

KENYA INDUSTRIAL PROPERTY INSTITUTE



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THE TRADE MARKS ACT CAP 506 OF THE LAWS OF KENYA

AND

IN THE MATTER OF TMA NO 68412 "GOLD ALYSSA" IN CLASS 26 IN THE NAME OF
REBECCA FASHION LIMITED AND OPPOSITION THERETO BY STRATEGIC INDUSTRIES
LIMITED

RULING BY THE ASSISTANT REGISTRAR OF TRADE MARKS

Background

On 16th June 2010, Rebecca Fashions Limited (hereinafter referred to as the Applicants) filed an application to register their trade mark TMA 68412 "GOLD ALYSSA" (WORDS) (hereinafter referred to as the mark) before the Registrar of Trade Marks. The mark was applied for in class 26 in respect of "artificial hair, beards, moustaches, toupees, hair bands, hair grips, hair ornaments, hair nets, bows for the hair".

The Registrar duly examined the mark in accordance with the provisions of the Trade Marks Act Cap 506 of the Laws of Kenya and on 28th July 2010, the mark was approved and published in the Industrial Property Journal of 31st July 2010, on page 36.

On 28th September 2010, Strategic Industries Limited (hereinafter referred to as the Opponents) filed a Notice of Opposition against the registration of the mark. The grounds of opposition were as follows:

1. We are the owner of the registered trade mark ALICIA which we have filed an application and used extensively along with our registered trade mark DARLING in class 26 for goods shown in paragraph 2 of this Notice of Opposition.

2. Our trade mark ALICIA has been used extensively on hair additions, hair pieces and braids, weaves ad wigs and has become well known to the Kenyan public by virtue of sales of our aforesaid goods.
3. The trade mark GOLD ALYSSA which REBECCA FASHION (KENYA) LTD hereinafter called ('The Applicant') is attempting to register so closely resembles trade mark ALICIA visually and phonetically that confusion and deception is likely to arise in the minds of the public so as to disentitle the trade mark GOLD ALYSSA object of TMA. No. 0068412 in class 26) to protection in a court of justice.
4. The goods covered by the Applicant's mark are identical to and/or are goods of the same character, nature or description to the goods on which our trade mark ALICIA is used. This is likely to further enhance the likelihood of confusion and deception arising if the Applicant's TMA. No. 0068412 GOLD ALYSSA is allowed to proceed to registration and use on the Kenyan market and therefore further disentitles that trade mark to protection in a court of justice.
5. Arising from what is stated in paragraphs (2), (3) and (4) above, there is a likelihood that members of the public may mistakenly purchase the Applicant's goods bearing the Trade Mark No. 0068412 ALICIA thinking they are goods manufactured by ourselves or vice versa.
6. That according to the publication on page 36 of the Industrial Property Journal, the Applicants did not enter a disclaimer of the words GOLD separately and apart from the mark as a whole as required by the provisions of section 17 of the Trade Marks Act.
7. TMA. NO. 0068412 GOLD ALYSSA should therefore be refused registration under sections 14 and 15A of the Trade Marks Act.

Wherefore, we the Opponent pray:

1. That registration of the mark represented in TMA. No. 0068412 GOLD ALYSSA should be refused;
2. That the costs of these proceedings be awarded to us (the Opponent).

The Opponents' Notice of Opposition was duly forwarded to the Applicants who on 17th November 2010 filed their Counter Statement. The Applicants stated the following as the grounds on which they would rely in support of their application:

1. The Applicant denies the contents of paragraph 1 of the Notice of Opposition and in particular that the opponent is the owner of the unregistered mark ALICIA (the Mark) or that the alleged mark has been extensively used, advertised and promoted by the opponent along with its registered trade mark DARLING in class 26 for the goods shown in paragraph 2 of the Notice of Opposition or at all.
2. The Applicant denies the contents of paragraph 2 of the Notice of Opposition and in particular that the opponent has extensively used, advertised and promoted the mark on and in connection with hair additions, hairpieces and braids, weaves and wigs. Further, the Applicant denies that the mark has become well known to the Kenyan public by virtue of the Opponent's sales products as alleged or at all and puts the opponent to strict proof thereof.
3. The Applicant denies the contents of paragraph 3 of the Notice of Opposition and puts the opponent to strict proof thereof. Particularly, that the mark belongs to the opponent or at all. Further that the mark closely resembles any other registered trade mark or unregistered marks either visually and phonetically or that confusion and deception is likely to arise in the minds of the members of the public as alleged or at all.
4. The Applicant denies *in toto* the contents of paragraph 4 of the Notice of Opposition and puts the opponent to strict proof thereof. Particularly, that the products covered by its intended mark are identical to and/or are goods of the same character, nature or description to any other products and that it is likely to cause confusion and deception amongst members of the public as alleged or at all.
5. The contents of paragraph 5 of the Notice of Opposition are denied *in toto* and the Opponent put to strict proof thereof. The Applicant denies that the members of the public may mistakenly purchase its products bearing the Applicant's intended trade mark GOLD ALYSSA thinking that they are the goods manufactured by the Opponent as claimed or at all.

6. Further, that the Opponent has no valid registration in Kenya and the associated variations thereto.
7. The Opponent has never taken any steps to protect the alleged infringement of its rights as the alleged proprietor of the subject mark or any variations thereof. The Notice of Opposition is brought in bad faith and is an attempt to lock out competition from the Applicant.
8. The Applicant pleads that trade marks are territorial in nature and the Opponent has no proof of use, advertisement, or promotion of products with the mark in Kenya and/or nay other countries in the world as alleged in the Notice of Opposition or at all.
9. The Opponent has never or at all used the mark as alleged or at all in Kenya and neither has the Opponent acquired any distinct goodwill and reputation on account of the mark, therefore, acceptance and registration of the Applicant's trade mark application number 68417 is not in any way seeking to deceive, confuse, exploit and or ride off the Opponent's goodwill but an enjoyment of the Applicant's inherent rights as the originator of the GOLD ALYSSA trade mark.
10. Without prejudice to the foregoing, the Applicant pleads that the opposition herein is actuated by bad faith and solely designed to deny the Applicant the benefit of its hard work and purposely exploit and ride off the distinctiveness of the current application for registration of trade mark GOLD ALYSSA.
11. In the alternative and without prejudice to the foregoing, the Applicant pleads that even if the Opponent was the proprietor of the mark and the associated variations thereto as alleged or at all, which the Applicant denies, the same is unregistered and the Opponent is precluded from by section 5 of the Trade Marks Act Cap 506 of the Laws of Kenya from bringing any action to prevent the alleged infringement by the Applicant.
12. The Applicant pleads that the Opponent's Notice of Opposition is otherwise an abuse of the opposition process and shall at the earliest opportunity seek to have the same struck out.

Reasons wherefore: The Applicant prays that:

- i. The present opposition be dismissed;

- ii. The subject application be allowed to proceed to registration;
- iii. Costs of these opposition proceedings be awarded in favour of the Applicant.

The Applicants' Counter Statement was forwarded to the Opponents who on 1st February 2011 filed their Statutory Declaration. The Statutory Declaration was sworn by one Mahmoud Saffideen, the Opponents' Managing Director who declared as follows *inter alia*:

1. I confirm that the opponent is the owner of the Trade Mark ALICIA for which we have filed an application No.68437 ALICIA in class 26, samples of labels are attached to this declaration marked Exhibit **MS1**.
2. The Opponent has used the Opponent's mark ALICIA since 1993 extensively on class 26 along side our registered trade mark (TM.NO.38928) DARLING for Hair additions, hair pieces and braids, weaves and wigs.
3. The Opponent has sold the goods bearing the Opponent's marks to purchasers in Kenya from the year 1993. Photocopies of the invoices/ Delivery notes of the Opponent proving such sales are attached to this Declaration in the bundle marked Exhibit **MS2**.
4. That I verily believe that by virtue of the resultant sales of the goods referred to in Exhibit **MS2** the Opponent's marks are well known to the Kenyan public in connection with the Goods sold by the Opponent.
5. With regard to paragraph 2 of the Counter Statement, I am advised by the Opponent's Advocate's Messrs Onyony and Co. Advocates and verily believe that bona fide use of a Trademark gives the owner of that trademark exclusive rights. Annexed hereto marked **SM3** is the certificate of registration, renewal certificate and certificate of Assignment of our registered Trademark DARLING.
6. The goods covered by the TMA.NO.68412 filed by the Applicant are either identical to or are goods of the same character, nature or description to the goods on which the Opponent uses the Opponent's marks ALICIA in class 26.
7. I verily believe that the trade mark which applicant is attempting to register under TMA.068412 so closely resembles the Opponent's mark

