

THE REPUBLIC OF KENYA

IN THE MATTER OF AN APPLICATION TO EXPUNGE

T.M.A NO. 57546 IN CLASS 21 IN THE NAME OF CASABELLA ASSOCIATES LIMITED

AND EXPUNGEMENT THERETO BY CORNING INCORPORATED.

Hearing conducted on

Counsel for Applicant: Kaplan & Stratton Advocates

Counsel for the Registered Proprietor/Respondent: Simba & Simba Advocates

Before

Assistant Registrar of Trade Marks- Elvine Apiyo

RULING AND DECISION OF THE ASSISTANT REGISTRAR

FACTS OF THE CASE

On 17th June 2005, Casabella Associates Limited hereinafter referred to as the Registered proprietor or respondent filed its Form TM 2 for the trade mark 'PYREX' in class 21 with respect to household and commercial glassware including drinking glasses, bakeware in all materials and all the articles included in class 21 therein.

On 18th July 2005, the respondent herein received a refusal notice from the examiner citing a similar mark already existing in the register with the following particulars:

'T.M.A No. 36500-PYREX in class 21 with respect to small utensils and containers (none of precious metals or coated therewith), cooking utensils, china, glassware, table ware, ovenware, drinkware, porcelain and earth ware all included in class 21 in the name of corning limited and the application was filed on 8th August 1988.'

On 19th June 2006, the respondent herein wrote to the Registrar requesting that its application proceed since the cited mark had been cancelled and removed from the Register for non-payment of renewal fees. The mark was then advertised on 31st October 2006, the Applicant sought extensions for possible opposition and the 1st extension sought was for 60 days that is from 30th December 2006 to 27th February 2007. The Applicant herein thereafter sought a further 30 days extension from 28th February 2007 to 29th March 2007. On 12th April 2007, the Applicant's Advocate wrote to the Registrar stating that its client did not wish to proceed with intended opposition.

T.M.A No.57546 In Class 21 In the Name of Casabella Associates Limited and Expungement Proceedings Thereto by Corning Incorporated.

On 11th May 2007, the mark PYREX was registered in the name of Casabella Associates Limited with effect from 17th June 2005 to 17th June 2015.

On 31st March 2009, Form TM 25 together with a Statement of case was filed by Corning Incorporated hereinafter referred to as the Applicant. The Statement of case raised the following grounds:

1. That the Applicant is the owner of the mark PYREX which is identical to the registered proprietor's mark, used in goods in class 21.
2. That the Applicant's mark has been used extensively and is widely known and has acquired a worldwide reputation for cookware, glassware and other household goods manufactured and sold by the Applicant in various classes worldwide.
3. That on or about the year 1967, the respondent herein was appointed or authorized by the Applicant's licensee, Arc International to distribute and/or sell in Kenya cookware, glassware, kitchenware and other household goods with no formal instrument of appointment executed between the two parties.
4. That in the early part of 2007 the Applicant sought to terminate the appointment or authorization of the respondent but arguments arose between the licensee and the respondent on the terms of termination of the distribution arrangements.
5. That on 17th June 2005, the respondent filed an application for the mark PYREX and the same was registered in its name in class 21.
6. That there was no authorization from the Applicant or the licensee for the respondent to apply and register the mark as its trade mark for goods in class 21.
7. That the respondent contravened Section 20(1) of the Trade Marks Act claiming that it is the genuine and true proprietor of the trade mark PYREX upon submission of its application and hence to that extent the mark was not and is still not entitled to protection in a court of justice under Section 14 of the Trade Marks Act.
8. That its application is contrary to Article 6 *septies* of the Paris convention for the protection of Industrial Property and that the Applicant being a national of the USA is entitled and relies on the protection accorded by the convention.

9. That at the time the respondent was registering the mark it was well aware of the Applicant's mark and its use of the mark on products which the respondent was distributing in Kenya at the time.
10. That the action by the respondent in registering the PYREX mark which is identical to the Applicant's mark was mala fides and constituted unfair competition.
11. That the Applicant is aggrieved with the respondent's registration that bars it from bona fide sales of its products in Kenya despite the fact that it had used the mark for many years prior to the respondent's registration.
12. That the entry of the respondent's mark on the Register and the consequent ability of the respondent to use that mark in class 21 is likely to cause confusion and deception and the entry was effected without sufficient cause.
13. That its existence will prevent the Applicant from registering its trade mark in Kenya and that its registration is likely to impair, interfere with or take unfair advantage of the Applicant's mark which is internationally well known.
14. That the mark should be expunged under Section 35 (1) of the Trade Marks Act.

STATEMENT OF CASE

1. That the Applicant is the true and genuine owner of an identical trade mark PYREX which it has been using for many years on cookware, glassware and other household goods falling in various classes worldwide including class 21.
2. That at the time of filing an application the respondent was engaged in marketing and distribution in Kenya of cookware or kitchenware bearing the Applicant's mark through its licensee for Kenya Arc International.
3. That no authority was sought from the Licensee by the Respondent and therefore the Registration was not bona fide or honest and constituted unfair competition, it was and is still is disentitled protection in a court of justice.
4. That its claim for proprietorship is in contravention of Section 20 of the Trade Marks Act and its continued existence offends and is against Article 6 *septies* of the Paris Convention and Sections 14, 20 and 35 of the Act.

