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THE TRADE MARKS ACT CAP 506 OF THE LAWS OF KENYA

AND

IN THE MATTER OF TRADE MARK NO. KE/T/2008/62668 "MABATIMAISHA" (WORD) IN CLASS 6 IN THE NAME OF MABATI ROLLING MILLS LIMITED AND EXPUNGEMENT PROCEEDINGS THERETO BY MAISHA MABATI MILLS LIMITED

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

Background

On 31st January 2008, Mabati Rolling Mills Limited (hereinafter referred to as "the Proprietors") filed an application to register their trade mark no. KE/T/2008/062668 "MABATIMAISHA" (Word) (hereinafter referred to as "the mark") before the Registrar of Trade Marks. The application was filed in international class 6 of the International Classification of Goods and Services for Purposes of Registration of Marks in respect of "Steel flat sheets and coils".

The Registrar duly examined the mark in accordance with the provisions of the Trade Marks Act, Cap 506 of the Laws of Kenya. On 26th February 2008, the mark was approved and published in the Industrial Property Journal of 31st March 2008, on page 44. Upon expiry of the sixty-day statutory period, the mark was entered in the Register of Trade Marks with effect from the said 31st January 2008 and a Certificate of Registration was issued.

On 29th October 2008, Maisha Mabati Mills Limited (hereinafter referred to as "the Applicants") filed an application for expungement of the mark.

The grounds of application were as follows:

1. We are aggrieved by the entry of TMA No 62668 "Mabati Maisha" (hereinafter referred to as "the Mark") in the Register of Trade Marks for the following reasons:
 - (a) The Applicant was incorporated and registered on 9th

February 2007 with the sole intention of *inter alia* manufacturing, distributing and selling corrugated, flat and related iron and steel sheets to be branded as Maisha Mabati in connection with its trade name.

- (b) Upon the incorporation and registration of the Applicant's company, the Applicant has invested a sum in excess of Kshs.4.5 billion in the project of *inter alia* manufacturing, distributing and selling Maisha Mabati corrugated flat, and related iron and steel sheets.
- (c) The Applicant who is about to launch the said goods and products recently commenced an application for registration of a trade mark Maisha Mabati before the Registrar of Trade Marks.
- (d) That upon a search of trade marks being made prior to the application for the trade mark Maisha Mabati, the Applicant was advised by the Registrar of Trade Marks that a trade mark by the name Mabati Maisha was applied for and registered by the Respondent and the same is subsisting on the Register of Trade Marks for the next ten (10) years with effect from 31st January 2008, a Certificate of Registration having been issued on 6th June 2008 vide TMA NO. 62668, for goods in class 6 of the International Classification of Goods and Services that is "steel flat sheets and profiled sheets and coils".
- (e) The Respondent is not a true owner and/or creator of the mark in respect of goods in class 6 of the International Classification of Goods and Services.
- (f) The registration of the Mark in favour of the Respondent has little or no intrinsic value to the products of the Respondent.
- (g) The Respondent's registration of the Mark was obtained through fraud and misrepresentation of facts and is therefore unlawful. Its use would be disentitled to protection in a court of justice in accordance with the provisions of section 14 of the Trade Marks Act.
- (h) The Applicant has extensively used the words Maisha Mabati as a trade mark of and in connection with the goods and products manufactured (about to be launched) and the said trade mark denotes the goods manufactured by or having an origin from the Applicant and will distinguish the

goods of the Applicant in the market.

- (i) The said goods of the Applicant are identical or similar to the goods in respect of which the Mark was registered in favour of the Respondent.
- (j) The Applicant is the proprietor and owner of the said trade mark Maisha Mabati having adopted the same in its trade name to distinguish its goods in the market and no other person's goods should be marketed using the said or similar trade mark.
- (k) In spite of the Respondent having been in the business of manufacturing corrugated, flat, and profiled iron and steel sheets for over forty (40) years, it has never had the intention of registering the trade mark Mabati Maisha until only recently when they became aware that the Applicant was about to launch competing products by the name Maisha Mabati.
- (l) The registration of the Respondent's mark is malicious, made in bad faith and only calculated to cause deception and/or confusion of the Applicant's products and/or frustrate the Applicant's efforts to register a related or similar trade mark and is likely to confuse or mislead the members of the public as to the origin and source of the Respondent's products which is similar to the Applicant's trade name.
- (m) The trade mark, TMA NO. 62668 in favour of the Respondent was obtained fraudulently by the Respondent who deceived the Registrar of Trade Marks that the Respondent is the proprietor of the same in accordance with the provisions of the Trade Marks Act while the Respondent knew that it had no actual, legal or valid claim to the said trade mark and that the Applicant is the only person with a legal and valid claim over the same.
- (n) In view of the kind of products which the Applicant is about to launch, it is inconceivable that the Respondent, who is in the same industry, was not aware of the existence and the intention of the Applicant to manufacture and launch corrugated, flat, and profiled iron and steel sheets and thereafter register a mark by the name of its trade name. Therefore the choice of the words Mabati Maisha by the Respondent is actuated by malice, bad faith and was by no means merely coincidental.

