

KENYA INDUSTRIAL PROPERTY INSTITUTE



Popo Rd, off Mombasa rd.
South 'C'
P.O. Box 51648-00200, Nairobi.
Tel. 802210/11
E-mail: kipi@swiftkenya.com
www.kipi.co.ke

THE TRADE MARKS ACT CAP 506 OF THE LAWS OF KENYA

AND

IN THE MATTER OF TRADE MARK NO. KE/T/2008/63557 "OMEGA SCHOOL BOARDS AND ACCESSORIES" (WORDS AND DEVICES) IN CLASS 16 IN THE NAME OF OMEGA SCHOOL BOARDS AND ACCESSORIES LIMITED AND EXPUNGEMENT PROCEEDINGS THERETO BY OMEGA CHALK INDUSTRIES (1993) LIMITED AND CHEMICAL AND SCHOOL SUPPLIES LIMITED

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

Background

On 2nd July 2008, Omega School Boards and Accessories Limited (hereinafter referred to as "the Proprietors") filed an application to register their trade mark no. KE/T/2008/063557 "OMEGA SCHOOL BOARDS AND ACCESSORIES" (WORDS AND DEVICES) (hereinafter referred to as "the mark") before the Registrar of Trade Marks. The application was filed in international class 16 of the International Classification of Goods and Services Purposes of Registration of Marks in respect of "instructional and teaching materials especially boards and their accessories".

The Registrar duly examined the application for registration of the mark in accordance with the provisions of the Trade Marks Act, Cap 506 of the Laws of Kenya. On 22nd July 2008, the application was approved and published in the Industrial Property Journal of 30th September 2008, on page 32. Upon expiry of the sixty-day statutory period, the mark was entered in the Register of Trade Marks with effect from the said 2nd July 2008 and a Certificate of Registration was issued. On 29th February 2012, Omega Chalk Industries (1993) Limited and Chemical and School Supplies Limited (hereinafter referred to as "the Applicants") filed an application for expungement of the mark.

The grounds of application were as follows:

1. THAT ... Omega Creative Industries (1993) Limited is the manufacturer of the products known as Omega Dustless Chalk and have been

producing the same for over 20 years. The same are produced at its factory in Jordan. A copy of the product's packaging both coloured and white are to be found at **Annexure D** of the Bundle of exhibits attached hereto.

2. THAT Chemical and School Supplies Limited has been importing from Omega Creative Industries (1993) Limited and exclusively distributing the said chalk to various outlets within the East and Central African Region for the last 20 years under several memoranda of understanding entered into between the two companies. Copies of the Memoranda, Importation documentation and evidence of importation, payment of taxes and duties and Kenya Bureau of Standard are annexed hereto and marked as Annexure E of the Bundle of exhibits.
3. THAT sometime in the years 2004, 2006 and again in the year 2010 Chemical and School Supplies Limited attempted to register the Trade mark "Omega Dustless Chalk" under class 16 which application was rejected for the reason that the mark was already registered by a Swiss Watch Manufacturer being Trade Mark No. 614933 "OMEGA" across all the Classes including the said Class 16 in the name of (Omega AG) Omega Limited of Jacob Stampfli-Strassee-Switzerland and as such the same was not available for registration. Annexed hereto and marked Annexure F is the pertinent Application for Registration and the letter from the office of the Registrar of Trade Marks.
4. THAT shortly thereafter I discovered that an entity by the name Omega School Boards and Accessories Limited had registered the Trade mark "Omega Dustless Chalk" under Class 16 on the 2nd day of July, 2008 and a Certificate issued by the Registrar. A copy of the Certificate is annexed hereto and marked Annexure G.
5. THAT the Applicants believe that the said Trade Mark should be expunged from the Register on the following grounds:-
 - (a) The Registration of the Trade Mark offends Section 15A of the Trade Marks Act Cap. 506 in so far as it purports to register a trademark that is of a well known and already registered brand, registered under an International registration regime recognized in Kenya being Trade Mark No. 614933 "OMEGA" in all classes in the name of Omega as (Omega AG) Omega Limited of Jacob Stampfli - Strassee, Switzerland.