COUNTERSTATEMENT

The Respondent filed its Counter statement on 13th May 2009, in response to Form TM 25 and the Statement of Case filed by the Applicant as follows:

1. That after it conducted a search in the Trade Marks Registry the search revealed that the Applicant's mark had expired on 8th August 1995.
2. That on 8th September 2005 a first renewal notice was sent to the Applicant for it to pay renewal fees but the same was not paid for and therefore a removal notice of the Applicant's mark was published on 31st May 2006.
3. That following the removal of the Applicants mark, the Registrar approved and registered the Respondent's application of 27th May 2005.
4. That on 19th December 2006 the Applicant formally opposed the Respondent's opposition but on 12th April 2007 the Applicant vides its letter indicated that it did not wish to proceed with the opposition and asked the Registrar to proceed to register the trade mark Pyrex in the name of the Respondent.
5. That the Respondent did not contravene section 14 of the Trade Marks Act nor was it obligated to seek authority from the Applicant or its licensee to apply since the mark had been removed from the Register. That in any event there was no relationship between both parties and therefore its application was bona fide and therefore did not constitute unfair competition.
6. That its mark is neither offensive nor likely to impair and/or interfere with or take unfair advantage of the Applicant's mark on the contrary, Article 6(3) supports its continued use.
7. That the Respondent was incorporated in 1994 and has therefore never entered into any agreement with the Applicant's licensee and that is why out of its own admission no proof of such an agreement can be adduced.
8. That since the Respondent has not been an agent of the Applicant or representative or the Applicant or its stated licensee, Article 6 *septies* of the convention does not apply. The question of termination of distributorship therefore does not arise.

9. That the Applicant has concealed several serious and pertinent facts from the Registrar within its knowledge rendering its application dishonest and without merit.
10. That at the time of applying for the mark the Applicant's mark had expired and it negligently failed to renew its mark.
11. That upon its removal the Applicant did nothing and later gave the Respondent an unequivocal, irrevocable and unsolicited approval for the Respondents application to proceed for registration.
12. That therefore the registration be maintained since the applicant surrendered all claims rights and benefits of its earlier trade mark. The relief claimed is baseless, obnoxious, unmerited and frivolous and the application should be dismissed with costs.

THE APPLICANT'S STATUTORY DECLARATION.

The Opponent filed its Statutory Declaration on 28th September 2009 sworn by Mr. Paul Robert Burke, the Intellectual Property Counsel and Manager of Administrative Operation of the Applicant's IP Department. The Statutory Declaration was made in support of the Applicant's application to expunge the Respondent's registered mark PYREX and made the following averments:

1. That the Applicant and its affiliate companies is the Proprietor of the PYREX trade mark in various classes in numerous countries worldwide.(See exhibit "C1").
2. That in Kenya one of the Applicant's affiliated companies, Corning Limited is the registered owner of TM 5370 in old class 15 covering all goods in that class, namely glass products.
3. That Corning limited is owned as to 97% by Corning International Corporation and as to 3% by Corning cable systems limited whereas the latter is 100% owned by Corning International Corporation.
4. That Corning Limited is indirectly owned by the Applicant, Corning Incorporated.
5. That T.M. No 5370 was originally registered in the name of James A. Jobling Company which subsequently changed its name to Corning Limited as per the search results marked 'C2'.

T.M.A No.57546 In Class 21 In the Name of Casabella Associates Limited and Expungement Proceedings Thereto by Corning Incorporated.

6. That the Applicant has extensively used its mark in Kenya for a period of forty years, another registration is T.M 36500 in class 21 under Corning limited the latter was not renewed upon expiry.
7. That the Applicant's licensee has forwarded the Applicant all its records and its predecessors-in-interest's records, including e-mails, statements and other documentary evidence relating to the distribution of PYREX products in Kenya by the Respondent herein as per the attached letter confirming the same marked 'C3'.
8. That the Applicant's licensee entered into a business relationship for distributorship with the family of Sunil Aggarwal.
9. That according to the records Sunil Aggarwal subsequently around 1994 incorporated Casabella Associates Limited, the Respondent herein and which by Sunil Aggarwal's admission, assumed and continued responsibility for distribution of Pyrex products in Kenya.
10. That the email attached and marked 'C5' confirmed that the said, Sunil Aggarwal advised an employee of the Applicant's licensee that correspondence on termination of distributorship arrangement or relationship with the Applicant's licensees should be addressed to Casabella Associates who has been its buyers for many years.
11. That the exhibit marked 'C6' to the Applicant's licensee employee shows the intended termination of the distributorship arrangement for Pyrex branded products since no other formal agreement or instrument of appointment was executed between the Applicant's Licensee and the Respondent.
12. That the e-mail dated 19th February 2007 confirmed that there was no formal contract for supply of Pyrex products and that the Applicant's licensee agreed to give 2 months notice during which the Applicant's licensee would not sell any Pyrex branded products to other company in Kenya.
13. That the MD of the Respondent in his email of 12th May 2007 annexed as Exhibit C8 stated categorically that his family had been marketing Pyrex and corning brands into East Africa for the last 40 years and that he was not going to give up on the brand that easily.

