

REPUBLIC OF KENYA

KENYA INDUSTRIAL PROPERTY INSTITUTE

IN THE MATTER OF THE TRADE MARKS ACT AND
IN THE MATTER OF TRADE MARK NOS. 63725 “WAKILISHA LIMITED ..TOTALLY
REPRESENTING..” (WORD AND DEVICE)
AND 64269 “WAKILISHA” (WORD AND DEVICE)
IN THE NAME OF WAKILISHA LTD
AND EXPUNGEMENT PROCEEDINGS BY VISION 2030 DELIVERY SECRETARIAT

(Hearing held on 17 July 2013

John Syekei, Coulson Harney for the applicant, Vision 2030 Delivery Secretariat;

Wanjiku Muriu, Wanjiku Muriu & Co., for the respondent, Wakilisha Ltd;

Amos Otieno, Clerk, KIPi;

Before the Registrar: Dr. Henry Kibet Mutai)

RULING

INTRODUCTION

This is an expungement proceeding filed by the applicant, Vision 2030 Delivery Secretariat, against the registration of trade mark numbers 63725 WAKILISHA LIMITED ..TOTALLY REPRESENTING.. (word and device) and 64269 WAKILISHA (word and device), in the name of Wakilisha Limited.

PROCEDURAL HISTORY

On 23 January 2012, the applicant herein, The Vision 2030 Delivery Secretariat, filed two applications for the expungement of trade mark nos 63725 WAKILISHA LIMITED ..TOTALLY REPRESENTING.. (word and device) in class 16 and 64269 WAKILISHA (word and device) in class 41.

The applications in Form TM 25, were accompanied by a statement of case and the requisite fees. The grounds on which the application was based were, *inter alia*, that the applicant was a semi-autonomous government entity that had been established to drive Kenya's development into a first world country by the year 2030 and to this end had prepared an aggressive marketing campaign centred around encouraging Kenyans to be a part of the development of Kenya and to represent themselves in the process, thus they would "Wakilisha" themselves, that the Wakilisha word was used in its common, descriptive and generic sense by the applicant, that the proprietor of the offending marks had by letter dated 11 January 2012 threatened to go to court to stop the applicant from using the word Wakilisha in its campaigns and that in doing so it was seeking to enforce its rights in a manner contrary to the public interest. The application further stated that the offending marks were contrary to section 12, Trade Marks Act, in that they were not distinctive as trade marks, that the offending marks were also contrary to sections 14 and 18 of the Act, that a market investigation carried out by the applicant had established that the proprietor was a brief case company that was not trading in the market and that, for those reasons, the offending marks were wrongly remaining on the Register. Lastly, the applicant stated that it was an aggrieved party in terms of section 35(1) of the Trade Marks Act as it was an agency of the government entitled to use the word Wakilisha in executing its lawful mandate and would be unable to use the word because of the existence of the offending marks on the Register.

The applications were duly forwarded to the respondent, Wakilisha Ltd., by a letter dated 1 February 2012.

On 21 February 2012, the respondent filed its counter statement to the application. In its counter statement, the respondent stated, *inter alia*, that it asserted its right to hold its legally acquired property, which property included intellectual property as set out in the definition of property in the Constitution, and that its ownership of the two trade marks was undisputed as per the certificates that were issued lawfully after the process set out in the Trade Marks Act on 9 January 2009 and 18 March 2009 respectively.

Further, the respondent stated that the applicant as the institution mandated to facilitate the actualisation of Vision 2030 was supposed to ensure that the three pillars of Vision 2030 were built up and strengthened, that as such, it ought to have at the very least carried out a search to establish whether the phrase they intended to use was a registered trade mark, that its action of taking over a duly registered trade mark was a gross violation of the tenets it was created to uphold and that its application to expunge the trade marks was an attempt to intimidate and harass the respondent to drop its claim.

The respondent further denied that the registration of the marks had been done in contravention of sections 12, 14 and 18 of the Trade Marks Act. It alleged that it had “the exclusive right to use the trade mark in education, providing of training, entertainment, sporting and cultural activities” and that the assertion by the applicant that it had been using the mark in a “public education campaign” was a blatant admission of infringement for which damages were payable. The respondent further stated that the applicant did not qualify as an aggrieved person simply by being a semi autonomous agency of the government.

Lastly, the respondent stated that the applicant was free to use any of the numerous terms in the Swahili language in its campaign without resorting to the mark owned by the respondent and that the market investigation carried out by the applicant leading to the conclusion that the respondent was a brief case company did nothing to cleanse or purge the infringement by the applicant.

