

REPUBLIC OF KENYA

KENYA INDUSTRIAL PROPERTY INSTITUTE

IN THE MATTER OF THE TRADE MARKS ACT, Cap 506

AND

IN THE MATTER OF TMA NO. 62286 (RANI NATURAL PEACH JUICE - word and device), TMA NO. 62287 (RANI NATURAL MANGO - word and device) AND TMA NO. 67859 (RANI PINEAPPLE JUICE- word and device) IN THE NAME OF AKABA INVESTMENTS LIMITED AND OPPOSITION THERETO BY AUJAN INDUSTRIES CO. (SJC)

RULING

INTRODUCTION

This is an opposition matter filed by Aujan Industries Co. (SJC) (“the Opponent”), against the registration of TMA No. 62286 “RANI NATURAL PEACH JUICE” (word and device), TMA No. 62287 “RANI NATURAL MANGO” (word and device) and TMA No. 67859 “RANI PINEAPPLE JUICE” (word and device), in the name of Akaba Investments Ltd. (“the Applicant”).

PROCEDURAL BACKGROUND

On 31st October 2007, the Applicant filed two applications for the registration of the marks RANI NATURAL PEACH JUICE (TMA No. 62286) and RANI NATURAL MANGO (TMA No. 62287) in class 32. The applications were examined and on 13th March 2008, the Applicant was informed that its earlier application TMA No. 55720 RANI NATURAL PEACH JUICE (word and device) in class 32 had been advertised and was under opposition. Consequently, the two applications were kept in abeyance pending the outcome of the opposition.

At this point it is important to clarify that TM 55720 RANI (word mark) in the name of Akaba Investment Ltd. already existed on the Register and the application then being considered by the Registry was an application to add to or alter a registered mark (Form TM 24) dated 21 May 2007. I will come back to this point later.

Returning to the marks in issue here, on 8th February 2010, the Applicant was required to disclaim the right to the exclusive use of the words “NATURAL”, “PEACH”, “JUICE” and the devices of the juice can and peach fruits with regard to TMA No. 62286 as well as the words “NATURAL” and “MANGO”, and the devices of the juice can and mango fruits with regard to TMA No. 62287, each separately and apart from the marks as a whole. Thereafter, on 10 February, the Applicant filed Form TM 19 to amend its applications and to include the said disclaimers.

Approval notices were sent to the Applicant on 11th February 2010 requiring it to pay advertisement fees. Thereafter, both marks were advertised in the Industrial Property Journal No. 2010/02 at page 17.

On 30th March 2010, the Applicant filed an application for the mark RANI PINEAPPLE JUICE (TMA No. 67859). This mark too was examined and on 28th May 2010, an approval notice was sent to the Applicant requiring it to pay the requisite advertisement and registration fees. Consequently, the mark was advertised in the Industrial Property Journal No. 2010/06 at page 39.

On 28th July 2010, the Opponent filed a Notice of Opposition to the registration of all the three marks, namely, TMA Nos 62286, 62287 and 67859. The grounds on which the opposition was based were, *inter alia*, that the Opponent was the sole proprietor of the RANI mark and device which had been successfully registered, extensively used, advertised and promoted by the opponent in many countries, that the Applicant’s marks were visually and phonetically similar to the Opponent’s RANI marks and were in respect of the same class of goods, that the Opponent had attempted to apply for registration of one of its RANI marks in Kenya but the application was impeded due to the existence of the Applicant’s already registered TM No. 55720, that registration of the Applicant’s marks would serve to be deceptive and confusing because of the reputation and goodwill acquired by the Opponent from its use of its RANI marks, that the Applicant had adopted confusingly similar marks knowing the notoriety and the fame of the Opponent’s marks and that the Applicant was seeking to exploit and ride off the already acquired goodwill in the RANI marks owned by the Opponent.

The Applicant filed its Counter Statement on 24th September 2010. In the Counter Statement it stated, *inter alia*, that the Opponent had neither registered nor used the

RANI trade marks in Kenya, that the Applicant had used the trade mark with the word RANI for a long period of time in the course of trade and business, that the Opponent had admitted the existence of a valid registration of a trade mark RANI in favour of the Applicant, that the Opponent had no valid registration of the so called “RANI MARKS” in Kenya and that the Opponent had acquiesced to the registration and subsequent trade usage of the RANI trade mark and had never taken any steps to protect the alleged infringement of its rights as the proprietor of the RANI mark.