14. That from the exchange of e-mails between Sunil Aggarwal and the Applicant's licensee, the Respondent had conceded to importing and distributing its PYREX branded products in Kenya for over 40 years.
15. That the PYREX trade mark qualifies as a well known mark in terms of the Paris convention.
16. That the respondent's mark is contrary to Sections 14, 15 and 20 of the Trade Marks Act and Article 6 septies of the Paris Convention.
17. That the Applicant admits that it had knowledge of the Respondent's advertised mark in the KIPJ Journal of 31st October 2006 and notified the Respondent of its intention to oppose its application. The Applicant contacted the licensee but did not receive information and hence informed the Registrar that it did not wish to pursue the opposition but this was not a waiver or surrender of the Applicant's right on the mark PYREX.
18. That the refusal by the Respondent to surrender the trade mark is proof that its registration was mala fide, dishonest and intended to give the Respondent unfair advantage in the marketing of products bearing the Pyrex trade mark but not originating from the Applicant.
19. That to prove that the registration is mala fide, dishonest and disentitled protection in a court of law, Sunil's email marked as exhibit 'C8' stated that to capitalize on their efforts, where they thought their principals would forsake them, they register brands so that they are always acknowledged for their efforts. He stated that they had registered over 40 brands in Kenya and East Africa for protection from counterfeits and companies wishing to play dirty on them.
20. That the Respondent further confirmed vide its e-mail of 30th May 2007, that it normally registers brands that it represents to protect themselves from decisions like that of the Applicant's licensee.
21. That the circumstances that led to the Applicant's non-renewals were due to its large portfolio of trade marks all over the world which it routinely files and abandons in the course of business. The abandonment of registration numbers 36500 and 15187 should therefore not be equated with lack of interest in or surrender of all original rights in the PYREX trade mark.

T.M.A No.57546 In Class 21 In the Name of Casabella Associates Limited and Expungement Proceedings Thereto by Corning Incorporated.

22. That the registration of TM No.36500 was due for renewal on 8th August 1995 but the same was not renewed.
23. That on 6th May 1996, the Applicant instructed its then lawyers in Kenya to file two new applications for PYREX in class 9 and 21 and therefore instructed them not to renew T.M. No.36500.
24. That the two applications were to be filed in the name of the Applicant so as to rationalize the holding of the PYREX trade mark within the Applicant's group of companies.
25. That the two applications were filed by its then lawyers Atikson Cleasby and Satchu Advocates and were accorded T.M.A Nos. 44499 and 44500 respectively. That for some reason the advocates did not report the status of the two applications in spite enquiries by the Applicant. See exhibit marked 'C12' and 'C13'.
26. That eventually the Applicant instructed another lawyer to conduct a search where it was found that there was a citation of existing mark TM 15187 in class 21 in the name of James A. Jobling.
27. That had the citation letter been brought to the Applicant's attention the Applicant would have easily overcome the objection because the cited mark was registered in the name of Corning Limited its subsidiary.
28. That the acceptance of the Respondents application without citing the Applicant's mark was irregular and in contravention of section 15 of the Trade Marks Act.
29. That at the time of applying for the trade mark the Respondent was distributing on behalf of the Applicant's licensee in Kenya and therefore non renewal could not justify the unauthorized application to register the offending mark.
30. That the statement by the Respondent that it had no relationship of any kind with either parties was untrue as evidenced by the exchange of emails between Sunil Aggarwal the Respondent's MD and Mathilde Madinan the Applicant's Licensee.

31. That Article 6(a)(3) does not seek to protect an agent or representative who contravenes Article 6 septies by applying to register or registering in the agent's name without the proprietor's authority.

RESPONDENT'S STATUTORY DECLARATION.

The Respondent filed its statutory Declaration on 10th November 2009 and of even date by the sworn evidence of Mr. Sunil K. Aggarwal, the Managing Director of Casabella Associates, the Respondent herein. He deposed as follows:

1. That the Respondent is the legally registered owner of the trade mark PYREX in class 21.
2. That a search conducted by the Respondent in 2005 revealed that at one time the same mark was registered in the name of Corning Incorporated from 8th August 1988 and that that same registration expired on 8th August 1995.
3. That the search further revealed that there was no registration made by Corning Incorporated or by anybody else that is a licensee or agent for the trade mark PYREX in class 21 in Kenya.
4. That on 27th May 2005, the Respondent filed Form TM 2 and was given a Trade mark application number 57546.
5. That on 8th September 2005, the Registrar sent a renewal notice to the Applicant asking it to pay USD 400 within 60 days.
6. That having not heard from the Respondent, the Registrar proceeded and cancelled its trade mark and the same was advertised in the journal of 31st May 2006.
7. That upon approval and advertisement of the Respondent's applied for mark, the Applicant admits that it had notice of the advertisement and it indeed applied for opposition of the mark on 19th December 2006.

T.M.A No.57546 In Class 21 In the Name of Casabella Associates Limited and Expungement Proceedings Thereto by Corning Incorporated.

8. That it is not true that the Applicant did not have enough time for filing the formal notice of opposition since the Applicant was granted extensions for a period over 100 days showing that it was disinterested in the PYREX trade mark.
9. That on 12th April 2007 the Applicant's Advocate wrote to the Registrar stating inter alia that they had instructions from the Applicant that it does not wish to proceed with the opposition and therefore requested the Registrar to proceed with the registration and issue the certificate to the Respondent.
10. That the Applicant is attempting to conceal material facts by omitting the instructions to the Registrar that he should proceed and issue the Respondent with a certificate and further stating that the instructions could not be interpreted to mean that it intended to give up all rights .
11. That the Registrar proceeded to register the Respondent's trade mark on 11th May 2007 and issued a certificate of registration which is valid up to 17th June 2015.
12. That for the Registrar to accept the Applicant's withdrawal of the opposition and allowing the Registrar to proceed to register the Respondent's applied for mark and now stating that it was a mere statement by the advocates, is likely to bring the tenure of the matter and with it the office of the Registrar into considerable disrepute and public ridicule.
13. That the Applicant's filing and abandoning applications at its own will is an abuse of due legal process of the country.
14. That the unsolicited instructions to the Registrar amounts to a waiver of the Applicant's rights to pursue other remedies including removal of the registration of the trade mark in question.
15. That the Respondent did not contravene Section 14 or any other sections of the Trade marks Act because at the time it applied for the registration the records showed that the Applicant's mark had expired therefore there was no need to apply to the Applicant or its licensee for authorization since there was no valid ownership.
16. That there had never existed any distributorship agreement between the Respondent and the Applicant's licensees.