The counter statement was thereafter forwarded to the applicant by a letter dated 20 March 2012 with a request for it to file its statutory declaration in reply.

On 4 June 2012, the applicant filed its statutory declaration sworn by Nicholas K. Mwilu. In the statutory declaration, the deponent averred, *inter alia*, that he was the Assistant Director Finance and Administration of the applicant, duly authorized and competent to make the declaration, and that the respondent’s counter statement did not answer or sufficiently answer the applicant’s expungement application.

The statutory declaration further stated that by a contract dated 27 April 2011, the applicant had procured an advertising agency to prepare an aggressive marketing and publicity campaign to achieve its objectives centred on encouraging Kenyans to play a

part in developing Kenya, that the Wakilisha campaign was launched on 5 December 2011 and ran for a period of five weeks across different media platforms, that the Wakilisha concept had been chosen from four creative concepts developed by the Agency and that the campaign statement “Wakilisha” was informed by the creative rationale which was to have Kenyans know that Vision 2030 represents them.

The deponent further averred that the applicant was aggrieved by the registration by the respondent of the two offending marks, that the respondent had, by a letter dated 11 January 2012, threatened to go to court to stop the applicant from using the word “Wakilisha” in its campaigns, that the applicant had instructed a private investigator to carry out an investigation into the respondent, that the investigator found no use by the respondent of the offending marks in commerce, and that the letter was thus written in bad faith.

For the reasons stated, the applicant prayed that the offending marks be expunged from the Register.

Attached to the applicant’s statutory declaration were a number of exhibits comprising:

Exhibit NKM1 - Kenya Gazette Notice No. 1386 dated 13 February 2009, establishing the Vision Delivery Board;

Exhibit NKM2 - Contract Agreement made on 27 April 2011 between Kenya Vision 2030 Delivery Secretariat and Ogilvy & Mather (EA) Ltd. for provision of integrated marketing communication services;

Exhibit NKM3 - letter dated 11 January 2012 to the Secretary/CEO of Vision 2030 Delivery Secretariat from Wanjiku Muriu & Company; and

Exhibit NKM4 - letter dated 23 January 2012 to Coulson Harney Advocates from Alexander James Private Investigators;

The statutory declaration was forwarded to the respondent by a letter dated 18 June 2012 in which it was requested to file its statutory declaration within 42 days of receipt of the letter.

The respondent duly filed its statutory declaration on 19 July 2012. In the statutory declaration, which was sworn on its behalf by Edith Wanjiku Muriu, the deponent

stated, *inter alia*, that she was an advocate of the High Court of Kenya and also a director of the respondent company, that she reiterated the contents of the counter statement and averred that the respondent's trade marks were properly and legally in the Register, that the respondent had no dispute with the applicant seeking to popularise its mandate and objectives and that its only contention was that the applicant had in its publicity campaign infringed on the rights of the respondent. The deponent denied that the applicant was an aggrieved party, and that the registration of the marks was in contravention of sections 12 and 18. The deponent averred that the word "Wakilisha" fell within the definition of distinctiveness and was in the same position as other trade marks emanating from the Swahili language and that there was nothing about the registration that restricted everyday speech. The deponent alleged that the applicant had admitted conduct of infringing a registered mark and hence did not come with clean hands and that its application for expungement was a total abuse of the legal process. For these reasons, the respondent prayed that the application be dismissed with costs.

Attached to the respondent's statutory declaration were a number of exhibits comprising:

Exhibit EWM1 - a certificate of incorporation of Wakilisha Limited dated 6 August 2007;

Exhibit EWM2a - The cover page of the Industrial Property Journal for December 2008;

Exhibit EWM2b - page 34 of the December 2008 Industrial Property Journal with applications for registration of the marks MULIKA MWIZI and SAWA highlighted; and

Exhibit EWM2c - page 40 of the December 2008 Industrial Property Journal with the application for registration of the mark AMA highlighted.

The statutory declaration was forwarded to the applicant by a letter dated 23 July 2012 in which it was asked to file its statutory declaration in reply, if any, within 30 days of receipt of the letter.

In response, the applicant's agents wrote back stating that their client did not intend to file a replying statutory declaration and seeking the fixing of a hearing date.

Hearing of the suit was subsequently fixed by consent for 15 November 2012. The hearing was not, however, able to proceed on that date. On 21 January 2013, the applicant wrote to the Registrar seeking the consolidation of the two matters so that they could be heard on the same day. This request was forwarded to the respondent, who by a letter dated 31 January 2013 indicated that it had no objection to the consolidation of the two matters.

Hearing of the matter eventually proceeded on the 17 July 2013.

At the start of the hearing, counsel for the respondent started by stating that in correspondence she had indicated that the respondent might wish to cross-examine the witnesses of the applicant.