- (o) The Respondent is not entitled to the trade mark since as at the time of filing the request to expunge the Respondent's mark and this Statement, the Respondent did not have a product by the name Mabati Maisha and has never used the Mark either before or after the registration of the mark and has never had *bona fide* intention of using the mark. Therefore, the Respondent acted dishonestly, fraudulently and with *mala fides* in having the mark registered.
- (p) The registration of the Mark by the Respondent was made for the sole purpose of stopping the Applicant from manufacturing, selling and distributing iron and steel sheets, which is a business that the Respondent has undertaken for a considerable period, so as to frustrate the Applicant from entering the said market of iron sheets. The said act constitutes unfair trade practices and unfair competition.
- (q) The registration of the Mark in favour of the Respondent is contrary to Articles 6 *sexies* and *bis* of the Paris Convention for the Protection of Industrial Property 1880 which Kenya ratified on 14th June 1965 and sections 14, 15, 20 and 35 of the Trade Marks Act.
- (r) The registration of the Mark should not remain in the register or be protected because its registration was and has been made with *mala fides* and without intention of using the Mark.
- (s) The Applicant contends that the Respondent knew very well about the Applicant's company and the likelihood of the Applicant using its trade name on its products but cunningly sought to exploit the same by taking unfair advantage in registering the Mark in an effort to frustrate the Applicant's business and thus the registration of the mark in favour of the Respondent is against public policy.
- (t) By the time it came to the attention of the Applicant that the Respondent had irregularly applied for registration of the mark, the same had already been registered in the Respondent's favour.
- (u) In spite of demand having been made to the Respondent to surrender the Mark, the Respondent has failed, refused and/or neglected to do so necessitating this application for expunging, varying or rectifying the Register of Trade Marks.
- (v) In view of the foregoing, the registration of the Respondent's

trade mark, TMA NO. 62668, ought not to have been effected in light of the rights that the Applicant had accrued over the use of the words and/or names Mabati Maisha.

2. Reasons wherefore the Applicant has sought the following relief:

- (a) THAT the registration of the Mark in the name of the Respondent be cancelled, removed, expunged and/or struck off the Register of Trade Marks pursuant to the provisions of Rule 82(1) of the Trade Marks Rules and section 35 (1), (2) & (5) of the Trade Marks Act;
- (b) THAT the costs of these proceedings be awarded to the Applicant; and
- (c) Any other relief that the Registrar may, at his discretion, deem fit to grant.

The application was duly forwarded to the Proprietors who on 11th December 2008 filed their Counter-Statement. The Proprietors stated the following as the grounds on which they would rely in support of their registration:

1. We, Mabati Rolling Mills Limited the Respondent herein is a Company registered and existing under the Laws of Kenya. We were registered as Mabati Limited in 1961 and later changed our name to Mabati Rolling Mills limited in 1982. We are a market leader in roofing solutions including galvanised iron sheets (both corrugated and flat sheets) which products have over the past forty (40) years been associated with us and commonly referred to as Mabati.
2. Having been in the iron roofing sheets industry for more than thirty (30) years, we have from time to time developed various brands based on the need to re-invent and grow our business while enjoying intellectual property rights guaranteed by our laws. Hence over the years we have developed and registered the following trade marks/brand names:-
 - TMA 9335 Rhino and Device (Effective Date of Registration - 17th February 2003).
 - TMA 38964 Lion brand (Effective Date of Registration - 3rd February 2003).
 - TMA 40453 Woodgrain (Effective Date of Registration - 17th February 2003).

