distinct from those allegedly used by the Opponent, namely hair products. There is therefore no reasonable possibility of confusion and/or infringement in the minds of the public when purchasing such products for very distinctly different purposes. I note that it has neither been alleged nor demonstrated that the Objector's market share in hair care products has been injured or is likely to be injured by the continued concurrent use of the marks.

The said Statutory Declaration was forwarded to the Applicants, who on 15th July 2008 filed a statutory declaration in reply sworn by the said Mr. Jose Monteiro, who denied all the contents of the Statutory Declaration filed by the Applicants.

The Ruling

I have considered the notice of opposition filed by the Opponents and the counter-statement filed by the Applicants together with the evidence adduced by both parties herein by way of their respective statutory declarations. I have also considered the submissions made before me by the advocates for both the Opponents and the Applicants during the hearing of this matter. I take cognisant of the following facts:

(a) Apart from the mark that is under opposition, that is, TMA No. 58890 "NICE & LOVELY HERBAL OIL MOISTURISER", the Applicants have registered their mark TMA No. 48507 "NICE & LOVELY" with effect from 1st March 1999;

(b) The Applicants are seeking to register other marks that are variants of the said "NICE & LOVELY" mark, that is TMA No. 56610 "Versman Nice & Lovely" and TMA no. 57969 "Smooth & Lovely";

(c) The Opponents herein have filed expungement proceedings against the said mark "NICE & LOVELY", registered in the name of the Applicants

herein and the expungement proceedings are pending before the Registrar of Trade Marks;

(d) The Opponents herein have filed opposition proceedings in regard to the above-mentioned TMA No. 56610 "Versman Nice & Lovely" and TMA no. 57969 "Smooth & Lovely";

(e) The Opponents registered their mark TMA No. 39813 DARK & LOVELY with effect from 17th June 1992;

(f) The Opponents have also registered several other variants of their above-mentioned mark TMA No. TMA No. 39813 DARK & LOVELY, which have been referred to in the pleadings herein, that is, TMA No. 47045 DARK & LOVELY CHOLESTEROL PLUS, TMA No. 49774 DARK & LOVELY special form II, TMA No. 50488 DARK AND LOVELY RESTORE & SHINE OIL MOISTURIZER CREME TMA No. 55797 DARK AND LOVELY DL PRECISE & Device and TMA No. 55798 DARK AND LOVELY ULTRA CHOLESTEROL;

(g) The opposition proceedings in regard to one of the marks, the said TMA No. 56610 "Versman Nice & Lovely" are part heard before me;

(h) The submissions made during the said hearing of the opposition proceedings in respect of TMA No. 56610 "Versman Nice & Lovely" are identical to the arguments advanced during the hearing of the current opposition proceedings in respect of TMA No. 58890 "NICE & LOVELY HERBAL OIL MOISTURISER";

(i) The arguments advanced by both parties in their respective notice of opposition, counter-statement and the statutory declarations filed for purposes of the opposition proceedings in respect of TMA No. 58890 "NICE & LOVELY HERBAL OIL MOISTURISER" are identical to the notices of opposition, counter-statements and the statutory declarations filed for purposes of the opposition proceedings in respect of TMA No. 56610 "Versman Nice & Lovely" and TMA no. 57969 "Smooth & Lovely"; and

(j) The arguments advanced by both parties in their respective Application for Expungement, counter-statement and the statutory declarations filed for purposes of the said expungement

proceedings in respect of TMA No. 48507 "NICE & LOVELY" are identical to the arguments advanced in the notices of opposition, counter-statements and the statutory declarations filed for purposes of the opposition proceedings in respect of the above-mentioned trade marks.

Having the above-mentioned facts in mind, I will proceed to determine whether or not the Applicants herein have a valid claim to the words "NICE & LOVELY" in view of the claims of the Opponents in the pending expungement proceedings, these opposition proceedings and the two other pending opposition proceedings as herein above indicated. The Opponents filed their opposition proceedings based on the provisions of sections 14, 15(1) and 15A of the Trade

Marks Act, Cap 506 of the Laws of Kenya. I will therefore consider the said provisions to assist me to determine the validity or not of the Applicants' claim to the mark "NICE & LOVELY".

