

REPUBLIC OF KENYA

THE KENYA INDUSTRIAL PROPERTY INSTITUTE

IN THE MATTER OF T.M.A NUMBER 60347

IN THE NAME OF M.A PANDIT & CO.LIMITED

AND OPPOSITION THERETO BY EXCEL CHEMICALS LIMITED.

CORAM:

Mr.Samuel Wainana of Kaplan & Stratton Advocates for Excel Chemicals Limited.

Mr.Sanjeev Khagram for M.A.Pandit & Co.Limited

Ms.Elvine Apiyo,Assistant Registrar of Trade Marks.

BACKGROUND FACTS:

M.A Pandit and Company Limited hereinafter referred to as the 'Applicant' filed Form TM 2 on 15th December 2006, for the Trade Mark RAHA Tea in class 30 with respect to tea. On 2nd January 2007, the Applicant received a refusal notice indicating that the mark is similar to another mark existing in the Register, RAHA in the name of Excel Chemicals Limited.

On 17th January 2007, the Applicant vides its letter dated 9th January 2007 objected to the said refusal notice giving the following grounds:

1. That the applied for image has a distinct kettle.
2. That the applied for mark has a distinct map of Kenya.

3. That the border pattern is a pronounced zigzag.
4. That the applied for mark is a totally different product to what we believe has been registered as RAHA under the same class for cocoa powder and drinking chocolate.
5. That under Sections 14 and 15 of the Trade Marks Act the proposed trade mark and the registered mark are distinct from one another and can co-exist.
6. That the Applicant has been using the applied for mark in good faith and such prior user should be accorded legal recognition through registration.
7. That the Applicant requests the Registrar to advertise its mark even without acceptance and any opposition hearings will clarify any outstanding issues.

On 13th February 2007, the Registrar then allowed the mark to proceed to advertisement without acceptance. On 7th March 2007, the Opponent filed its notice of opposition giving the ground that the Opponent's are the registered owners of the trade mark RAHA T.M.A No. 51981.

On 6th June 2007, the Applicant filed its counter statement in support of its application giving the following grounds:

1. That the applied for mark has distinct features, i.e the image of the kettle, map of Kenya and the zig-zag border pattern.
2. That the Opponent's mark RAHA is registered for cocoa powder and drinking chocolate products entirely different from the Applicant's intended use for tea.
3. That the Opponent's cannot have proprietary rights over the word RAHA which is a Kiswahili dictionary word.
4. That the applied for trade mark is distinct from the registered trade mark within the meaning of Sections 14 and 15 of the Act and both marks can co-exist without any risk of the Applicant's mark being likely to deceive or cause any confusion in the course of trade so as to cause injury or prejudice to the proprietor or registered user of the mark registered, nor is the mark as presented for registration, likely to be taken as importing a reference to the Opponent.
5. That the Opponent has been using the mark in good faith for well over four years now and such prior user ought to be granted legal recognition through registration.

The Opponent through Mr.Suresh Shah filed its Statutory Declaration on 31st August 2007, averring as follows:

1. That the Opponent is the registered proprietor of the trade mark application number 51981'raha' in class 30 in respect of cocoa powder and drinking chocolate.
2. That the Opponent mark was subsequently altered from the plain letters of the word RAHA to a stylized form as per the certificate of alteration dated 30th August 2005.
3. That the Opponent has extensively used its mark on its products since the year 2002 in Kenya as set out in the annexure marked SS3.
4. That in addition to use, the Opponent has extensively advertised and promoted its products. figures range from 500,000 to 1.6M for television advertisements and 180,000/- to 957,000/- for push girls between the years 2004 to 2006 respectively.
5. That as a result of extensive sales and promotion of products bearing the opponents' mark, its mark has become synonymous with products originating from the opponent.
6. That the applied for mark is phonetically and visually so close to the Opponent's mark as to be likely to cause deception and confusion to the public mainly enhanced due to the fact that the goods covered are the same or of the same description.
7. That by reason of its likelihood to deceive or cause confusion, the Applicant's mark is by virtue of section 14 of the Act disentitled protection in a court of justice.
8. That in comparing trade marks one of the principal considerations is the idea of the mark, although the Applicant has added the image of a kettle, map of Kenya and a zig-zag border pattern, the main idea conveyed is the word RAHA.
9. That in comparing both device marks the leading characteristics or essential features or particulars is the word RAHA.

10. That the contention by the Applicant in its Counter Statement that tea is different from cocoa powder and drinking chocolate covered by the Opponent's mark is incorrect because cocoa and tea products fall under the same international classification of goods, are by nature used to prepare beverages or drinks for human consumption and are sold through the same trade channels or outlets.
11. That the goods covered by both marks are the same goods or description of goods and therefore registration of the applied for mark is prohibited under Section 15(1) of the Act.
12. That an attempt by a different Applicant, Royal Tea Limited to register its trade mark 'RAHA TEA' device in class 30 was refused based on the existence of The Opponent's mark.
13. That by virtue of a different entity applying for registration of the mark RAHA tea, the claim of proprietorship is incorrect, wrongful, misleading in view of the earlier claim and on that ground alone does not qualify to be registered.
14. That the opponent denies any use of the Applicant's mark in good faith as alleged, any such good faith use should have been preceded by a search at the registry which would have revealed the existence of the Opponent's mark.