- TMA 46923 Galsheet Resincot (in Blue and Red) (Effective Date of Registration –17th February 2003)
 - TMA 46924 Galsheet Simba Mabati (Effective Date of Registration –17th February 2003)
 - TMA 47579 Rhino Mabati & Device (Effective Date of Registration –17th February 2003)
 - TMA 52631 Simba Mabati (Effective Date of Registration –25th February 2002)
 - TMA 52632 Dumu with Zas Technology (Effective Date of Registration –25th February 2005)
 - TMA 55342 Galsheet Dumu Resincot The New Force in Roofing (Effective Date of registration - 21st February 2005)
 - TMA 55455 Mabati Rolling Mills Limited Logo (Effective Date of Registration-17th December 2003)
 - TMA 55752 Galsheet Resincot (White and purple on yellow background) (Effective Date of Registration-19th March 2004)
 - TMA 56663 Versatile (Effective Date of Registration –18th October 2004)
 - TMA 57008 Versatile with Roof Device (Effective Date of Registration - 9th March 2005).
 - TMA 57133 Dumu Zas (Effective Date of Registration-5th April 2005)
 - TMA 58249 Zinal (Effective Date of Registration-2nd November 2005)
 - TMA 61183 Saflok 700 (Effective Date of Registration – 11th May 2007)
 - TMA 61184 Dumu Mabati (Effective Date of Registration – 11th May 2007).
 - TMA 62668 Mabati Maisha (Effective Date of Registration –31st January 2008)
 - TMA 62669 Safal Group Logo (Effective Date of Registration 31st January 2008)
 - TMA 63042 Lifestile (Effective Date of Registration - 14th April 2008)
3. The philosophy behind the development of the trade names and/or brand names for our products has been to represent the distinctive quality of our products, which has been their longevity and durability. Indeed this quality has been the single most prominent aspect of our advertising and product promotion campaigns.
4. It was in line with the stated philosophy that early this year (2008) we decided to develop a brand name to reflect the added technological improvements on our products. We, after various deliberations, settled on the brand name *Mabati Maisha* meaning that our products were long lasting. This was a concept, which had earlier been developed and put on to the public through our advertisements running both on print and electronic media. The brand name had significance for us because *mabati* is part of our

corporate name and logo TMA 55455 which is already registered and *maisha* is reflective of the quality of the products - longevity and durability.

5. Being conscious of the procedural aspects of registration of trade marks, we took the following steps to actualise the registration of the mark:-

(a) On 14th January 2008, we lodged Form TM 27 with registrar this being a request for search under Rule 114/ Application for Search/Preliminary Advice as to Distinctiveness. For this request we paid the requisite fee of Kshs.6, 000/= under receipt No. G31 0180;

(b) By a letter dated 21st January 2008, we received a letter from the Senior Trade Marks Examiner referenced as follows:-

"Preliminary Advice No. 8760 a Trade Mark Mabati Maisha (Word) in Class 6 in the name of Mabati Rolling Mills Limited. "

The import of the letter was that after preliminary search and examination of our trade mark under Sections 12, 14 and 15 of the Trade Mark Act, the following results were found:-

Available for registration subject to the following conditions:-

(i) You disclaim the right of the exclusive use of the word "Mabati" separately and apart for the trade mark as a whole;

(ii) You provide English translation of the word "Maisha".

a. On 31st January 2008, we made our application for Registration by lodging Form TM2 in which we disclaimed the exclusive use of the word "Mabati" separately and apart for the mark as whole and provided an English translation of the word "Maisha" to mean "Long-lasting". The requisite fee of Kshs.12, 000/= was paid and we were issued with receipt No.G310450.

b. On 31st March 2008 our application was advertised in the KIPJ Journal with notification for anyone with any objection to raise such objection within sixty days. We are not aware that any objection was raised. Hence in the absence of an objection thereof, the Trademark was duly registered and a certificate of registration was sealed on 9th June 2008.

6. As evidenced above, we followed the due process of registration

- laid down in the Act and obtained this registration legitimately.
7. It was therefore with great surprise that we received information from sources within the market that Applicant was claiming that we had stolen its name by registering our Trade Mark. We took the information seriously and conducted various searches at the Companies Registry to confirm whether indeed the Applicant traded in the name and style as it was claimed:-
 - (a) instructed our lawyer A. F. Gross & Company Advocates to conduct a search on two different occasions. The Advocate was turned away by the Company Registry staff saying that no such file could be traced.
 - (b) Further, we made our own personal inquiries at the Companies Registry and received no confirmation that indeed there existed a company known as Maisha Mabati Mills Limited.
 8. We were further surprised to receive a letter of demand from the Applicant on 3rd October 2008 claiming that we had obtained the registration of our trade mark by fraud.
 9. Alarmed by the allegations we instructed our Advocates to seek more particulars on the existence of the Applicant and particulars of fraud or malice as was alleged. This they did by their letter of 3rd October 2008.
 10. It was only after this request was made, did the Applicant forward its Certificate of Change of Name but failed to set out any particulars of fraud or malice as alleged. The Certificate of change of Name clearly shows that the Applicant was never originally registered as Maisha Mabati Mills Limited. It is also instructive to note that when the alleged change of name was effected no notice was given to the whole world and therefore the Respondent had no notice that a company by the name Maisha Mabati Mills Limited existed.
 11. For avoidance of doubt we reiterate that:-
 - (a) Our application for registration of *Mabati Maisha* Trade Mark was made in good faith, consistent with our policy on brand development and in line with other trade marks we have registered in the past;
 - (b) At no time before the disclosure by the Applicant's Advocates to our Advocates on 13th October 2008 did we know that the