1. **Is the Applicants' mark "NICE & LOVELY so similar to the Opponents' mark "DARK & LOVELY" as to cause a likelihood of deception or confusion as provided for under sections 14 and 15(1) of the Trade Marks Act?**

Section 14 of the Trade Marks Act provides as follows-

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

Section 15 (1) 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."

In regard to the issue of similarity between the two marks, the Opponents stated that the marks are quite similar since the only difference is the word "Dark" in the Opponents' Mark "DARK & LOVELY" as opposed to the word "NICE" in the Applicants' mark "NICE & LOVELY". The Opponents submitted that the said similarity is more so considering the fact that the goods that both marks are in respect of are similar and they are sold in the same trade channels and quoted the South African Case referred to as of Plascon-Evans Paints V Van Riebeeck Paints.

On the other hand, the Applicants state that their mark is distinctive of their goods and they have used the same in the market for a long while and have created goodwill in the market.

The trade marks "DARK & LOVELY" and "NICE & LOVELY" are word marks and the right approach when considering word marks is as was stated by Parker J. 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".

While considering the provisions of the said sections 14 and 15(1) of the Act and the words of Parker J in the above-mentioned matter, several factors need to be taken into account. The following is a consideration of some of the said factors:

The strength of the complainant's mark:
It is apparent that the marks "DARK & LOVELY" and "NICE & LOVELY" both comprise of ordinary English words, which neither the Opponents nor the Applicants created but simply adopted for use in the market in respect of beauty products. The marks are not identical but both are comprised of the word "LOVELY". According to the Thesaurus, the word "LOVELY" could also mean attractive, beautiful, charming, divine, exquisite, good-looking, gorgeous, handsome or pretty. It is therefore apparent that when used in respect of goods under class 3 of the Nice International Classification of Goods and Services, which are mainly beauty products, then the mark would not be considered to be a coined or arbitrarily mark but one that is suggestive and descriptive of the said goods in class 3. In the book WIPO Intellectual Property Handbook by the World Intellectual Property Organisation 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."

It is my view that the word "LOVELY" when used in respect of goods in class 3 falls in the category of a mark that would be descriptive of the said goods especially in regard to the intended purpose of making the user attractive, beautiful, charming, divine, exquisite, good-looking, gorgeous, handsome or pretty.

In the said book WIPO Intellectual Property Handbook by the World Intellectual Property Organisation 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 English infringement case referred to as British Sugar Plc v James Robertson & Sons Limited, British Sugar Plc had registered the word "TREAT" for goods in class 30 in 1992. In 1995 James Robertson produced similar goods known as "Robertson's Toffee Treat". British Sugar brought an action for trade mark infringement against James Robertson on the basis of the inclusion of the mark "TREAT" as part of the name of their product. Robertson argued that their use of the "TREAT" sign is not use as a trade mark for the purposes of infringement because of the natural English meaning of the word. Jacob J held that this did not constitute infringement.

Borrowing from the said case, if the mark "DARK & LOVELY" was strong, an arbitrary mark or a coined mark, then the likelihood of deception or confusion between the said Opponents' mark "DARK & LOVELY" and the Applicants' mark "NICE & LOVELY" would be substantial.

In the German case referred to as *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 another German case referred to as Lloyd Schuhfabrik Meyer v Klijsen Handel Case, the court stated as follows:

"the more distinctive the earlier mark, the greater will be the likelihood of confusion. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make a global assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings. In making that assessment, account should be taken of all relevant factors and, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered. It is not possible to state in general terms, for example by referring to given percentages relating to the degree of recognition attained by the mark within the relevant section of the public, when a mark has a strong distinctive character".

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."

Further, in the aforementioned 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 Office Cleaning Services Ltd v Westminister and general Cleaners Ltd, the claimant unsuccessfully tried to restrain the defendant from using the trading name Office Cleaning Association". In the claimant's unsuccessful appeal, to the House of Lords, Viscount Simonds said (at page 42):
"the courts will not readily assume that the use by a trader as part of his trade name descriptive words already used by another trader as part of his trade name is likely to cause confusion and will easily accept small differences as adequate to avoid it. It is otherwise where a fancy word has been used as part of the name."