17. That Article 6(3) of the Paris Convention supports the unhindered use of the mark.
18. That the deponent ,Mr. Sunil authored several e-mail communications to Arc international, the Applicant's licensee with a view to establish formal modalities of selling Pyrex products in Kenya and those proposals were rejected by the Respondent.
19. That there had never been any distributorship agreement between the Respondent and the Applicant or its licensee the question of termination of agreement therefore does not arise.
20. That the Applicant's application as presented in Form TM 25 and in the statement of case concealed several serious and pertinent facts, that is, the fact that they stated that they had no intention of opposing the Opponent's application and allowed the application to proceed to registration, which in effect renders its expungement application dishonest and without merit.
21. That the Respondent did not issue any threats to the Applicant's licensee or agent but intended to convey the message that any party who would act contrary to the law and proceeded to sell its products without the Respondents permission would suffer the consequences.
22. That after a lapse of 12 years from the date of expiry of its mark the Applicant now woke up to the reality that it had lost its mark and then decided to oppose the mark ,abandon it and then apply for its expungement.
23. That for the reasons stated by the Respondent the registration of its mark should be retained in the Register and the Respondent be accorded full protection as under the Kenyan and any applicable international law.
24. That the Applicant only sold goods worth USD 55,588.00 over a period of 5 years, very relatively low sales that cannot be construed to pose any injury to their worldwide market dominance. The Applicant therefore does not by virtue of the sales enjoy extensive rights and reputation which are well known.
25. That neither the deponent nor the Respondent has ever dealt in products falling under the subject trade mark in Kenya for the entire period of validity of registration of the mark in the name of the Applicant.

T.M.A No.57546 In Class 21 In the Name of Casabella Associates Limited and Expungement Proceedings Thereto by Corning Incorporated.

26. That the relief claimed by the Applicant for expungement is unmerited, baseless, obnoxious, frivolous and an afterthought, the same should be dismissed with costs. The Respondent further prays that based on the lucid explanations in the Applicants statutory declaration, the Registrar has been provided with sufficient grounds to justify summary dismissal of the application without a hearing.
27. That except as contained in its statutory declaration, the Respondent denies and dismisses every allegation contained in the applicant's statutory declaration.

APPLICANT'S STATUTORY DECLARATION

The Applicant filed its statutory Declaration on 10th March 2010 sworn by Paul Robert burke of painted post, New York, United States of America in response to the Respondent's declaration dated 10th November 2009 and deponed as follows:

1. That the Applicant denies that it withheld important information in its first statutory declaration the Applicant was not advised by its advocates on record then that its application was still subsisting and was in the process of prosecution before the Registrar of Trade Marks.
2. That at the time the Respondent was applying for the trade mark in question, the trade mark PYREX was and still is the registered proprietor of the trade mark Number 5370 in class 15 now reclassified in class 21 in the name of Corning Limited.
3. That the statement made by the Applicant's advocate did not amount to surrender of the Applicant's right because there were no negotiations between the Opponent and the Applicant which led to the issuing of the letter, the letter was addressed to the Registrar and not copied to the Respondent, the Registrar has a duty to protect the public from deception in the course of registering trade marks and that the statement dose not in any way preclude the Registrar from considering the circumstances leading to the application and registration of T.M. No. 57546 or discharging his duty to protect the public from deception and confusion.
4. That the Applicant continues to market its trade mark in Kenya as per exhibit marked C21 ,receipt for purchase of glass manufactured by the licensee of the Applicant therefore since the Respondent is capable of distributing similar glass

or houseware products for marketing in the Kenyan market this would give rise to confusion and deception to the public.

5. That the Applicant's mark is a well known mark all over the world and arising from the fact that the products are high quality they enjoy extensive goodwill and reputation in the market place and have become collector's items. (See the collectors guide marked C22).
6. That in the Webster's Ninth new Collegiate Dictionary and Webster's New World college dictionary(4th Edition), PYREX is defined as a trade mark used in glass and glassware that contains appreciable oxide of boron and is resistant to heat ,chemicals and electricity. The Applicant is the proprietor of PYREX in many countries where the products are manufactured or marketed.
7. That a bundle of certificates and renewals in many countries all over the world are annexed.
8. That the statement by the Respondent that there has never been any distributorship arrangements is clearly not supported by the contents of the e-mails exchanged between Mr. Sunil and the licensee's agent including that attached by the Respondent and that it is not necessary to prove existence of formal distributorship arrangement since neither the Paris convention nor the trade marks Act requires the existence of such an agreement as a condition for reliance upon Article 6 septies of the Paris convention.
9. That the statement in the Para 29 of the Respondent's declaration does not refute the existence of a formal distributorship arrangement.
10. That there was no requirement for Arc International to register as a licensee or as a registered user since it was merely an agent marketing the Applicant's products.
11. That the Applicant did not disclose any pertinent facts from the Registrar and failure to pursue the opposition proceedings did not preclude it from filing these expungement proceedings and equally does not affect the Registrar's duty to consider whether the continued registration of the Respondents mark offends the law and is harmful to the public interest.

T.M.A No.57546 In Class 21 In the Name of Casabella Associates Limited and Expungement Proceedings Thereto by Corning Incorporated.