The Applicant also stated that it had registered the RANI trade mark either by itself or through its associated companies in other countries, that the issue of visual and phonetic similarity leading to deception and confusion did not arise because the Applicant was the registered proprietor of the RANI trade mark and that the Applicant’s mark had been in use in Kenya and had acquired its own distinct goodwill and reputation.

On 15th February 2011, the Opponent filed its Statutory Declaration. In the declaration, Dawood Al Mbuyidh, deponed, *inter alia*, that he was the Operation Support Division Manager of the Opponent and was duly authorized to make the Statutory Declaration, that the Opponent was the sole proprietor of the RANI marks and had sought and obtained extensive trade mark protection worldwide since 1985, that the RANI marks enjoyed international renown in relation to products in class 32, that products bearing the RANI marks had maintained a steady presence and as such were well recognized by consumers in many countries of the world and that the Opponent had been using and advertising its marks internationally for a long period of time.

Attached to Dawood Al Mbuyidh’s declaration were the following marked exhibits:

Exhibit 1 - A copy of a list of registrations and pending applications in the African continent and a sample of Certificates of Registrations from various jurisdictions worldwide owned by the Opponent for the RANI marks.

Exhibit 2 - A copy of a table showing the Sales Performance of products bearing the RANI marks in various countries around the world from the year 1991-2010 and a graph detailing sales of products bearing the RANI marks in the millions against total sales and growth.

Exhibit 3 - Copies of shipping documents evidencing the importation of products bearing the RANI marks into Kenya together with a sample of other shipping documents evidencing the exportation of products bearing the RANI marks to various other jurisdictions.

Exhibit 4 - Copies of samples of print campaigns and a graph recording the advertising and promotion expenses from the years 2001-2010 and percentage growth in the millions.

DM 1 - The Declarant made reference to the exhibit marked DM 1 but I was unable to find such an exhibit on record.

The Applicant thereafter filed its Statutory Declaration on 1st July 2011. In the declaration sworn by Humud Suleiman Mohamed, the deponent averred, *inter alia*, that he was the Manager of the Applicant and was duly authorized to swear the declaration, that the Applicant had for over ten years been carrying out and continued to carry out the manufacture, sale and distribution of products bearing the RANI marks in Kenya, Uganda, South Sudan either directly or through the Applicant's sister company Blue Horizon Property Limited and that the Applicant had entered into trade arrangements and agreements where the Applicant had been appointed as the sole distributor of various products including those bearing the RANI marks within Kenya, Uganda, Zanzibar and Southern Sudan.

The deponent also stated that the Applicant had entered into business and trade arrangements with Derhim Industrial Company Limited in Yemen to import various products including those bearing the RANI marks for sale and distribution in the local markets where the Applicant had registered its trade marks bearing the RANI marks, that the said Derhim Industrial Company limited was the registered owner of the mark RANI in other jurisdictions including the Republic of Yemen since 25th October 1984 and in the Republic of Ethiopia, that the Applicant was the sole proprietor of the marks bearing the RANI mark in Kenya and in other jurisdictions either by itself or through the sister company Blue Horizon Company Limited, that the Opponent's products bearing the RANI marks entered into the Kenyan market through Kenroid Limited in the year 2006 by which time the Applicant's products were already in the market and that the importation and distribution of the products bearing the RANI

marks in Kenya by Kenroid Limited on the Opponent's behalf had caused confusion in the market.

Further, the deponent stated that the RANI marks had gained extensive repute in Kenya solely due to the Applicant's efforts as the sole and registered proprietor of the RANI marks, that the Applicant continued to be involved in aggressive marketing activities to popularize its product through various ways, that the Opponent had never taken steps to protect the RANI marks in Kenya or any other place, that Derhim Industrial Company Ltd had previously successfully protected its trade marks bearing the RANI mark through legal proceedings against the Opponent as a result of which the Opponent was barred from exporting products bearing the RANI mark into the Republic of Yemen and that trade marks were territorial in nature and the Applicant had demonstrated its entitlement to protection in Kenya.

Attached to the Statutory Declaration were the following marked exhibits:

HSM 1 - Copies of the Applicant's product catalogue evidencing various products produced and/or distributed by the Applicant including products bearing the RANI marks and registration documents evidencing the shareholding relationship between the Applicant and its sister company, Blue Horizon Properties Limited.

HSM 2 - A copy of the Distributorship Agreement between the Applicant and Al-Mahra Industries Limited.