- (b) The proprietor's Trade mark is invalid having been registered by an entity which at the time of the purported registration was not legally existent (see the official search certificate annexed hereto as Annexure H which shows the proprietor's date of incorporation as being the 8th day of October, 2009 while the Certificate of Registration of its Trade mark is the 2nd day of July, 2008).
- (c) In the alternative and without prejudice to the foregoing grounds, the Registration of the Trade Mark offends Section 15 of the Trade Marks Act Cap. 506 which specifically precludes Registration of a Trade Mark of a well known mark being "Omega" TM No. 614933 aforesaid and "Omega Dustless Chalk".
- (d) The Registration is coloured with fraud, deception, non-disclosure/concealment, error, mistake, misrepresentation of material facts and that the mark infringes on a mark registered and recognized Internationally being "Omega" Trade Mark number 614933 in the name of Omega Sa (Omega AG) Omega Limited of Switzerland and that the same is liable to being expunged under Section 16 I (a) and (b) of the Trade Mark Act Cap. 506.
- (e) The Trade Mark does not meet the threshold of distinctness enshrined on Section 12 of the Trade Mark Act Cap 506.
- (f) THAT the Trade Mark offends the Provisions of Section 18(2) (b) (i) and (ii) since the proprietor did not register a disclaimer knowing fully well that the words used were well known and solely consisted words, descriptions and pictures (graphics) which were under Common Law and registration in use in trade and protection before the proprietor's purported registration both by the Applicants and the above said Omega Sa (Omega AG) Omega Limited of Switzerland
- (g) The Trade Mark was registered without any bona fide intention on the part of the proprietor that it should be used in relation to those goods or services by it, and that there has in fact been no bona fide use of the Trade mark in relation to the goods or services by the proprietor and the same is thus liable to being 'taken off the Register pursuant to Section 29(1) of the Trade Marks Act.
- (h) By virtue of the fraud, non disclosure, misrepresentation, wrong entry, error and/or defect aforesaid the Registrar should direct that

the said registration of the Trade Mark should be cancelled and/or that the register be rectified so as to enter an appropriate disclaimer or memorandum relating to the Trade Mark Pursuant to Rules 25 and 35 of the Trade Marks Act.

- (i) The Proprietor has acquiesced for a period of more than 5 years to the continuous use of the registered trade mark and is therefore estopped from the exclusive use of the Trade mark or opposition thereto as enshrined in Section 36B of the Trade Mark Act Cap. 506. (For further evidence also see **Annexure J** hereof).
6. The Applicants have had continuous trade use of the products protected under the Trade Mark for a period of over 20 years and as such have acquired a common law right upon the said Trade Mark as recognized under Section 49 of the Trade Marks Act See **Annexure marked H** for evidence of long trade use.
7. THAT the proprietor has lodged a complaint with the Anti Counterfeit Authority in which complaint the proprietor has alleged abuse of its intellectual property rights and has caused the said Agency to issue a seizure order in situ against the 2nd Applicant and his suppliers. Copies of the Court Order and seizure Orders are annexed hereto and found at Annexure **marked I** in the bundle of exhibits attached hereto. Also see letters from the Second Applicant's clients showing long-standing dealings in the products at **annexure J**.
8. THAT the proprietor has since withdrawn the complaint against the Second Applicant's customers and as a consequence has actively acquiesced in the trade use of the Trade Mark of the goods he purports infringed on his Trade Mark hence the Applicants plea of estoppel under Section 36B of the Trade Marks Act (**Annexure K** is a copy of a letter from the Applicant withdrawing his complaint against the Suppliers).
9. The Applicants are apprehensive that their businesses and distribution outlets with turnover stock worth over US Dollars 400,000 per annum and business reputation of over twenty years is at stake and stand the risk of waste and irreparable loss should the prayer sought in the Application filed herewith not issue.
10. THAT I verify that the Cause of action mentioned in these proceedings arises out of facts, which are true and correct to the best of my knowledge.

11. THAT to the best of my knowledge and recollection, there is no other suit pending and there have been no previous Proceedings in any Court between the Plaintiff and the Defendant over the matter the subject hereof herein save for those specifically mentioned herein and letters exchanged between Lawyers for the respective parties which letters are annexed hereto and marked as **Annexure L**.