12. That the registration by the Respondent of the PYREX mark was done in bad faith and intended to intimidate the Applicant following its decision to terminate their sale and distribution arrangements.
13. That the threats given by the Respondent in respect to registering trade marks in its own name but not belonging to it was indeed sinister since it had registered various listed marks in Kenya not belonging to it.
14. That the Applicant remains the common law owner of the trade mark PYREX ,the registered proprietor of the trade mark PYREX, T.M 5370 in Kenya and the proprietor of many trade mark registrations all over the world.
15. That the continued existence of the two marks will cause confusion and deception to the public.
16. That the Respondent as a former agent cannot appropriate itself the Applicant's trade mark on the ground that it does not consider the volume of sales achieved to be sufficient to cause injury to the Applicant.
17. That there is nothing unique or detrimental in the Applicant's management of its portfolio of trade marks.
18. That upon denying its agent relationship the Respondent should have given specific and proper explanations of the statements it made in the various e-mails exchanged.

THE RESPONDENT'S FURTHER STATUTORY DECLARATION:

The response to the further declaration was mainly to clarify issues raised in the Applicant's statutory Declaration dated 2nd march 2010. This declaration was made by Sunil K Aggarwal on behalf of the Respondent and it was filed on 7th May 2010. He deposed as follows:

1. That the failure on the part of the Applicant to act by the Applicant on the various applications it lodged with the Registrar must not be allowed to be used by the Applicant to camouflage that it deliberately and negligently failed to use the statutory channels open to it thus now showing bad faith and clear attempt to conceal material facts.

2. That the surrender of the trade mark by the Applicant was unequivocal, unsolicited and did not require any negotiations to suggest that would expose the legal process to total and complete ridicule.
3. That the cardinal issue is that legal and procedural removal of the Applicant's mark and the subsequent valid registration of T.M. No 57546 in class 21.
4. That the foreign registrations are not pertinent to this case which deals with the registration in Kenya only and that the PYREX brand is not well known in Kenya.
5. That neither the deponent nor the Respondent was a distributor of the Applicant, its subsidiaries, agents and associates their relationship was on cash purchases.
6. That the Respondent has appropriately interpreted Article 6(a) 3 of the Paris Convention.
7. That the registrations made by the Respondent are part of normal business practice after complying with the due legal process in Kenya and has not interfered with any other organization outside Kenya.
8. That looking at the Applicant's multiple trade mark registrations in Kenya, the same are intended to cause unnecessary confusion and that one is left wondering why the Applicant finds it necessary to register one trade mark so many times for the same product.

APPLICANT'S THIRD SATUTORY DECLARATION:

The Applicant filed its reply to the Respondent's response on 8th July 2101 and the same was made on its behalf by Paul Robert Burke. He deponed as follows:

1. That the Applicant's 2nd declaration did not bring any contradictions or confusion relating to the issues in question.
2. That none of the alleged failures of the Applicant gives the Opponent the right to claim ownership and seek registration for a trade mark that did not belong to it and in respect of which it had full knowledge of the Applicant's ownership.

T.M.A No.57546 In Class 21 In the Name of Casabella Associates Limited and Expungement Proceedings Thereto by Corning Incorporated.

3. That T.MA 57546 does not qualify for the protection conferred by Section 16(1) of the Trade Marks Act in respect of marks which have been registered for 7 years or more.
4. That at the point of registration the Respondent knew its claim for ownership was false, wrongful and *mala fides* the Respondent can therefore not use the Applicant's non-pursuance of the opposition proceedings to justify its wrongful and unlawful action of claiming ownership of the PYREX mark.
5. That on well knowness though it brand does not enjoy the status of safaricom or coca cola the Respondent admitted that it had sold the brand for 40 years, the issue therefore was still knowledge of the Applicant's ownership.
6. That Article 6(a)3 means that once registered in a country of the union a trade mark remains independent and is unaffected by the fate of similar registrations in other countries including the country of origin.
7. That the other registrations filed by the Respondent with respect to marks belonging to other parties is admissible by virtue of Section 15 of the Evidence Act.

THE APPLICANT'S WRITTEN SUBMISSIONS:

The Applicant filed its written submissions on 13th June 2012 together with the list of authorities. The Applicant's Counsel submitted that the pertinent issues to be determined in these expungement proceedings were:

1. Whether as per Article 6 *septies* of the Paris Convention the Respondent including the family of the Respondent's Managing Director was an agent or representative of the Applicant for the purposes of distributing products originating and bearing the trade mark PYREX.
2. Whether on the material date and in terms of the Paris Convention, the Applicant was the true and genuine owner of the trade mark PYREX in Kenya and worldwide.
3. If 1, 2 above are in the affirmative, whether the agent was given authorization to register PYREX in its own name.
4. Whether the Applicant's inability to pursue the intended opposition against the registration of the Respondent's alleged mark precludes the Applicant to

institute these removal proceedings under section 35 and Article 6 septies of the Paris convention.

5. Whether the letter dated 27th April 2007 addressed to the Registrar by the Applicant's advocates stating inter alia that the Registrar proceed to register and issue a certificate of registration to the Respondent constituted a surrender by the Applicant of all claims, rights and benefits relating to or arising from the trade mark PYREX in Kenya.
6. Whether the Respondent's trade mark registration contravened the prohibition contained in section 15 of the trade marks Act in as far as the Applicant's trade mark TMA 5370 in class 15 now reclassified to class 21 still subsists in the Register.

