

KENYA INDUSTRIAL PROPERTY INSTITUTE



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THE TRADE MARKS ACT CAP 506 OF THE LAWS OF KENYA

AND

IN THE MATTER OF TMA NO 68415 "NEW BODY WAVE" IN CLASS 26 IN THE NAME OF REBECCA FASHION LIMITED AND OPPOSITION THERETO BY STRATEGIC INDUSTRIES LIMITED

RULING BY THE ASSISTANT REGISTRAR OF TRADE MARKS

Background

On 16th June 2010, Rebecca Fashions Limited (hereinafter referred to as the Applicants) filed an application to register their trade mark TMA 068415 "NEW BODY WAVE" (WORDS) (hereinafter referred to as the mark) before the Registrar of Trade Marks. The mark was applied for in class 26 in respect of "artificial hair, beards, moustaches, toupees, hair bands, hair grips, hair ornaments, hair nets, bows for the hair".

The Registrar duly examined the mark in accordance with the provisions of the Trade Marks Act Cap 506 of the Laws of Kenya and on 28th July 2010, the mark was approved and published in the Industrial Property Journal of 31st July 2010, on page 37.

On 28th September 2010, Strategic Industries Limited (hereinafter referred to as the Opponents) filed a Notice of Opposition against the registration of the mark. The grounds of opposition were as follows:

1. We are the owner of the registered trade mark Number 66383 ADDISA BODY CURL which we have used extensively along with our registered trade mark DARLING in class 26 for goods shown in paragraph 2 of this Notice of Opposition.
2. Our trade mark ADDISA BODY CURL has been used extensively on

hair additions, hair pieces and braids, weaves and wigs and has become well known to the Kenyan public by virtue of sales of our aforesaid goods.

3. The trade mark NEW BODY WAVE which REBECCA FASHION (KENYA) LTD hereinafter called ('The Applicant') is attempting to register so closely resembles trade mark ADDISA BODY CURL visually and phonetically that confusion and deception is likely to arise in the minds of the public so as to disentitle the trade mark NEW BODY WAVE (which is the subject of TMA. No. 0068415 in class 26) to protection in a court of justice.
4. The goods covered by the Applicant's mark are identical to and/or are goods of the same character, nature or description to the goods on which our trade mark ADDISA BODY CURL is used. This is likely to further enhance the likelihood of confusion and deception arising if the Applicant's TMA. No. 0068415 NEW BODY WAVE is allowed to proceed to registration and use on the Kenyan market and therefore further disentitles that trade mark to protection in a court of justice.
5. That further and in the alternative and without prejudice to the above averments, the words NEW BODY WAVE are descriptive words commonly used in the hair industry and therefore, nobody can claim exclusive right, and further, the grant of the exclusive use of the word NEW BODY WAVE might unfairly prejudice the opponents commercialization of its products.
6. That according to the publication on page 37 of the Industrial Property Journal, the Applicants did not enter a disclaimer of the words NEW and WAVE each separately and apart from the mark as a whole as required by the provisions of section 17 of the Trade Marks Act.
7. Without prejudice to the foregoing, we aver that even if the words NEW, BODY and WAVE were disclaimed each separately and apart from the mark as a whole, the mark cannot pass the test of having essential elements as envisaged under section 12 of the Trade Marks Act, Cap 506 of the Laws of Kenya.
8. TMA. No. 0068415 NEW BODY WAVE should therefore be refused registration under sections 12, 14, 15A and 17 of the Trade Marks

Act.

Wherefore, we the Opponent prays:

(a) That registration of the mark represented in TMA. No. TMA. No. 0068415 NEW BODY WAVE should be refused;

(b) That the costs of these proceedings be awarded to us (the Opponent).

