

REPUBLIC OF KENYA

KENYA INDUSTRIAL PROPERTY INSTITUTE

IN THE MATTER OF THE TRADE MARKS ACT, Cap. 506

AND

**IN THE MATTER OF TMA NO. 65912 (GULF ENERGY Follow Us to the Future - logo) and
TMA NO. 68113 (GULF ENERGY - logo), IN THE NAME OF GULF ENERGY LTD. AND
OPPOSITION THERETO BY GULF INTERNATIONAL LUBRICANTS LIMITED**

(Hearing held on 14 February 2012)

Counsel for the applicant: Anthony Njogu, with Njau Mukuha of Daly & Figgis Advocates;
Counsel for the opponent: William Maema, with Emma Wachira and Hiram Nyaburi of Iseme,
Kamau & Maema Advocates;
Amos Otieno, Clerk, KIPi;
Before the Registrar of Trade Marks, Dr. Henry Kibet Mutai)

RULING

INTRODUCTION

This is an opposition matter filed by the opponent, Gulf International Lubricants Limited (“the Opponent”), who is the registered proprietor of TM No. 43442 “GULF” (word) and TM No. 43443 “GULF” (logo), against the registration of TMA No. KE/T/2009/65912 “GULF ENERGY Follow us to the future” (logo) and TMA No. KE/T/2010/68113 “GULF ENERGY & G device” (words and device), in the name of Gulf Energy Limited (“the Applicant”).

PROCEDURAL BACKGROUND

On 14 July, 2009 and 7 May, 2010, the applicant herein filed applications for registration of trade marks “Gulf Energy Follow us to the Future” and “Gulf Energy & G device” respectively in classes 4, 12, 16, 25, 35 and 42. Both applications were examined and approved for advertisement in the Industrial Property Journal and the same was communicated to the applicant by letters dated 10 September 2009 for TMA No. 65912 and 8 July 2010 for TMA No. 68113.

With regard to TMA No. 65912, three applications were received on different occasions from counsel for the opponent seeking extension of time to provide adequate time to prepare a Notice of Opposition against the registration of the applicant's mark. The opponent subsequently filed a Notice of Opposition to the registration in classes 4 and 35 on 30 March 2010, on the grounds, *inter alia*, that the applicant's mark was similar to its registered trade marks, that the applicant's mark so closely resembled the opponent's registered trade marks as to cause confusion, that the opponent's marks though not registered in class 35 were well known and distinctive both in Kenya and in many other countries and therefore deserving statutory protection under section 15A of the Trade Marks Act and that registration of the applicant's mark should be refused under section 14 and 15A(4) of the Act.

The applicant filed its counter statement on 19 July 2010. In the counter statement it stated, *inter alia*, that the applicant's mark viewed as a whole is distinctive from the opponent's trade marks, that the applicant has used the trade mark since May 2008, that the applicant disclaimed the use of the word "GULF" because it is a geographical name and the opponent cannot claim exclusive right to the use of that word. It also denied that the opponent's trade marks had acquired and enjoyed a reputation and goodwill and had been well known in Kenya and in many other countries.

On 14 December 2010, the opponent filed its statutory declaration. In his declaration, Richard Hoare, deponed, *inter alia*, that he was the General Counsel of the opponent and was duly authorized to make the statutory declaration, that the opponent had registered its GULF and GULF logo trade marks and used them in numerous countries worldwide, that the opponent had made extensive use of its trade mark in Kenya, that the opponent's marks qualified as well known trade marks as contemplated in Article 6 (b) of the Paris Convention, that the applicant's mark was phonetically and conceptually similar to its trade marks and therefore confusingly and deceptively similar and that the goods covered by the applicant's marks in class 4 were similar to the goods covered by the opponent's trade marks.

The declarant also denied the applicant's assertions that the opponent's trade marks and the applicant's mark were distinguishable, that the word "GULF" was in itself a

geographical name and that it was common in the trade for oil and oil products. Attached to Richard Hoare's declaration were the following marked exhibits:

A2 - Schedule of opponent's trade marks registrations consisting of or including the word "GULF" around the world.