In the passing off proceedings referred to as Antec International Ltd v South Western Chicks (Warren) Ltd (at page 285), Laddie J said as follows:
"As it is sometimes put, no trader will be allowed to fence off words in the common of the English language. From this it flows, that in some cases where a trader has used a highly descriptive name, he will find it virtually impossible to obtain protection at all by means of passing off proceedings."

I borrow from all the above cases and state that, 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 in respect of similar goods and especially beauty products under class 3 of the International Classification of Goods and Services. This is as opposed to the above-mentioned case known as Plascon-Evans Paints V Van Riebeeck Paints that was quoted by the Opponents. In the said case, 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 their pleadings and in their submissions, the Applicants stated that the Register of Trade Marks contains other trade marks registered in respect of goods in the said international class 3 comprising of the word "LOVELY" which means that the Opponents cannot claim the exclusive use of the said word "LOVELY". On the other hand, the Opponents stated that those other marks are not the subject of these opposition proceedings and should not be considered and that the state of the Register is of no consequence to these opposition proceedings. However, I am of the

view that one cannot ignore the practice of the Registry of Trade Marks and the marks contained in the Register of Trade Marks, one of the statutory documents that the Registrar of Trade Marks is required to maintain under the Trade Marks Act.

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."

The following table indicates that apart from the Opponents and the Applicants who have registered or applied to register several marks that are variants of their respective "DARK & LOVELY" and "NICE & LOVELY" marks, there are other marks registered in the name of various proprietors in respect of goods falling in the said international class 3 comprising of the word "LOVELY":

	TMA No	Date of Application	Trade Mark	Class	Goods	Proprietor
1.	**33496**	**14th October 1985**	**"FAIR & LOVELY" (WORDS)**	**3**	**Bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices.**	**Dorothy Gray Inc**
2.	**40673**	**21st July 1993**	**"LOVELY LADY " (WORDS and DEVICE)**	**3**	**Hand and body lotions, cream, cosmetics, perfumery hair lotions, dentifrices**	**Mt. Kenya Oil Millers Limited**
3.	**42672**	**29th June 1995**	**"FAIR & LOVELY" (WORDS)**	**3**	**Soaps; perfumes, esential oils, cosmetics; non-medicated toilet preparations, oils, creams and lotions for the skin, skin lighteners; preparations for the hair, dentifrices; anti-perspirants, deodorants for personal use**	**Unilever PLC**
4.	**50606**	**25th September 2000**	**"SOFT & LOVELY" (WORDS)**	**3**	**Essential oils, hair conditioners pure petroleum jellys, shampoos and other beauty**	**Nairobi Masters Limited**

					products.	
5.	51279	22nd February 2001	"BLACK AND LOVELY" (WORDS)	3	Nail polish, Nail polish remover, perfumes, hand and body shampoo, Foam bath, Roll-on creams, lipstics, hair creams and gels, curl activator gel creme relaxers, neutralizing shampoos, perm relaxers, hairfoods, normal shampoos, pre softening gel, soaps toiletries and skin lightening cremes	Strategic Industries Limited
6.	51310	28th February 2001	"LOVELYCARE" (WORD)	3	Nail polish, perfumes, hand and body lotions, creams, lipsticks, hair creams and gels, curl activator gel, creme relaxers, neutralizing shampoos, perm relaxers, hairfoods, normal shampoos pre softening gel, soaps, toiletries and skin lightening cremes.	Strategic Industries Limited
7.	54653	9th June 2003	"FAIR & LOVELY" (WORDS and DEVICE)	3	Soaps; liquid soaps; bath and shower preparations, including bath foam and shower gels; shaving and after shave preparations; perfumery, essential oils; cosmetics; preparations for the hair; sachets for perfuming linen; hair preparations; skin care preparations; deodorants; anti-perspirants; hand-washes; detergents	Unilever PLC
8.	61567	13th July 2007	"GLORY & LOVELY" (WORDS)	3	Cosmetics	Sonal Pharma Kenya Limited
9.	67235	13th January 2010 (approved by the Registrar	"FAIR & LOVELY MAXFAIRNESS" (WORDS)	3	Soaps, essential oils; bath and shower preparations; skin care preparations; oils, creams and lotions for the skin; shaving preparations; pre-shave and after-shave preparations;	Unilever PLC

		and pending payment of publication fee)			**depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up removing preparations; petroleum jelly; lip care preparations; talcum**	

The Opponents adopted the word "LOVELY" for their business for goods in class 3. The word "LOVELY" is not only descriptive of the goods in class 3 but is also registered and being used by other persons in similar businesses. It is apparent that all the above-mentioned proprietors on the Register of Trade Marks have entered a disclaimer of the right to the exclusive use of the word "LOVELY" separately and apart from the mark as a whole.