visually and phonetically that the Kenyan public are likely to be confused or deceived into thinking that the goods to which the applicant intends to affix the mark which is shown in TMA.NO.068412 originate from the opponent. This possibility of confusion is further enhanced by the fact that the opponent's mark is used on identical goods or essentially identical goods.

8. With regard to paragraph 3 of the Counter Statement I am advised by the Opponent's Advocates, and I verify believe that the principle test to proof reputation and goodwill in such an opposition, a trader needs to demonstrate that the words have acquired a secondary meaning not only of the goods of which they relate but also specifically of the goods which he is the source. The trader must show the length of use and demonstrate that they have sold and marketed the product in Kenyan market. The Opponent's Advocates will make further submission on this aspect at the hearing of this opposition.
9. With regard to paragraphs 4, 5, 6 and 7 of the Counter-Statement, I am advised by the Opponent's Advocate and verily believe that the principal test in such an opposition is whether the two marks are sufficiently close visually and phonetically as to be likely to cause the public to be confused or deceived. I verily believe that on the basis of that test confusion or deception of the public is likely to arise. The Opponent's Advocates will make further submission on this aspect at the hearing of this opposition.
10. With regard to paragraphs 8 and 9 of the Counter-Statement, I reiterate the contents of paragraphs 7 and 8 and attachments **MS2** and **MS3** of my Statutory Declaration. In the alternative and without prejudice to the foregoing, we are not aware of the existence of the applicant's goods in the market so as to warrant taking an infringement action against them and further that in the event that we discover that the applicant's goods bearing the mark GOLD ALYSSA are in the Kenyan market we will most certainly file an infringement action immediately.
11. With regard to paragraph 10 of the Counter-Statement we deny the contents and put them to strict proof thereof and further that our unsuspecting consumers are likely to purchase the applicant's goods bearing the words GOLD ALYSSA believing they are our ALICIA or thinking that the two marks GOLD ALYSSA and ALICIA come from one source. The

opponent's Advocate will make further submission on this aspect at the hearing of this opposition.

12. In response to paragraphs 11, 12 and 13 of the Counter-Statement I am advised by the Opponent's Advocate and verily believe that it is within our right provided under sections 14 and 15 of the Trade Marks Act Cap 506 of Laws of Kenya to oppose the registration of deceptive, identical and resembling trade marks. We believe GOLD ALYSSA and ALICIA cannot coexist in the Trade Marks Register and in the market without causing confusion. We also believe that a disclaimer to the exclusive use of the word GOLD would have been entered before the applicant's application number 68412 GOLD ALYSSA was allowed to proceed to advertisement.

The Opponents' Statutory Declaration was forwarded to the Applicants who on 25th March 2011 filed their Statutory Declaration. The Statutory Declaration was sworn by one Hongxia Li, a Director of the Applicants who declared as follows *inter alia*:

1. The contents of paragraph 4 of the Declaration are not true or correct.
2. The Opponent is not the registered owner of the Trade Mark ALICIA as claimed in the Declaration or at all.
3. The contents of paragraphs 5 and 6 of the Declaration are not true or correct. There is no evidence tendered by the Opponent to demonstrate that it has been selling goods bearing the mark ALICIA from the year 1993 as claimed.
4. The Applicant is a stranger to the contents of paragraph 7 of the Declaration. In further reply thereto, I am aware that the Applicant has not claimed use of the mark ALICIA or DARLING.
5. The contents of paragraph 8 of the Declaration are not true or correct in so far as they seem to suggest that the Opponent is the registered owner of a trade mark by the name ALICIA. In further reply thereto, the annexed Certificate of Registration relates to the Trade

Mark DARLING owned by Stripes Industries Ltd and not the Opponent.