A3 - Copies of selected registration and renewal certificates in respect of the opponents registrations in a few African countries including Uganda, Tanzania, Malawi, Botswana and Zambia.

A4 - Print outs from the opponents' website which evidence use of the opponents' marks in relation to the products and services.

A5 - Copy of opponent's Orange Disc magazine issue no. 12 of 2006 detailing opponents' expansion into Africa.

A6 - Invoice for 14573 kilograms of lubricant products.

A7 - Invoice of 23520 kilograms of lubricant products.

A8 - Invoice of 15120 kilograms of lubricant products.

A9 - Photographs taken at different locations and stores in Kenya.

A10 - Photographs and information taken from the opponents' website evidencing opponents' involvement in international motorsport.

A11 - Watch notice

A12 - Copies of print-outs of the first pages of the search result when a search is conducted in respect of the word "GULF" on the popular Google search engine.

On 23 May 2011, the applicant filed its statutory declaration. In the declaration sworn by Cyrus Kirima, the deponent averred, *inter alia*, that he was the Lubricants Manager and an authorized signatory of the applicant, that whereas the opponent stated that it had registered its "GULF" and "GULF" logo trade marks in numerous countries there was no concrete evidence of use in those countries and that the opponent had not proved extensive use of its marks in Kenya. He reiterated that the applicant's trade marks were distinguishable from the opponent's marks and that the word "GULF" was a geographical name. Attached to the Statutory Declaration were a number of exhibits including:

GEL 1 - Copy of the application form T.M. 2 as filed with the Registrar of Trade Marks.

GEL 2 - Copies of the Journal advertisements

GEL 3 - Copy of opponent's website showing the worldwide brand names for

lubricants sold by the opponent.

GEL 4 - Brand names for goods sold by the applicant.

GEL 5 - Copies of internet search results

GEL 6 - Photographs of the applicant's various service stations in various locations in Kenya.

On 23 September 2011, the opponent filed its statutory declaration in reply. In the declaration, Richard Hoare averred, *inter alia*, that the opponent's worldwide trade mark registrations were proof of the fame and reputation of its trade marks, that the applicant's marks in respect of which the prominent and distinctive feature is the mark "GULF" were likely to take unfair advantage of the distinctive character of the opponent's well known trade marks, that the word "GULF" was not a geographical name and that the opponent had used its trade marks in relation to products sold in service stations in Kenya to the extent that the marks had acquired an extensive reputation and goodwill.

With regard to TMA No. 68113, the opponent filed its Notice of Opposition on 28 September 2010. Thereafter, the applicant filed its Counter Statement on 12 November 2010. This was followed by the opponent's first Statutory Declaration filed on 17 February 2011 and the applicant's Statutory Declaration filed on 5 July 2011. In response to the applicant's Statutory Declaration, the opponent filed its Statutory Declaration in Reply on 16 November 2011.

In light of the fact that the pleadings filed in TMA No. 68113 were the same as those filed in TMA No. 65912, the arguments discussed above with respect to TMA No. 65912 are the same as those discussed in TMA No. 68113.

On 2 November 2012, the hearing for TMA No. 65912 was fixed for 14 February 2012. Thereafter, by letter dated 30 January 2012, both parties gave their consent to have the matters consolidated on the grounds that there were identical questions of law and fact arising from both opposition matters and that it was in the best interest of justice, expediency and cost that both matters be consolidated. The effect of this consent was that both matters proceeded for hearing on 14 February 2012.

The opponent and the applicant filed their list of authorities on 10 February 2012 and 13 February 2012 respectively. The hearing for both matters proceeded on 14 February 2012 as

agreed.

I shall now briefly summarise the parties' oral submissions made at the hearing.