Applicant existed trading in the name and style it now alleges;

- (c) At no time was the registration of our trade mark intended to capitalize on any good will created in the market by the Applicant. Indeed we deny categorically that any such good-will existed or even that the Applicant has marketed its goods in the same class as our products or any other goods for that matter in the brand name *Maisha Mabati* or *Mabati Maisha* or at all;
- (d) The brand name *Mabati Maisha* derives from our corporate name and logo, is reflective of the longevity, durability and quality of our goods and is in no way confusing to the market in which our products have always been referred to as *Mabati*;
- (e) The registration of our trade mark followed the due process of the law. The Applicant having failed to raise any objection during the time allowed for such objection is now trying to circumvent the process of the law by raising a spurious claim;
- (f) No particulars of malice or fraud have been set out or proved and the Applicant is making an idle allegation intended to confuse the Registrar, vex the Respondent and legitimise a claim which is otherwise time barred;
- (g) The registration of our trade mark does not offend any law or international treaty as alleged or at all;
- (h) The Applicant therefore denies each and every allegation set out in paragraph 2 of the Applicant's Statement of Claim;
- (i) The Respondent being the lawfully registered proprietor of the trade mark in question enjoys all the rights and privileges afforded to it by the Trade Marks Act. In the absence of any legal justification as to why those rights should be denied, the Application's claim must fail;
- (j) The mere registration of a company at the companies' registry does not confer any trade mark protection under the Act. There was a specific purpose that the Trade Marks Act was supposed to serve. It is therefore not justification enough, for expungement proceedings, that the Applicants name resembles our Trade Marks. It is only we as the duly registered proprietors of the Trade Mark that enjoy protection under the Act.

12. Reasons wherefore the Respondent seeks the following relief:-

- (a) That the Applicant's request that the Respondent's trade mark be cancelled, expunged and/or struck off the Register of Trade Marks be dismissed;
- (b) The costs of these proceedings be awarded to the Respondent; and
- (c) Any other or further relief as the Registrar may deem fit to grant.

The Counter Statement was forwarded to the Applicants who on 26th January 2009 filed their statutory declaration sworn by Mr. Kaushik Pandit, the Director of the Applicants herein. Mr. Kaushik Pandit confirmed on oath the Applicants' claim as indicated in the Application and the Statement of Case.

The Statutory Declaration was duly forwarded to the Proprietors who on 29th October 2012 filed their Statutory Declaration. The Declaration was sworn by Antony M. Kungu, the Legal & Compliance Manager of the Proprietors who confirmed on oath the grounds on which the Proprietors were relying in support of their registration.

The Statutory Declaration was forwarded to the Applicants who filed their Statutory Declaration In Reply on 17th December 2012. The Declaration was sworn by the said Kaushik Pandit who replied to the issues raised by the Proprietors in their Statutory Declaration. The Declaration was forwarded to the Proprietors and this marked the close of the pleadings.

Thereafter, a hearing date was agreed upon by the parties subsequent to which it was agreed that the matter would proceed by way of written submissions. The Applicants filed their written submissions on 21st May 2013, the Proprietors filed their written submissions on 25th June 2013 and the Applicants filed their written submissions on 12th July 2013.

Ruling

I have considered the application made herein by the Applicants and the counter-statement filed by the Proprietors together with the evidence adduced by both parties herein by way of their respective statutory declarations. I have also considered the written submissions made by Ms Mohamed Madhani & Company Advocates for the Applicants and Ms Oraro & Company Advocates for the Proprietors. I am of the view that the following are the issues that should be determined in these expungement proceedings:

1. Did the Proprietors have a valid and legal claim to the mark "MABATIMAISHA" (WORD) before applying to register the same in accordance with the provisions of section 20(1) of the Trade Marks Act?
2. Are the Applicants aggrieved persons in accordance with the provisions of section 35 of the Trade Marks Act?

The following is a consideration of each of the said issues:

1. Did the Proprietors have a valid and legal claim to the mark "MABATIMAISHA" (WORD) before applying to register the same in accordance with the provisions of section 20(1) of the Trade Marks Act?