The Opponents' Notice of Opposition was duly forwarded to the Applicants who filed their Counter Statement on 17th November 2010. The Applicants stated the following as the grounds on which they would rely in support of their application:

1. The Applicant denies the contents of paragraph 1 of the Notice of Opposition and in particular that the opponent is the owner of the alleged registered mark 66385 ADDISA BODY CURL (the Mark) or that the alleged mark has been extensively used, advertised and promoted by the opponent along with its registered trade mark DARLING in class 26 for the goods shown in paragraph 2 of the Notice of Opposition.
2. The Applicant denies the contents of paragraph 2 of the Notice of Opposition and in particular that the opponent has extensively used, advertised and promoted the mark on and in connection with hair additions, hair pieces and braids, weaves and wigs. Further, the Applicant denies that the mark has become well known to the Kenyan public by virtue of the Opponent's sales products as alleged or at all and puts the opponent to strict proof thereof.
3. The Applicant denies the contents of paragraph 3 of the Notice of Opposition and puts the opponent to strict proof thereof. Particularly, that the mark belongs to the opponent or at all. Further that the mark closely resembles any other registered trade mark or unregistered marks visually and phonetically or that confusion and deception is likely to arise in the minds of the members of the public as alleged or at all.
4. The Applicant denies in toto the contents of paragraph 4 of the Notice of Opposition and puts the opponent to strict proof thereof. Particularly, that the mark products covered by its intended mark are identical to and/or are goods of the same character, nature or description to any other products and that it is likely to cause confusion and deception amongst members of the public as alleged or at all.

5. The contents of paragraph 5 of the Notice of Opposition are denied in toto and the opponent put to strict proof thereof. The Applicant denies that the words NEW BODY WAVE are descriptive words commonly used in the hair industry. The Applicant pleads that the phrase NEW BODY WAVE is distinctive and is capable of being registered for exclusive use.
6. In reply to the contents of paragraph 6 of the Notice of Opposition, the Applicant pleads that NEW BODY WAVE are words which together are of a distinctive character in relation to the hair industry and therefore capable of protection as such. The Applicant has not breached section 17 of the Trade Marks Act as suggested or at all.
7. In reply to the contents of paragraph 6 of the Notice of Opposition, the Applicant reiterates the contents of the foregoing paragraph.
8. Without prejudice to the foregoing, the Applicant pleads that the opposition herein is actuated by bad faith and solely designed to deny the Applicant the benefit of its hard work and purposely exploit and ride off the distinctiveness of the current application for registration of trade mark NEW BODY WAVE.
9. The Applicant pleads that the Opponent's Notice of Opposition is otherwise an abuse of the opposition process and shall at the earliest opportunity seek to have the same struck out.

Reasons wherefore: The Applicant prays that:

- i. The present opposition be dismissed;
- ii. The subject application be allowed to proceed to registration;
- iii. Costs of these opposition proceedings be awarded in favour of the Applicant.

The Applicants' Counter Statement was forwarded to the Opponents who filed their Statutory Declaration on 1st February 2011. The Statutory Declaration was sworn by one Mahmoud Saffideen, the Opponents' Managing Director who declared as follows, inter alia:

1. I confirm that the opponent is the owner of the Trade Mark No. 66385 ADDISA BODY CURL in class 26, samples of labels are attached to this declaration marked Exhibit MS1.
2. The Opponent has used the Opponent's mark ADDISA BODY CURL since 1993, extensively on class 26 alongside our registered trade mark (TM NO. 38928) Darling for hair additions, hair pieces and braids, weaves and wigs.
3. The Opponent has sold the goods bearing the Opponent's marks to purchasers in Kenya from the year 1993. Photocopies of the invoices/Delivery notes of the Opponent proving such sales are attached to this declaration in the bundle marked Exhibit MS2.
4. That I verily believe that by virtue of resultant sales of the goods referred to in Exhibit MS2 the Opponent's marks are well known to the Kenyan public in connection with the goods sold by the Opponent.
5. With regard to paragraph 2 of the Counter statement, I am advised by the Opponent's Advocates Messrs Onyony & Company Advocates and verily believe that the registration and bona fide use of a trade mark gives the owner of that trade mark exclusive rights so long as the mark is validly existing in the Register of Trade Marks. Annexed hereto and marked SM3 is the certificate of registration, renewal certificate and certificate of assignment.
6. The goods covered by the TMA.NO.68415 filed by the Applicant are either identical to or are goods of the same character, nature or description to the goods on which the Opponent uses the Opponent's marks ADDISA BODY CURL in class 26.
7. I verily believe that the trade mark which the Applicant is attempting to register under TMA.068415 ADDISA BODY CURL so closely resembles the Opponent's mark visually and phonetically that the Kenyan public are likely to be confused or deceived into thinking that the goods to which the Applicant intends to affix the mark which is shown in TMA.NO.068415 originate from the Opponent. This possibility of confusion is further enhanced by the fact that the Opponent's mark is used on identical goods or essentially identical goods.
8. With regard to paragraphs 2 and 3 of the Counter statement, I am advised by the Opponent's Advocates Messrs Onyony & Company Advocates and verily believe that the principal test to proof reputation