THE OPPONENT'S SUBMISSIONS

Counsel for the opponent started by stating that the opponent was aggrieved by the applications to register the opposed marks in classes 4 and 35 owing to the prior existence of its registered trade marks, that is to say, TMA No. 43442 "GULF" (word) and TMA No. 43443 "GULF" (logo) both registered on 8 December, 1995 in class 4. He submitted that the opponent's case was founded on the similarity between the opposed marks and opponent's marks. The opponent contended that owing to the similarity, the registration of the opposed marks was calculated to deceive, confuse and mislead the public contrary to section 14 of the Trade Marks Act. Counsel argued further that to the extent that the opposed marks related to the same description of goods as those covered by the opponent's marks, registration of the marks would be contrary to section 15(1) of the Act. It was the opponent's contention that its trade marks were well known not only in Kenya but also internationally and therefore registration of the marks in class 35 would be contrary to section 15A of the Act.

Counsel then went on to assert that the issues raised by the parties' pleadings and which the Registrar of Trade Marks had to determine were: firstly, whether the opposed marks were similar to the opponent's marks; secondly, whether the similarity was likely to cause confusion; thirdly, whether the opponent's marks were well known and therefore should be protected under section 15A of the Act; and lastly, whether registration of the applicant's marks would be contrary to section 14, 15(1) and 15A of the Trade Marks Act.

On the question of similarity, the opponent submitted that section 14 of the Act was clear that no person should be allowed to register a trade mark which was likely to deceive or cause confusion in the market and that the similarity between the marks was such that the two sets of marks cannot co-exist on the register without causing confusion and deception to the public and consumers.

Counsel argued that the principle to be applied in determining similarity was laid down in *Sabel BV v Puma AG* at page four:

“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.”

Where the three elements existed the marks should be judged to be confusingly similar. It was submitted that the three elements were present in the subject marks. Upon a visual examination of the two device marks: Exhibit A1 and Exhibit GEL 1, counsel identified the following features as being evidently common:

- 1) The word “GULF” which was the dominant feature in both marks;
- 2) An almost circular or roundish device;
- 3) The word “GULF” in blue;
- 4) An observation from the certificate that both marks are restricted to colour blue; and
- 5) The white background.

The opponent submitted that the choice by the applicant of marks that bore close similarity to the opponent’s marks was calculated to deceive the public into believing that the applicant and opponent’s products were the same or that the two companies were in some way associated. Counsel argued that the choice of similar marks had to be deemed to be suspect and that in *Beiersdorf AG v Emirchem Products Limited*, the court had placed the burden on the new entrant into the market to demonstrate that the choice of similar mark was made in good faith. He submitted that there were many oil companies in Kenya and none except the applicant had chosen a name and trade mark bearing the word “GULF”. Counsel argued that consumers were generally guided by the visual and generally did not proceed to analyze the special details of the mark. He made reference to Jeremy Phillips: *Trade Mark Law: A Practical Anatomy*, chapter 10 of which provided as follows in paragraph 1024:

“The average consumer generally perceives a mark as a whole and does not proceed to analyze its various details”

It was the opponent’s submission that upon seeing the marks the consumer would see the word “GULF”, circular device and colour blue and proceed to conclude that the goods either came from the same source or related companies.

On a visual examination of Exhibit GEL 1 the opponent stated that the word “ENERGY” was in a faint font in order to give prominence to the word “GULF”. He argued that it was not meant to distinguish the applicant’s mark from the opponent’s mark because the word “ENERGY” being descriptive of the petroleum products could not be used to distinguish. He further argued that the slogan “Follow us to the future” was a marketing tool rather than a distinguishing feature of a trade mark.

On the issue of aural similarity, the opponent submitted that the aural similarity between the marks was 100% because both sets of marks comprise the word “GULF” and consumers could not reasonably be expected to distinguish between identically pronounced trade marks belonging to different proprietors.