HSM 3 - Copies of the company profile, products of the said Derhim Industrial Company Limited and a copy of the Quality Services Survey Report evidencing the quality of the said products.

HSM 4 - Copies of the Certificates of Registration of trade mark bearing the RANI mark under class 35 in favour of Derhim Industrial Company Limited in the Republic of Ethiopia and the Republic of Yemen including the certified translation of the said certificate from the Republic of Yemen.

HSM 5 - Copies of documents evidencing the registration of trade marks bearing the RANI marks under class 32.

HSM 6 - Copies of invoices evidencing the supply of products bearing the RANI marks by the Applicant to various retail outlets within Kenya.

HSM 7 - Copies of extracts of the Applicant's audited accounts evidencing the sale turnovers from the Applicant's business activities over the years 2002-2008.

HSM 8 - Copies of Bills of Lading, Packaging Lists and Commercial Invoices indicating the importation by the Applicant of the products bearing the RANI marks from Derhim Industrial Company Limited into Kenya, Southern Sudan, Zanzibar since 2003.

HSM 9 - Copies of documents evidencing some of the complaints received by the Applicant on account of confusion of the products bearing the RANI marks.

HSM 10 - Copies of documents evidencing some of the marketing activities employed by the Applicant to popularize its products including newspaper/publication excerpts, photographs of vehicles branded with various products of the Applicant including those bearing the RANI mark, excerpts of the Applicant's audited accounts evidencing the amounts spent on advertisement and participation in the ASK show activities.

HSM 11 - Copies of documents evidencing the steps taken by the Applicant to protect its product under its registered trade marks bearing the RANI mark against perceived infringers including Kenroid Limited in Kenya being court proceedings, letters of complaints by the Applicant on the counterfeit activities to its RANI products and newspaper notices to members of the public.

On 11th November 2011, the Opponent filed its Statutory Declaration in Reply. In the declaration, Daniel Wanjau Muriu averred, *inter alia*, that he was an advocate and partner at Hamilton Harrison and Mathews, advocates for the Opponent duly authorized to swear the declaration, that it was factually incorrect that Derhim Industrial Company Ltd which was alleged to have entered into business and trade arrangements with the Applicant was the first registered owner of the trade mark RANI in class 32 and that the correct position was that the Opponent was the first registered owner of the trade mark RANI in class 32 having sought and obtained registration of the trade mark RANI in the Kingdom of Bahrain and the Hashemite Kingdom of Jordan as confirmed by the registration certificates issued on 17th May 1984 and 21st October 1984 respectively.

Attached to the Statutory Declaration in Reply was an exhibit marked DWM 1 containing copies of registration certificates of the trade mark RANI in the Kingdom of Bahrain and the Hashemite Kingdom of Jordan and the English translated versions of the certificates.

On 23rd February 2012, the hearing for all the three matters was fixed for 4th and 5th July 2012. At the hearing, both parties consented to have the hearing proceed by way of written submissions. The Opponent and Applicant filed their Written Submissions and List of Authorities on 11th July 2012 and 20th July 2012, respectively. Thereafter, the Opponent filed its Written Submissions in Reply on 26th July 2012.

I now turn to the parties' submissions.

THE OPPONENT'S SUBMISSIONS

The Opponent identified the following issues for determination by the Registrar:

- 1) Whether the Opponent was the registered proprietor of the RANI mark and was therefore entitled to protection of its marks on the ground that the Applicant had, knowing the notoriety and fame of the Opponent's marks, wrongfully adopted confusingly similar marks and applied for their registration.
- 2) Whether the Applicant's marks and the Opponent's RANI mark were visually and phonetically similar and were in respect to the same class of goods.
- 3) Whether the Applicant's marks had by reason of the reputation and goodwill acquired by the Opponent from its use of its RANI marks in various countries in Africa and throughout the world are in respect to the same class of goods and as such were likely to cause confusion or deceive the public as to the origin of goods.
- 4) Whether the Applicant's trade mark applications number KE/T/2007/062286, KE/T/2007/062287 and KE/T/2010/067859 should be allowed to proceed to registration or whether the same should be rejected.

