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THE TRADE MARKS ACT CAP 506 OF THE LAWS OF KENYA

AND

IN THE MATTER OF TMA NO 68417 "CHARMING" 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 068417 "CHARMING" (WORD) (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 CHARME which we have filed an application number 69136 CHARME and 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 CHARME 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 CHARMING which REBECCA FASHION (KENYA) LTD hereinafter called ('The Applicant') is attempting to register so closely resembles trade mark CHARME visually and phonetically that confusion and deception is likely to arise in the minds of the public so as to disentitle the trade mark CHARMING object of TMA. No. 0068417 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 CHARME is used. This is likely to further enhance the likelihood of confusion and deception arising if the Applicant's TMA. No. 0068417 CHARMING 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. Arising from what is stated in paragraphs (2), (3) and (4) above, there is a likelihood that members of the public may mistakenly purchase the Applicant's goods bearing the Trade Mark No. 0068417 CHARMING thinking they are goods manufactured by ourselves or vice versa.
6. TMA. NO. 0068417 CHARMING should therefore be refused registration under sections 14 and 15A of the Trade Marks Act.

Wherefore, we the Opponent pray:

1. That registration of the mark represented in TMA. No. 0068417 CHARMING should be refused;
2. That the costs of these proceedings be awarded to us (the Opponent).

The Opponents' Notice of Opposition was duly forwarded to the Applicants who on 17th November 2010 filed their Counter Statement. 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 unregistered mark CHARME (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 or at all.
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 either 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 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. Further, that the Opponent has no valid registration in Kenya and the associated variations thereto.
6. The Opponent has never taken any steps to protect the alleged infringement of its rights as the alleged proprietor of the subject mark or any variations thereof. The Notice of Opposition is brought in bad faith and is an attempt to lock out competition from the Applicant.
7. The Applicant pleads that trade marks are territorial in nature and the Opponent has no proof of use, advertisement, or promotion of products with the mark in Kenya and/or any other countries in the world as alleged in the Notice of Opposition or at all.

8. The Opponent has never or at all used the mark as alleged or at all in Kenya and neither has the Opponent acquired any distinct goodwill and reputation on account of the mark, therefore, acceptance and registration of the Applicant's trade mark application number 68417 is not in any way seeking to deceive, confuse, exploit and or ride off the Opponent's goodwill but an enjoyment of the Applicant's inherent rights as the originator of the CHARMING trade mark.
9. 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 CHARMING.
10. In the alternative and without prejudice to the foregoing, the Applicant pleads that even if the Opponent was the proprietor of the mark and the associated variations thereto as alleged or at all, which the Applicant denies, the same is unregistered and the Opponent is precluded by section 5 of the Trade Marks Act Cap 506 of the Laws of Kenya from bringing any action to prevent the alleged infringement by the Applicant.
11. 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 on 1st February 2011 filed their Statutory Declaration. 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 CHARME for which we have filed an application in class 26, samples of labels are attached to this declaration marked Exhibit MS1.
2. The Opponent has used the Opponent's mark CHARME 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 of our registered trade mark DARLING.
6. The goods covered by the TMA.NO.68417 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 CHARME in class 26.
7. I verily believe that the trade mark which the Applicant is attempting to register under TMA.068417 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.068417 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 paragraph 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 paragraphs 8 and 9 of the Counter-Statement, I reiterate the contents of paragraphs 7 and 8 and attachments Exhibits MS2 and MS3 of my statutory declaration. In the alternative and without prejudice to the foregoing, we are not aware of the existence of the Applicant's goods in the market so as to warrant taking an infringement action against them and further that in the event that we discover the Applicant's goods are in the market we will most certainly file an infringement action immediately.
11. With regard to paragraph 10 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 CHARMING believing they are our CHARME and/or thinking that the two marks CHARMING and CHARME come from one source. The Opponent's Advocate will make further submission on this aspect at the hearing of this opposition.
12. In response to paragraph 11, 12 and 13 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. We believe that CHARMING and CHARME cannot co-exist in the Trade Mark's Register and in the market without causing confusion.

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 CHARME 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 CHARME 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 use of the mark CHARME or DARLING.
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 CHARME. 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 reply to the contents of paragraph 9 of the Declaration, I am aware that both the Applicant and the Opponent business relates to selling of hair products, hair additions and extensions. However, it is not true or correct that the Applicant's products under the mark CHARMING are of the same character, nature and description as claimed or at all.
6. The contents of paragraph 10 of the Declaration are not true or correct. The correct position is that the Kenyan public will not be confused as to the origin and manufacturers of the products as alleged or at all for the following reasons:-
 - (a) The mark CHARMING does not in any way resemble the unregistered mark, CHARME;

- (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 blue 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 purple colour and the mark DARLING together with the caption "CHARME", logo, name and telephone numbers; and
- (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.