With regard to conceptual similarity, the opponent denied the applicant's argument that the word “GULF” refers to the Persian Gulf and was therefore a geographical name. The opponent submitted that “GULF” was a mere English word and that if it was a geographical name or description of petroleum producing countries it would not have qualified for registration as a trade mark. Counsel submitted that based on the evidence, the opponent was the only global company known as “GULF” but the applicant went ahead to get incorporated under the Companies Act under the Gulf name and was now seeking to encroach on the intellectual property of the opponent. It was the opponent's submission that the applicant used a loophole in the Companies Act which does not protect global companies which, however famous, are not registered in Kenya. The Registrar of Companies has no way of determining that a name sought to be registered is also a registered trade mark. Counsel submitted that the Trade Marks Act was different and allowed foreign entities to protect their marks even in the absence of a legal presence.

It was further argued that the fact that the applicant sought a disclaimer of the word “GULF” suggested that it was aware that the opponent had prior rights to the word but nonetheless applied for registration. The opponent stated that their marks were registered without any disclaimer and that the legal effect is to be found in section 7 of the Act which is that the opponent enjoys exclusive right over the word “GULF” and all the rights in its trade mark therefore there is no room for the registration of another gulf mark in class 4. It was submitted that registration will extinguish the exclusivity of the opponent’s marks. Counsel made reference to *Trade Mark Law - A Practical Anatomy* by Jeremy Phillips at

page 317 which states as follows:

“...since it is those features which trade marks have in common which cause consumers to confuse them, in principle we should ask not how far two marks differ from each other but how far their shared features will cause consumers to confuse them...”

On the issue of well known nature, the opponent argued that its marks were not only well known in Kenya but internationally and that section 15A of the Act conferred protection to well known marks even if they were not registered in Kenya. The opponent contended that the services covered in class 35 were so incidental to the trading in goods falling in class 4 such that the use of a similar mark will only cause confusion and deception in the market. It was the opponent’s submission that its marks were well known as evidenced by the following evidence:

- 1) The local distributor of the opponent’s products in Kenya was Gapco (Gulf African Petroleum Corporation) which was described as a successful oil distributor;
- 2) Exhibit A2 and A3 demonstrated the registration of opponent’s marks in no less than 126 countries including Kenya;
- 3) Exhibit A5 illustrated use of opponent’s marks through various petrol stations in Kenya and the rest of Africa;
- 4) Exhibit A6, A7 and A8 all demonstrated the sale of the opponent’s products in Kenya.

The opponent submitted that the opponent’s marks met the criteria of well known marks and therefore registration of the opposed marks ought to be refused.

Regarding the authorities that the applicant relied on, counsel commented that:

- 1) *Match Masters Limited vs. Rhino Matches Limited*. The court held that while a person is entitled to use his own name he could not do so in a manner that confused his goods with those of another, he must take steps to distinguish his goods from those of a registered proprietor. Court concluded that it was more than likely that an ordinary person could be confused by the two marks.
- 2) *Brook Bond Kenya Limited vs. Chai Limited*. The opponent submitted that these two main factors make this case irrelevant:
 - a. It was decided in 1970 long before the concept of well known trade marks was invented and prior to enactment of section 15A of the Act;

- b. Unlike in the cited case the applicant herein is not the proprietor of any registered trade mark. The ultimate decision was that there was confusing similarity between the two marks.
- 3) *Cut Tobacco Kenya Limited vs. British American Tobacco (K) Limited*. The opponent stated that the case involved trade marks that were not identical and that the facts were different.
 - 4) *Mathew Ashers Ochieng vs. Kenya Oil Co. Limited & another*. In referring to page 3 of the judgment, the opponent asked that the registrar disregard this judgment because of the ignorance of Intellectual Property Law by the judge.
 - 5) *Unilever Plc vs. Bidco Industries Limited*. The opponent submitted that this is a different kind of comparison from the present case, that is, the rights granted to the opponent in respect of the registered marks.
 - 6) *Aktiebolaget Jonkoping - Vulcan Industricksfabriksaktiebolag vs. East Africa Match Ltd* (The Steamship case). Since the case was decided in 1962 and concerned an alleged infringement rather than opposition, the opponent submitted that the facts of the case were irrelevant.