and goodwill in such an Opposition, a trader needs to demonstrate that the words have acquired a secondary meaning not only of the goods of which they relate but also specifically of the goods which he is the source. The trader must show the length of use and demonstrate that they have sold and marketed the product in Kenyan market. The Opponent's Advocates will make further submission on this aspect at the hearing of this opposition.

9. With regard to paragraphs 4,5, 6 and 7 of the Counter-Statement, I am advised by the Opponent's Advocate and verily believe that the principal test in such an opposition is whether the two marks are sufficiently close visually and phonetically as to be likely to cause the public to be confused or deceived. I verily believe that on the basis of that test confusion or deception of the public is likely to arise. The Opponent's Advocates will make further submission on this aspect at the hearing of this opposition.
10. With regard to paragraph 8 of the Counter-Statement we deny the contents and put them to strict proof thereof and further that our unsuspecting consumers are likely to purchase the applicants goods bearing the words **NEW BODY WAVE** believing they are our ADDISA BODY CURL and/or thinking that the two marks **NEW BODY WAVE** and ADDISA BODY CURL come from one source. The Opponent's Advocate will make further submission on this aspect at the hearing of this opposition.
11. In response to paragraphs 9 and 10 of the Counter-Statement I am advised by the Opponent's Advocate and verily believe that it is within our right provided under Sections 14 and 15 of the Trade Marks Act Cap 506 of Laws of Kenya to oppose the registration of deceptive, identical and resembling trade marks.

The Opponents' Statutory Declaration was forwarded to the Applicants who on 25th March 2011 filed their Statutory Declaration. The Statutory Declaration was sworn by one Hongxia Li, a Director of the Applicants who declared as follows *inter alia*:

1. The contents of paragraph 4 of the Declaration are not true or correct. The Opponent is not the registered owner of the mark ADDISA BODY CURL as claimed in the Declaration or at all.
2. The contents of paragraphs 5 and 6 of the Declaration are not true or correct. There is no evidence tendered by the Opponent to

demonstrate that it has been selling goods bearing the mark ADDISA BODY CURL from the year 1993 as claimed.

3. The Applicant is a stranger to the contents of paragraph 7 of the Declaration. In further reply thereto, I am aware that the Applicant has not claimed the use of the mark ADDISA BODY CURL.
4. The contents of paragraph 8 of the Declaration are not true or correct in so far as they seem to suggest that the Opponent is the registered owner of a trade mark by the name ADDISA BODY CURL. In further reply thereto, the annexed Certificate of Registration relates to the trade mark DARLING owned by Stripes Industries Ltd and not the Opponent.
5. In response to the contents of paragraph 9 of the Declaration, I am aware that both the Applicant and the Opponent business relates to hair additions and extensions. However, it is not true or correct that the Applicant's products under the mark NEW BODY WAVE are of the same character, nature and description as claimed or at all.
6. The contents of paragraph 10 of the Affidavit are not true or correct. The correct position is that the Kenyan public will not be confused as to the origin and manufactures of the products as alleged or at all for the following reasons:-
 - (a) The mark NEW BODY WAVE does not in any way resemble the unregistered mark, ADDISA BODY CURL.
 - (b) All the goods sold by the Applicant are clearly marked with the Applicant's name and mark;
 - (c) It is not likely to be taken as indicating a connection in the course of trade between the Applicant's goods and the Opponent's goods for the reason that the Applicant clearly indicates the distinctiveness of its products as compared to the Opponent's products;
 - (d) The Applicant's hair products are distinctly identified by the Applicant's conspicuous Trade Mark, "Fashion Idol" logo, name and website and there can be no confusion in the eyes of the general public and in particular, a client within the hair industry, with those of the Opponent which are equally