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 2nd September 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. I am of the view that the following are the issues that should be determined in these opposition proceedings:

- 1. Is the Applicants' mark "CHARMING" so similar to the Opponents' mark CHARME as to be likely to cause confusion as provided for under section 14 of the Trade Marks Act?**
- 2. Did the Applicants have a valid and legal claim to the mark "CHARMING" before applying to register the same in accordance with the provisions of section 20(1) of the Trade Marks Act?**

The following is a consideration of the two aforementioned issues:

- 1. Is the Applicants' mark "CHARMING" so similar to the Opponents' mark "CHARME" as to be likely to cause a likelihood of deception or confusion as provided for under section 14 of the Trade Marks Act?**

To be able to determine whether or not marks are similar, several factors need to be considered. In the case *Eli Lilly & Co V Natural Answers Inc* 233, F. 3d 456, [USA] the following were indicated as some of the factors to consider:

- (a) The strength of the complainant's mark;
- (b) Similarity between the marks in appearance and suggestion;
- (c) The degree of care likely to be exercised by consumers; and
- (d) The area and manner of concurrent use of the products.

In the article "A Tale of Confusion: How Tribunals Treat the Presence and Absence of Evidence of Actual Confusion in Trade Mark Matters" Paul Scott states as follows:

"One of the key issues in both trade mark opposition and infringement proceedings is whether the use of one mark is likely to cause confusion or deception with another mark. In determining whether a mark is likely to do so tribunals consider a number of factors. These include whether:

1. the marks appear on the same or similar goods or services;

2. the price of the goods or services on which the marks appear is expensive or cheap;
3. consumers purchase the goods or services carefully or on impulse; and
4. the goods or services appear in the same or similar retail outlets."

In the New Zealand case of Pioneer Hi-Bred Corn Co. v. Hy-Line Chicks Pty Ltd, the Court stated as follows:

"In considering the likelihood of deception or confusion, all surrounding circumstances have to be taken into consideration, including the circumstances in which the applicant's mark may be used, the market in which his goods may be bought and sold and the character of those involved in that market.

The following is a consideration of some of the aforementioned factors:

(a) Is there a similarity between the marks in appearance and suggestion?

The marks being compared are "CHARMING" for the Applicants and "CHARME" for the Opponents. Both of the said marks are word marks and the correct test is the one laid down by Parker J in the Pianotist case where he stated as follows:

"You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks."

Considering the two marks, it is apparent that the prefix "CHARM" is identical in both the Applicants' mark "CHARMING" and the Opponents' mark "CHARME". Then the Applicants have incorporated the letters "I", "N", "G", to their mark while the Opponents have incorporated the letter "E", to their mark. I am of the view that the marks are quite similar. The marks appear and sound similar and have an identical suggestion both stemming from the prefix "CHARM".

In the book WIPO Intellectual Property Handbook by the World Intellectual Property Organization, it is stated as follows on page 87:

"The second most important point when testing the similarity of trade marks is that they should be compared as a whole, and that more weight should be given to common elements which may lead to confusion, while differences overlooked by the average consumer should not be over emphasized. Notwithstanding this basic rule of comparing trade marks as a whole, and not dividing them into parts, the structure of the signs is important. Common prefixes are normally more important than common suffixes; if two signs are very similar or identical at the beginning, they are more likely to be confused than if the similarity is in their endings. Long words with common or similar beginnings are more likely to be confused than short words with different initial letters."

In the Indian case of Glaxo Group Ltd. vs. Neon Laboratories Ltd, the judge stated as follows:

"Judging the marks as a matter of first impression and applying the test of an ordinary person with average intelligence and an imperfect recollection the case must be answered in the plaintiff's favour. ...There is a very high possibility of a mispronunciation leading a person to mistake one mark for the other. A perfect pronunciation, a clear enunciation of the words may indicate the difference. But words such as these are not always so pronounced. Moreover it is useful to mention, as has been noticed in several decisions, that words tend not to be properly enunciated and in particular the ending of words is often slurred. Even if either of the marks is pronounced correctly there is an equally high possibility of the person hearing the same to mistake one for the other."

Having considered the two marks, I am of the view that the two are so similar that "judging the marks as a matter of first impression and applying the test of an ordinary person with average intelligence and an imperfect recollection", it is apparent that the two marks contain more similarities than differences both in appearance and suggestion. This is the same consideration that the Registrar of Trade Marks must have had when the Opponents' application for registration of their trade mark TMA No. 69136 "CHARME" was refused for the reason that the Applicants' Application TMA No. 68417 "CHARMING" was pending at the Registry of Trade Marks.

(b) What is the strength of the earlier mark?

The records at the Registry of Trade Marks indicate that the earlier mark in these opposition proceedings is the Applicants' mark "CHARMING" whose application for registration was received at the Registry of Trade Marks on 16th June 2010 while the Opponents' application for registration of their

mark "CHARME" was received on 3rd September 2010. It is apparent that the Applicants' mark is not descriptive of the goods in class 26 of the International Classification of Goods and Services for Purposes of Registration of Marks.