Based on these submissions, counsel for the opponent urged the Registrar to find that registration of the applicants marks would be contrary to section 14 and 15(A) of the Act and ought to be refused.

THE APPLICANT'S SUBMISSIONS

In reply, counsel for the applicant started by submitting that the first element to be considered was that there had to be confusion to the public. He argued that similarity of marks was not evident from a comparison of them. The opponent had submitted that the two marks: Exhibit A1 and Exhibit GEL1 were similar. The applicant submitted that the opponent's marks were significantly differentiated from the applicant's mark and that the dominant feature is the orange circle with the word "GULF" in the colour blue. The bold colour orange was not present in the applicant's mark. Counsel argued that contrary to Opponent's approach, if the two marks were looked at together the question to be asked is whether the two marks are similar. The applicant submitted that they are not.

Upon examining Exhibit A5, counsel noted that the actual name of the publication is the

Orange Disc. He argued that not only are the two dissimilar, the colours chosen for the Applicant's mark Exhibit GEL 1 were blue and grey. On whether either of the two marks would lead any member of the public to lead the goods to the opponent, the Applicant submitted that it was not the case.

It was the applicant's submission that the opponent had to show that it had products to which the mark applied and the same had been supplied to the public.

Counsel also submitted that the applicant was duly registered as a company and that this was not a loophole in the law but an indication that the opponent did not trade in this market and did not find a need to register itself.

On the issue of extensive use of the word, the applicant submitted that the same was stated but not proved. He argued that use of the mark should be shown in this (Kenyan) market. In relation to Exhibit A6, A7 and A8 having been produced allegedly as evidence of proof of sale in Kenya, the applicant submitted that all the three sets of documents appeared to relate to one transaction and that the same did not make reference to volumes or any market share in the local oil or lubricants history therefore casting doubt on the claim of extensive use in Kenya.

The applicant argued that section 15(2) of the Act contained provision for registration of identical or similar marks. Counsel argued that the opponent had not addressed the element of the "G" device in TMA 68113 and that it became clear that the marks were clear and distinctive. On the issue of the meaning of the word "GULF", the applicant submitted that the word was a geographical term and that was why it disclaimed the word in its application.

Counsel submitted that any alleged resemblance between the marks must be shown to exist and to be deceptive and that the onus was on the opponent to show that the resemblance existed.

On the opponent's submission that if there was aural or conceptual similarity that the marks will be deemed to be similar, the applicant submitted that this must be analyzed from a global look of the mark, that is, the overall impression of the marks.

On the opponent's opposition to registration in class 35, the applicant argued that the opponent's marks were not registered in this class and that one would expect that if the opponent was operating in the market it would have applied or sought registration in that

class. He further argued that the word “GULF” was used by various companies and was a common English word that should be properly disclaimed.

The applicant argued that according to section 15A (1) of the Act, the mark should be well known in Kenya. It was the applicant’s submission that since the mark was not well known in Kenya, the opponent’s application did not meet the threshold or contain any weight in terms of evidence. The applicant argued that the evidence did not show any petroleum stations in Kenya but in other markets outside Kenya.

In conclusion, counsel for the applicant commented on two cases relied on in this matter. Firstly, with regard to *Mathew Ashers Ochieng v. Kenya Oil Company Limited & Another*, the applicant submitted that this case was nonetheless a decision of the High Court and contained the correct submission that the fact that a party registered a common name did not disentitle another person from the use of that name. The vital element was the correct meaning and appreciation in the same market.

Secondly, regarding *Beiersdorf AG v. Emirchem Products Limited*, the applicant stated that the circumstances of the case were that the name was similar and in a similar colour and typeface. He stated further that each case is to be determined on its own circumstances.

Lastly, the applicant submitted that it had been using its mark since 2008 and had substantial investments both in the brand and in its business, specifically spending an amount in the region of approximately Kenya Shillings six hundred million (Kshs. 600,000,000/=) in setting up fuel stations.