The application was duly forwarded to the Proprietors who on 9th May 2012 filed their Counter-Statement. The Proprietors stated the following as the grounds on which they would rely in support of their registration:

1. That the Respondent is the Registered Proprietor of Trade Mark No.63557 "OMEGA SCHOOL BOARDS AND ACCESSORIES (device) (hereinafter referred to as the Respondent's Mark).
2. That the Applicant's Application for Making, Expunging or Varying on an entry in the Register (TM 25) filed at the Kenya Industrial Property Institute on the 29th February 2012 is defective ab initio and we shall at the appropriate moment apply to the Registrar of Trade Marks for expungement of the same from record.
3. Without prejudice to the foregoing we state as follows:
4. The Respondent's Mark was registered in the Kenya Industrial Property Institute on the 2nd July 2008 under Class 16 in respect of instructional and teaching materials especially boards and their accessories and has been in use since then.
5. That at the time of registration of the Respondent's Mark the Respondent was trading in the name and style Omega School Boards and Accessories which name was subsequently changed into Omega School Boards and Accessories Limited and the change was notified and registered by the Registrar of Trade Marks vide the Certificate of Change of Name dated 26th October 2009.
6. That prior to the registration of the Respondent's Mark, the Respondent had been using its mark to market its products in Kenya for a long duration.
7. That due to use of the Respondent's mark for a long duration of time, the Respondent's Mark has become well known amongst consumers of the products marketed under the Respondent's mark.

8. That the Respondent has been importing its products under class 16 notably dustless chalk from the Middle East and the Far East in bulk and thereafter repackaging the same into small units in packets bearing the Respondent's Mark.
9. That the consumers of the Respondent's products have come to associate the Respondent's products with its mark.
10. That in the year 2009, the Respondent realized that the 2nd Applicant was marketing dustless chalk in Kenya in packets bearing the mark "OMEGA" whereupon the Respondent through their Advocates Nyaguthie Njuguna & Company Advocates sent a demand letter to the 2nd Applicant demanding that they desist from use of the mark "OMEGA SCHOOL BOARDS AND ACCESSORIES (device)" as the Respondent was the registered proprietor of the Trade Mark Number 63557 "OMEGA SCHOOL BOARDS AND ACCESSORIES (device)".
11. That further to paragraph 10 above, after receipt of the Respondent's demand, the 2nd Applicant did not desist from use of the Respondent's Mark but insisted on continued use of the same under the guise that the mark is registered under the laws of Israel where the manufacturer of the products is situated and as such they had all the rights to use the mark.
12. That further to paragraph 11 above, after the 2nd Applicant's refusal and neglect to desist from use of the Respondent's Mark, the Respondent through their Advocates, Messrs Kiai Nuthu & Associates informed the Distributors and Stockists of their products of existence in the market of counterfeit goods/ goods bearing the Respondent's Mark.
13. That use of the Respondent's Mark by the 2nd Applicant and the refusal to desist from using the mark despite the Respondent's demand they desist from using the same, is an attempt by the 2nd Applicant together with its alleged partner, the 1st Applicant to ride on the goodwill that the Respondent's Mark has acquired over a period of time.
14. That further to paragraph 13 above, the Respondent has suffered losses amounting to millions of Shillings due to the use of their mark by the Applicants.