Evidently, the Proprietors' mark "MABATIMAISHA" and the Applicants' mark "MAISHA MABATI" are virtually identical conceptually, phonetically and visually. The only difference is that the order of the words "MABATI" and "MAISHA" has been interchanged. Further, the goods in respect of which the Proprietors' mark has been registered and the goods in respect of which the Applicants' mark is sought to be registered are goods of the same character. The respective goods of the Proprietors and the Applicants would also be offered for sale through the same trade channels. It would therefore be contrary to the provisions of the Trade Marks Act for the two marks to co-exist in the Register of Trade Marks. It is imperative that the issue of whether or not the Proprietors, who were the first to file their trade mark application at the Registry of Trade Marks, had a valid and a legal claim to the mark "MABATIMAISHA" by the time they made the application to register the mark in accordance with the provisions of the Trade Marks Act.

It is the Proprietors' case that they are the rightful owners of the trade mark "MABATIMAISHA" which they adopted for use in respect of "Steel flat sheets and coils" in the Kenyan market. They claim to have registered their said mark in good faith and to have marketed their products using the mark extensively in the Kenyan market. On the other hand, the Applicants claim that they are the true owners of a similar trade mark "MAISHA MABATI" which is derived from their name Maisha Mabati Mills Limited.

Section 20(1) of the Trade Marks Act states as follows:

"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 for registration either in Part A or in Part B of the Register."

The learned author of the book Kerly's Law on Trade Marks, 12th Edition, on page 28 paragraph 4-02 states *inter alia*:

"...it would seem to be settled that the claim must be in some sense a justified one, if the registration is to stand; whether by virtue of the section or under its general jurisdiction, the court will expunge a registration if the applicant for it could not in good faith make this claim".

In the Vitamins Trade Marks Case [1956] RPC I Justice Lloyd stated as follows on page 11, *inter alia*:

"There are two matters which I have felt right to take into consideration upon this aspect of the case. The first one is the propriety or otherwise of the action of the applicants in making the application which they made for registration. By the rules, which have the force of the statute, it is provided that applications of this character shall be made upon Form TM 2 which requires that an application for registration should assert, in the case of a mark which has not yet been the subject matter of use in trade that it is proposed and that the applicant is claiming to be the proprietor thereof....

A proprietary right in a mark sought to be registered can be obtained in a number of ways. The mark can be originated by a person or can be acquired, but in all cases it is necessary that the person putting forward the application should be in possession of some proprietary right which, if questioned, can be substantiated."

Prior to making an application for registration of a mark with the Registrar of Trade Marks, an Applicant must have a valid and legal claim as the proprietor or owner of such a mark. The Applicant must also be able to show that the mark under consideration can act as a badge of origin for the respective goods or services. The aforementioned learned author of the book Kerly's Law on Trade Marks, 14th Edition, states as follows on page 8 paragraph 2-002:

"A trade mark is (or should be) a badge of origin. In other words, it indicates the source of the trade origin of the goods or services in respect of which it is used. A trade mark may do other things as well, but it must act as a badge of origin."

Upon receiving an application to register a mark, the Registrar of Trade Marks examines the same and has to be satisfied that the same is distinctive and adapted to distinguish the goods or services of the Applicant in accordance with the provisions of section 12 of the Trade Marks Act. Section 12(3) of the Act provides as follows:

"In determining whether a trade mark is adapted to distinguish, the court or the Registrar may have regard to the extent to which

- (a) the trade mark is inherently adapted to distinguish; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish."

The Proprietors adopted for use the mark "MABATIMAISHA" to distinguish their goods, that is, "steel flat sheets and profiled sheets and coils" in the Kenyan market. Subsequently, on 31st January 2008 the Proprietors made an application before the Registrar of Trade Marks to register the same under class 6 of the International Classification of Goods and Services for Purposes of Registration of Marks. On 9th June 2008, the Proprietors' mark was entered in the Register of Trade Marks, with effect from the said 31st January 2008. However, as indicated in the Applicants' Statement of Case and the Statutory Declaration, the Applicants had by 9th May 2007 changed their name at the Companies Registry to Maisha Mabati Mills Limited. Having adopted a mark that is similar to the Applicants' name for registration in respect of goods that are identical to those of the Applicants, then the Proprietors cannot be said to have a valid and legal claim to the mark "MABATIMAISHA" under the provisions of section 20(1) of the Trade Marks Act. As stated by the learned author of the book Kerly's Law on Trade Marks in the paragraphs quoted herein above, I am not convinced that the Proprietors can make a claim to the mark in good faith. Further, it is my view that the alleged proprietary right of the Proprietors' mark "MABATIMAISHA" has not been sufficiently substantiated in these proceedings as required by law. The Proprietors state that the Applicants did not file opposition proceedings against registration of the mark "MABATIMAISHA" when the application was duly published in the Industrial Property Journal and that they should not use a loophole in the Companies Act to claim the mark "MAISHA MABATI" on account of their name Maisha Mabati Mills Limited. I am aware that registration of a company does not give one automatic protection under the Trade Marks Act. However, it would be unjust to hold that one cannot use their company's name as a trade mark. Further, section 12 (1) (a) of the Trade Marks Act includes the name of a company as one of the essential elements of a mark that qualifies for registration under the Act. It would be unfathomable to have a situation where use of one's company name would amount to infringement of a trade mark which was