In reply, counsel for the applicant stated that the applicant would not be calling any witnesses in the matter but would be relying on the declaration and statement on record. Moreover, he stated that he would be ready to proceed by way of written submissions.

Having heard counsel for both parties and read their statements, I ruled against the respondent's application on the ground that the issues to be determined were legal in nature and the key facts, such as they are, were not in dispute. There was therefore no value to be gained in calling witnesses.

APPLICANT'S SUBMISSIONS

Counsel for the applicant started his submissions by reiterating that the applicant relied on the grounds stated in its Form TM25 statement of case and the statutory declaration of Nicholas Mwilu in its entirety and adopted the same for the purposes of the submissions. He submitted that there were four key legal issues for determination:

- i) Whether the applicant was an aggrieved person within the meaning of section 35(1), Trade Marks Act and entitled to bring the expungement proceeding;
- ii) Whether the applicant had discharged its burden of proving that the entries of TM 64269 (word and device) were made in the Register without sufficient

cause and whether the entry of TM 63725 (slogan) was made in the Register without sufficient cause;

iii) Whether the applicant had discharged its burden of proving that the entry of TM 64269 and the entry of TM 63725 wrongly remained on the Register; and

iv) Whether TM 64269 and TM 63725 should be removed from the Register.

He submitted that the substantive law governing expungement proceedings was the Trade Marks Act and what should be of concern and of relevance was the legality of the continued existence on the Register of the two marks as trade marks. He submitted further that the essential function of a trade mark was to allow the parties or consumers to identify and connect the owner of a trade mark to the goods or services to which the trade mark was applied.

In short, trade mark registration was a matter of public policy and whether or not it was a constitutional right for a person to register a trade mark would not be material to expungement proceedings but rather whether trade marks were validly registered and used in accordance with registration conferred upon them. He submitted that the applicant was an aggrieved person and was lawfully entitled to bring the proceedings by virtue of section 35(1), read with rule 82 of the Rules.

In support, he cited *Kerly's Law of Trade Marks and Trade Names* at pages 260-261 where it was stated that any trader who wished to use a challenged registered trade mark not as a trade mark but as a description of his goods qualified as an aggrieved person.

Further, in *In re Ralph's Trade-Mark* (1883) 25 Ch. D. 194, 198 the court had held that a person against whom an injunction was sought or threatened against his use of a mark which ought not to be on the Register was an aggrieved person and entitled to make an expungement application.

Counsel submitted that it was not in dispute based on the facts contained in the statutory declarations that the respondent sent a cease and desist letter and threatened infringement proceedings before the High Court on the basis of the applicant's continued use of the word WAKILISHA in its advertising campaign. It was not in doubt that the relief that would have been given to the respondent would have

been to obtain an injunction against the applicant's continued use of the word WAKILISHA. In light of this, he submitted that the Registrar should find that the applicant qualified as an aggrieved person under section 35, Trade Marks Act. With regard to the legal issues that had to be proved for one to be successful in an expungement proceeding under s. 35(1), counsel submitted that these were settled. In a decision by the Registrar in *In re TM No. 59514 RISEK OMEPRAZOLE (Getz Pharma (Private) Ltd v Gulf (Julphar) Pharmaceutical Industries)*, it was stated that s. 35(1) of the Trade Marks Act provided that in order to succeed in an application for removal or expungement of a mark from the Register, an aggrieved person had to plead and prove either or all of the following factors:

- a) That an entry in the Register was made without sufficient cause, or
- b) That an entry wrongly remains in the Register, or
- c) That there was an error or defect on the entry in the Register.

Counsel submitted that the material legal issues were set out and based on the facts contained in the pleadings and statutory declaration of Nicholas Mwilu, and that TM 63725 and TM 64269 were challenged on the basis of the *Getz Pharma* decision. To expound on these factors the applicant relied on the statement made by Lord Diplock in *General Electric v The General Electric Co. Ltd.*

The applicant's argument was that when considering these factors, the burden of proof for the applicant was to show that the challenged mark should not have been registered in the first place as it was likely to deceive or cause confusion per s. 14 and this would have been found to be an entry made without sufficient cause.

Secondly, on its argument seeking to expunge the trade mark on the ground that an entry wrongly remains on the register, the applicant had to prove that although the entry was valid, the likelihood of confusion in the market had developed, resulting from some blameworthy act of the proprietor exposing it to an expungement action. It was counsel's submission that there were two angles to the proceedings: the first one was that the challenged marks were registered without sufficient cause and this was indicated in the facts set out in Nicholas Mwilu's statutory declaration.