15. That the Applicants herein Omega Chalk Industries (1993) Ltd and Chemical and School Supplies Ltd have no locus/ standing to institute this Application under Section 15A of the Trade Marks Act (Chapter 506) for reasons stated below.
16. That the Respondent has no knowledge of the contents of paragraphs 1, 2 and 3 of the Applicants' Application save to state that:
- (i) There has been no disclosure of any interest or interests that Omega Chalk Industries (1993) has in the subject application;
 - (ii) Omega Creative Industries (1993) is a stranger to the subject application.
17. That the Respondent is a stranger to the contents of paragraphs 4 and 5 of the Applicants' Application and puts the Applicant to strict proof thereof.
18. That in response to paragraph 6 of the Applicants' Application we aver that the Respondent is a stranger to the contents thereon and further reiterate the contents of paragraph 16.
19. That in reply to paragraph 7 we aver that the fact that the Applicants applied for registration of the mark "OMEGA DUSTLESS CHALK" under class 16 and the same was rejected is not a concern of the Respondent whose mark is "OMEGA SCHOOL BOARDS AND ACCESSORIES" (device) and the Applicants had a recourse with the Registrar of Trade Marks on the rejection of the mark they had applied for. We further aver their claim as contained in paragraph 7 is non-starter, in bad faith and does not add value to their continued use of the Respondent's Mark.
20. That in reply to paragraph 8 of the Applicants' Application we reiterate the contents of paragraph 4 above and further aver that the Respondent's Mark is "OMEGA SCHOOL BOARDS AND ACCESSORIES" (device) and not "OMEGA DUSTLESS CHALK" as alleged by the Applicants.
21. That in reply to paragraph 9 of the Applicants' Application we state that:-

- (a) the Applicants are put to strict proof the contents of paragraph 9 (a) and further aver that the Applicants have no instructions to defend the alleged owners of Trade Mark Number 614933 "OMEGA".
- (b) In response to paragraph 9 (b) we reiterate the contents of paragraph 5 above.
- (c) In response to paragraph 9 (c) we deny the contents thereof and put the Applicants to strict proof.
- (d) The Applicants have also not stated whether 'Omega Dustless Chalk' is the registered Trademark of Chemical and School Supplies Ltd's supplier or suppliers namely: Omega-Israel, Omega Creative Industries (1993) Ltd, Omega Chalk Industries (1993) Ltd or Omega-a Collective Agriculture Association.
- (e) That the Respondent's Mark is distinctive and meant to distinguish the products of the Respondent from those of other traders as it is composed of a pictorial element comprising a laughing Bumble Bee holding a black briefcase on the left hand and a club on the other; a diagonal streak of yellow clouds and a bundle of seven grey clubs on the bottom right hand corner with the background colour scheme of the logo being Cyan Blue and a streak of yellow surrounded by red and the text in the logo being 'OMEGA SCHOOL BOARDS AND ACCESSORIES'.
- (f) We deny the contents of paragraph 9 (f) and state that the Respondent did register a disclaimer of the words "SCHOOL" and BOARDS".
- (g) In response to paragraph 9 (g) the Respondent wishes to state that it has been using its mark and continues to use the same on goods in class 16 and therefore the Applicants are put to strict proof of their malicious allegations contained in the said sub paragraph.
- (h) The Respondent has not acquiesced to continued use of its mark by the any person the Applicants included. As a matter of fact the Respondent has taken necessary action by informing the Registrar of Trade Marks (vide their letter dated 12th October 2010) and its stockists and distributors of the continued use of its mark by the Applicants We deny the

contents of paragraph 9 (h) and put the Applicants to strict proof of their allegations.

22. That in response to paragraphs 10 and 11 of the Applicants' Application, it is averred that the contents thereon are an afterthought, as they do not concern the issue before the registrar. The mentioned Anti Counterfeit Agency deals with goods whereas the issue before the Registrar is whether the Respondent's Mark is valid and whether it was properly entered in the Register of Trade Marks.

23. That the Respondent is a stranger to the contents of paragraphs 12, 13, 14, 15 and 16 and puts the Applicants to strict proof thereof.

The Counter Statement was forwarded to the Applicants who on 19th July 2012 filed their statutory declaration sworn by Amit Shah, the Managing Director of Chemical and School Supplies Limited, one of the Applicants herein. Mr. Amit Shah 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 30th July 2012 filed their Statutory Declaration. The Declaration was sworn by Richard Nguhu Kimani, the Managing Partner of the Proprietors who also 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 29th August 2012. The Declaration was sworn by the said Amit Shah 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 25th January 2013 while the Proprietors filed their written submissions on 13th February 2013. Upon filing of written submissions, the parties appeared before me on 24th July 2013 to highlight on the said written submissions.