registered after the company had already been legally and procedurally incorporated as in the case of the Applicants.

I had earlier indicated that the Proprietors' mark "MABATIMAISHA" and the Applicants' mark "MAISHA MABATI" are virtually identical conceptually, phonetically and visually. It is therefore my view that considering all the circumstances of these expungement proceedings, the Proprietors' claim to the mark "MABATIMAISHA" cannot be said to be valid and legal. Their claim to be the proprietors of the mark "MAISHA MABATI" as at 31st January 2008 had already been preceded by the Applicants' effecting a change of their company name to Maisha Mabati Mills Limited.

I therefore hold that the Proprietors did not have a valid and legal claim to the mark "MABATIMAISHA" (WORD) before applying to register the same in accordance with the provisions of section 20(1) of the Trade Marks Act.

2. Are the Applicants aggrieved persons in accordance with the provisions of section 35 of the Trade Marks Act?

Section 35 (1) of the Trade Marks Act provides as follows:

"Any person aggrieved by the non-insertion in or omission from the register of an entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the court or, at the option of the applicant and subject to the provisions of section 53, to the Registrar, and the court or the Registrar may make such order for making, expunging or varying the entry as the court or the Registrar may think fit."

The Applicants claim to be aggrieved persons for the following reasons:

- (a) The Proprietors are not the true owners of the mark "MABATIMAISHA" that is similar to the Applicants' mark "MAISHA MABATI" which was derived from the Applicants' company name Maisha Mabati Mills Limited; and
- (b) The Applicants' application to register their trade mark "MAISHA MABATI" was rejected by the Registrar of Trade Marks on account of the existence of the Proprietors' mark "MABATIMAISHA" in the Register of Trade Marks.

On the other hand, the Proprietors state that the Applicants are not

aggrieved because;

- (a) The Proprietors are the true owners of the mark "MABATIMAISHA", which was created from their company name Mabati Rolling Mills Limited and indicates the longevity of their products; and
- (b) Having filed an application to register the application for registration of the mark "MABATIMAISHA", which was approved, published and registered without opposition proceedings being filed, the Proprietors have a right to registration of their mark.

In the Kenyan case of Saudi Arabia Airlines Corporation V Saudia Kenya Enterprises Limited, the Court of Appeal stated as follows:

... it is clear that Saudi Arabia Airlines Corporation was substantially interested in having each mark removed from the Register. And its interests would probably be damaged if these marks remained on it as those of Saudia Kenya Enterprises Limited.

And it is certain that as rival travel promoters, in Kenya, assuming they are for the moment, Saudia Kenya Enterprises Limited would be gaining an advantage from these registered trade marks as its own which would be wrong if it were not entitled to them and certainly qualify Saudi Arabia Airlines Corporation as an aggrieved person for the purpose of section 35 of the Act."

The learned author of the book Kerly's Law on Trade Marks and Trade Names, Tenth Edition, states as follows on page 203, paragraph 11-02-

"The persons who are aggrieved are ... all persons who are in some way or other substantially interested in having the mark removed ... from the Register; including all persons who would be substantially damaged if the mark remained, and all the trade rivals over whom an advantage was gained by a trader who was getting the benefit of a registered trade mark to which he was not entitled".