The second angle was that even if they may have been registered with sufficient cause, they wrongly remained on the register because of the blameworthy acts of the

proprietor because trade marks could only exist if they met the essential functions of a trade mark and were able to be identified by the public as trade marks.

In this regard, counsel referred to section 14, Trade Marks Act which provides that

No person shall register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

He submitted that there were material issues that derived from section 14 in the shape of deception, confusion and or otherwise.

Counsel submitted that a trade mark which was not inherently distinctive under s. 12, Trade Marks Act and which was dominantly comprised of words that were common every day words, descriptive or generic in nature and which would not provide character to a trade mark enabling it meet its essential function were disentitled to any protection by a court of justice under s. 14, because such words were likely to cause deception, confusion in the market unless it could be proved otherwise.

This was the very reason why marks were required to be distinctive.

Counsel submitted that the dominant element of TM 64269 would be the word WAKILISHA separately and apart from the device. This was because the respondent through its action of sending a cease and desist letter to the applicant emphasized and focussed on the word WAKILISHA with no reference to the device.

He submitted further that the word WAKILISHA was by its nature a common and ordinary Kiswahili word used by Kenyans in their every day speech in light of the fact that Kiswahili was a national language. He submitted that this word was descriptive in the sense that the English translation of the word WAKILISHA was to represent and going further 'represent' would mean the capacity or ability of a person to be entitled or appointed to act or speak for someone especially in an official capacity. In support of this contention, counsel relied on an extract from *Tuki Kamusi ya Kiswahili-Kiingereza* (Swahili-English Dictionary) and oxforddictionaries.com.

In light of the above, counsel submitted that anyone who sought to claim trade mark rights over an inherently descriptive word would need to satisfy the Registrar that this word had no meaning when applied to the goods or services it sought to identify as

belonging to the proprietor and as such would be used in that manner, or that this particular word had gained a secondary meaning through use prior to registration. He further submitted that the Registrar did allow descriptive words that had gained secondary meaning to be registered or words that would generally have a meaning ascribed to them in the local language subject to a disclaimer limitation over the use of the word. In any case, he submitted that such trade marks were registered at a risk and the function of any disclaimer was to put the proprietor on notice that such trade marks should be used as a trade mark and not in their descriptive sense because this would defeat the whole philosophy and rules around trade mark protection and enforcement, in light of their public role.

He asserted that though trade marks were proprietary in nature, they had to be used in a manner that allowed them to distinguish the services or goods to which they were applied from the rest of the other goods in the market. He submitted that the burden that lay on a proprietor who had registered such a trade mark was extremely high and in this case the proprietor of the challenged marks registered these trade marks knowing all too well that they were trade marks made up of words that could easily be used in their descriptive manner.

In short, these trade marks would easily fall in grace and possess no trade mark qualities depending on the nature of their use. Therefore it was paramount that the use of these trade marks was analysed. On the basis of the facts contained in the statutory declarations, both by the applicant and the respondent, he submitted that there was no evidence of any use of the challenged trade marks.

Counsel submitted that the applicant had provided evidence that it was using the mark WAKILISHA in its descriptive sense for a nation wide campaign in fulfilment of its public mandate to promote the government's Vision 2030 goals. This use of the word WAKILISHA resonated with any other person's right to use an ordinary Kiswahili word, in its descriptive sense as a verb.

If a trade mark owner as was the case with the respondent was allowed exclusive rights in the use of the word WAKILISHA or any other word of similar nature that described a person, place or attribute of a product, the Swahili language would be depleted. Indeed, if you registered a trade mark that could be used by anybody in a

descriptive sense and you did nothing to distinguish it in the market, you would be guilty of allowing your trade mark to become generic.

Counsel referred to *New Kids on the Block et al v News America Publishing v Gannett Satellite Information Network* 971 F.2d 302, where a trade mark registrant was forbidden from appropriating a descriptive word for his exclusive use or registering a word and seeking to enforce it in its descriptive sense.

In this regard, he also referred to Article 17, TRIPS which provides that “Members may provide limited exceptions to the rights conferred by a trade mark, such as fair use of descriptive terms, provided that such exceptions take account of the legitimate interests of the owner of the trade mark and of third parties”.

Counsel argued that the respondent very well chose a mark which it sought to register and it was the applicant’s submission that it should not have complained if that word could easily be used in its descriptive sense, as they essentially registered a trade mark that was perhaps distinctive or claimed to be distinctive at the point of registration but then in contrast with their purported use of these trade marks sought to enforce these trade marks in their descriptive sense essentially confirming that those trade marks were descriptive in nature and could only be enforced in that manner as descriptive words.