The Applicant Counsel relied on the issues raised and reiterated what was stated in the three statutory Declarations of Paul Robert Burke. The Applicant submitted that the content of the e-mails adduced as evidence attested to the fact that there was existence of a long standing business relationship between the Applicant and the Opponent. He further submitted that the Respondent was aware of the Applicant's ownership of the trade mark PYREX in Kenya and worldwide. Article 6 septies was therefore submitted to be relevant and that no authorization for registration of the mark in Kenya was granted by the Applicant and in any event it ought to have been sought from the Applicant.

The Applicant further submitted that it was the true and genuine owner of the trade mark PYREX based on several other registrations with respect to the same mark in the Kenyan register that is TMA 5370,15187,44499and 44500 in class 15(reclassified to 21),class 21,class 9 and class 21 respectively. In addition to the Kenyan registration the Applicant submitted that it was the registered proprietor of the same mark in different jurisdictions as annexed in its exhibit C24.HE concluded that the non-renewal of T.M. 36500 in class 21 did not constitute evidence that Applicant had abandoned its rights to the PYREX trade mark.

He submitted that the inability of proceeding with the Opposition proceedings as per section 16(1) of the Trade Marks Act that stipulates that a registered trade mark shall be taken to be valid after the expiration of 7 years from the date of that registration unless,

- a) The registration was obtained by fraud; or
- b) The trade mark offends against section 14.

T.M.A No.57546 In Class 21 In the Name of Casabella Associates Limited and Expungement Proceedings Thereto by Corning Incorporated.

He further submitted that section 35 also allows for removal of marks wrongly remaining in the register. He submitted that he letter written by it's advocates dated 27th April 2007.

The Applicant therefore invited the Registrar to find that on the material date, the Respondent had no authority from the Applicant to apply for registration of the trade mark PYREX in class 21 as this is an entry wrongly remaining in the register and liable to cancelation pursuant to Article 6 septies of the Paris Convention and contravenes Section 15 .The same be removed under section 35(1) of the Act and Article 6 septies of the Paris Convention.

OPPONENT'S WRITTEN SUBMISSIONS:

The opponent filed its written submissions together with the list of authorities on 9th July 2012 reiterating all that was filed in its counterstatement and statutory declarations.

The respondent framed the following issues that were to be determined by the Registrar:

1. Whether in terms of Article 6 *septies* of the Paris convention, the Respondent was an agent or representative of the Applicant in Kenya.
2. Whether the Respondent is the true and genuine owner of the trade mark PYREX.
3. Whether the Respondent obtained the Applicant's authorization to register the trade mark in its own name.
4. Whether the Respondent was justified under Article 6 *septies* of the PARIS Convention to register the trade mark PYREX in class 21.
5. Whether the Applicant is justified in instituting expungement proceeding after abandoning opposition proceeding and the letter consenting to the Respondent's application to proceed to registration.
6. Whether the Applicant has acted in bad faith.

The Respondent submitted that despite the witty attempts by the Applicant to subsume the existence of an agency distributorship agreement and not having reduced the same to a formal contractual relationship, the respondent was not its agent but its relationship was based on buyer purchaser terms.

The Respondent submits that it was not necessary to seek the Applicant's authority because it carried out a pre-registration search which revealed the expiry of the Applicant's mark and since there was no agency relationship, authorization was not necessary.

He further submitted that the letter dated 12th April 2007, expressly authorized the Registrar to proceed with the registration with the full knowledge of the existence of the other marks that were removed. He reiterated that it was immaterial how long the mark had stayed in the Register once it was removed it remained available for other interested users. He submitted that the Applicant's disinterest was illustrated by it not pursuing the opposition proceedings and it has similarly not demonstrated use or even promotion of the said trade mark in Kenya.

That should the Applicant be found to be the true and genuine owner, section 15(2) of the Trade Marks Act should be invoked. That Article 6(3) of the Paris Convention specifically supports the Respondent's unhindered use of the mark PYREX. He submitted that he had no knowledge that Arc International was a licensee or registered user of PYREX in Kenya .He reiterated that marks were territorial and that it did not matter whether the Applicant had similar registrations elsewhere in the world. He relied on the Victoria Secret Inc-Vs Edgars Stores Ltd Case on territoriality of marks.

That the Applicant had not produced evidence to support its claim that the Pyrex mark was well known in Kenya As per section 15A of the Trade Marks Act He submitted that the mark is not well known in Kenya.

He submitted that in the case of Give Me five and 7 heaven it was held that unless there was a clear intent to ride on the back of an established reputation the adoption of a mark which is merely similar unlikely to warrant an allegation of bad faith.

He submitted that the application was a mere afterthought devoid of any merit and should not be entertained by the Registrar as it amounted to abuse of the process .He concluded that the Registrar should award costs to the Respondent currently held in the joint names of the Advocates and the interest thereon.

ISSUES TO BE DETERMINED BY THE ASSISTANT REGISTRAR:

I have singled out the following issues as key in determining whether or not the Respondent's mark wrongly remains in the Register as per the provisions of Section 35 of the Trade Marks Act.

1. Who is the owner of the mark PYREX?
2. Whether the Applicant's Advocate letter dated 27th April 2007, amounts to a surrender of its mark to the Respondent and a subsequent bar to seek removal of the same?
3. Can the two marks co-exist under Section 15(2) of the Trade Marks Act?

Who is the Owner of the trade mark PYREX?

Section 20 of the trade marks stipulates that:

'a person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it shall apply in writing to the Registrar in the prescribed manner.....'