APPLICANT'S STATUTORY DECLARATION:

The Applicant herein filed its statutory Declaration sworn by Sanjay Pandit and filed on 28th January 2008. He averred as follows in support of the Applicant's application:

1. That Royal Tea Limited and the Applicant are sister concerns sharing common directors and shareholders. That soon after lodging the application for registration of the mark, Royal Tea Limited assigned the mark to the applicant.
2. That the Registrar of Trade marks acted in bad faith by giving a citation of the mark FURAHA by a different proprietor and after removing the same from the register thereafter informing the Applicant of the Opponent's mark.

3. That from the foregoing, reservation of name was made first in time by the Applicant and therefore use of the mark is not a coincidence.
4. That the Applicant has used its mark RAHA tea for well over four years without the Opponent's objection since the date of filing of the counterstatement, it can therefore not be said that the Opponent's mark is synonymous with products from the Applicant; in any event the mark has since been altered.
5. That marks can co-exist in the same class provided they are distinct in features. The use of the word RAHA, a Kiswahili dictionary word cannot give the Opponent any exclusivity as it cannot have any proprietary right thereto.
6. That exclusivity can only be imposed for the complete mark having regard to all its distinctive features, colour and design but cannot be applied selectively to only parts of such marks.
7. That the marks as compared are distinctively different and are not phonetically or visually so close as to cause confusion or deception to the public. The colours are totally different with distinct features.
8. THAT the only leading feature or characteristic in question is not the word RAHA. In fact the application for registration of the word RAHA TEA was made prior to the Opponent.
9. That tea is not the same good or description of goods as cocoa powder or drinking chocolate simply because they fall in the same class of goods. Section 15(1) therefore does not prohibit registration of the applied for mark and that the marks do not closely resemble.
10. That the Applicant prays that the opponent's opposition is dismissed with costs as it is baseless and misconceived.

THE OPPONENT'S FURTHER STATUTORY DECLARATION:

The Opponent filed a further statutory declaration on 15th May 2008 in response to the issues raised by the Applicant in its Statutory Declaration. The following was averred by Suresh Shah on behalf of the Opponent:

1. That the Opponent was not a party to the exchange of correspondence between the Registrar of Trade Marks and the firm of

Messrs A.B. Patel and Patel, Advocates and is therefore a stranger to the allegations of bad faith on the part of the Registrar.

2. That the proper cause of action for the Applicant would have been to appeal against the Registrar's rejection of T.M.A No. 54120 "KENYA RAHA TEA" upon receiving notification to that effect from the Registrar.
3. That the Applicant's subsequent application to register T.M.A No. 060347 "RAHA TEA" following the earlier rejection by the Registrar to register T.M.A No. 54120, "KENYA RAHA TEA" was an attempt to undermine the Opponent's mark RAHA.
4. That the Applicant had ample opportunity to oppose the registration of the Opponent mark when the acceptance of the relevant application was advertised in the Kenya Gazette and a period of sixty (60) days allowed for doing so, but did not.
5. That the introduction by the Applicant in these proceedings of matters relating to the rejection of T.M.A No. 54120 by the Registrar way back in 2003 appears like a belated attempt to appeal against such rejection well out of time.
6. That neither the Act nor the Rules contain a provision for 'reservation of name' as alleged by the Applicant.
7. That the Opponent denies any knowledge of the usage of the Applicant's mark and further averred that the alteration of the mark did not substantially affect the identity of the mark.
8. That cocoa and tea are the same goods or description of goods as tea, the registration of the applied for mark is therefore prohibited under Section 15(1) of the Act.
9. That the word RAHA is distinctive based on the fact that it has no direct reference to the goods, the fact that the word RAHA is defined in a Kiswahili dictionary has no relevance as to descriptiveness. Further it is not open to the Applicant by way of these proceedings to challenge distinctiveness of the Opponent's mark.

10. That the issue of the alleged Registrar's conduct of bad faith in relation to the earlier application is an attempt to appeal at a very late stage and has no relevance to these proceedings.

APPLICANT'S ORAL SUBMISSIONS.

The matter was then fixed for hearing on 27th October 2009 and parties appeared before the Assistant Registrar. The Opponent made the following submissions:

1. That the mark was altered and a device added to it but principally its mark comprises of the word RAHA and is registered in class 30.
2. That the Applicant similarly attempted to register RAHA tea in class 30 as advertised in the journal of 28th February 2007.
3. That the burden of proof is on the Applicant to satisfy the Registrar that the mark is not reasonably likely to deceive or cause confusion. This was stated in *Re an application by Bourjouis* (1964) EA 265. On the same point he submitted that if the Registrar has doubt on the likelihood of confusion the registration is to be refused.
4. That the onus of proof does not shift at all as was determined in *Enno Vs Dunn* [1893] 10 RPC and in *Kerly's law of trade marks and trade names*.
5. That the registration of the Applicant's mark offends the provisions of Section 15(1) of the Act and shall cause a likelihood confusion and deception to members of the public as was authoritatively held in the case of *Enno Vs Dunn*.
6. That upon application of the principles of comparison of trade marks as set out in chapter 17 of *Kerly's law of trade marks and trade names* 10th Edition, the first comparison is that one must take the two words, then judge them by their look and their sound. He submitted that RAHA and RAHA tea looked and sounded the same.
7. That one must consider the goods which are to be applied and the nature and kind of customer who would be likely to buy those goods.
8. That upon considering the comparisons above-mentioned, members of the public were likely to wonder whether RAHA tea and RAHA for cocoa come from the same source or the same manufacturer.