distinctly identified by the Opponent's dark and light green stripes and purple mark DARLING together with the caption ADDISA BODY CURL, logo, name and telephone numbers;

(e) The Opponent's and the Applicant's products are not so similar as to be likely to deceive or cause confusion in the minds of the general public and in particular, a client within the hair industry.

7. The contents of paragraph 11 of the declaration are correct.

8. In reply to the contents of paragraphs 12, 13, 14, 15, 16 and 17 of the declaration I reiterate the contents of paragraph 8 hereinabove.

The Applicants' Statutory Declaration was forwarded to the Opponents who on 23rd May 2011 filed their Statutory Declaration In Reply. The Statutory Declaration was sworn by the said Mahmoud Saffideen, the Opponents' Managing Director who denied in toto singularly and severally the allegations and averments made in the Statutory Declaration of the Applicants. This marked the close of the pleadings, subsequent to which the parties herein agreed on a hearing date. However, it was later agreed that the matter would proceed by way of written submissions. The Opponents filed their written submissions on 24th October 2011 and the Applicants filed their written submissions on 30th January 2012.

Ruling

I have considered the Notice of Opposition filed by the Opponents herein, the Counter-Statement filed by the Applicants and the evidence adduced by the parties by way of their respective Statutory Declarations. I have also considered the written submissions filed herein by Onyony & Company Advocates and Issa & Company Advocates for the Opponents and the Applicants respectively. It is apparent that these opposition proceedings have been filed under sections 12, 14, 15A and 17 of the Trade Marks Act. I am of the view that the following is the issue that should be determined in these opposition proceedings:

Did the Applicants have a valid and legal claim to the mark "NEW BODY WAVE" before applying to register the same in accordance with the provisions of section 20(1) of the Trade Marks Act?

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."

This means that before a person files an application for registration of a mark with the Registrar, he must have a valid and legal claim as the owner of such a mark.

The learned author of the book Kerly's Law on Trade Marks, 12th Edition, on page 28 paragraph 4-02 writes *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 case the Vitamins Trade Marks Case [1956] RPC, Justice Lloyd-Jacob stated *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 propriety right which, if questioned, can be substantiated."

In the case of Victoria Secret Inc. Vs. Edgar Stores Limited, it was stated that the dictionary definition of the word proprietor is 'one who has exclusive right or title to the use of a thing.. '

The Applicants' trade mark that is being considered herein is "NEW BODY WAVE". The mark is comprised of ordinary English words "NEW ", "BODY" and "WAVE". As indicated on the Application Form TM 2, the Applicants have disclaimed the right to the exclusive use of only the word "BODY" separately

and apart from the mark as whole under the provisions of section 17 of the Trade Marks Act. This means that it is the Applicants' desire that the Registrar of Trade Marks grants them the right to the exclusive use of the rest of the words "NEW and "WAVE" for use in respect of goods in class 26 mainly comprised of artificial hair additions. The Applicants state that the said mark "NEW BODY WAVE" is distinctive, is capable of distinguishing their goods and should be entered in the Register of Trade Marks. On the other hand, the Opponents herein state that the Applicants' mark is comprised of descriptive words, which would prejudice the Opponents' business.