Counsel submitted that indeed the respondent at paragraph 14 of its counter statement had indicated that the applicant was free to use any other terms in the Swahili language thereby admitting that it sought to expropriate a Kiswahili word in its ordinary and descriptive meaning despite the existence of a disclaimer with respect to TM No. 64269 where they disclaimed Represent.

In this regard, counsel referred to the “*Daiquiri Rum*” trade mark case [1969] RPC 600.

Counsel continued that in the event that the Registrar found that the marks were registered with sufficient cause, the applicant submitted that the facts in this matter showed that the challenged trade marks wrongly remain on the Register because of blameworthy acts of the proprietor.

The blameworthy acts were:

- i) The respondent registered trade marks using descriptive words but failed to take steps as it was required to do by virtue of its registration to distinguish these marks through use;
- ii) The respondent had used these challenged marks in their descriptive manner rendering them generic and had sought to enforce them in their descriptive manner;
- iii) The respondent had sought to actively appropriate a Kiswahili word as belonging to it in its descriptive sense.

Counsel submitted that a proprietor who registered a highly descriptive trade mark bore a heavier burden to take steps to prevent its becoming a common name than one who registered an inherently distinctive word. In support of this proposition, counsel referred to *Kerly's Law of Trade Marks and Trade Names* at p. 372 and to the *KIPI Trade Marks Manual of Examination* procedures at pages 5 and 35.

He submitted that in light of the above, the respondent had chosen not to use the challenged trade marks to indicate any connection with the goods or services it purportedly traded in but to use them in their descriptive sense hence establishing that these trade marks lacked essential character needed to enable them fulfil their functions in the market. Further, that by seeking to enforce these offending trade marks as against the applicant, the respondent had used the trade marks contrary to the registration conferred upon them by the Registrar of Trade Marks, who gave them a monopoly over these challenged trade marks as long as they were used as trade marks in a distinctive manner. This, the respondent has failed to do.

Looking at the two trade marks, counsel argued that one would note that one was in class 41 seeking to denote services of entertainment and the other was in class 16 for printed material. It was surprising that the respondent sought to enforce its purported rights over the word WAKILISHA with respect to the use by the applicant by relying on entertainment services for which it had secured trade mark rights and printed material because without any proof of use showing any distinctive nature over the word WAKILISHA, then it was likely that the challenged trade marks could be used in such manner that the entire entertainment industry and the entire printing industry would be unable to use the word WAKILISHA to describe the representation of

entertainment services or goods to Kenyans and promote those services through promotional materials on billboards and stationery and posters to the Kenyan public. These challenged trade marks' continued existence on the Register would be contrary to public interest. Therefore, it was the applicant's humble submission that the application for expungement of TM 64269 and 63725 be allowed as prayed and that an order of costs be made in favour of the applicant.

RESPONDENT'S SUBMISSIONS

Counsel for the respondent started by reiterating that the applications for expungement were opposed by the respondent and that its documents, that is, the counter-statement and declarations, were on record. She stated that she would rely on those two documents and reiterate all that was contained therein.

She highlighted the fact that the marks sought to be expunged had been registered in 2009, long before the campaign instituted by the applicant. The applicant had been in existence since February 2009 and did nothing to object to the registrations that it now sought to have expunged. Consequently, the respondent imputed indolence and failing to exercise due diligence before the commencement of its (the applicant's) campaign. She submitted that one of the stated functions of the applicant was to promote the rule of law in Kenya and that it should be leading in legal compliance which it had failed to do.

For the applications to succeed, counsel submitted that the test was very clear in section 35 and that the burden of proof lay on the applicant, never the respondent to prove that there was insufficient cause, there was an error or defect or that the entries remained wrongly on the Register, and that the applicant was an aggrieved party.

She submitted that since section 35 and rule 82 did not define who an aggrieved party was, one had to look at the facts to determine who really was an aggrieved party. She submitted that the facts showed that the applicant was an infringing party. It was an admitted fact that there was a massive electronic/print media campaign in December 2012, there had been no suggestion that in any search, the marks were not found on the Register and the respondent's submission was that an infringing party

could not be an aggrieved person. In support of this assertion, she relied on *Kerly's Law of Trade Marks* at p. 261.

Counsel submitted that the applicant did not use the mark before it was registered and had only began the use of the marks three years after registration. It was thus not an aggrieved person and on that ground the application had to be struck out.