9. That the main idea for each of the marks is the word RAHA and equally the general impression and recollection would be the word RAHA and not the other minor details incorporated by the Applicant.
10. That cocoa and tea are used for making hot beverages both taken as warming or invigorating drinks and are invariably sold and exhibited in the same part of shops or supermarkets. The only difference is that tea is processed from leaves whereas cocoa prepared from cocoa beans (see in an Application by Ladiskis Jellinek (1946) 4 RPC).
11. That in the case of Nestle Vs Starssburger the court readily accepted that tea is the same description of goods as cocoa at page 50 of the case in addition both marks are in the same class and therefore as per Section 15(1) of the Act are of the same description of goods.
12. That if the word RAHA cannot be monopolized as a trade mark as argued by the Applicant then it is not clear why the Applicant has applied to register the same word.
13. That the Registrar can only effect the Applicant's registration on the grounds of honest concurrent use under Section 15(2) of the Act.
14. That the Applicant has not adduced evidence of use of RAHA tea, the Registrar must also consider the extent of use and quantity. Further there is no evidence of the area of the use of the Applicant's mark.
15. That there was no honest concurrent use because the Applicant of T.M.A No. 54120 being the sister company of the Applicant herein was made aware of the existence of the Opponent's mark.
16. That if the Applicant was aggrieved by the registration of the Opponent's mark the remedy open to the Applicant was to apply for expungement rather than impute blame on the Registrar and claim bad faith on the part of the Registrar.
17. That the Registrar should consider the impact the registration would have on the public. He invited the Registrar to apply the principles and evidence of the high degree of likelihood of confusion and deception which would arise.

The matter was then adjourned following a request by the Applicant's Counsel for the reason that he was to attend a funeral in Mombasa. The Opponent's Advocate obliged him and did not object to the application. The Assistant Registrar then asked parties to fix another hearing date in the normal manner.

APPLICANT'S WRITTEN SUBMISSIONS:

The Applicant made the following submissions in support of its application and the pleadings it filed against the Opponent's allegations.

He stated that the principle objection by the Opponent to the Applicant's application is that it is the owner of a Trade Mark 'RAHA' T.M.A. No. 51981 which was initially a word mark for Cocoa Powder and Drinking Chocolate but was subsequently altered into a device mark principally comprising of the word 'RAHA' in a stylized format in Class 30.

He submitted that the Certificate of Registration and Alteration appear as annexures 'SS1' and 'SS2' to the Opponent's First Statutory Declaration. It is clear that although the initial registration was in respect of the word 'RAHA' which is on the Certificate recognized to mean leisure in English.

He submitted that the alteration turned the mark into a device mark with a specific colour scheme that is purple and brown. The Applicant submitted that, 'there is and cannot be any monopoly of the use of the word 'RAHA' by itself which is, as is recognized in the Initial Certificate of Registration referred to above, as a common Kiswahili word. He relied on the case of B.A.T Kenya Ltd -Vs- African Tobacco Agents Ltd - Nbl High Court Civil Case No.3466 of 1995 -where it was held, '*there is and cannot be any monopoly on the use of a common word.*'

He reiterated that in the present opposition proceedings, the issue in question was the objection to the use of the word 'RAHA' as there can be no question as to distinctiveness of the mark as a whole of the device intended to be registered and it was therefore his humble submission that the Opponent could not acquire property to the exclusive use of the word 'RAHA' and any suggestion to the contrary would make the mark unregistrable or one that could continue to subsist on the Register under part A as defined in Section 12 of The Trade Marks Act.

That when one considers the contents of the KIPi Journal No.2007/02 of the 28th February 2007, in which the Applicant's application is published at page 26, one will see numerous instances where there are specific exclusions to

the exclusive use of words (whether English or Kiswahili) of common usage.(For instance, at page 21, Entry for "SOKO HEWANI", the exclusive usage of the word "SOKO" has been excluded and page 28, entry for "AFYA SALT" has had the exclusive usage of the word "AFYA" excluded.)

Accordingly, and relying further on the decision of Mr. Justice P.J.S. Hewett in the case of Unilever Plc -Vs- Bidco Oil Industries Limited - Nbi Hccc No.1447 of 1999 annexed hereto marked 'B', it is accepted that "common English words.....Cannot be registered on their own".

He submitted that likewise, in Kenya, where Kiswahili is a National language and accepted as being used commonly by the entire population, it cannot by any stretch of imagination be argued that the word 'RAHA' is an invented word or one that it is unconnected with or unknown to the population such that it is registrable under PART A to confer exclusive rights of usage for the word 'RAHA'. Besides, and in any event, the Certificate of Addition to or Alteration of Registered Trade Marks annexed to the Opponents' First Statutory Declaration as 'SS2' clearly shows that the mark is now registered as a device with distinctive features not having had such features earlier.