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 Lubulellah & Associates Advocates for the Applicants and Nyaguthie Njuguna & Company Advocates for the Proprietors as well as the highlights made by the respective Advocates on the written submissions. 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 "OMEGA SCHOOL BOARDS AND ACCESSORIES" 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 the said issues:

- 1. Did the Proprietors have a valid and legal claim to the mark "OMEGA SCHOOL BOARDS AND ACCESSORIES" before applying to register the same in accordance with the provisions of section 20(1) of the Trade Marks Act?**

To identify their goods, "instructional and teaching materials especially boards and their accessories", in class 16 of the International Classification of Goods and Services for Purposes of Registration of Marks, the Proprietors adopted the trade mark "OMEGA SCHOOL BOARDS AND ACCESSORIES" (WORDS and DEVICES) which they claim to be the rightful owners in the Kenyan market. The trade mark was entered in the Register of Trade Marks with effect from 2nd July 2008. The trade mark is a composite mark comprised of the words "OMEGA", "SCHOOL", "BOARDS" "AND" and "ACCESSORIES" and the devices of chalk and a laughing bumble bee and is in colours blue, red, white and yellow. The Proprietors claim to have used the mark in the said Kenyan market for a long while and the purchasers of their goods have come to identify the said goods with the Proprietors. On the other hand, the Applicants' claim is that the said mark does not belong to the Proprietors but to Omega Creative Industries (1993) Limited, who has been manufacturing dustless chalk referred to as "OMEGA Dustless Chalk" for the last 20 years in Jordan. Chemical and School Supplies Limited, the 2nd Applicants herein have been importing the said dustless chalk from the said Omega Creative Industries (1993) Limited and exclusively distributing the same in the said Kenyan market and other outlets within the East and Central African Region. The Applicants also claim that when they sought to register a similar mark, their application was not allowed by the Registrar of Trade Marks on account of the trade mark "OMEGA" which had been registered in all classes in the name of Omega Sa (Omega AG) Omega Limited

of Switzerland. It is therefore the Applicants' case that the Proprietors' mark should have been refused registration in accordance with the provisions of section 15A of the Trade Marks Act. The Applicants also claim that the Proprietors' mark is not distinctive and was registered without a disclaimer as provided for under the law.

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."

In the UK case of Registrar of Trade Marks V W & du Cros Ltd, Lord Parker stated as follows:

"The Applicant for registration in effect says, 'I intend to use the mark as a trade mark, i.e. for the purpose of distinguishing my goods from the goods of other persons,' and the Registrar or the Court has to determine before the mark be admitted for registration whether it is such of a kind that the applicant, quite apart from the effects of registration, is likely or unlikely to attain the object he has in view".

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. 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."

As aforementioned, on 2nd July 2008 the Proprietors made an application before the Registrar of Trade Marks to register their mark "OMEGA SCHOOL BOARDS AND ACCESSORIES" (WORDS and DEVICES) in respect of goods in class 16 of the International Classification. Registration of the Proprietors' mark was effected from the said 2nd July 2008 and is valid on the Register of Trade Marks up to 2nd July 2018.

I am of the view that the Proprietors have a valid and legal claim to the mark. Firstly, it is apparent from the evidence filed that the Proprietors have been using the trade mark "OMEGA" in the Kenyan market since 1997 for various goods in class 16, including their own stationery. This is clearly indicated by the various copies of cash sales/ invoices that have been attached to the Statutory Declaration that was filed herein by the Proprietors. In response to the said evidence that was filed by the Proprietors to signify the said use of the trade mark "OMEGA", the Applicants stated in their Statutory Declaration In Reply that the same amounts to "covert admission of its trading in the 1st Applicant's products from as early as 1997". However, I am of the view that the Proprietors were actually using their trade mark in the Kenyan market legally thereby creating goodwill in the said market to the exclusion of other traders. The law of trade marks recognises that the function of a trade mark is to enable the respective proprietor to distinguish their goods in a particular market and to exclude others from using a similar or an identical mark in the same market in respect of goods or services of a similar description.