It is clear from the pleadings filed that both parties are alleging that they are the owners of the mark PYREX. Section 20 of the Trade marks Act above quoted allows any person being the Proprietor or owner of a trade mark that is already being used or proposed to be used, to register the same in the prescribed manner.

The Applicant herein alleges that it is the true and genuine owner of the trade mark PYREX by virtue of its earlier registrations in respect of the same mark. The Respondent on the other hand argues that the Applicant did not renew one of its marks that were cited against the Respondent's application, allowed it to proceed to registration after an attempt to oppose it and therefore by virtue of the opposition withdrawal, the Respondent is the rightful owner of the trade mark PYREX.

A trade mark is defined as a sign that individualizes goods of a given enterprise and distinguishes them from the goods of its competitors, this is defined in the WIPO Intellectual Property Handbook, Policy Law and Use at page 68.

It is often defined generally as a badge of origin that distinguishes the goods of one undertaking from that of another. The primary function of trade marks is therefore to protect the source or origin with respect to avoidance of confusion by the purchasing public.

It is to be noted that the purchasing public may identify the source as a manufacturer, owner or licensee, the underlying and vital factor is that the purchaser should not be confused or likely to be confused thinking that the products or services are from a particular undertaking whereas they are not. It is vital therefore to ensure that the public is not confused as to the source or origin of the PYREX mark with respect to goods it is applied.

This then takes me to the question, who may register a trade mark? Section 20 of the Trade Marks Act specifically refers to the proprietor, meaning the owner of the mark. Ownership may be assigned or licensed but such registrations must be done under the authority of the registered proprietor.

In Kenya, registered and unregistered marks are protected .Registration is therefore *prima facie* proof that the entity registering is the owner of a trade mark unless

evidence to the contrary is adduced, however unregistered marks are still protected against the common law tort of passing off under Sections 5 and 10 of the Trade Marks Act. The key consequence of registration of a trade mark is the exclusivity it gives the registered proprietor to exclude all others from using its mark. Section 31 of the Trade Marks Act stipulates that the permitted use of a trade mark shall be deemed to be use by the proprietor thereof and shall be deemed not to be use by a person other than the proprietor for purposes of Section 29 and for any other purpose for which use is material under this Act or at common law. (emphasis mine).

The Respondent herein has vehemently denied that there was any form of agency relationship between itself and the Applicant. Article 6 *septies* of the Paris Convention is to the effect that:

‘ (1) if the agent or representative of the person who is the proprietor of a mark in one of the countries of the union applies, without such proprietor’s authorization, for the registration of the mark in his own name, in one or more countries of the union, the proprietor, shall be entitled to oppose the registration applied for or demand its cancellation or, if the law of the country so allows, the assignment in his favour of the said registration ,unless such agent or representative justifies his action.

(2) The proprietor of the mark shall, subject to the provisions of paragraph 1, above, be entitled to oppose the use of his mark by his agent or representative if he has not authorized such use.

(3) Domestic legislation may provide an equitable time limit within which the proprietor of a mark must exercise the rights provided for in this article.”

The Applicant has produced several emails exchanged by its agent and the Respondent with respect to the mark PYREX that impliedly show that there was some form of agency relationship between the two companies. The Respondent has not denied the contents of the emails but rather denied and qualified the statements therein.

The fact that the Respondent filed its trade mark application in Kenya before removal of the Applicant’s mark cannot be ignored. I note that the Applicant still has a subsisting registration T.M. No. 5370 with respect to the mark PYREX until 31st March 2018 in class 15 with respect to all goods in class 15 in the name of Corning Limited.T.M.No.5370 has been in effect since 31st March 1952.

‘Provided, however that the claim of proprietorship is made in good faith, and is not rebuttable on the ground that in fact someone else was the proprietor. In the case of Quiet May T .M [1967] F.S.R 27 at P.38 the Registrar expunged the mark, inter alia, on the grounds that although the application had been made in good faith, in fact

T.M.A No.57546 In Class 21 In the Name of Casabella Associates Limited and Expungement Proceedings Thereto by Corning Incorporated.

the claim to proprietorship was wrong because the applicant for rectification was, by reason of his prior use, the proprietor.'

The above case cited further compounds the importance of a person claiming proprietorship and even though such claim is made in good faith it may be rebuttable due to prior use. The same applies in this matter by the very reason that the Applicant for expungement was in the register earlier and no application for removal on the basis of non-use had been applied for under Section 29 of the Trade Marks Act.

It is further stated in Para 4-03 of Kerly's Law of Trade Marks, the 10th Edition that:

"the forms of application contain an assertion of the claim by the applicant in the same terms as the section; and if an applicant is aware that there is another party who ought to be registered, the assertion may be regarded as a deliberate attempt to deceive the Registrar which would amount to fraud such as to prevent a registration in part A from becoming conclusive after seven years.

Following the above dicta by virtue of the Applicant for expungement having registered its mark way before the Respondent clearly attests to the fact that by reason of prior use he was the proprietor as required under section 20 of the Trade Marks Act. The subsisting registration has been renewed since 1966 to date until 2018.

I find that by virtue of the foregoing, and the evidence adduced before me, the Respondent is not the owner of the trade mark PYREX and any ownership that it may claim must derive or has been acquired by the Respondent through the Applicant. Article 6(3) of the Paris Convention does not therefore apply in this case in as far as ownership is concerned it just reinstates the principle of territoriality of trade marks.

On the issue of who owns the PYREX mark? I find that the same belongs to the Applicant.

Whether the Applicant's Advocate letter dated 27th April 2007 amounts to a surrender of its mark to the Respondent and a subsequent bar to seek removal of the same?