David I. Bainbridge, the learned author of the book, Intellectual Property, Sixth Edition states as follows on page 634:
"Where the similarity with an earlier trade mark results only from elements disclaimed in that earlier trade mark, there can be no similarity if no other elements are the same or similar."

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 another 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."

The feature that the Opponents are relying on in these proceedings is the English word "LOVELY". I am of the view that with the presence of several other marks on the Register and in the Kenyan market that comprise the word "LOVELY" the Opponents cannot "prove that the feature of their product on which they rely has acquired a meaning or significance, so that it indicates a single source for goods on which that feature is used." The Opponents have not been able to show that they are the only

ones using a trade mark with the word "LOVELY" in respect of beauty products meaning that the Opponents cannot claim to be the only or the single source of the said goods. In the words of the court in the above-mentioned case of Bata Limited V Face Fashions and Michael Terrence Gormley, the word that the Opponents relied on to file the current opposition proceedings "is an ordinary word in everyday use, as distinct from an invented or made-up word" and which has been registered and used by other traders for similar goods and cannot therefore be monopolized by any one trader to the exclusion of all the other traders. The Opponents' mark is not a strong mark for purposes of use in respect of beauty products in class 3 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 "DARK & LOVELY" and "NICE & LOVELY" and their variants are mainly beauty products. In my view, beauty products are comparable to pharmacetical products which, though not very expensive like for example a motor-vehicle, 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 "unusully 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 beauty products 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 quite discerning and are very careful having in mind that buying that which you did not intend to purchase could damage the hair or the skin at the worst or alternatively, leave the hair or the skin without the desired effect of making the same beautiful attractive, exquisite, good-looking, gorgeous or pretty.

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

Similarity between the marks in appearance and suggestion
The Opponents' mark and that of the Applicants are not identical but contain a similar element, the word "LOVELY". 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 ealier-registered mark "Reed" and the latter mark, "Reed Business Information" since the two are not identical, though they are similar and are 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."

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.
As aforementioned, the respective marks of the Opponents and the Applicants "DARK & LOVELY" and "NICE & LOVELY" are not identical. They have different words, which are "DARK" and "NICE". 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. Like it was stated by Jacob LJ in the Reed Executive PLC v

Reed Business Information Ltd case, the said words "DARK" and "NICE" would not go unnoticed by purchasers of beauty products.

Further, I had earlier stated that neither the Opponents' nor the Applicants' mark is fanciful or arbitrary. Both of them are using marks that cannot be considered to be very strong and when used in respect of goods in class 3, they are descriptive of the said goods.

In the aforementioned case of Sabel v Puma, the court stated as follows:

"However, in circumstances such as those in point in the main proceedings, where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion."

In a South African Case referred to as Cowbell AG V ICS Holdings Limited, the court found that visually and aurally, there could be no confusion between the Opponents' trade mark DAIRYBELLE and JERSYBEL and the application COWBELL AND COW'S HEAD WITH HANGING BELL DEVICE where the marks in issue were in respect of dairy products. On the question of conceptual similarity, the Supreme Court of Appeal overruled the decision of the court which had reasoned that a person having heard the one mark being advertised on the radio when confronted with the other in a supermarket would not be astute enough to discern that they are not the same or are not cows from the same herd. The court stressed that unless the analogous semantic content can reasonably give rise to a likelihood of confusion or deception, it is irrelevant. The court concluded as follows:

"In short, the Respondent cannot lay a claim to the exclusive use of the words having a dairy connotation all ending in "BELLE" or "BEL" in relation to dairy products where these do not form a dominant part of its mark and have not any particular distinctive character. That is why "Coca Cola" and "Pepsi Cola" have been able to co-exist side by side."