On the issue of whether the Opponent was the registered proprietor of the RANI mark, the Opponent argued that it was the proprietor of the mark having first launched products bearing its mark in 1982 and thereafter taken steps to register it on 17th May 1984. It was further argued that the Applicant had not attached evidence to

demonstrate that it first launched products with the same mark prior to 1982 either in Kenya or elsewhere in the world. Instead, the Applicant alleged that a company known as Derhim Industrial Company Limited, which was not the Applicant and which it alleged affiliation with, obtained registration of the RANI mark on 25th October 1984 in the Republic of Yemen. The Opponent submitted that the mere fact of obtaining a first registration in Kenya was not tantamount to making the Applicant the registered proprietor of the trade mark and urged the Registrar to hold that the Applicant had merely taken a mark which was internationally recognized and had already gained a substantial reputation and goodwill to register it as its own.

With regard to whether the Applicant's marks were similar to the Opponent's RANI marks, the Opponent argued that there was no significant difference between the Applicant's marks and the Opponent's mark since they all bore the mark RANI thus leaving room for confusion and deception. The Opponent further argued that the Applicant's marks and the Opponent's RANI mark relate to goods in class 32 and were specific to fruit drinks and fruit juices therefore there was no distinction in the quality of products. It was the Opponent's submission that by applying the test of a global appreciation and perceiving the Opponent's mark as a whole and by comparing the distinctive and dominant components, the marks were similar. Accordingly, the Opponent submitted that the Applicant's marks would offend section 14 and 15 (1) of the Trade Marks Act and should therefore not be allowed to proceed to registration.

On the issue of likelihood of confusion or deception to the public as to the origin of the goods, the Opponent argued that the marks in question and the goods to which both marks apply were similar. In relying on the test set out in *the Pianotist* case, the Opponent submitted that there was a high possibility of confusion and a real tangible danger of confusion as to the origin of the products bearing the RANI marks.

Further, the Opponent submitted that its mark was well known because it was recognized by consumers in many countries of the world as the Opponent had for a long time exported products bearing the RANI marks to various jurisdictions around the world in Kenya. The Opponent urged the Registrar to consider the evidence filed by the Opponent in determining whether the mark was well known.

The Opponent then urged the Registrar to allow the opposition and decline the Applicant's applications.

THE APPLICANT'S SUBMISSIONS

The Applicant identified the following issues for determination by the Registrar:

- 1) Whether the Applicant was the registered proprietor of the RANI marks in particular in Kenya and therefore entitled to protection as such.
- 2) Whether the RANI marks were well known in Kenya and East Africa on account of the Opponent as to be protected without prior registration in Kenya.
- 3) Whether the Applicant's marks were confusingly, visually and phonetically similar and in respect of the same class of goods as likely to cause confusion or deceive the public as to the origin of goods in comparison with the Opponent's marks and if so, who was entitled to protection against the other between the Applicant and the Opponent.
- 4) Whether the Opponent's RANI marks had any goodwill and reputation in Kenya and if so whether the Applicant or the Opponent had created such goodwill and reputation.
- 5) Whether the Applicant's trade mark applications number KE/T/2007/062286, KE/T/2007/062287 and KE/T/2010/067859 should be allowed to proceed to registration or whether the same should be rejected.

On the issue of whether the Applicant was the registered proprietor of the RANI trade mark, the Applicant submitted that it was indeed the registered proprietor of the RANI trade mark in Kenya and other countries in East Africa including South Sudan. The Applicant also submitted that as a proprietor of an unregistered trade mark in Kenya, the Opponent could not be allowed to institute or sustain the present proceedings under section 5 of the Trade Marks Act or otherwise. The Applicant also argued that in terms of Article 6(3) of the Paris Convention, trade marks were territorial in nature and it did not matter whether the Opponent had similar registrations elsewhere in the world. The Applicant as the registered proprietor of the RANI trade marks in Kenya including TMA No. 55720 in Kenya was entitled to be protected as such whether the Opponent was registered as such in other parts of the world. It was the Applicant's submission that the registration of trade marks by the Opponent elsewhere in the world was irrelevant in the absence of the Opponent's registration of the similar marks in Kenya.

With regard to whether the RANI marks were well known in Kenya on account of the Opponent as to be protected without prior registration, the Applicant submitted that section 15A of the Trade Marks Act referred to the protection of a mark that was well known in Kenya and that no evidence had been adduced by the Opponent to show that the mark was well known in Kenya on account of the Opponent. In applying the guidelines set out by the Joint Recommendation Concerning Provisions on the Protection of Well Known Marks, the Applicant submitted that the trade mark RANI was not well known in Kenya on account of the Opponent.