Consequently, it is the Applicant's submission that the continued existence of the registration of the mark 'RAHA' in favour of the Opponent in the form it remains is, pursuant to Section 18(2)(a), " ... an entry wrongly remaining on the register entitled to either remove the same from the register or " in the case of a decision in favour of its remaining on the register require as a condition thereof that the Proprietor disclaim any right to the exclusive use of that word"

Like in the instances cited above, the Applicant submitted that the Registrar was under a duty to ensure that a mark does not wrongly remain on the register. He submitted that the Applicant had raised the issue in its Counter-Statement at paragraph 3. He reiterated that the next question that then ought to be determined is whether the mark as presented by the Applicant is registrable and within the law.

He submitted that in view of the foregoing, there could be no exclusivity or property in the word 'RAHA', the device sought to be registered must be considered in its entirety and as a whole in comparison to that registered in favour of the Opponent, even though the latter is for cocoa powder and drinking chocolate whereas the Applicant's device is sought to be registered for tea.

In this respect, the Applicant submitted that it agrees with the principles laid down in the case of *Re: An Application By Bourjois Ltd (1964) E.A. 265* relied upon by the Opponent but also annexed and marked 'C'. The prohibition to registration of a deceptive mark is contained in Section 14 of The Trade Marks' Act which provides that; " ... no person shall register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design " In other words, the only prohibition is if the Trade Mark or part thereof is likely to deceive or cause confusion.

He submitted further that upon consideration of the Applicant's mark nothing is objectionable save for the word 'RAHA' due to the distinct kettle image, map of Kenya and distinct colour scheme incorporated in its mark.

He Relied on Lady Justice Okwengu's judgement (as she then was) recognized and held in the case Of LORDS HEALTHCARE LIMITED -VS- SALAMA PHARMACEUTICALS LIMITED [2008] EKLK - Annexed and marked 'D' that,

"...the alleged infringement by the Defendant being anchored on the existence of the Plaintiffs exclusive rights, and the existence of the exclusive rights being doubtful, no prima facie case has been established."

He submitted that the issue in that case, as is presently, was whether or not the Plaintiff had exclusive rights to the use of the word 'Budecor'. Should the Registrar, accept the Applicant's submission on the question of the non-exclusivity of the word 'RAHA', it is the Applicant's humble submission that then he ought to hold in its favour on the question of causing deception and confusion. He reiterated that the design, colour scheme and entire 'getup' of the Opponents' device is distinctively different from that of the Applicant and no confusion or deception is likely to be caused.

He stated that as it is evident from the Applicant's Statutory Declaration at paragraphs 4 and 5 there is no doubt that the Applicant has not only been using the mark for many years (in good faith) and in any event from March 2001 when the first attempt at registration was made - which was wrongly rejected by the Registrar's office on account of flimsy reasons only for the Opponents' trade mark 'RAHA' to be registered some 9 months after the first application was made.

Again, the principles as regards comparison of trade marks as stated by the Opponents' Counsel are as set out in the texts relied by the Opponent namely, Kerly's Law of Trade Marks And Trade Names - Tenth Edition annexed and marked 'E' and Intellectual Property: Patents, Copyright, Trade Marks And Allied Rights Third Edition annexed and marked 'F', one of the pertinent issues the Applicant has raised is the question of honest concurrent use and in order to determine this, he submitted that a number of factors ought to be considered.

On the degree of likelihood of confusion, He submitted that although the Opponent's contention is that the words RAHA COCOA and RAHA TEA sound phonetically the same and look the same too, two important aspects appear not to have been addressed ,the colour scheme and get up as well as the components of the device itself.

He submitted that there is a substantially marked difference in the two devices and under no circumstances can there be any comparison between the two whatsoever. The colour scheme and design of the two devices is markedly different, one focusing on yellow green and red and the other on purple and orange /brown. Besides, the focal point of the Opponent's device is the cocoa bean with specific type writing whereas that of the Applicant's device is the kettle, map of Kenya and writing in a straight font. The zig zag pattern, another focal point in the Applicant's device is missing from that of the Opponent.

He alluded to the fact that the objection appeared to be on the assumption of the exclusivity of the use of the word 'RAHA'. He submitted therefore that should the Registrar, adopt and agree with the Applicant's position that there can be no property in a common Kiswahili word 'RAHA', based on the fact that there is no other objection by the Opponent, that the Registrar ought to find in favour of the Applicant on this by holding that there is likely to be no confusion.

Relying on his authority marked 'F', it is clear that where the mark is not just a word, it must be compared in it's entirety (page 604) and in the case of 'SKIN DEW' and SKIN DEEP', the objection could not be sustained as the 'idea' of the two marks was different, as is the instant case.

On the issue of Honesty and the original adoption and subsequent use of the mark, he submitted that the same had not been questioned and could not

be so, given the circumstances of the matter particularly in view of the fact that the application for 'RAHA' was lodged prior to the Opponent's mark.

On the issue of length of Applicant's use of its mark, it was submitted that the same was unquestionable and the evidence on record clearly showed it has been used for a period in excess of at least 11 years (8 years at the time the matter was lodged).

On evidence of confusion in actual use he submitted that although there is no evidence on record on actual use, though it was submitted that the main idea of the two marks was RAHA and all other additions were minor details, he submitted that the elements of the mark including the tea kettle, map, zig zag pattern, colour scheme and 'getup' were not minor details but constitute the main focal point of the mark which is distinctively different from that of the Opponent.