The Applicant's Advocate vides its letter dated 27th April 2007 wrote to the Registrar stating as follows:

'we have client's instructions that it does not wish to proceed with the opposition. In the circumstances please proceed to register the above trade mark 57546 "PYREX"(word) class 21 and issue the registration certificate to the applicant'

What is the implication of the statements contained in the said letter? Would it amount to surrender of the Applicant's mark and an implied authorization that the Respondent proceed to register the mark in its name?

Section 36A stipulates that: 'a proprietor may surrender a registered trade mark in respect of some or all of the goods or services for which it is registered.

The first part of the Applicant's Advocates letter states that the Applicant did not wish to proceed with the opposition, the second part of the statement can be construed to mean that as a result of not proceeding with the opposition the Registrar was to go ahead and register the mark and issue the certificate to the applicant for registration, the Respondent herein.

The question before me is, had the Applicant for expungement acquiesced or surrendered its rights over the trade mark PYREX? Section 36B stipulates that:

"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, on 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.

The Registrar at the onset was advised to proceed with registration of the mark by the earlier right holder and did so, but it has later been brought before the Registrar through these expungement proceedings that the said registration by the Respondent was not done in good faith. Does the law allow the Applicant to now come back and institute expungement proceedings after withdrawing the opposition proceedings?

On this point, I do agree with the Respondent's submissions that this amounts to abuse of the process on the one hand withdrawing opposition proceedings and on the other instituting expungement proceedings.

However as per Section 36B as quoted above it is clear that for the Applicant to be barred from seeking invalidation a continuous period of five years in the use of its mark should have lapsed. In this case, the Respondent's mark was registered as from 17th June 2005 as this was the filing date, the Applicant withdrew its opposition on 27th April 2007 and filed the expungement on 31st March 2009. It took the Applicant about two years after withdrawal of the opposition which does not bar it from

T.M.A No.57546 In Class 21 In the Name of Casabella Associates Limited and Expungement Proceedings Thereto by Corning Incorporated.

expunging as a result of acquiescence, this is further reinstated at Section 16 of the Trade Marks Act.

I find that the Applicant did not acquiesce its earlier right to the Respondent because it still has a subsisting registration in its name with respect to the same mark PYREX T.M.5370 and did not surrender its rights by virtue of withdrawing the opposition with respect to one registration. Furthermore, Section 35 f the Trade Marks Act does not give a time frame as to when an application for expungement should be made.

I find that if it was indeed the Applicant's intention to surrender its rights of the trade mark PYREX, then it should also have abandoned T.M.No. 5370 that is also in its name with respect to the same mark and the same goods.

Can the two marks co-exist under Section 15(2) of the Trade Marks Act?

The Respondent has the trade mark PYREX registered in class 21 and the Applicant has one of its marks PYREX T.M.No. 5370 subsisting in the Register in class 15. Goods in Class 15 were in the second schedule and were later reclassified to Class 21 currently in the 10th Edition of the Nice Classification. The effect of this is that two trade marks have been in the register with respect to identical marks and identical goods.

Section 15(1) of the Trade Marks Act prohibits the registration of trade marks that are similar or identical with respect to the same description of goods or identical goods. Section 15(2) however may allow similar or identical marks to co-exist if there has been honest concurrent use of the same.

I do not see any honesty in the use of the trade mark PYREX by the Respondent but rather an attempt by a 'purchaser' as he describes himself curtailing the owner of his mark from dealing in his own goods in the Kenyan market. From the e-mail of 12th May 2007 marked exhibit 'C8', the Respondent states that:

'it has been our policy to capitalize on all our efforts where we think our principals may forsake us. Also we have a policy to register brands as a result due to this so that we are always acknowledged for our efforts. PYREX is no exception. We have 40 brands registered in Kenya /East Africa for protection from counterfeits and companies who wish to play dirty on us.....these brands are not for sale'

Indeed the Respondent routinely registers marks that belong to several of its principals and bar them from terminating any distributorship contract or arrangement so that they do not terminate or give any other distributor or registered user to act on their behalf. The list produced by the Applicant and a perusal of the Register with respect to the same substantiates the same and confirms the statement of the other registered 40 brands in the e-mail above. This list was perused only as proof of such

bar used as a safeguard by the Respondent, since the listed marks are not before me and therefore the details of the same was not entered into so as to ensure I do not delve into extraneous matters.

The Registrar must guard against such blatant, malicious and devious practices by agents, distributors, licensees or those so authorized to sell on behalf of the proprietor of a mark and protect the public as a matter of public policy.

At the point of application only one mark was cited yet the Applicant had several marks similarly registered in the name of the Applicant, this could have happened because of the fact that goods in class 15 have now been reclassified to class 21. At the time of registration the Respondent's mark, T.M No. 5370 did not and had not been brought to the attention of the Registrar since it was not cited during examination and this is why opposition and expungement proceedings are available avenues to resolve such matters that may have not been considered by the Registrar.

In view of the foregoing, I find that both marks cannot co-exist in the Register as per Section 15(2) of the Trade Marks Act.

ASSISTANT REGISTRAR'S DECISION.

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

1. That the Respondent Casabella Associates Limited trade mark registration T.M.A 57546, 'PYREX' in class 21 be and is hereby expunged from the register.
2. That the money deposited by the Applicant as security for costs in a joint account in the names of both Advocates and any interest accrued thereon be returned to the Applicant.
3. That the Respondent shall bear the cost of these expungement proceedings.

Dated this 28 day of July 2013.


Elvine Apiyo

ASSISTANT REGISTRAR OF TRADE MARKS.