In the same way, in the current opposition proceedings, the Opponents cannot lay a claim to the exclusive use of the word "LOVELY", for beauty products and in any event, registration of their mark "DARK & LOVELY" and all the variants thereof contain a disclaimer of the right to the exclusive use of the words "DARK" and "LOVELY" separately and apart from the mark as a whole.
In the 1978 English legal case of Morning Star Cooperative Society v Express Newspapers Limited [1979] FSR 113, the publishers of the Morning Star, a British Communist party publication, sought an injunction to prevent Express Newspapers from launching their new tabloid, which was to be called the Daily Star. Mr. Justice Foster asked whether the plaintiffs could show:

"a misrepresentation express or implied that the newspaper to be published by the defendants is connected with the plaintiffs' business and that as a consequence damage is likely to result to the plaintiffs"

and stated as follows:

"if one puts the two papers side by side I for myself would find that the two papers are so different in every way that only **a moron in a hurry** would be misled." (Emphasis added).

In this case, where the judge was of the view that only a moron in a hurry would be misled, the common word was "star" which is a common word in the trade of newspapers. I am of the same view as the said judge in regard to the current opposition proceedings. Like I had said earlier, beauty products would not usually be bought by "morons in a hurry" or children. They are usually bought by people who are quite discerning who take their time to go through all the details on the packaging.

In the UK case of European Ltd v Economist Newspaper Ltd, the Claimant alleged that the Defendant had infringed, under section 10(2) of the Trade Marks Act 1994, its registered trade mark THE EUROPEAN and device by producing a newspaper called 'European Voice', because it was so similar as to give rise to a likelihood of confusion. The Court of Appeal found that the judge was right to have decided that there was no likelihood of confusion, and had in mind the correct factors, including that the goods were identical. The signs were different in appearance, the word 'European' was being used in a different manner in the two signs, and because the word was descriptive, the monopoly attaching to the registration of the trade mark was restricted on the descriptive use of registered trade marks and criminal liability.

As earlier indicated, in the English case of Office Cleaning Services v Westminster Window and General Cleaning, Lord Simmons held that where a mark is largely descriptive "small differences may suffice" to avoid confusion.

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

"Of importance here is the recognition that an addition in the defendant's sign to a registered mark may take the case outside one of "identity". This is obviously sensible – one word can qualify another so as to change its impact, "Harry" qualifies "Potter" and vice versa, for instance. It is particularly in the recognition that additions can change identity that the ECJ has moved on from the rather rigid view taken under the old UK law.

The last sentence is an acknowledgement of a fact that has long been recognised: where a mark is largely descriptive "small differences may suffice" to avoid confusion (*per* Lord Simonds in *Office Cleaning Services v Westminster Window and General Cleaning* (1946) 63 RPC 30 at p.43). This is not a proposition of law but one of fact and is inherent in the nature of the public perception of trade marks.

It is worth examining why that factual proposition is so – it is because where you have something largely descriptive the average consumer will recognise that to be so, expect others to use similar descriptive marks and thus be alert for detail which would differentiate one provider from another. Thus in the cited case "Office Cleaning

Association" was sufficiently different from "Office Cleaning Services" to avoid passing off."

It is my view that the differences in the marks "DARK & LOVELY" and "NICE & LOVELY" and the respective variants used by both the Applicants in addition to all the other factors indicated herein above make the two marks quite different and capable of distinguishing the products of each of the proprietors without any confusion in the Kenyan market.

For all the above-mentioned reasons, taking into consideration all the relevant circumstances and on a balance of probabilities, I am of the view that the trade mark "NICE & LOVELY" is not so similar to the trade mark "DARK & LOVELY" as to cause a likelihood of deception or confusion in accordance with the provisions of sections 14 and 15(1) of the Trade Marks Act.

(2) Is the Opponents' mark a well-known mark in Kenya and therefore deserving protection under 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

    (a) is a national of a convention country; or

    (b) 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. Subject to the provisions of section 36B, the proprietor of a trade mark which is entitled to protection under the Paris Convention or the WTO Agreement as a well-known trade mark is entitled to restrain by injunction, the use in Kenya of a trade mark which is identical or similar to his, in relation to identical or similar goods or services where the use is likely to cause confusion among the users of the goods.

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.