That when all factors are considered, the case in favour of the Applicant is much stronger than that of the Opponent's. He submitted that the question to be considered by the Registrar is if there is sufficient reputation built by the Opponent such that the goods using its mark are likely to be passed off as those of the opponent. The onus is on the Opponent to prove these allegations and this was not discharged.

He submitted that the Opponent's had not established any reputation amongst the public and therefore there was no likelihood of confusion. He relied on the case of an Application by Ladislav Jelinek.

Finally he submitted that the Opponent providing a list of expenditure on advertisements made in respect of its mark is irrelevant in absence of direct evidence. No figures or values were submitted to justify the connection for instance level of sales.

OPPONENT'S REPLYING WRITTEN SUBMISSIONS:

The Opponent filed its reply to the Applicant's written submissions on 8th May 2012. He stated as follows:

1. That on the use of a common word in the Kiswahili language it was submitted that it was not clear whether the judges in the two cases relied on by the Applicant, were considering registrability or distinctiveness of the marks in those particular cases.

2. That the test of registrability is set out in Section 12(1) of the Trade Marks Act and a mark must satisfy at least one of the essential particulars therein listed.
3. That in Section 12 (1) (d) of the Trade Marks Act common words in any language are not excluded from registration as trade marks for as long as they have no direct reference to the character or quality of goods, that is they are not descriptive of the goods covered by the mark and are not ordinarily geographical names or surnames.
4. That RAHA though admittedly a common word in Kiswahili language is not disqualified from registration for as long as it was not descriptive of the goods of which it is sought to be registered.
5. That there are many common words registered in the trade marks register. He submitted that from a search performed at the Institute by the Opponent the word RAHA has been registered in various classes as a trade mark.
6. That RAHA TEA would equally be disqualified as a common word if the Applicant's reasoning is adopted.
7. On distinctiveness he submitted that words in common use in the trade or open to the trade as stated in Kerly's law of trade marks and trade names at Para 8-70 are not registrable. He submitted that the two cases relied on by the Applicant may have been referring to such words.
8. That the Opponent's mark RAHA is neither common to the trade for goods in class 30 including tea and cocoa nor open to the trade to use as far as such goods are concerned.
9. That although the Opponent altered its mark and incorporated a device the alteration did not substantially affect the identity of the mark as per Section 38 of the Trade Marks Act. He further submitted that notwithstanding the alteration the word RAHA was the most prominent or significant feature of the Opponent's mark.
10. That the Opponent's mark was registered with effect from 4th September 2001. Section 16(1) of the Act provides that in all legal proceedings relating to a trade mark registered in Part A of the register

(including applications under section 35) the original registration in Part A of the register of the trade mark shall, after the expiration of seven (7) years from the date of that registration, be; taken to be valid in all respects, unless that registration was obtained by fraud; or the trade mark offends against Section 14.

11. He submitted that while the Applicant would like the Registrar to require the Opponent to disclaim the right to the exclusive use of "RAHA" as a condition for continued registration, it has not itself offered to disclaim the word "RAHA" in its application (T.M.A No.60347 "RAHA TEA"). This is clear from Exhibit SS4 annexed to the Statutory Declaration dated 29th August 2007 sworn by Suresh Shah. There is however no basis whatsoever for the Applicant's assertion that a disclaimer of RAHA should have been required as a condition for registration of TM No.51981 "RAHA" since the word "RAHA" as mentioned in these submissions is not descriptive of cocoa powder.
12. That the inclusion of the word RAHA in the Applicant's mark was an attempt to appropriate the most significant feature of the opponent's mark founded on the erroneous view that a common word in any language is neither registerable or usable and is therefore disentitled to protection in a court of justice as per Section 14 of the Trade Marks Act.
13. That RAHA TEA is identical and so nearly resembles RAHA Cocoa as per Section 15(1) of the Trade Marks Act.
14. That for purposes of Section 15(1) of the Trade Marks Act, cocoa and tea are the same goods or description of goods on the basis of the test laid down in the PANDA case.
15. That in the absence of any evidence of use of the mark presented by the Applicant Section 15(2) of the Act cannot be considered, there is no ground upon which the Registrar may permit registration of the applied for mark RAHA tea.

16. That the applied for mark should be refused registration on the grounds set out in these submissions and the oral submissions.

ASSISTANT REGISTRAR DECISION:

Having read the submissions made by the Applicant and Opponent herein I single out the following as the issues to be determined:

1. Whether the Applicant's mark 'RAHA TEA' and Opponent's mark 'RAHA' are identical or similar or not?
2. Are the goods applied with respect to the two marks identical or similar or of the same description or not?
3. Is there a likelihood of confusion or both marks can co-exist?

SIMILARITY OF MARKS:

I must first establish whether the two marks in question are similar or not .The two marks are:

'RAHA TEA' (with kettle, map of Kenya,tea cup , the word 'karibu' and zig zag border line for the Applicant and 'RAHA' (Stylized with device of cocoa bean) registered by the Opponent. Both marks are in class 30. The applied for mark RAHA TEA is applied with regard to tea whereas that of the Opponent is for cocoa and drinking chocolate.