Secondly, as earlier indicated, the Proprietors' mark also comprises the Proprietors' name Omega School Boards and Accessories Limited. However, and as aforementioned, the Applicants are of the view that the Proprietors' said mark is not qualified for registration under the Trade Marks Act since the same is not capable of distinguishing the goods of the Proprietors in the Kenyan market. 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. Further, in the case of *Mabatli Rolling Mills Ltd v Maisha Mabatli Mills Ltd*, the court stated as follows:

"Suffice it to observe that in the case of *Assabwalla v Khadija Bint Gafoor & Others*, the Court of Appeal held that the bona fide user by a man of his name was protected by the law, whether he traded under that name, or whether he used it as a trade mark in respect of his goods, and that a person will not lose that protection merely because confusion may result from the use by that person of his own name. That which applies to a human person applies equally to a Company, which is a legitimate legal person in its own right. A Company is in law entitled to use and carry on business in its registered name unless it can be demonstrated that in so doing it is not acting bona fides."

Considering that the Proprietors have been using the trade mark OMEGA that is comprised of their name, for more than fifteen years now without interruption and with no issues being raised by any person, it means that they have created sufficient goodwill in the Kenyan market, they have been acting bona fides and they have acquired a valid and legal claim to their mark. As indicated in the aforementioned case of *Vitamins Trade Marks*, the lengthy use of the Proprietors' mark in the Kenyan market enables the Proprietors to have a proprietary right in the said mark that is justifiable.

As specified by the learned author of the book *Kerty's Law on Trade Marks* in the paragraphs quoted herein above, I am convinced that the Proprietors can make a claim to the mark in good faith. For this reason, I am of the view that the Proprietors have a valid and legal claim to their mark "OMEGA SCHOOL BOARDS AND ACCESSORIES" (WORDS and DEVICES), which was entered in the Register of Trade Marks for a good cause and without fraud.

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) Registration of the mark "OMEGA SCHOOL BOARDS AND ACCESSORIES" (WORDS and DEVICES) offends the provisions of section 15A of the Trade Marks Act since the mark is similar to a well-known mark "OMEGA" in the name of Omega SA (Omega AG) Omega Limited;
- (b) Registration of the mark in the name of the Proprietors was "coloured with fraud, deception, non-disclosure/concealment, error, mistake, misrepresentation of material facts and that the mark infringes on a well-known mark registered and recognized internationally being "Omega" Trade Mark number 614933 in the name of Omega Sa (Omega AG) Omega Limited of Switzerland" and that the mark did not qualify for registration under the provisions of section 15A of the Trade Marks Act; and
- (c) The 1st Applicants are the owners of the trade mark "OMEGA DUSTLESS CHALK" (WORDS and DEVICES) in Kenya which they licensed the 2nd Applicants to use in the Kenyan market and which has been used in the said market for a period of twenty (20) years.

On the other hand, the Proprietors state that the Applicants are not aggrieved persons because;

- (a) The Proprietors are the true owners of the trade mark "OMEGA SCHOOL BOARDS AND ACCESSORIES" (WORDS and DEVICES) which they have been using in the Kenyan market since the year 1997. The Proprietors made an application for registration of their trade mark in Kenya which was duly approved for registration and was entered in the Register of Trade Marks with effect from 2nd July 2008;
- (b) Prior to registration of the trade mark, the Proprietors had used the mark in Kenya for a long period of time and therefore, the consumers of the Proprietors' products have come to

associate the Proprietors' products with their mark; and

- (c) The Applicants have no locus standi to institute the application under section 15A of the Trade Marks.

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".

In the UK case referred to as *Powell v The Birmingham Vinegar Brewery Co Ltd*, Lord Herschell stated as follows:

"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 referred to as *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."

In the WIPO Intellectual Property Handbook: Policy Law and Use, it is stated as follows on page 83 with regard to removal of trade marks from the Register: "Normally, removal from the Register is ordered only if the grounds for invalidity already existed when the trade mark was registered. Moreover, even if the trade mark should not have been registered owing to lack of distinctiveness, its cancellation is excluded if in the meantime it has become distinctive by use".