One of the reasons for opposing registration of the Applicants' mark is due to the fact that the Opponents claim that their mark "DARK & LOVELY" and its variants is quite well-known both in Kenya and internationally. They have submitted to the Registry documents to indicate that their mark has been registered in many parts of the world where the mark has gained a reputation and has become well-known. They also state that registration of the Applicants' mark would impair, interfere with or take unfair

advantage of the distinctive character that the Opponents' well-known trade mark has gained in Kenya. On the other hand, the Applicants state that their mark is also very well-known in Kenya and in fact, their products bearing the mark "NICE & LOVELY" and its variants are more well-known in Kenya than the products of the Opponents.

The World Intellectual Property Organization has issued the following guidelines on the protection of well-known marks, known as Joint Recommendation Concerning Provisions on the Protection of Known Marks:

1. The degree of knowledge or recognition of the mark in the relevant sector of the public;

2. The duration, extent and geographical area of such use;

3. The duration, extent and geographical area of any promotion of the mark, including advertising;

4. 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;

5. The record of successful enforcements of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities; and

6. The value associated with the mark.

Though the said Guidelines are just that, Guidelines, the Registrar of Trade Marks has widely used the same to determine how famous or well-known a mark is, in several opposition or expungement proceedings. Several authors and courts have also come up with similar guidelines that have assisted in determining how well-known or famous a trade mark is.

In an article known as Recent Developments in Trade Dress Infringement Law published in the Journal of Law and Technology, the authors state as follows:

"The courts consider the following factors to determine whether or not a mark is famous:

(a) the degree of inherent or acquired distinctiveness of the mark;

(b) the duration and the extent of use of the mark in connection with the goods or the services with which the mark is used;

(c) the duration and extent of advertising and publicity of the mark;

(d) the geographical extent of the trading area in which the mark is used;

(e) the channels of trade for the goods or services with which the mark is used;

(f) the degree of recognition of the mark in the trading areas and channels of trade used my the marks' owner and the person against whom the injunction is sought;

(g) the nature and the extent of use of the same or similar marks by third parties; and

(h) whether the mark was registered."

The Black's Law Dictionary defines a famous trade mark as follows:

"a trade mark that is not only distinctive but also has been used and 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 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."

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

(a) The inherent distinctiveness of the earlier trade mark and the uniqueness or otherwise of the mark in the market place.

In their pleadings and submissions, the Opponents stated that their mark "DARK AND LOVELY" is well known as distinguishing their products and registration of the Applicants' mark would interfere with and take advantage of the distinctive character that their well-known mark has gained in Kenya.

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." **(Emphasis added).**

It is apparent that the common feature between the respective marks of the Opponents and the Applicants is the word **"**LOVELY". I had earlier stated that given the dictionary meaning of the word **"**LOVELY", the same cannot be deemed to be distinctive when adopted for use or registration in respect of goods under class 3 of the International Classification of Goods and Services. I had also indicated that the Register of Trade Marks contains several registered trade

marks, in class 3 in respect of similar goods like those of the Opponents. For these reasons, the Opponents cannot claim that they hold a position of exclusivity or uniqueness in the Kenyan market. In this regard then, the Opponents' mark cannot be said to be well-known in Kenya.

(b) The nature and the extent of use of the same or similar marks by third parties.

While considering the issue of similarity between the marks "NICE & LOVELY" and "DARK & LOVELY", I indicated by means of a table how the Registrar of Trade Marks has registered several other trade marks in the name of various other proprietors apart from the Opponents and the Applicants and they are all co-existing. Using the said fact, I indicated that the mark of the Opponents cannot be said to be a strong mark. This means that in regard to this issue, the Opponents' mark cannot be said to be well-known.

(c) The range of goods or services for which the earlier mark enjoys reputation.

The Opponents' mark is registered and used in respect of beauty products under class 3 of the International Classification of Goods and Services. In my consideration of the issue of similarity between the marks "NICE & LOVELY" and "DARK & LOVELY", I indicated that beauty products are not goods that would be bought by "unusually stupid people, fools or idiots, or a moron in a hurry". Knowing the effect that the wrong choice of the beauty products would have on their hair or skin, the purchasers would be deemed to be reasonably circumspect, well informed and observant.

(d) The record of successful enforcements of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities.