Section 15(1) of the Trade Marks Act, prohibits the registration of a mark in respect of goods or description of goods that are identical or similar to one already in the register belonging to another entity with respect to identical or similar goods or description of goods.

The first assessment I will make is on the basis of visual and phonetic similarity .It is apparent that the two words are identical in as far as the word RAHA is concerned. The principles governing the comparison of trade marks are entrenched in the case of **Pianotist Co's Application (1906) 23 R.P.C 774** it was held in part by Lord Parker that,

you must take the two words. You must judge them by their look and by their sound....."

Using the above dicta and looking at Sections 14 and 15 of the Trade Marks Act relied upon by parties and authorities in relation to the issue of similarity of

marks, I deduce and summarize the basic guidelines for comparison of marks generally are:

- The appearance of the two marks
- The sound of the two marks
- The goods or services to which the mark is applied
- The kind of customer likely to buy the goods or use the services. A more knowledgeable consumer is less likely to be confused and similarly for a more specialized customer in a particular trade.
- The surrounding circumstances.

In no way is this list exhaustive but it acts as a guide, the same guide was used in the Pianotist case by Lord Parker J. Let us break it down and see how the list relates to the current case.

Similarity in Terms of Appearance/Visual Similarity;

- RAHA TEA and RAHA, judging them by their look they look the same in as far as the word RAHA is concerned the only difference is the incorporation of the word tea.

The Sound/Phonetic Similarity:

- On phonetics the word RAHA is pronounced identically in both marks save for the additional word Tea in the applied for mark.

The goods the mark is applied:

- Both marks are in the same class of goods that is class 30 with respect to cocoa powder, drinking chocolate and tea.
- Both marks incorporate a device{s}.

Several differences can also be noted from the two marks:

- The applied for mark has incorporated the devices of the map of Kenya, kettle, colour scheme, tea cup, the word 'karibu' and a zig zag border line whereas the Opponent's mark has a device of a cocoa bean, the word RAHA changed to logo written in a stylized form with a restriction to colour purple/blue, yellow light& dark brown and red.
- The applied for mark is in capital letters whereas the Opponent's mark is in small script and is in a stylized form somewhat in italics or slanting font.

- The applied for mark is in colour yellow, green, red, white and blue but does not specifically limit the mark in these colours in Form T.M 2 whereas that the Opponent has incorporated a colour restriction.

In determining visual similarity with the foregoing in mind, it is crucial to first determine whether the words are identical or similar. In order for me to determine whether the two marks are identical or similar, I rely on the case of

L TJ DIFFUSION Vs SADAS VERTBAUDET [2003] FSR 34, the ECJ in considering whether a mark and a sign are identical, held that:

".....two elements compared should be the same in all respects.....there is therefore identity between the sign and the trade mark where the former reproduces without any modification or addition, all the elements constituting the latter....."

In order to establish whether the marks RAHA TEA and RAHA are identical as earlier highlighted, I find that the words RAHA appearing in both marks are identical in all respects as per the above dicta.

I cannot however ignore the fact that both marks appear different when assessed by the eye overall and are not as a whole identical in all respects because of the incorporation of the device(s).

It is at this point very vital to ensure that although I will look at the constituent parts of the marks as held in the Pianotist case the same must be balanced by an overall appreciation of the two marks as well.

This was held in ERECTIKO V ERECTOR [1935] 52 R.P.C 151 where the Assistant Registrar took the two words, Erector and Erectiko and divided them into two, he eliminated 'Erect' from the words and proceeded to compare the suffix 'or' with the suffix 'iko' and pointed out that there was a grave difference between 'or' and 'iko'. It was held that.....'I do not think it is right to take a part of the word and compare it with a part of the other word; one word must be considered as a whole and compared with the other word as a whole.....'

In this present case following the above dicta, I note that the differences hereinabove highlighted in both marks bring out a somewhat different visual impact because of the colour and the devices altering the overall visual outlook.

I must therefore take into consideration the visual, oral and conceptual similarity of the marks including the overall impression given by the marks

bearing in mind, in particular, their respective distinctive and dominant components.

In the case of *Sabel Vs Puma AG* (Case C-251/95) the ECJ said it was held that the global appreciation of the visual, aural or conceptual similarity of marks in question must be based on the overall impression given by the marks bearing in mind their distinctive and dominant components.

I must therefore strike a balance between the constituent parts vis a vis the dominant parts. I find that the dominant part in both marks is RAHA. It should be noted that it is irrelevant that the word is written in small or capital letters or italics in so far as the purchasing public is concerned.

Colour is vital in determining distinctiveness; I however note that the Applicant did not invoke the provisions of Section 19(1) of the Trade Marks Act by indicating that it has restricted its mark to the specified colours in its mark. The effect of that omission then compels me to invoke Section 19(2) that its mark shall be deemed to be registered in all colours. I shall therefore not consider the specific colours represented in the mark as this could change. I however note that if the colours remain as they are depicted in Form T.M 2 then the visual impact is generally altered.

On the issue of the kettle and the cup, I find that these are common and in my view not necessarily distinctive as they are used to describe the goods in question and may be subject of disclaimers in class 30 of the Nice Classification. It is highly probable that those packaging beverages would ordinarily use a tea cup or kettle as devices. The inclusion of these devices however changes the visual impact significantly.