With regard to the issue of whether or not the entry was made in the Register with sufficient cause, counsel stated that the applicant had said that it was done without sufficient cause because the mark was not distinctive enough, but was merely a descriptive word used in every day speech. She admitted that the word WAKILISHA indeed emanated from the Swahili language and was used in everyday use. However, the reason it was registered as a trade mark was very clear and appeared in the relevant certificates. It was, she submitted, registered in classes 16 and 41, education, entertainment, public campaigns. Those had no relation whatsoever to the ordinary meaning of the word which was to 'represent'. For the purposes of the services/goods, it was thus distinctive within the meaning of section 12(2), Trade Marks Act.

The respondent's submission was that all references to description in the applicant's submissions had to be dismissed. Suffice it to say that the test of distinctiveness lay with the Registrar and that before the mark was registered there was an entire process to establish distinctiveness or otherwise of the mark. It had to be presumed that the process was followed and the Registrar registered the marks.

With regard to whether the mark was likely to cause confusion in the minds of the public, counsel submitted that the answer was no. In any event, whether or not confusion could be caused was a matter for evidence. In support of this, she relied on the *General Electric Case* at p. 36.

At this level, she submitted, the question as to whether or not there was confusion was hypothetical. There was no evidence that anybody had been confused. She further pointed out that in this case as in the *Getz Pharma* case, both applications to

expunge were dismissed with costs. She thus invited the findings of the Registrar and the judges in England in that regard to be upheld.

Counsel further submitted that in Mwilu's statutory declaration, there had been no evidence, implied or expressed saying that the marks were registered without sufficient cause. The applicant had sought to demonstrate that the respondent had blameworthy conduct that would now disentitle it to the property it legally held. Her submission was that the only legal duty on the respondent was vigilance. The respondent was not obliged to prove its business dealings with suppliers, bankers and whoever else it dealt with neither was there a legal obligation to undertake massive advertising. All the holder of a trade mark was required to do was enforce his proprietary rights. A trade mark was property, like real property, and as long as one could establish good title, the whole world was excluded from asserting contrary title. There was no requirement for a holder of property to develop it although it would make good economic sense. The respondent, in her submission, was a holder of a valid trade mark, it was a trading company, it was known to those to whom the respondent traded and that was enough.

She further submitted that if anyone was guilty of using the mark in its descriptive form, that person was the applicant, not the respondent. Classes 16 and 41 were very clear as to what the holder of a trade mark could and could not do with the mark and this was not unusual.

The Registrar had previously and continued to register words in the Kiswahili language and the respondent had annexed exhibits to this effect from the Industrial Property Journal. That did not mean that a Kenyan could not use the same words in ordinary conversation. There was thus nothing extra-ordinary in having WAKILISHA registered as a mark in its respective classes.

Counsel submitted that there had been no evidence led to show that the registration was contrary to law, scandalous or immoral i.e. there was no evidence to show that the continued possession of the marks by the respondent offended section 14.

In conclusion she submitted that even if it were to be found that there was a requirement for use, it could not be made before the expiry of five years. The respondent had been in possession of the marks since 2009, had at least five more

years until the expiration of the marks and the period of time that had lapsed was not sufficient neither could it be said to be unreasonably long as to disentitle the respondent of possession.

Concerning *The New Kids on the Block* and the “*Daiquiri Rum*” cases, counsel submitted that those decisions were not binding law in Kenya and they could therefore be distinguished on that ground.

The respondent’s last submission was that it was contrary to public policy and any notion of justice that a person could be deprived of its legally acquired property without fair compensation. This was a well-settled principle and in the demand letter that was sent to the applicant, invitation was actually made for the parties to come to a suitable licence agreement. The respondent was also a Kenyan citizen, had no problems or objections to the objectives of Vision 2030 but the law had to be followed. In the respondent’s view, the applicant’s action of straight away moving for expungement without at the very least making moves for a suitable license agreement smacked of malice and bad faith which could not be condoned.

Counsel prayed that the marks be found not to be descriptive or offensive or against public policy and to remain on the Register for the classes for which they were registered. She noted that the applicant had asked that the respondent be penalised with costs and asked that costs in any event be awarded to the respondent as there could be no allegation that the registration was obtained fraudulently and there was no reason for it to be made to pay costs. The respondent had been dragged to court by the applicant. She thus prayed that the application be dismissed with costs.

APPLICANT’S SUBMISSIONS IN REPLY

In reply, on the issue that the applicant had been in existence since 2009 and that the registration was in place before the applicant came into place, counsel for the applicant submitted that that was not relevant as a party was entitled to file an application whether or not it was in existence. Moreover, there was no duty in any case to conduct searches before using words in their everyday sense.

With respect to section 35, counsel agreed that the burden of proof did lie with the applicant and he stated that it was their belief that they had discharged that burden

by relying on the cease and desist letter. He also referred to the *Getz Pharma* ruling at p. 6 regarding whether the applicant was an infringing party or an aggrieved party. He argued that the fact of sending a cease and desist letter made the recipient an aggrieved person.