OPPONENT’S SUBMISSIONS IN REPLY

Firstly, on the applicant’s submission that the dominant feature is the orange disc, the opponent urged the Registrar to disregard that submission. He argued that the only relevant issue is the eye of the average consumer and that the dominant features are the word “GULF” and colour blue. The opponent submitted that there should not be similar products going by names that could be confused by relevant segment of consumers.

Further, the applicant had submitted that the mark with the letter “G” was not similar to the opponent’s marks. In reply, the opponent submitted that to the extent to which letter “G” represented Gulf coupled with the fact that the word “GULF” was represented in blue, the representation made it confusingly similar to the opponent’s trade mark. He further

submitted that the applicant still had a chance to change its mark to exclude the word “GULF”.

On the issue of registration of similar marks, the opponent submitted that marks were valid on the record unless expunged for reason of non-use as per section 29 of the Act and that no third party should be allowed to register similar marks while the opponent's marks were validly on the register. He further argued that there was no evidence of honest concurrent use and that the applicant should have been aware of the existence of the Opponent's marks.

Regarding the applicant's submission that there were other businesses bearing the name “GULF”, the opponent submitted that the exclusivity granted to the opponent with respect to the word “GULF” related to goods in class 4 and 35 but did not prevent the use of the word by totally unrelated businesses such as banks.

On the issue of the meaning of the word “GULF”, the opponent submitted that no citation had been made to prove the so called meaning of the word “GULF” and that no two businesses should be allowed to trade in the same business name.

Lastly, the opponent submitted that evidence as to the cost of setting up petrol stations should be disregarded.

THE ISSUES TO BE DETERMINED

Having carefully read through all the evidence on record, listened to the parties' submissions and read the authorities submitted in support of the respective positions, I propose to address the issues in the order in which they were raised by counsel for the opponent, that is to say:

- 1) Are the opposed marks similar to the opponent's registered marks?
- 2) Would the registration of the opposed marks be likely to cause confusion or deception in the market?
- 3) Are the opponent's marks well known in Kenya?
- 4) Would the registration of the opposed marks be contrary to the provisions of ss. 14, 15(1) and 15A of the Trade Marks Act?

1. Similarity

Section 15(1), Trade Marks Act provides that:

Subject to the provisions of subsection (2), 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, or in respect of services, is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of the same services or description of services.

On this issue, the opponent argued that the applicant's marks were visually, aurally and conceptually similar to the opponent's marks. The opponent submitted that upon examination of Exhibit A1 and Exhibit GEL 1, there were common distinct features which included the word "GULF" as the dominant feature, the word "GULF" in colour blue and an almost circular device. The opponent also argued that the applicant's choice of marks that bore close similarity to its registered marks was calculated to deceive the public into believing that the applicant and opponent's products were the same or that the two companies were in some way associated.

Counsel in citing the case of *Beiersdorf AG vs. Emirchem Products Limited* stated that the burden lay on the new entrant into the market to demonstrate that the choice of a similar mark was made in good faith. It submitted that the applicant could have chosen any other name but instead chose a name similar to that of the opponent.

Counsel for the applicant, on the other hand argued that the opponent's marks were significantly differentiated from those of the applicant. In making this argument, the applicant relied heavily on what it referred to as the dominant feature of the opponent's mark, that is to say, the orange disc feature of the opponent's mark.

Having examined the evidence on record, heard the arguments of both parties and read their submissions carefully, I find that the word "GULF" features prominently in all the marks in question and that the opponent is the validly registered proprietor of this word for goods in class 4. I find that in spite of the presence of a number of slight differences, the applicant's opposed marks bear a sufficiently close similarity to those of the opponent to bar them from registration in class 4.

I also find that insufficient evidence has been placed before me to prove that there was

honest concurrent use of the marks such as would permit the registration of the marks pursuant to the provisions of section 15(2).

2. Likelihood to deceive or cause confusion

Section 14 of the Trade Marks Act 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.