The map of Kenya and the word 'karibu' gives a concept of tourism in my view although this was not pleaded by the Applicant giving it a different concept as compared to the cocoa bean that gives an indication of the ingredient used in the Opponent's mark. The concept is however similar if the meaning of the Kiswahili word appearing in both marks is considered as 'leisure' or 'happy' in addition to the fact that both marks are related to beverages such that it would mean that the spirit of the drinkers is elated.

I overall do find that the marks are identical in as far as the word RAHA appears in both marks but are not visually similar if looked at as a whole.

PHONETIC SIMILARITY:

In considering the sound of two marks generally, I wish to address myself to the following issues as adopted in the Singapore Examination Manual.

1. Possibility of slurred pronunciation
2. Distortion of sound in telephone or other conversations
3. The syllabic structure of words
4. The first syllable as it is usually accentuated
5. Modern marketing methods

In the case of London Lubricants [1925] 42 R.P.C 264 also known as Tripcastroid case it was held that:

'the tendency of persons using the English language to slur the termination of words also has the effect necessarily that the beginning of words is accentuated in comparison ,and.....the first syllable of a word ,is ,as a rule, far the most important for the purposes of distinction.

Looking at the current scenario the trade marks are RAHA and RAHA TEA in pronunciation it is critical to note that the first words are identical and are pronounced exactly the same save for the addition of the word tea in the applied for mark.

In the London case it is held that the first part of the syllable is the most important part of the mark so does the KIPI Examination Manual at page 48. The overriding fact is that I do find that the pronunciation of the two marks are so similar.

I do find that the marks are identical in terms of sound and the two would be pronounced identically if not similarly.

SIMILARITY OF GOODS:

Let me now embark on the issue of goods which the Applicant submitted that the goods are not similar. In assessing likelihood of confusion the similarity of goods or otherwise must be considered.

Section 15(1) of the Act stipulates that the goods must be identical or similar before a mark is refused. In comparing goods and services it is well established that several factors should be considered. In the case of British Sugar Plc Vs James Robertson & Sons Ltd in deciding whether the goods are similar, Jacob J stated as hereunder;

1. *The nature and characteristics or composition of the goods*
2. *The respective uses to which the goods will be put*
3. *The users of the goods*
4. *The trade channels through which the goods are respectively bought and sold*
5. *The origin of the goods*

6. *The purpose of the goods*
7. *Whether the goods are usually produced by one and the same manufacturer*
8. *Whether the goods are distributed by the same wholesale houses*
9. *Whether the goods are sold in the same shops, over the same counter (if sold in self service outlets, whether they will be positioned on the same shelves), during the same season and to the same class or classes of customers.*
10. *Whether those engaged in the manufacture and distribution are regarded as belonging to the same trade.*
11. *The extent to which respective goods are competitive.*

I note from the record that both marks apply to goods in class 30, the description of the goods is however different, the applied for mark is in respect to tea and the Opponent's mark is with respect to cocoa powder and drinking chocolate.

It has been established that there are certain goods that may be in the same class of the Nice Classification but are not considered as being identical or similar or of the same description and at the same time there are some goods that may be in different classes but are identical or similar or of the same description. The issue therefore is that each case must be handled carefully and exclusively taking into consideration all the surrounding factors.

It has been submitted that cocoa powder, drinking chocolate and tea are similar or of the same description due to their respective uses, it was submitted that both are taken as invigorating drinks or warming agents.

In considering the nature and composition of the goods it is apparent or indeed factual that tea is prepared from tea leaves whereas cocoa prepared from cocoa beans. The composition of these two is different in that respect.

When I look at the respective use of the goods, I am convinced that the two marks are applied to goods with similar uses. Both marks apply to goods solely or largely for beverages. They all lie in the same category mostly for making hot beverages that is coffee, tea and cocoa.

The users of the goods would also be varied ranging from the sophisticated to the very young depending on various preferences and tastes. The Applicant did not adduce any evidence to show any sophistication or otherwise on the users. No price justifications were also presented.

The trade channels for the goods applied by both marks are most probably the same that is supermarkets and shops mainly and it is similarly highly probable that they would be placed side by side. I find that the trade channels are similar for lack of evidence to the contrary. Similarly the manufacturers and distributors are most likely to be the same due to the nature of the goods.

In view of the foregoing, I find that the goods in question though not necessarily identical are similar.

LIKELIHOOD OF CONFUSION:

The central issue after considering whether or not there is visual, phonetic and conceptual similarity is that of likelihood of confusion. Section 14 of the Trade Marks Act is to the effect that marks or any parts thereof that are likely to deceive or cause confusion should not be registered and should be disentitled protection in a court of justice.

In the case of Sabel Vs Puma AG (Case C-251/95) the ECJ said in part that:

".....The likelihood of confusion must 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 upon the overall impression given by the marks bearing in mind in particular their distinctive and dominant components....."

Using the above reasoning it is clear in this case that the dominant part of both marks is the word RAHA save for the fact that the applied for mark has several additions to it:

- the map of Kenya and the word Kenya in small letters inside the map.
- the image of a kettle
- the word karibu
- the coloured zig zag border line
- cup
- the word RAHA TEA in capital.

The Applicant neither lays claim to colour nor does he restrict its mark to any colour although the mark as represented has the colours yellow, blue, green, red and white.