In their statutory declaration, the Opponents indicated that their mark has been registered and used in several jurisdictions all over the world. However, they did not indicate anything in regard to successful enforcement anywhere in the world or a matter where the mark was declared to be well-known by any competent authority. Neither did the Opponents indicate that there has been any attempt to enforce their trade mark rights in Kenya as against the Applicants in any court of law. In the absence of such an action, and in the apparent co-existence of the Applicants, the Opponents and other proprietors in the Kenyan market and the Register of Trade Marks, then the Opponents cannot claim protection under the provisions of section 15A(2), which gives protection subject to the provisions of section 36B. The said section 36B provides as follows:

(1) A proprietor of an earlier trade mark or any other earlier right, who has acquiesced for a continuous period of five years in the use of a registered trade mark in Kenya, being aware of that use, shall cease to be entitled, n the basis of that earlier trade mark or earlier rights –

(a) to apply for a declaration that the registration of the latter trade mark is invalid, or

(b) to oppose the use of the latter trade mark in relation to the goods or services in relation to which it has been so used, unless the registration of the latter trade mark was applied for in bad faith.
It is apparent that the Applicants' trade mark "NICE & LOVELY" has been in the Kenyan market for a continuous period of more than five years and since the Opponents have never sought to bar the Applicants from using their said trade mark, then in accordance with the provisions of the said section 36B, they are barred from claiming protection of their mark **"**DARK & LOVELY" as a well-known mark in Kenya.

In conclusion and in consideration of all the relevant factors, I am of the view that the Opponents have not succeeded in showing me that their mark **"**DARK & LOVELY" is well-known in Kenya.

3.Has there been honest concurrent use of the marks "NICE & LOVELY" and "DARK & LOVELY"?

Section 15(2) of the Trade Marks Act provides as follows:
"In case of honest concurrent use, or of other special circumstances which in the opinion of the court or the Registrar make it proper so to do, the court or the Registrar may permit the registration of trade marks that are identical or nearly resemble each other in respect of the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any,
as the court or the Registrar may think it right to impose."

The Applicants state that they have used their mark **"**NICE & LOVELY" for a long time, that is since the same was registered with effect from 1st March 1999. On the other hand, the Opponents state that there is no evidence that the Applicants have used their mark at all in the Kenyan market. However, it is apparent that the Applicants' mark **"**NICE & LOVELY" was registered with effect from 1st March 1999 and that their goods have been in the market for a number of years.

In Pirie's Application [1933] 50 R.P.C. 147 at 159, Lord Tomlin gave the following inter alia as the guidelines to be followed for purposes of determining honest concurrent use of two marks:

(1) The honesty of the concurrent use;
(2) The extent of use in time and quantity and the area of the trade;
(3) The degree of confusion likely to ensue from the resemblance of the marks which is to a large extent indicative of the measure of public inconvenience;
(4) Whether any instances of confusion have in fact been proved; and
(5) The relative inconvenience which would be caused if the mark in suit were registered, subject if necessary to any conditions and limitations.

In the book Bentley and Sherman's Intellectual Property Law, the learned authors state as follows at page 880:

"In considering whether there has been an honest and concurrent use, the criteria taken into account include:

(a) the length of use;
(b) the amount of use;
(c) the area in which the mark was used;
(d) the degree of confusion (present, absent or likely);
(e) the honesty of the concurrent user;
(f) the existence of actual confusion;
(g) the degree of likely confusion; and
(h) the impact that the registration would have on the public.

It is apparent that the Opponents' and the Applicants' goods have co-existed in the market for quite sometime. There is no evidence brought by the Opponents to indicate that they attempted to stop the Applicants from ever using their mark. After the two marks having co-existed for a while now, then the Opponents are deemed to have acquiesced to the use of the Applicants' mark in the market.

As regards confusion, the Opponents did not cite any evidence of actual confusion. I am aware that these are opposition proceedings and that one need not produce evidence of confusion but only indicate a likelihood of confusion for the respective mark to be deemed not registrable. However, one cannot ignore the continuous and interrupted use of both marks by the Opponents and the Applicants for a period of over ten years and in the same market. This for me proves honest concurrent use. In the afore-mentioned case of Alex Pirie and Sons Limited's Application, it was held that the fact that the commercial user has not produced any proof of confusion cannot be regarded as unimportant even though allowance be made for difficulty of proof.