6. In reply to the contents of paragraph 9 of the Declaration, I am aware that both the Applicant and the Opponent business relates to selling of hair products, hair additions and extensions. However, it is not true or correct that the Applicant's products under the mark GOLD ALYSSA are of the same character, nature and description as claimed or at all.
7. The contents of paragraph 10 of the Declaration are not true or correct. The correct position is that the Kenyan public will not be confused as to the origin and manufacturers of the products as alleged or at all for the following reasons:-
 - (a) The mark GOLD ALYSSA does not in any way resemble the unregistered mark, ALICIA.
 - (b) All the goods sold by the Applicant are clearly marked with the Applicant's name and mark;
 - (c) It is not likely to be taken as indicating a connection in the course of trade between the Applicant's goods and the Opponent's goods for the reason that the Applicant clearly indicates the distinctiveness of its products as compared to the Opponent's products;
 - (d) The Applicant's hair products are distinctly identified by the Applicant's conspicuous blue Trade Mark, "Fashion Idol" logo, name and website and there can be no confusion in the eyes of the general public and in particular, a client within the hair industry, with those of the Opponent which are equally distinctly identified by the Opponent's yellow and purple colour and the mark DARLING together with the caption "ALICIA", logo and name;
 - (e) The Opponent's and the Applicant's products are not so similar

as to be likely to deceive or cause confusion in the minds of the general public and in particular, a client within the hair industry.

8. The contents of paragraph 11 of the declaration are correct.
9. In reply to the contents of paragraphs 12, 13, 14, 15, 16 and 17 of the declaration I reiterate the contents of paragraph 8 hereinabove.

The Applicants' Statutory Declaration was forwarded to the Opponents who on 23rd May 2011 filed their Statutory Declaration In Reply. The Statutory Declaration was sworn by the said Mahmoud Saffideen, the Opponents' Managing Director who denied in toto singularly and severally the allegations and averments made in the Statutory Declaration of the Applicants. This marked the close of the pleadings, subsequent to which the parties herein agreed on a hearing date. However, it was later agreed that the matter would proceed by way of written submissions. The Opponents filed their written submissions on 2nd September 2011 and the Applicants filed their written submissions on 30th January 2012.

Ruling

I have considered the Notice of Opposition filed by the Opponents herein, the Counter-Statement filed by the Applicants and the evidence adduced by the parties by way of their respective Statutory Declarations. I have also considered the written submissions filed herein by Onyony & Company Advocates and Issa & Company Advocates for the Opponents and the Applicants respectively. It is apparent that these opposition proceedings were filed under the provisions of sections 14 and 15A of the Trade Marks Act. I am of the view that the following are the issues that should be determined in these opposition proceedings:

- 1. Is the Applicants' mark "GOLD ALYSSA" so similar to the Opponent's mark "ALICIA" as to cause a likelihood of confusion in contravention of the provisions of section 14 of the Trade Marks Act?**
- 2. Is the Opponents' mark "ALICIA" a well-known mark in Kenya and therefore deserving of protection under the provisions of section 15A of the Trade Marks Act?**

The following is a consideration of the two aforementioned issues:

1. Is the Applicants' mark "GOLD ALYSSA" so similar to the Opponent's mark "ALICIA" as to cause a likelihood of confusion in contravention of the provisions of section 14 of the Trade Marks Act?

Section 14 of the Trade Marks Act provides as follows-

"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."

To be able to determine whether or not marks are similar, I shall consider the following factor:

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

The marks being compared are "GOLD ALYSSA" for the Applicants and "ALICIA" for the Opponents. While the Opponents contend that the Applicants are attempting to register a mark that closely resembles their mark, the Applicants state that their mark is not deceptively similar to the Opponents' mark. Both of the said marks are word marks and the correct test is the one laid down by Parker J in the Pianotist case where he stated as follows:

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

Considering the two marks, it is apparent that the Applicants' mark is comprised of two words "GOLD" and "ALYSSA" while the Opponents' mark is comprised of one feature "ALICIA". I am of the view that when you consider the two marks as whole, the two marks contain differences that would not be ignored by the purchasers of the respective goods. I am of the view that the two marks are different in appearance. The marks are also different phonetically mainly due to the fact that the Applicants' mark is comprised of two elements while the Opponents' mark is comprised of only one element.