To identify their goods in class 26 of the International Classification of Goods and Services for Purposes of Registration of Marks, the Applicants' adopted a mark that is comprised of ordinary English words "NEW ", "BODY" and "WAVE". "NEW " is an adjective which refers to something that is fresh, novel or modern. This means that no person would be allowed exclusive use of the said term in respect of goods in the industry that involves artificial hair additions. As regards the term "BODY", the Applicants are aware that the same is not distinctive of the goods in class 26 and that is the reason why they have entered a disclaimer of the same separately and apart from the mark as a whole. The term "WAVE" is an English word, which as a noun would also refer to a gesture or a signal. The term could also refer to one of a series of ridges that moves across the surface of a liquid. However, the term could also mean a hairdo that creates undulations in the hair or a hairstyle that creates a wavy impression on the head. This means it is not possible to grant exclusive use of the term "WAVE" for use with respect to goods in class 26 for artificial hair additions. A consideration of the Register of Trade Marks reveals that the term "WAVE" has been entered in the said Register in respect of goods in class 26 in the name of several proprietors but with a disclaimer of the right to the exclusive use of the said term separately and apart from the mark as a whole. The said marks include TMA No. 060397 - NICE & LOVELY COLLECTIONS WATER WAVE STYLE and 060410- NICE & LOVELY COLLECTIONS FRENCH WAVE STYLE both in the name Cicero Holdings Limited as well as 075928- SILKY WAVE in the name of Solpia Kenya Limited. This means that the Applicants adopted English words, which are not distinctive of the goods in class 26 of the International Classification. I am aware that marks should be considered as a whole and they should not be dissected. However, the consideration of each of the terms comprising the Applicant' trade mark has been inevitable because what the Applicants have presented as the dominant feature of the mark has been used and registered by other traders in a similar trade.

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."

In the case of Scandecor Development AB v Scandecor Marketing AB, the Court stated as follows:

"A trade mark is a badge of origin or source. The function of a mark is to distinguish goods having one business source from goods having a different business source. It must be distinctive. That is to say it must be recognizable by a buyer of goods to which it has been affixed as indicating that they are of the same origin as other goods which bear the mark and whose quality has engendered goodwill".

Having adopted the mark "NEW BODY WAVE" that is comprised of three ordinary English words with each having a reference to the character of goods in respect of which the said mark is sought to be registered, then the Applicants would not be in a position to show that their mark "is inherently adapted to distinguish" their said goods as provided for under the aforementioned section 12(3) of the Trade Marks Act. As earlier indicated, all the words are used by other traders in the similar field of manufacturing artificial hair additions and are therefore incapable of playing one of the most important roles of a trade mark, that is, being a badge of origin or source. Any element or a combination of elements of a trade mark that describes the character of a person's goods

cannot distinguish the said goods in the market and cannot therefore function as a trade mark.

Further, I am of the view that registration of the trade mark "NEW BODY WAVE" in respect of goods related to artificial hair additions would be contrary to the provisions of section 12 (1) (d). The section provides that for a mark to be considered as distinctive and therefore registrable, then it must be comprised of certain essential particulars, which include "a word or words having no direct reference to the character or quality of the goods".

Having adopted a mark that is contrary to the aforementioned provisions of the Trade Marks Act, then the Applicants would not be said to have had a valid and legal claim to the trade mark "NEW BODY WAVE" before making an application to register the same before the Registrar of Trade Marks.

Conclusion

For the above-mentioned reasons, I have come to the conclusion that on a balance of probabilities:

- (a) the Opponents have succeeded in these opposition proceedings; and
- (b) the Applicants' trade mark no. KE/T/20010/68415 "NEW BODY WAVE"(WORDS) shall not proceed to registration.

The Opponents and the Applicants in these opposition proceedings shall each bear their own costs.

Eunice Njuguna
Assistant Registrar of Trade Marks

24th Day of July 2013

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



Eunice Njuguna
Assistant Registrar of Trade Marks

24th Day of July 2013