On the issue where the respondent's counsel indicated that the word was distinctive for goods in class 16 and services in class 41, counsel submitted that this went to the root because the question the applicant was posing was, if they were distinctive, why were they being enforced in a descriptive manner against the applicant?

On the point that the Registrar registered the trade marks and should have known that they fail the test of section 12, the applicant's reply was that section 35 existed to allow a party to challenge a trade mark for that reason.

On the question that the only duty of the respondent was vigilance and that no evidence was provided by the applicant, counsel replied that the application was on two legs, firstly, that the marks were registered without sufficient cause because they are descriptive, and secondly, they were wrongly on the register due to blameworthy acts of the respondent.

Counsel further submitted that the respondent's counsel had agreed with the applicant's submissions in the sense that the applicant used the word in its descriptive sense and yes, they were guilty of using it in a descriptive sense. The question was, were the trade marks distinctive and it was clear they were not and they did not have any distinctive sense.

Counsel concluded by observing that the respondent had offered to licence the word in its descriptive sense and that it was contrary to public policy to allow extortion.

ISSUES TO BE DETERMINED

The applicant seeks the expungement from the Register of the respondent's two trade marks primarily on the grounds that the main element of the marks, "Wakilisha", is a common, descriptive and generic Swahili word and that their registration was contrary to the provisions of sections 12, 14 and 18 of the Trade Marks Act.

The respondent, on the other hand, opposes the application on the grounds that the trade marks were legally registered in accordance with the process provided for under

the Trade Marks Act and that the applicant is not an aggrieved person under the relevant provisions of law.

I have carefully read through all the pleadings, exhibits and authorities as well as heard the submissions by the parties and, having done so, identified the following as the issues to be determined in resolving this matter:

- Is the applicant an aggrieved person within the meaning of section 35, Trade Marks Act?
- Were the two marks entered on the Register without sufficient cause?
- Were the two marks wrongly remaining on the Register?

Before I embark on discussing the above issues, it is worthwhile to clarify the background and current status of the two marks in question.

TM No. 63725 WAKILISHA LIMITED ..TOTALLY REPRESENTING.. (word and device) was registered subsequent to an application for registration of the mark in class 16 for “Printed Matter” by Wakilisha Limited. The application was filed on 24 July 2008 and duly approved for advertisement on 7 August 2008. The mark was then advertised in the Industrial Property Journal of September 2008 after which, no notice of opposition having been received, it was registered with effect from 24 July 2008 for Class 16 (Printed Matter). The registration expires on 24 July 2018.

TM No. 64269 WAKILISHA (word and device) was registered subsequent to an application for registration of the mark in Class 41 for “Entertainment” by Wakilisha Limited. The application was filed on 17 October 2008 and duly approved for advertisement on 25 November 2008. The mark was then advertised in the Industrial Property Journal of December 2008 after which, no notice of opposition having been received, it was registered with effect from 17 October 2008 for Class 41 (Entertainment). The registration expires on 17 October 2018. It should be noted that the certificate for TM No. 64269 bears the annotation TRANSLATION INTO ENGLISH OF THE KISWAHILI WORD “WAKILISHA” IS “REPRESENT”. This is additional information that was included in the application for registration.

With this background in mind, I shall now proceed to address the issues identified.

1. Is the applicant an aggrieved person?

This is an issue that was addressed by both parties with the applicant asserting that it is an aggrieved person under section 35 and the respondent contesting that assertion. In support of its position, the applicant relied on *Kerly's Law of Trade Marks and Trade Names* and the case of *In re Ralph's Trade-mark* together with evidence in the form of the cease and desist letter received from the respondent. The respondent, on the other hand, argued that the applicant did not become an aggrieved person simply because of its status as a semi autonomous government agency and more so because the applicant was, in its opinion, an infringing party.

The relevant legal provision, referred to by both parties, is section 35(1) which provides that:

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.

As the respondent correctly pointed out, this provision does not actually define who an aggrieved person is. In the *Getz Pharma* case, the two parties being involved in the same trade persuaded the Registrar to hold that the applicant was an aggrieved person. In this instance, the two parties are not in the same trade.

However, I am in agreement with counsel for the applicant and am persuaded by the decision in *In re Ralph's Trade-mark* case, that the sending by the respondent of a cease and desist letter to the applicant in which the two marks were referred to, renders the applicant an aggrieved person with the capacity to initiate expungement proceedings.