After considering all the relevant circumstances of these expungement proceedings, I am of the view that the Applicants are aggrieved persons under the provisions of the Trade Marks Act for the following reasons:

- (a) I have already considered the issue of whether or not the Proprietors have a valid and legal claim to the mark "MABATIMAISHA" in respect of "steel flat sheets and profiled sheets and coils" in the Kenyan market. I have determined

that the Proprietors have no valid and legal claim to the mark on account of the Applicants' company name Maisha Mabati Mills Limited which was registered before the Proprietors' trade mark "MABATIMAISHA" was entered in the Register of Trade Marks. In the Australian case of Kraft Foods Inc (Previously Known As Kraft General Foods, Inc) v Gaines Pet Foods Corporation [1996] FCA 1337 (22 March 1996), the Court cited the case of Paine and Co v Daniells and Sons' Breweries where it was stated as follows:

"The purity of the register of trade marks - if one may use the expression - is of much importance to trade in general; quite apart from the merits or demerits of particular litigants. If on a motion like the present the attention of the court is called to an entry on the register of a trade mark which cannot in law be justified as a trade mark, it seems to me that the court's duty may well be - whatever the demerits of the applicant - to purify the register and to expunge the illegal entry in the interests of trade... As a rule, the court on being seized of the matter, would doubtless put an end to the existence of a trade mark which could not possibly be justified by law."

Ordinarily, when applicants present themselves before the Registrar of Trade Mark to make an application for registration of a trade mark, they are saying to the Registrar that they have a legal and valid claim as the proprietors of the respective mark. If the applicants do not have such a claim that is recognized in law, they would obtain the registration of the mark irregularly as is the case with the Proprietors in these proceedings. The Applicants are therefore aggrieved persons and have a right to seek the purity of the Register by having TMA No. KE/T/2008/62668 "MABATIMAISHA" expunged therefrom because the same "cannot in law be justified as a trade mark".

- (b) As indicated in the pleadings herein, on 29th September 2008, the Applicants made an application TMA No. KE/T/2008/64174 to enter their trade mark "MAISHA MABATI" in the Register of Trade Marks. However, the said application was refused on account of the aforementioned TMA No. KE/T/2008/62668 "MABATIMAISHA" that had been registered in the name of the Proprietors. As long as the said trade mark of the Proprietor subsists in the Register of Trade Marks, the

Applicants' trade mark "MAISHA MABATI" cannot proceed to publication and eventual registration. In the UK case referred to as *Powell v The Birmingham Vinegar Brewery Co Ltd*, Lord Herschell stated as follows:

"In my opinion, any trader is, in the sense of the statute 'aggrieved' whenever the registration of a particular trade-mark operates in restraint of what would otherwise have been his legal rights. Whatever benefit is gained by registration must entail a corresponding disadvantage upon a trader who might possibly have had occasion to use the mark in the course of his business. It is implied, of course, that the person aggrieved must manufacture or deal in the same class of goods to which the registered mark applies, and that there shall be a reasonable possibility of his finding occasion to use it, I should be very unwilling unduly to limit the construction to be placed upon [the words 'person aggrieved'], because, although they were no doubt inserted to prevent officious interference by those who had no interest at all in the register being correct and to exclude a mere common informer, it is undoubtedly of public interest that they should not be unduly limited, inasmuch as it is a public mischief that there should remain upon the register a mark which ought not to be there, and by which many persons may be affected who nevertheless would not be willing to enter upon the risks and expense of litigation. Wherever it can be shown, as here, that the applicant is in the same trade as the person who has registered the trade mark, and wherever the trade mark if remaining on the register would or might limit the legal rights of the applicant so that by reason of the existence of the entry upon the register he could not lawfully do that which but for the appearance of the mark upon the register he could lawfully do, it appears to me that he has a *locus standi* to be heard as a 'person aggrieved'."

In the Australian case of *Ritz Hotel v Charles of the Ritz* the Court stated as follows:

"From the time of commencement of these proceedings the plaintiff has been an applicant for registration of the trade mark RITZ in respect of all goods in Class 3. Each of the four subject marks registered in respect of goods in Class 3 is a serious obstacle to the success of the plaintiff's

application for registration of that mark. Those circumstances alone are in my opinion sufficient to constitute the plaintiff a "person aggrieved" in respect of each of those four marks, regardless of the merits or deficiencies on other grounds of the plaintiff's application for registration."