As regards the comparison of the two marks in suggestion, the Opponents' mark is comprised of a common girl's name ALYSSA which according to Wikipedia is derived from the name of the flower known as Alyssum. On the other hand, the Applicants' mark is also comprised of a common girl's name ALICIA which means sweet in German and America while it means honest in Greek and Spanish. This means that the two marks are also different in suggestion with the Applicants' mark suggesting a "gold flower" while the Opponents' mark describes characters like "sweetness" and "honesty".

In the Case of SA LTJ Diffusion V SA Sadas Vertbaudet, the European Court of Justice held that a sign is to be regarded as identical with a trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they could go unnoticed by an average consumer.

In regard to this issue, David I. Bainbridge, the learned author of the book Intellectual Property, Sixth Edition states as follows on page 632:

"As a likelihood of confusion is presumed where there is a complete identity of the sign, and the earlier trade mark and the goods or services, the grounds of refusal...should be reserved for those cases where a significant number of consumers would presume that there was complete identity given that it has been established that consumers do not usually make a direct comparison between the sign and the earlier trade mark."

In the case of National Brand Ltd v Blue Lion Manufacturing Ltd, the court stated as follows:

A word mark, and particularly one that makes use of ordinary language, is not merely a combination of abstract symbols (at least to the illiterate observer) but is usually recognizable as a whole. In that respect, in my view, its visual appearance cannot be separated altogether from its sense. Where the sense of one word mark differs markedly from that of another, it seems to me that the scope of deception or confusion is reduced.

In the English case of 10 Royal Berkshire Polo Club Trade Mark [2001] RPC 643, it was held that the semantic content of the marks was not such as to give rise to a belief that the Opponents' goods and the Applicants' goods came from the same undertaking or economically linked undertaking.

Further, consideration of the Register of Trade Marks indicates that on 16th June 2010, the Opponents made an application for registration of their trade mark "ALICIA". The Registrar of Trade Marks duly examined the trade mark which was duly approved, published and was eventually entered in the Register of Trade Marks with effect from the said 16th June 2010. As earlier indicated, this was the same date when the Applicants' application to register the mark "ALICIA" was received by the Registrar of Trade Marks. Having examined both marks and approved both of them for publication in the Industrial Property Journal, it means that the Registrar was of the opinion that the two marks are not similar and can therefore co-exist in the Register of Trade Marks in Kenya as well as the Kenyan market.

I agree with the said opinion of the Registrar and hereby determine that the two marks are not similar in appearance or suggestion and can therefore co-exist in the Register of Trade Marks.

2. Is the Opponents' mark "ALICIA" a well-known mark in Kenya and therefore deserving of protection under the provisions of section 15A of the Trade Marks Act?

Section 15A of the Trade Marks Act provides as follows:

1. 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 person who is a national of a convention country; or 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.
2. ...
3. ...
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.

The Paris Convention for the protection of Industrial Property provides as follows under Art 6bis:

The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of

this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation.

The TRIPS Agreement provides as follows under Article 16:

1...

2. ... In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark.

3. Article 6bis of the Paris Convention (1967) shall apply, mutatis mutandis, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.

The World Intellectual Property Organization has developed the Joint Recommendations Concerning Provisions on the Protection of Well-Known Marks. Various authors and courts have also indicated the factors to consider while determining whether or not a mark is well known. In his book titled Famous and Well-known Marks, Fredrick Mostert indicates that the degree of recognition of the mark, the degree of inherent or acquired distinctiveness of the mark, the degree of exclusivity of the mark and the nature and extent of use of the same or similar marks by third parties are important factors to consider in determining whether or not a mark is well-known in any country. In the UK case referred to as Oasis Ltd's Trade Mark Application, the Court stated as follows:

"In considering detriment under this heading, it appears to me to be appropriate to consider:

- (a) the inherent distinctiveness of the earlier trade mark;
- (b) the extent of the reputation that the earlier mark enjoys;
- (c) the uniqueness or otherwise of the mark in the market place;
- (d) the range of goods or services for which the earlier mark enjoys reputation; and
- (e) whether or not the earlier trade mark will be any less distinctive for the goods or services for which it has a reputation than it was before."