The Opponent's mark is the stylized logo RAHA with a cocoa bean and colour restriction of blue/purple, yellow, light and dark brown and red as hereinabove already discussed.

Before I come to the conclusion whether both marks are likely to cause confusion to the purchasing public I first consider the average consumer's test. It has been established in various cases that the average consumer:

- a) normally perceives a mark as a whole and does not proceed to analyze its various details;
- b) rarely has the chance to make a direct comparison between two marks but relies on imperfect recollection of that which is in his mind; and
- c) level of attention varies depending on the category of goods or services

The summed up points were elaborated in the *Canon Kabushiki Kaisha Vs Metro Goldwyn* case. My role therefore is to establish who the average consumer would be and if they are capable of distinguishing both marks as coming from different entities.

From an overall outlook of both marks it is evident that although the visual impact may be different in terms of the colour combinations and the images incorporated the emphasis on both marks is the word RAHA which is the dominant part of the mark.

I find that there may be a likelihood of confusion especially by association where the public may wrongly believe that the respective goods come from the same or economically linked undertakings.

This then brings me to the issue of honest concurrent use. Section 15(2) of the Act makes provision for identical or similar marks to be registered upon certain conditions being imposed by the Registrar.

The Applicant in its Statutory Declaration at Paras. 4 and 5 allude to the fact that they have been using the mark for many years in good faith. The Applicant alleges that it used its mark for over 11 years from March 2001. The Opponent on the other hand submitted that there is no evidence of actual use of the applied for mark. He submitted that the Applicant's use was not in good faith as it had knowledge of the Opponent's mark at the time it lodged its application and that the Opponent had no knowledge of use of the applied for mark.

Section 15 (2) of the trade marks Act makes provision for two identical or similar marks to co-exist in the Register on the basis of honest concurrent use or any special circumstances.

In the case of *C.S.S Jewellery Company Limited Vs the Registrar of Trade Marks HCMP 2602/2008* a two stage analysis was adopted in determining whether registration should be allowed on honest concurrent use.

1. whether there has been honest concurrent use of the mark applied for and the earlier mark.

2. if the answer to 1 is in the affirmative, whether after considering all relevant circumstances, including public interest, the discretion should be exercised to accept the application for registration of the mark, despite the fact that the use of the mark in relation to the goods or services in question is likely to cause confusion on the part of the public.

From the above analogy it is critical when invoking Section 15(2) for one to adduce evidence of use and further concurrent use and the honesty of the concurrent use.

The length of time is therefore also important in deciding whether marks should co-exist and what degree of confusion is likely to ensue from such resemblance of the marks. Honesty of the Applicant's use may be doubted where his mark was copied from an earlier mark, or where it was adopted with the knowledge that it was identical or very similar to the earlier mark.

In the present matter I note that M/s Royal Tea Limited filed Form TM 2 on 25th February 2003 and it is similarly alleged by the Applicant herein that these two companies are sister companies and the former assigned its trade mark to it. I reluctantly accept this fact although no agreement is annexed to prove this fact save for a copy of letter indicating the transfer marked as Exhibit 'SS4'. This application was preceded by a search on 14th March 2001 that revealed that the mark was similar to 'FURAHA' at the time as depicted in Exhibit 'SP 2' and 3 respectively.

Subsequent reminders were sent by the Applicant until the Opponent's mark was registered and when the Applicant now lodged its application after being informed that the cited mark 'FURAHA' had been removed from the register, the Opponent's mark was cited as being similar barring the Applicant from applying.

I do find that the Applicant has not proven any use of the mark, he has also not shown any concurrent use of the mark or honesty for that matter. I can only invoke section 15(2) of the Act upon prove that both marks have been in the market concurrently. The Applicant has not shown where the goods are sold, any invoices or any evidence to show use.

I find that although it was unfortunate that the applied for mark was presented for registration at an earlier date the law envisages such a scenario and provides for remedy under Section 35 of the Trade Marks Act. At the point that the Opponent was sent a refusal notice citing the Opponent's mark on 29th May 2003, The Applicant did not do anything but rather came to lodge another application 3 years later with the same mark varying it with several additional devices and adding colour. I am of the view that the Applicant had recourse at the time when the Opponent's mark was cited against its mark to file for expungement before the Registrar citing prior use.

It is established that equity aids the vigilant and not the indolent.

The Applicant still has re-course under Section 35 of the Trade Marks Act as I note that it is his submission that the entry of the Opponent's mark wrongly continues to remain on the Register.

Section 15(2) of the Act further gives a leeway for accepting both marks under special circumstances, the same was not prayed for and no special circumstance has been demonstrated by the Applicant who has the onus of proof in these proceedings. The only special circumstance I would imply is that the mark is applied in respect of tea whereas the Opponent's mark is with respect to cocoa and drinking chocolate but the goods have also been found to be similar.

OVERALL RULING:

In view the findings and authorities herein relied upon, I hereby rule as follows:

1. That the Trade Mark application number 60347 shall not proceed to registration.
2. That each party shall bear its own costs.

The Opponent's opposition is by virtue of this decision upheld.

Ruling delivered and dated at **Nairobi** this **16th** day of **April** 2013.



Elvine Apiyo

Assistant Registrar of Trade Marks