Both the Applicants and the Proprietors are involved in the business of manufacturing iron sheets and offering the same for sale in the Kenyan market. As indicated in the pleadings that were filed herein by the Applicants they are unable to register their trade mark "MAISHA MABATI", which is derived from their company name, due to the existence of the TMA No. KE/T/2008/62668 "MABATIMAISHA". As I had indicated earlier, section 12 (1) (a) of the Trade Marks Act includes the name of a company as one of the essential elements of a mark that qualifies for registration under the Act. This means that the Applicants have a legal right to have their mark "MAISHA MABATI" entered in the Register of Trade Marks in respect of goods in class 6 of the International Classification of Marks including iron sheets. As long as the Applicants cannot exercise the aforementioned legal right as stated in the said case of *Powell v The Birmingham Vinegar Brewery Co Ltd*, then they are qualified as aggrieved persons under the provisions of the Trade Marks Act; and

- (c) In 2010, and while these proceedings were still pending, the Proprietors filed infringement proceedings against the Applicants herein. The Proprietors sought to have the Applicants barred from infringing on their registered trade mark TMA No. KE/T/2008/62668 "MABATIMAISHA" under High Court Civil Case 380 of 2010. Where a person who is using a mark is sued for infringement, then that person qualifies as an aggrieved person in respect of expungement proceedings relating to the said mark. In the Supreme Court of India case of *National Bell Co. & Another vs Metal Goods Mfg. Co. (P) Ltd. & Another*, the Court observed that the expression "aggrieved person" has received liberal construction from the courts and includes a person who has, before registration, used the trade mark in question as also a person against whom an infringement action is taken or threatened by the registered proprietor of such a trade mark. A person aggrieved includes rivals in the same trade who are aggrieved by the entry of rival's mark in the register of trade

marks or persons who are in some way or the other substantially interested in having the mark removed from the register or persons who would be substantially damaged if the mark remained on the register."

The Applicants herein have used the trade mark "MAISHA MABATI" in the Kenyan market for a number of years now in respect of goods of an identical description as those in respect of which the Proprietors' mark "MABATIMAISHA" was entered in the Register of Trade Marks. The use of the said Applicants' mark would certainly be curtailed by the subsistence of the trade mark "MABATIMAISHA" in the Register of Trade Marks and the infringement proceedings at the High Court of Kenya.

I am of the view that the Applicants have an interest in seeking to ensure the purity of the Register of Trade Marks and I am convinced that the Applicants are not mere busy bodies. I do not agree with the contention of the Proprietors that the Applicants are not aggrieved persons because they did not oppose registration of the Proprietors' mark. In the Australian case of *Health World Ltd v Shin-Sun Australia Pty Ltd*, the Court stated as follows:

... the legislative scheme reveals a concern with the condition of the Register of Trade Marks. It is a concern that it have "integrity" and that it be "pure". It is a "public mischief" if the Register is not pure, for there is "public interest in [its] purity". The concern and the public interest, viewed from the angle of consumers, is to ensure that the Register is maintained as an accurate record of marks which perform their statutory function – to indicate the trade origins of the goods to which it is intended that they be applied. This concern and this interest are reflected in the following scheme. If an application is made to have a mark registered which does not meet the criteria for registration, there are two opportunities for registration to be prevented. And if a mark has been registered which does not meet the criteria for remaining on the Register, a further opportunity exists to have the Registrar adjust it.

... While the Act offers these facilities for ensuring that the Register is pure in the sense that no mark is to be registered unless valid, and no registration of a mark is to continue if it is not valid, the purpose of ensuring purity exists alongside another purpose. That is the purpose of preventing the security of the Register from being eroded by applications for rectification or removal by busybodies or "common informers or strangers proceeding wantonly" or persons without any interest in the Register or

the functions it serves beyond gratifying an intellectual concern or reflecting "merely sentimental motives". Applications of that kind, by clogging up and causing delay in the courts, would cause an unnecessary cloud to hang over registrations. ... Applications by persons who are not aggrieved are positively inimical to the fulfilment of the statutory purposes through the Register."

The law of trade marks allows a person who did not get an opportunity to oppose registration of a mark to make an application to rectify the Register. It is for the said purpose that the provisions of section 35 were included in the Trade Marks Act. This is the opportunity that the Applicants herein are appropriately utilizing. I am of the view that the Applicants are aggrieved persons in accordance with the provisions of section 35 of the Trade Marks Act.

Conclusion

- (a) For the above-mentioned reasons and on a balance of probabilities, I have come to the conclusion that the Applicants have succeeded in these expungement proceedings;
- (b) I hold that the Proprietors' trade mark No. KE/T/2008/62668 "MABATIMAISHA" was entered in the Register of Trade Marks without sufficient cause and in error since the Applicants were not entitled to the same;
- (c) The Register of Trade Marks is hereby rectified by expunging the said trade mark No. KE/T/2008/62668 "MABATIMAISHA" from the Register under the provisions of section 35 of the Trade Marks Act; and
- (d) I award the costs of these expungement proceedings to the Applicants.

Eunice Njuguna
Assistant Registrar of Trade Marks

5th Day of September 2013

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

Eunice Njuguna
Assistant Registrar of Trade Marks

5th Day of September 2013