In the book, Kerly's Laws of Trade, 14th Edition, paragraph 9-039, the learned author states as follows:

"The more distinctive the earlier mark, the greater will be the likelihood of confusion. A mark may have a particularly distinctive character either per se, or because of the reputation it enjoys with the public."

In the South African case known as Plascon-Evans Paints V Van Riebeeck Paints the marks in contention were "Mikacote" and "Micatex" and the judge stated as follows at page 645 while finding that there was infringement of the mark "Micatex" by the proprietor of the mark "Mikacote":

"In the case before us the evidence establishes that the word "MICA" is not one generally used in the paint trade to describe paint products".

In the case of Canon Kabushiki Kaisha and Metro-Goldwyn-Mayer Inc, it was stated as follows:

"... the more distinctive the earlier mark, the greater the risk of confusion. Since the protection of a mark depends on there being a likelihood of confusion...marks with a highly distinctive character, either per se or because of the recognition they possess on the market, enjoy broader protection than marks with a less distinctive character. ...It follows that, registration of a mark may have to be refused, despite a lesser degree of similarity between the goods or services covered, where the marks are very similar and the earlier mark, in particular its reputation is highly distinctive".

In the case of Sabel V Puma, the court stated as follows:

"In that respect, it is clear ...that the appreciation of the likelihood of confusion depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case. That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall

impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. ... the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion."

As aforementioned, the Applicants' "CHARMING" has no reference to the character of the goods in international class 26 and would therefore be considered to be a strong mark.

After considering all the relevant circumstances, I am of the view that the two marks are so similar as to be likely to cause a likelihood of deception or confusion contrary to the provisions of section 14 of the Trade Marks Act.

2. Did the Applicants have a valid and legal claim to the mark "CHARMING" 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."

The aforementioned 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 Vitamins Trade Marks Case [1956] RPCI 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 propriety 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, writes 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."

To distinguish their goods, that is, "artificial hair, beards, moustaches, toupees, hair bands, hair grips, hair ornaments, hair nets, bows for the hair", the Applicants selected the mark "CHARMING" and made an application before the Registrar of Trade Marks to register the same under class 26 of the International Classification of Goods and Services for Purposes of Registration of Marks. I had earlier indicated that the said mark "CHARMING" is a strong mark

and is distinctive of the said goods in class 26. This means that the mark is qualified for registration under section 12 (3) of the Act and that the Applicants have a valid and legal claim to the mark "CHARMING" under the provisions of section 20(1) of the Trade Marks Act, Cap 506 of the Laws of Kenya.

However, I had also stated that the said mark is similar to the Opponents' mark "CHARME", the basis on which the Opponents filed these opposition proceedings and the two marks would therefore not be allowed to co-exist in the Register of Trade Marks Act. In their pleadings, the Opponents had stated that they have been using the mark "CHARME" for a long while together with their registered mark DARLING in the Kenyan market. The issue then to consider here then is whether or not the Opponents have filed evidence to prove use of their mark "CHARME" in the Kenyan market. In the opposition proceedings of Doshi Iron Mongers Limited and Opposition thereto by Ralson (India) Limited, the Registrar of Trade Marks stated as follows at page 17:

"... to establish use of a mark, various factors must be proved. These include:

- (a) The products or service covered by the mark must actually be in the Kenyan market;
- (b) Advertisement and promotional campaigns of the mark should be shown to have taken place in Kenya;
- (c) The use of the mark must be shown in Kenya and not in a foreign territory;
- (d) The actual use of the trade mark must not be a sham or token; and
- (e) There must be commercial exploitation of the mark in Kenya."

Relying on the said opposition proceedings, I am of the view that the Opponents have not filed any evidence to prove that they had used the mark in Kenya prior to 16th June 2010, the date that the Applicants herein made an application to register their trade mark "CHARMING". The Opponents did not file any evidence of advertisement and promotional campaigns of the mark in the Kenyan market. In paragraph 6 of their Statutory Declaration, the Opponents indicated that they had attached "photocopies of invoices/delivery notes" proving the sales made by the Opponents of their goods bearing the mark "CHARME" in Kenya since the year 1993. However, the documents attached are unsigned, undated and unstamped and cannot therefore qualify either as invoices or delivery notes. Further, even if the documents attached would qualify as invoices or delivery notes, it is apparent that the use and the sales indicated on the said documents would be termed as a token. I am therefore of the view that the Opponents have not filed any evidence that would challenge the Applicants' claim to their mark "CHARMING", which claim I had found to be legal and valid.

Conclusion

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

- (a) The Opponents have failed in these opposition proceedings; and
- (b) The Applicants' trade mark no. KE/T/2010/68417 "CHARMING" (WORD) shall 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

30th Day of July 2013

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



Eunice Njuguna
Assistant Registrar of Trade Marks

30th Day of July 2013