The respondent's allegations that the applicant had infringed its trade marks and hence could not be an aggrieved party are not relevant and cannot be entertained given that the allegation of infringement has not been canvassed and determined before a competent court of law.

2. Were the two marks registered without sufficient cause?

Under section 35(1), this is one of the grounds on which a mark can be expunged from the Register. On this matter, the applicant's argument was to the effect that the word WAKILISHA was not a distinctive term capable of registration under section 12 of the Trade Marks Act and thus would not be entitled to protection by a court of law under section 14. Rather it was a common Kiswahili word used in everyday conversation.

The respondent, on the other hand, while agreeing that the word emanated from the Kiswahili language, submitted that with regard to the specific classes under which the marks were registered, the marks fell within the definition of distinctiveness in section 12(2).

On this issue, I would wish to start by noting that contrary to the respondent's assertion in paragraph 11 of its counter-statement, which was repeated in its submissions, that TM 64269 gives it the exclusive right to use the trademark "in education, providing of training, entertainment, sporting and cultural activities", the trade mark is in fact registered for just one of the services available in class 41, and that is ENTERTAINMENT. Any claim to exclusivity with regard to any of the other particular services in class 41 is invalid as they were neither included in the applicant's application, as required by section 6(1) of the Trade Marks Act, nor included in the certificate of registration.

That being so, I am in agreement with the respondent's arguments that in so far as the registration of TM 63725 in class 16 for PRINTED MATERIAL and TM 64269 in class 41 for ENTERTAINMENT is concerned, the respective marks do indeed fall within the definition of distinctive under section 12 and do not have any direct reference to the character or quality of the respective goods and services.

The issues as to whether or not the applicant's publicity campaign was using the word WAKILISHA in an ordinary, every-day manner and whether or not the respondent was justified in seeking to stop the applicant's use of the word are not relevant for purposes of determining whether the marks were registered without sufficient cause and would more appropriately be canvassed in an infringement dispute. Suffice it to say that the respondent's rights with regard to the registered marks extend only to

PRINTED MATTER (in class 16) for TM 63725 and ENTERTAINMENT (in class 41) for TM 64269.

3. Are the two marks wrongly remaining on the register?

On this issue, the applicant argued that the marks in question wrongly remained on the register due to the blameworthy acts of the respondent. These blameworthy acts were, firstly, failing to take steps to distinguish the marks through use, secondly, seeking to enforce the marks in a descriptive manner and thirdly, seeking to appropriate a Kiswahili word in its descriptive meaning.

The respondent for its part, argued that the only legal duty required of a proprietor was to exercise vigilance, that there was no duty to develop property even though it would make good economic sense, and that in any case, the issue of use could not be raised before the expiry of five years from registration.

In order for an applicant to succeed on this ground, it has to establish that even though the mark(s) in question had been validly registered, a situation now existed where their continued existence on the register could no longer be justified.

On this issue, I am in agreement with the respondent that it is premature for the applicant to argue that the respondent has taken no steps to distinguish its marks through use. The Kenyan Trade Marks Act permits the registration of a trade mark before use and if the proprietor does not thereafter use the mark within five years, then it runs the risk of having the mark removed for non-use.

In this instance, the acts complained of by the applicant and the arguments that it makes with regard to the actions taken by the respondent to enforce its trade mark would find greater traction in a forum where the issue to be determined is infringement. I accordingly find that there are no grounds on which I can hold that the two marks are wrongly remaining on the register.

Before I conclude, there are a couple of observations that I would wish to make.

Firstly, I would like to thank both counsel for having ably represented their clients before this forum. Secondly, with regard to the arguments made by the applicant regarding the manner in which the respondent went about enforcing its marks, these

would have been more relevant had the issue been one of infringement rather than expungement where the key issue relates to the validity of the marks, as registered. In other words, if the applicant believed that it had not infringed the trade marks, one option would have been to wait for its day in court and defend against any infringement action.

That being said, the respondent in this matter would appear to be operating under a misapprehension regarding the scope of protection afforded to its registered marks. As mentioned above, the registrations only extend to PRINTED MATTER in class 16 for TM 63725 and ENTERTAINMENT in class 41 for TM 64269. If the applicant wishes to extend the registration to other particular goods or services for which it wishes to use the mark then there are clear procedures set out in the Trade Marks Act and Rules.

DECISION

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

1. The applicant is an aggrieved person qualified to bring this application;
2. That the applicant has not established that the two marks were registered without sufficient cause;
3. That the applicant has not established that the two marks wrongly remain on the register; and
4. That each party shall bear its costs in this matter.

Ruling dated and delivered at Nairobi this 22 day of August 2013.



Dr. Henry Kibet Mutai
Managing Director