On the issue of similarity between the Opponent's marks and the Applicant's marks and the likelihood of confusion and deception, the Applicant argued that the Opponent had not proved its protection either by registration or as a well known mark in Kenya. The Applicant also argued that the Opponent cannot rely on section 15(1) because the Opponent has not registered any of the RANI marks in Kenya. It was the Applicant's submission that in the absence of the Opponent bringing itself within the realms of sections 14 and 15 of the Trade Marks Act, the issue of similarity should not arise. However, the Applicant still addressed the similarity issue and submitted that the marks are not similar and that there is no likelihood of confusion.

In relation to whether the Opponent's RANI marks had any goodwill and reputation in Kenya and if so whether the Applicant or the Opponent had created such goodwill and reputation, the Applicant submitted that any reputation and goodwill of the RANI products in Kenya was solely as a result of the Applicant's efforts and denied the Opponent's steady presence in various markets including Kenya. The Applicant urged the Registrar to make a finding that the reputation and goodwill by the RANI products acquired in Kenya was solely as a result of the Applicant's efforts and not the Opponent's.

The Applicant urged the Registrar to disallow the opposition by the Opponent as unmerited and allow the marks to proceed to registration.

OPPONENT'S SUBMISSIONS IN REPLY

On the issue of whether the Opponent was the registered proprietor of the RANI mark, the Opponent reiterated that it was the sole proprietor of the RANI mark having

successfully registered, extensively used, advertised and promoted the mark in many countries and having obtained the first registration on 17th May 1984 in the Kingdom of Bahrain.

With regard to the issue of similarity, the Opponent stated that the substantive section was section 14 of the Trade Marks Act. The Opponent reiterated that the marks were similar and urged the Registrar to find that without distinctive differentiation of the products, there was a real risk that a consumer wishing to buy the Opponent's products would inadvertently buy the Applicant's products and vice versa.

In relation to whether the Opponent's RANI marks had any goodwill and reputation in Kenya and if so whether the Applicant or the Opponent had created such goodwill and reputation, the Opponent maintained that its mark was well known and relied on its previous submissions. In response to the steps that the Applicant had taken to portray the goodwill and reputation of products bearing the RANI mark, the Opponent noted that there was no proof of a judicial determination or order supporting injunctive orders in favour of the Applicant and that there was no proof that the Applicant had filed or issued demand notices of its intention to file passing off proceedings.

The Opponent urged the Registrar to allow the opposition and decline the Applicant's trade mark applications.

ISSUES TO BE DETERMINED

I have carefully read through all the evidence on record and the parties' submissions together with the authorities submitted in support of the respective positions. I have also scrutinized the documents on record with regard to TM No. 55720, to which both parties have referred. Having done so, I have arrived at the conclusion that the resolution of the following two critical issues is sufficient to dispose of this matter:

- 1) Who is the owner of the RANI mark?
- 2) What is the nature of the RANI mark?

These two issues are closely related and because they revolve around TM No. 55720, I shall start my analysis by providing a summary of the material on record regarding that mark.

TM No. 55720 - RANI (word mark)

On 11 March 2004, Akaba Investment Ltd (the applicant herein) filed an application for the registration of the mark RANI (word mark) for juices in class 32. Note that the application itself appears to have been erroneously dated 11 April as the record shows that it was received at the Registry on 11 March. On 13 October 2004, the mark was approved for advertisement, advertised in the Industrial Property Journal of 31 December 2004 and subsequently registered on 19 April 2005 for a period of 10 years with an effective registration date of 11 March 2004.

On 21 May 2007, the applicant filed Form TM24, an application to add to or alter a registered trade mark, in which it sought to alter the mark as per an attached label bearing the words RANI NATURAL PEACH JUICE, a can and peach device. The application disclaimed the words ENRICHED, VITAMIN, the letter C, NATURAL, PEACH, JUICE and the picture of the peach fruits. On 29 May 2007, the applicant was requested to also disclaim the device of the can, which it did on 31 May 2007.

Following advertisement, a notice of opposition to the application was filed by Aujan Industries Co. on 27 July 2007. The notice was forwarded to the applicant's advocates by registered mail on 9 October 2007, but when the letter was returned to the Registry by the post, a copy was delivered physically in March 2008. No response was received from the applicant meaning that the application to alter the mark was deemed abandoned under rule 52A of the Trade Mark Rules.