After considering all the relevant circumstances of these expungement proceedings, I am of the view that the Applicants do not qualify as aggrieved persons under the provisions of the Trade Marks Act for the following reasons:

- (a) According to the pleadings filed, it is impossible to tell who actually owns the mark "OMEGA DUSTLESS CHALK" which the Applicants claim to have used in the Kenyan market for the last twenty (20) years, a ground that the Applicants are relying on in these expungement proceedings. First, the 1st Applicants herein are known as Omega Chalk Industries (1993) Limited. These are the actual parties as indicated on the title of the Form TM 25 that was filed by the Applicants on 25th February 2012 and the Statutory Declaration that was sworn and filed on behalf of the Applicants by one Amit Shah on 19th June 2012. However, in the actual pleadings including the said Statutory Declaration, Omega Chalk Industries (1993) Limited does not feature at all. The firm that features is one referred to as Omega Creative Industries (1993) Limited. Are these two companies one and the same entity? Second, on paragraph 4 of the said Statutory Declaration that was sworn and filed on behalf of the Applicants, it is

averred that Omega Creative Industries (1993) Limited was registered in the Republic of Israel on 29th December 1993 while the copy of the Certificate of Registration annexed thereto refers to Omega, a Collective Agriculture Association, an entity that was associated and registered as a collective association on 29th April 2007. With a total of three (3) different entities being referred to as the 1st Applicants, it is impossible to tell which party really owns the said mark "OMEGA DUSTLESS CHALK" and who qualifies as an aggrieved person. The situation gets further complicated for the reason that the 2nd Applicant claims to have applied to register the same mark "OMEGA DUSTLESS CHALK" which application was rejected by the Registrar of Trade Marks because of the mark "OMEGA" that had been registered in the name of Omega Sa (Omega AG) Omega Limited of Switzerland. One can only make an application to register a mark in which they can have a valid and legal claim to. It is not therefore clear if the 2nd Applicants considered themselves as the owners of the mark "OMEGA DUSTLESS CHALK" while their pleadings indicate that they are distributors of the goods bearing the mark "OMEGA DUSTLESS CHALK" from the 1st Applicants. When the Proprietors raised this issue in their pleadings, the Applicants responded by indicating that the description of the 1st Applicants "is clearly put to rest by the documentation produced as annexure B of the Statutory Declaration filed herein by the Applicants". However, a consideration of the said annexure B to the Applicants' Statutory Declaration reveals that the annexure referred to is a Certificate of Incorporation of the 2nd Applicants, which was dated 15th November 1998. In addition, the Applicants state that the Proprietors' mark should not have been registered due to the existence in the Register of Trade Marks of the mark "OMEGA" that had been registered in the name of Omega Sa (Omega AG) Omega Limited of Switzerland. It is my view that this is a contradiction on the part of the Applicants who have claimed to have used their mark "OMEGA DUSTLESS CHALK" in the Kenyan market for the last twenty (20) since the use would amount to infringement of the said mark that is registered and owned by Omega Sa (Omega AG) Omega Limited. The Applicants have not been able to show which interests each of the entities referred to in their pleadings represent and it is therefore impossible to determine how each of the said entities would qualify as an aggrieved person as provided for under the Trade Marks Act;

- (b) The Applicants' contention that the Proprietors' mark "OMEGA SCHOOL BOARDS AND ACCESSORIES" (WORDS and DEVICES) should be expunged from the Register of Trade Marks under the provisions of section 15A of the Trade Marks Act on account of the trade Mark "OMEGA" in the name of

Omega Sa (Omega AG) Omega Limited is unsupported. Any person claiming that a trade mark is well-known in the Kenyan market has to submit evidence to prove that the mark is recognized by the relevant segment of the market and has to show the extent of the reputation that the mark enjoys. In the New Zealand Court of Appeal Case known as N V Sumatra Tobacco Trading Company Versus British American Tobacco (Brands) Incorporated, the Court stated as follows in regard to well-known marks:

"All that an opponent needs to show is "awareness", cognisance" or "knowledge" of the mark. This means that the opponent will first have to identify the relevant market, then point to evidence showing that a substantial number of persons in that market have awareness, cognisance or knowledge of its mark. What is a substantial number of persons depends on the nature and size of the market and is relative both to the number of persons involved in and their impact on that market."