The effect of Section 14 is that there should be no registration of a mark where that mark would be likely to cause confusion and deception to the public.

From a comparison of Exhibit A1 and GEL 1, the applicant argued that the opponent's marks are significantly differentiated from the Applicant's marks. It argued that the dominant feature in the opponent's mark was the orange circle with the word "GULF" in the colour blue and that the bold colour orange was not present in its mark. It was submitted that when the two marks are looked at together the marks could not be said to be similar and that the marks would not lead any member of the public to trace the goods to the opponent.

Being guided by the finding above that the applicant's and opponent's marks are similar and that they apply to the same goods in Class 4, I find that the applicant's marks are likely to deceive and confuse consumers of petroleum products into thinking that the applicant's products are either the same as the opponent's products or that the two companies are in some way associated.

At this point, I should also comment on the applicant's submission to the effect that the word "GULF" was a geographic term that had become so associated with petroleum products that no individual should be allowed to appropriate the word for itself. I do not find the applicant's arguments on this point sufficiently convincing. It did not place any evidence before me to support this contention and there are therefore no grounds on which I can hold that the word "GULF" has become descriptive in nature.

3. Well known nature of the marks

The opponent argued that its marks were not only well known in Kenya but also internationally and therefore entitled to protection under section 15A of the Act.

Section 15A provides, *inter alia*, that

- (4) A trade mark shall not be registered if that trade mark or an essential part thereof, is likely to impair, interfere with or take unfair advantage of the distinctive character of the well-known trade mark.

Thus, before a proprietor can enjoy protection under this provision, it must prove that its name is well known.

In order to prove the well known nature of its marks, the opponent adduced evidence which included copies of certificates of registration in Kenya, a schedule of its trade marks registrations in other countries, photographs taken at different locations and stores in Kenya, photographs and information taken from the opponent's website evidencing opponent's involvement in international motorsport as well as invoices to show sale of its products in Kenya.

For the applicable test, it relied on the International Trademark Association's (INTA) *Board Resolutions on Well-known Marks Protection* of 1996, which sets out a number of factors to be considered in determining whether a mark is well-known.

The applicant, on the other hand, argued that use of the mark should be shown in the Kenyan market and that there was no evidence to prove extensive use of the Opponent's marks in Kenya. It further argued that the three invoices produced allegedly as evidence of proof of sale in Kenya only related to one transaction dated 17 March 2010. The applicant submitted that this did not support the claim of extensive sales in Kenya.

On this issue, I am in agreement with counsel for the applicant that in order to determine the well known nature of a mark, the relevant market is Kenya.

Section 15A(1) provides:

References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark, are to a mark which is well known **in Kenya** as being the mark of a person who-

- a) Is a national of a convention country; or
- b) Is domiciled in, or has a real and effective industrial or commercial establishment in, a convention country, whether or not that person carries on business or has any

goodwill in Kenya.

In *Independent Tobacco FZE vs. Rothmans of Pall Mall* (ruling delivered on 11 June 2010), the Registrar had to contend among others with a determination as to whether or not the “Rothmans Royal” mark was well known in Kenya. The Registrar found that the absence of proof of the degree of knowledge or recognition of the mark in the relevant sector of the Kenyan market is one of the most important criteria for a mark to be said to be well known. In that case, the fact that registration of the mark had been secured in various other countries was not enough to prove that the mark was well known to the relevant sector of the Kenyan public.

In determining the issue of whether or not a mark is well known, the Joint Recommendations Concerning Provisions on the Protection of Well Known Marks adopted by the General Assembly of WIPO provide useful guidelines. In this instance, the opponent has failed to prove that it has made extensive use of its mark in Kenya. The Orange Disc magazine marked as Exhibit A5 only goes to show the opponent's expansion into Africa and not that the mark is well known in Kenya. The invoices are all dated the same day which seems to indicate one order regardless of the argument by counsel for the opponent that because lubricants are sold in small volumes, this would be a substantial quantity. Though the opponent submitted that it had not attached evidence of more sales due to a desire not to burden the Registrar with too much material, it would have been advisable to provide further evidence regarding the volume of sales in Kenya. In addition, the photographs taken of different locations and stores in Kenya marked as exhibit A9 cannot be said to be proof of extensive sales.

