



REPUBLIC OF KENYA

IN THE HIGH COURT OF KENYA AT NAIROBI

COMMERCIAL AND TAX DIVISION

CIVIL SUIT NO.500 OF 2015

FIBRELINK LIMITED.....PLAINTIFF

- VERSUS -

STAR TELEVISION PRODUCTIONS LTD.....DEFENDANT

JUDGEMENT

1. This is an appeal brought by **FIBRELINK LIMITED**, in respect to the Ruling delivered by the Registrar of Trade Marks, on 7th February 2012. The said Ruling was made in Opposition Proceedings, against the appellant's application to register the Trade Mark "**STAR PLUS**" in class 38, for Telecommunications Services.

2. The appellant stated the following as its grounds for challenging the Ruling;

"i) That during the hearing, the Respondent-Opponent failed to prove his only one pleaded ground in the Opposition Notice, that his claimed mark was well-known. This fact that the Respondent did not prove his claim is admitted and recorded in the Registrar's Ruling. The trademark in dispute is T M A No. 65503 (Star Plus) in class 38 in the name of Fibrelink.

ii) That the Registrar misapplied Section 14 of the Trademarks Act as a basis for his Ruling, instead of applying the correct provision of the law under Section 15 (1) of the Trademarks Act.

iii) That the Registrar failed to recognize the fact that deception and confusion mentioned under Section 14 of the Act is not about consumer deception and confusion caused in the course of trade, usually associated with competition of trademark products under Section 15 (1) of the Trademark Act, but deception and confusion caused by deceit and confusion per se".

3. The appellant pointed out that it had applied to register the trademark after the Registrar had advised it that the mark was available for registration.

4. According to the appellant, when a mark is available for registration, that implies that the said mark was not owned by any person or entity.

5. It is the further understanding of the appellant that ownership of a trademark can be through either registration or by virtue of the mark being well-known to be associated with the proprietor.

6. In this case, the respondent raised an objection to the appellant's application for the registration of the mark, when the process of registration was at the last stage.

7. The appellant has submitted that for any party to oppose the registration of a trademark, the party must first establish ownership of the trademark in question. In the event that the party did not prove ownership of the mark, the appellant submitted that the said party lacked *locus standi*: to oppose the intended registration.

8. The appellant emphasized that establishing ownership or the proprietorship of a mark is a condition precedent for any party who wishes to lodge a claim of right in a trademark or in any other intellectual property.

9. However, the appellant acknowledged that pursuant to Section 29 (1) of the Trademarks Act, there was an exception, which enabled an Aggrieved person to bring proceedings without necessarily being the proprietor or the owner of the trademark.

10. However, the appellant pointed out that the Respondent in this case was not such an Aggrieved person.

11. It is common ground that the Registrar of Trademarks made the finding that the Respondent had failed to prove that its mark was well-known in Kenya.

12. Therefore, as far as the appellant was concerned, that finding should have led the Registrar to conclude that the registration of the appellant's mark could proceed. That contention is premised on the appellant's submission that the ownership or the proprietorship of a trademark was a condition precedent to institution of action to bar the registration of a trademark by another person.

13. Section 15 (1) of the Trademarks Act stipulates as follows;

“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, which 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”.

14. Pursuant to that statutory provision, a person whose mark is already on the register is granted protection against any other person who may wish to register a mark which was either identical with or which so resembled the registered mark.

15. Therefore, if the respondents' case was based on Section 15 (1) of the Trademarks Act, the respondent would only have succeeded in its objection if it had demonstrated that its mark was already registered.

16. However, the respondent's objection to the appellant's application for registration of the mark in issue, was not based on Section 15 (1) of the Trademark's Act. The respondent's objection was based on Sections 14, 15 A (1) to 15 A (4) of the Trade Marks Act, as read with Article 16 (3) of the **TRIPS** Agreement. The said statutory provisions were expressly spelt out on the face of the Notice of Opposition dated 28th October 2009.

17. In the circumstances, as the opposition was founded, inter alia, upon Section 14 of the Trade Marks Act, I find that it was incumbent upon the Registrar of Trade Marks to take into account that provision of law, when he was making his determination.

18. Accordingly, it cannot be right for the appellant to find fault with the Registrar when he relied upon Section 14 of the statute, in the course of making his determination.

19. The said Section 14 was enacted for the purposes of making it clear when registration of a trade mark would be prohibited, if the application for which registration was being sought was deceptive or likely to cause confusion. The section provides as follows;

“14. Prohibition of Registration of deceptive, etc....matter

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”.