I now proceed to consider some of the aforementioned factors that would enable me to determine whether or not the Opponents' mark "ALICIA" is a well known mark in Kenya.

(a) The extent of the reputation that the earlier mark enjoys

In the UK case referred to as L-Oreal SA and Others v Bellure NV and Others, the Court stated as follows while discussing the issue of reputation: "In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it."

In the case of ConAgra Inc v McCain Foods (Aust) Pty Ltd, the Federal Court of Australia stated as follows:

"...it is still necessary for a plaintiff to establish that his goods have the requisite reputation in the particular jurisdiction, that there is a likelihood of deception among consumers and a likelihood of damage to his reputation. ... reputation within the jurisdiction may be proved by a variety of means including advertisements on television, or radio or in magazines and newspapers within the forum. It may be established by showing constant travel of people between other countries and the forum, and that people within the forum (whether residents there or persons simply visiting there from other countries) are exposed to the goods of the overseas owner."

In the New Zealand Court of Appeal Case known as N V Sumatra Tobacco Trading Company Versus British American Tobacco (Brands) Incorporated, the Court stated as follows in regard to well-known marks:

"All that an opponent needs to show is "awareness", cognizance" or "knowledge" of the mark. This means that the opponent will first have to identify the relevant market, then point to evidence showing that a substantial number of persons in that market have awareness, cognizance or knowledge of its mark. What is a substantial number of persons depends on the nature and size of the market and is relative both to the number of persons involved in and their impact on that market."

I am of the view that the Applicants have not submitted adequate evidence to indicate that the mark "ALICIA" has gained such a reputation in the Kenyan market for the mark to be considered well known in Kenya. The Opponents did not submit any evidence, which would include advertisements on television, or radio or in magazines and newspapers within the country, to indicate that the mark "ALICIA" has gained reputation within the Kenyan market. In the aforementioned Statutory Declaration that was filed on behalf of the Opponents by their Managing Director, the Opponents indicate that they had annexed photocopies of invoices/ delivery notes to prove the sales made by

the Opponents. However, the documents attached are unsigned, undated and unstamped and cannot therefore qualify either as invoices or delivery notes. I am therefore of the view that there is no evidence to indicate the extent of the reputation of the Opponents' trade mark.

(b) The duration and geographical area of the registrations of the mark "ALICIA"

One of the factors indicated in the aforementioned Joint Recommendations Concerning Provisions on the Protection of Well-known Marks by the World Intellectual Property Organization is "the duration and geographical area of any registrations, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark".

As earlier indicated, the Opponents' mark was entered in the Register of Trade Marks with effect from 6th June 2010. This means that the mark has been in the Register of Marks for a period of three (3) years now. This cannot be said to indicate that the mark is well-known in Kenya. Further, there is no indication that apart from Kenya, the mark has been registered in any other jurisdiction. The evidence submitted does not therefore indicate that the duration and geographical area of registration of the Opponents' mark "ALICIA" is wide enough for the said mark to be deemed to be well-known in Kenya.

In conclusion and after considering all the relevant factors, it is my opinion that the mark "ALICIA" is not well known in Kenya and does not deserve protection under the provisions of section 15A of the Trade Marks Act.

Conclusion

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

- (a) The Opponents have failed in these opposition proceedings; and
- (b) The Applicants' trade mark no. KE/T/2010/68412 "GOLD ALYSSA" (WORDS) shall proceed to registration. However, I agree with the Opponents that the Applicants should have been required to file a disclaimer of the word "GOLD" separately and apart from the mark as whole. The said Applicants' trade mark no. KE/T/2010/68412 "GOLD ALYSSA" (WORDS) shall therefore proceed to registration on condition that the Applicants file the prescribed Form TM 19 effecting the requisite disclaimer of the word "GOLD".

The Opponents and the Applicants in these opposition proceedings shall each bear their own costs.

Eunice Njuguna
Assistant Registrar of Trade Marks

30th Day of July 2013

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



Eunice Njuguna
Assistant Registrar of Trade Marks

30th Day of July 2013