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, British Sugar Plc, 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, then 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 beauty products bearing the Opponents' and the Applicants' respective marks **"**DARK & LOVELY" and **"**NICE & LOVELY" and their variants have been used side by side in the same market for quite some time now without any evidence of confusion, then it means that no confusion would be likely to occur once the Applicants' mark is registered.

Further and as aforementioned, the Applicants' mark **"**NICE & LOVELY" was registered with effect from 1999. A perusal at the file indicates that the mark is in force up to the year 2016. Ideally, a businessperson seeks to register a trade
mark for protection and for use in the respective territory where the mark is registered. In my view, there cannot be any other way of using a registered mark than an honest use. Looking at it in any other way would defeat the purpose of having a mark protected by way of registration.

In an 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 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."

The current case compares very well to the above-mentioned case of Hannaford & Burton. Having being sold side by side and there having been no evidence of confusion between the beauty 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.
As regards the issue of convenience, the question is whether the inconvenience to the Applicants by refusing registration will be greater than the inconvenience to the Opponents by allowing registration. It is my view that if the mark "Nice & Lovely Herbal Oil Moisturizer" one of the variants of the Applicants' registered trade mark **"**NICE & LOVELY", is not registered, then it would be of great inconvenience to the Applicants who, as already stated have been in the market for a considerable length of time. On the other hand, I am of the view that if the mark is registered, the Opponents would not be inconvenienced since the two marks have already co-existed in the market for quite a while now without any evidence of confusion or any effect of the market share of the Opponents' products. As regards convenience to the members of the public, my view is that since they have not been inconvenienced by the registration and use of the Applicants' mark **"**NICE & LOVELY", then they would not be inconvenienced by registration and use of the of the mark "Nice & Lovely Herbal Oil Moisturizer".

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."

Taking all the above-mentioned factors and all other circumstances into consideration, I am the view that since no confusion has been shown to have occurred in the Kenyan market where the goods of both the Opponents and the Applicants have co-existed, then no confusion will be likely to occur. I find that there has been honest concurrent use of the two marks and that the two marks can co-exist on the Register in accordance with the provisions of section 15(2) of the Act and can continue co-existing in the Kenyan market.

Conclusion

1. It is apparent that the feature in contention between the Opponents and the Applicants is the common English word "LOVELY". Should the Opponents be allowed to fence off a common English word to the exclusion of all the other traders who would desire to use or who are currently using the said word "LOVELY" in respect of beauty products under class 3 of the International Classification of Goods and Services? The answer is no. It is for this reason that all the above indicated proprietors of the marks comprising of the word "LOVELY" have had to disclaim the right to the exclusive use of the word "LOVELY", separately and apart from the mark as a whole. The word "LOVELY" on its own is not capable of distinguishing the goods of any one trader in respect of beauty products to the exclusion of all the other traders. In the Australian case of McCain Foods (Aust) Pty Ltd - *vs.* -Conagra Inc where the issue was whether or not the words HEALTHY CHOICE were registrable in respect of goods in class 29 of the International Classification, the court stated as follows:

"The reality of modern marketing and buying of food products with emphasis on the health value of foods and the dominance of self selection shopping mean that combining the words HEALTHY and CHOICE could not be regarded as creating any subtle or skilful allusion. Rather it appeals as descriptive of products of desirable nutritional character. As such, without evidence of actual distinctiveness acquired through use it does not have the quality of being capable of distinguishing the goods of the Applicant so as to be registrable."

The conclusion is that on a balance of probabilities, the Opponents have failed in these opposition proceedings under the provisions of the above-mentioned sections 14, 15(1) and 15A of the Trade Marks Act.

2. Do the Applicants have a valid claim to their mark TMA NO 58890 "Nice & Lovely Herbal Oil Moisturizer" (WORDS)? The answer is yes. Taking into consideration all the above-mentioned reasons, I am of the view that the Applicants have a valid and legal claim to the mark "Nice & Lovely Herbal Oil Moisturizer" and have successfully discharged their onus of proving that registration of their said mark will not cause confusion under the provisions of the Act and the same should

proceed to registration. I award the costs of these opposition proceedings to the Applicants.

Eunice Njuguna
Assistant Registrar of Trade Marks

27th Day of September 2010

I certify that this is a true copy of the original.

Eunice Njuguna
Assistant Registrar of Trade Marks

27th Day of September 2010