

KENYA INDUSTRIAL PROPERTY INSTITUTE



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Our Ref: T.M.A. NO. 107520

Date: 27th September 2024

Your Ref: 11/143/2023/76

Ndungu Njoroge & Kwach Advocates, LLP
P. O. Box 41546 - 00100
Nairobi

Dear Sirs

T.M.A. NO. 107520 IN THE NAME OF ELIPA MAURITIUS LIMITED

Reference is made to the above-mentioned matter and to your letter dated 30th June 2020.

It is noted that in a letter dated 3rd October 2019, the Registry of Trade Marks rejected your above trade mark for the reason that the mark was similar to Trade Mark Application TMA No. 81794 "E-PAY" (the cited trade mark). In your letter of 30th June 2020, you stated that you did not agree with the above opinion for the following reasons, *inter alia*:

- (a) Your above trade mark and the cited trade mark would not be considered to be confusingly similar under the provisions of the Trade Marks Act; and
- (b) The cited mark contains elements that are not distinctive when used with respect to services in class 36 of the Nice Classification of Goods and Services for Purposes of Registration of Marks (the Nice Classification) and should therefore, not be a bar to the registration of your above mark.

It appears that your trade mark was refused registration due to the provisions of section 15 (1) of the Trade Marks Act. Section 15 (1) of the Act prohibits registration of a trade mark that is similar or identical to a trade mark that is already in the Register of Trade Marks, registered with respect to goods or services of a similar or identical description.

A cursory consideration of the Register of Trade Marks with respect to the cited trade mark and your above mark indicates as follows:

- (a) The cited mark is registered with respect to goods and services in classes 9, 36, 38 and 42 of the Nice Classification;

- (b) The cited mark is registered with a disclaimer of the right to the exclusive use of the letter "E" and the word "PAY", each separately and apart from the mark as a whole;
- (c) Your above mark is sought to be entered in the Register of Trade Marks in Kenya with respect to services in classes 36 and 42 of the Nice Classification;
- (d) Although not indicated in your Application Form 2, your mark "E-LIPA" has been presented in the Kiswahili language and would be translated as "E-PAY" in the English language.

I agree with the contents of your letter dated 30th June 2020 for the reason that both trade mark contain words that are not distinctive especially when registered or sought to be registered with financial services. This means that the two trade marks are not strong trade marks.

In *Eli Lily & Co V Natural Answers Inc*,¹ it was indicated that some of the factors that should be considered when determining the issue of similarity of trade marks include the strength of the complainant's mark.

Trade marks that are deemed to be descriptive are those that are commonly used in the particular trade to designate the "kind, quality, intended purpose, value, place of origin, time of production or any other characteristic of the goods for which the sign is intended to be used or is being used."² These are the trade marks that would be described as weak marks, confusion with similar marks would not be likely to occur and registration of similar trade marks would not be deemed to be in contravention of the law. Conversely, trade marks that are distinctive, that is, marks that are coined or arbitrary, would be confused more easily than marks whose meanings would be associated with the character of the goods in respect of which the marks have been entered on the Register of Trade Marks.³ While considering whether or not a trade mark is distinctive, one ought to make an overall assessment and determine whether or not a particular trade mark has the capacity to identify the specific goods or services as originating from a certain undertaking as opposed to all other undertakings that would be dealing with goods of a similar description. In making that assessment, consideration should be had of the inherent characteristics of the mark, including the fact that the mark does not comprise

¹ 233, F. 3d 456, [USA].

² WIPO: Intellectual Property Handbook: Policy, Law and Use: (2nd edn, WIPO Publication 2004) 87.

³ *ibid*.

an element that is descriptive of the character of the goods or services in respect of which the mark has been registered.⁴

In *Thomson Holidays Limited v Norwegian Cruise Line Limited*,⁵ it was stated that there would be a higher likelihood of confusing marks with a highly distinctive character than marks that are not distinctive. The former marks would therefore receive greater protection than the latter ones because of the reputation that they would have attained in the respective market.

In *Canon Kabushiki Kaisha and Metro-Goldwyn-Mayer Inc.*,⁶ the Court stated that protection of a mark is dependent on the likelihood of confusion or not. This means that marks that are highly distinctive would be more likely to be protected than marks with a less distinctive character. Therefore, it follows that registration of a less distinctive trade mark may be refused even where there is a small degree of similarity with the earlier mark, depending on the distinctiveness of the earlier mark.

In conclusion, your application T.M.A No. 113847 is hereby allowed to proceed to publication. This approval is on the following conditions:

- (a) Provide a translation of the word "LIPA" and indicate the language in which the word is in;
- (b) File the prescribed Form TM 19 to enter a disclaimer of the right to the exclusive use of the letter "E" and the words "LIPA" and "CONVENIENT", each separately and apart from the mark as a whole, upon payment of the prescribed fee.

Kindly note that the contents of this letter are not a bar to any opposition proceedings that may be filed under the provisions of the Trade Marks Act once the mark is duly published in the Industrial Property Journal. In the event that opposition proceedings are filed, the Registrar of Trade Marks shall consider the proceedings on merit.

Yours faithfully



Eunice Njuguna
Assistant Registrar of Trade Marks

⁴ Kerly's Law on Trade Marks, 14th Edition, page 8, paragraph paragraph 9-074.

⁵ [2002] All ER (D) 249.

⁶ C-39/97.