In light of this, I find that the Opponent has failed to establish that its marks are indeed well known in Kenya.

4. Registrability of the opposed marks under ss 14, 15(1) and 15A, Trade Marks Act

Regarding the registrability of the opposed marks under section 14 of the Act, which deals with the likelihood of confusion or deception, I find that use of the word “GULF” in the applicant's trade marks would be disentitled to protection in a court of justice for being

likely to deceive or cause confusion insofar as registration for goods in class 4 is concerned. For that reason, the opponent's opposition regarding registration for class 4 goods is upheld. However, in light of the fact that the opponent is not the registered proprietor of the mark GULF in class 35, registration of the opposed marks for that particular class is allowed.

For the same reasons, I find that while registration of the opposed marks in class 4 is not permitted under section 15(1) by virtue of its similarity to the opponent's "GULF" marks, the registration of the opposed marks in class 35 is allowed.

Lastly, the opponent argued that its marks are well known and therefore entitled to protection under section 15A of the Act and that the services covered in class 35 are so incidental to the trading in goods falling in class 4 such that the use of a similar mark would only cause confusion in the market. However, I find that there was insufficient evidence placed before me to prove that the opponent's marks are well known in Kenya such as to prevent registration of the opposed marks in class 35. If the applicant desired to have protection under class 35, it is sophisticated enough to have applied for registration in that class.

At this point I would like to comment on the applicant's submission that because it had made substantial investment both in brand and in business and that it had incurred a cost of some KSh. 600 million in setting up petrol stations, this was a factor to be considered in determining whether it was entitled to registration of the marks. On this, I wish to state that the applicant is a knowledgeable company and assumed the risk when it ventured into business. If the end result of this ruling is that the applicant has to rebrand its businesses then that is the inevitable result of a risk it willingly took.

Registered proprietors of trade marks should not live in fear that some individual or company with deeper pockets than they can undertake a branding and marketing blitz using their registered marks and thereby somehow acquire rights to those marks. That would render the entire registration process an exercise in futility.

Evidence

A final issue that I would wish to address concerns the evidence placed before me by the opponent, specifically, the exhibits annexed to the opponent's statutory declarations. Rule 9 of the Oaths and Statutory Declarations Rules clearly states as follows:

All exhibits to affidavits shall be securely sealed thereto under the seal of the commissioner, and shall be marked with serial letters of identification.

This is a mandatory provision of law. All exhibits presented before the Registrar by the opponent in its statutory declarations dated 2 December 2010 and 2 February 2011 have only been marked by pen as “A1”, “A2”, and “A3” and so on instead of being sealed as required by the law. As such, an issue arises as to the admissibility of these exhibits. However, in the interest of justice and owing to the fact that the issue was not raised by the applicant, I took them into consideration in arriving at my decision. Parties are, however, cautioned against a repetition of the same since this may lead to non admission of their evidence.

DECISION

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

- 1) The opponent has exclusive rights to the use of the word “GULF” in relation to goods in class 4;
- 2) The opponent’s opposition to the registration of the applicant’s applications TMA 65912 and TMA 68113 in class 4 succeeds and registration of the said marks shall not be allowed with regard to class 4;
- 3) The opponent’s opposition to the registration of the applicant’s applications TMA 65912 and TMA 68113 in class 35 is dismissed;
- 4) The applicant may, if it so wishes, amend its application in TMA no. 68113 to register the stylized “G device” only in respect to class 4;
- 5) Since the opposition herein has been partially successful, I order each party to bear its own costs in this matter.

Ruling dated and delivered this 15th day of May 2012


Dr. Henry Kibet Mutai
Managing Director