No further action took place with regard to the mark until 6 June 2012, when an application to register an assignment or transmission (Form TM14) was received at the Registry. The application indicated that the person entitled to registration by assignment was Al Mahra Industries Ltd and the attached deed of assignment shows that the Assignment had actually taken place on 1st day of May 2008 from Akaba Investments Ltd. as Assignor to Al Mahra Industries Ltd as the Assignee. The Certificate of Registration of Assignment was duly issued on 7 June 2012 with the effective date of registration being 1 May 2008.

Ownership of the RANI mark

With that background in mind, the legal position with regard to the ownership of the mark RANI is therefore that the registered proprietor of the mark is Al Mahra

Industries Ltd, and this has been the case since 1 May 2008. The Opponent has not provided sufficient evidence to support its contention that it is the proprietor of the RANI mark in Kenya and, having not lodged a challenge to the registration of TM No. 55720 which has been on the register since 2004, it would appear to have accepted the use of the RANI word mark in Kenya by the Applicant. Even after its application was refused due to the Applicant's registration of the RANI mark as admitted by the Opponent, the Opponent did not take any action to assert its right as alleged proprietor of the RANI mark.

With regard to the actions of the Applicant, it is a matter of great concern that in its counter-statement, statutory declaration and written submissions, the Applicant repeatedly averred that it was the owner of TM No. 55720, knowing full well that it had assigned it to Al Mahra as long ago as 2008. This is critical because the applicant relied on that averment of ownership to contest the opponent's ownership of the mark in Kenya, yet, as recited above this is demonstrably false.

Section 20(1) of the Trade Marks Act provides that:

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 this instance, it is clear that at least by the time it was filing TMA No. 67859 in March 2010, it knew that it was no longer the owner of the RANI mark. It is therefore doubtful that the Applicant satisfied the ownership requirements for filing the trade mark application. The opposition to the registration of TMA No. 67859 succeeds on this ground.

At this point, I should also point out that in filing application TMA No. 62286 RANI NATURAL PEACH JUICE (word and device), knowing that it had made a similar application with regard to TM No. 55720 on 21 May 2007, the applicant was abusing the trade mark registration process by seeking to secure the grant in this application of what had already been opposed in the earlier application. This attempt to circumvent the registration process is to be deplored.

In the circumstances, the opposition to the registration of TMA 62286 also succeeds though for reasons other than those put forward by the opponent.

Nature of the RANI mark

The second issue that I consider critical to determining this matter relates to the nature of the RANI mark. As recited above, in all the three applications in question, the applicant disclaimed the descriptive words as well as the can device and the pictures of the various fruits. Once this was done, the only distinctive or dominant element of the mark remaining is the word RANI.

Section 15(1) of the Trade Marks Act provides, *inter alia*, that ‘no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods.’

Section 15(2) contains a proviso allowing registration of an identical mark in the case of honest concurrent use or other special circumstances.

Applying the law to the situation at hand, it is clear that there is a mandatory prohibition against the registration of identical marks for identical goods save for exceptional circumstances. In this instance, RANI is a registered mark, TM No. 55720, belonging to Al Mahra and it is the duty of the Registrar to safeguard a proprietor’s mark by refusing the registration of identical marks for the same class of goods. Having registered that mark, the proprietor was and is at liberty to use it for any juices that it produces.

The Opponent argued that it was the true owner of the mark RANI but was unable to produce any evidence of having registered the mark in Kenya. As the applicant correctly pointed out, trade mark protection is territorial in nature and the fact that the opponent may have managed to secure registration of its mark in other territories is no guarantee of registration in Kenya. In this instance, we have a validly registered mark on the Register, as acknowledged by the Opponent in its Notice of Opposition, and in the absence of any challenge to that registration, the issue of the ownership of the mark RANI is settled, as discussed above.

Consequently, by virtue of section 15(1) of the Trade Marks Act, the applications for the registration of the three marks are refused and the marks shall not proceed to registration.

I would like to end by thanking the parties for their detailed and voluminous pleadings and submissions in this matter, which I read carefully, but for the aforesaid reasons, there is no need to enter into a detailed discussion of those pleadings.

DECISION

For the reasons set out above, the Registrar finds as follows:

- 1) The Opponent's opposition to the Applicant's application to register TMA Nos 62286, 62287 and 67859 succeeds.
- 2) The Applicant's applications herein shall not proceed to registration.
- 3) Costs of the proceedings are awarded to the Opponent.

Ruling dated and delivered this 12th day of September 2012



Dr. Henry Kibet Mutai
Managing Director