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

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

Having submitted no evidence to support their claim under the provisions of section 15A of the Act, then the Applicants cannot succeed as aggrieved person under the said section.

- (c) I have already considered the issue of whether or not the Proprietors have a valid and legal claim to the mark "OMEGA SCHOOL BOARDS AND ACCESSORIES" (WORDS and DEVICES) in respect of "instructional and teaching materials especially boards and their accessories" in the Kenyan market. I have determined that the Proprietors have a valid and legal claim to the mark. This means that the Proprietors' aforementioned trade mark was entered in the Register of Trade Marks in compliance and in accordance with the provisions of the Trade Marks Act. As indicated in

the aforementioned WIPO Intellectual Property Handbook: Policy Law and Use, marks should be removed from the Register of Trade Marks "only if the grounds for invalidity already existed when the trade mark was registered". As earlier indicated, the Proprietors applied to register their trade mark on 2nd July 2008. According to the evidence filed by the Proprietors, this was around ten (10) years subsequent to the commencement of the use of the said trade mark in the Kenyan market by the said Proprietors. The aforementioned section 35 of the Act provides that if a person is aggrieved by the entry of a trade mark in the Register of Trade Marks "without sufficient cause, or by any entry wrongly remaining on the register", then he may apply to the Registrar of Trade Marks to have the Register rectified. I am of the view that the said mark was validly registered, is legally in the Register of Trade Marks and was entered in the Register of Trade Marks because the Proprietors had and still have a valid and legal claim to the said trade mark. A person can only be "an aggrieved person" under section 35 of the Act if the proprietor of the respective mark has with the registration of the mark gained an advantage that he was not entitled to. I am of the view that the Proprietors herein were and still are entitled to the rights conferred by registration of their mark "OMEGA SCHOOL BOARDS AND ACCESSORIES" (WORDS and DEVICES).

It is my view that the Applicants' alleged interest in seeking to ensure the purity of the Register of Trade Marks is outweighed by the aforementioned valid and legal claim of the Proprietors to the trade mark "OMEGA SCHOOL BOARDS AND ACCESSORIES" (WORDS and DEVICES). 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 ... 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. But the matter is wholly different when the trade mark complained of is one which is not in itself illegal or improper, although at the date of registration its registration might have been perhaps successfully opposed by some third party who did not in fact oppose it. In such a case, the defect in the register is

not a defect of which the court is bound to take cognizance at the instance of every complainant."

The entry of the Proprietors' trade mark "OMEGA SCHOOL BOARDS AND ACCESSORIES" (WORDS AND DEVICES) with effect from 2nd July 2008 has not been shown to have been made illegally. I do not observe any defect in the Register of Trade Marks with regard to the said mark, which ought to be rectified under the provisions of the Trade Marks Act. The said entry was neither illegal nor inappropriate and should therefore not be interfered with.

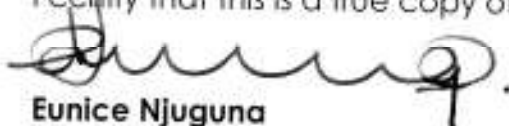
Conclusion

- (a) For the above-mentioned reasons, I have come to the conclusion that the Applicants have not discharged their onus of proving that registration of the Proprietors' trade mark TMA No. KE/T/2008/063557 "OMEGA SCHOOL BOARDS AND ACCESSORIES" (WORDS AND DEVICES) is invalid, have failed in these expungement proceedings and I decline to rectify the Register of Trade Marks as sought by the Applicants;
- (b) I hold that the Proprietors have a valid and legal claim to their trade mark TMA No. KE/T/2008/063557 "OMEGA SCHOOL BOARDS AND ACCESSORIES" (WORDS AND DEVICES), that the said mark was entered in the Register of Trade Marks in accordance with the provisions of the Trade Marks Act and shall remain validly registered; and
- (c) I award the costs of these expungement proceedings to the Proprietors.

Eunice Njuguna
Assistant Registrar of Trade Marks

28th Day of August 2013

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



Eunice Njuguna
Assistant Registrar of Trade Marks

28th Day of August 2013