20. As the appellant, correctly, pointed out, Section 14 does not talk about trade marks which were identical or similar.

21. However, it was not lost on the appellant that;

“...under Section 14, what is prohibited is deceit and confusion which offends law, public policy and morality...”

22. In my understanding, when a trade mark was so identical or similar to another one, which was already in use, the possibility of deceit or confusion would be a reality.

23. Therefore, it would be against public policy to allow the second or subsequent mark to be registered.

24. Section 15 A of the Trade Marks Act provides protection of Well-Known trade marks. It reads as follows;

“(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the W T O Agreement as a well known trade mark, are to a mark which is well known in Kenya as being a 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”.

25. The Registrar of Trade Marks noted that Kenya is a party to both the Paris Convention and to the **TRIPS** Agreement, and that therefore they form a part of the Law of Kenya.

26. In his considered view, the respondent had fallen short of proving that the **STAR PLUS** mark was well known in Kenya.

27. In the circumstances, the appellant submitted that when a trade mark was neither registered nor well known in Kenya, confusion and deception could not occur.

28. In the case of **PHARMAKEN LIMITED Vs LABORATORIES ALMIRAL S.A, HIGH COURT CIVIL APPEAL No. 616 of 2012**, Onyancha J. dealt with a matter in which the respondent had opposed the registration of a trade mark under Section 14 of the Trade Marks Act. The learned Judge noted that when two names were substantially similar, there was a likelihood that that could cause deception and confusion.

29. Quoting the words of Sir Udo Udoma C.J in **ATKIEBOLAGET JONKOPING VUCAN INDUSTRIKFA BRIKASTIEBOLAG Vs EAST AFRICA MARCH COMPANY LTD [1964] E.A 62**, the learned Judge noted thus;

“It is for the plaintiff company to prove that there is a resemblance between the two marks, and that such resemblance is deceptive. It is also a well-established principle of law that it is the duty of the Judge to decide whether the trade mark complained of so nearly resembled the registered trade mark as to be likely to deceive or cause confusion in the minds of the public”.

30. In the case of Pharmaken Limited the learned Judge concluded that the marks were phonetically and visually different. Therefore, he concluded that the possibility of confusion arising, was *meagre*.

31. But the significant holding is that when two trade marks bore resemblance, the Judge should determine if such resemblance could deceive or cause confusion.

32. In this case, the trade marks were identical, and the Registrar of Trade Marks held that there could arise deception or confusion.

33. I find no reason in law or in fact for faulting the said conclusion of the Registrar.

34. I also find that even though the respondent’s mark was not well known in Kenya, the respondent had proved that the said mark had been in use in Kenya, for couple of years.

35. It is not the extent to which the mark had penetrated the market which would determine whether or not the mark could be confused with another mark which was identical to or similar with the respondent’s mark.

36. The similarity of trade marks is what can lead to deceit or confusion, or both. And whether or not the extent of such deceit or confusion was either widespread or was limited, would not alter the fact that they exist.

37. Once it is determined that a trade mark was so similar to another that there was a likelihood of confusion or deceit, if both were registered, it was incumbent upon the Registrar of Trade Marks to reject the registration of the mark which came into being later than the other.

38. In this case the respondent had produced evidence to demonstrate that it had distributed programmes under the **STAR PLUS** mark to over 10,000 subscribers in Kenya, by the end of 2009.

39. Of course, as the Registrar held, 10,000 subscribers do not constitute a substantial percentage of the overall Kenyan public.

40. But the fact that there were 10,000 subscribers to the product which bore the respondent's mark, meant that the respondent had shown that it had identified its product using the mark in contention. In the circumstances, even though the said mark may not have been either well known or registered in Kenya, it belonged to the respondent.

41. Once the respondent had proved that it had been using, and continued to use the mark in contention, the Registrar of Trade Marks was right to grant protection to the mark, by rejecting the appellant's application for registration of an identical mark.

42. In the result, I find that the Registrar did not err. His decision was well founded on both the evidence and the applicable law.

43. Accordingly, there is no merit in the appeal. It is dismissed, with costs to the respondent.

DATED, SIGNED and DELIVERED at NAIROBI this 7th day of November 2017.

FRED A. OCHIENG

JUDGE

Judgement read in open court in the presence of

Swanya for the Plaintiff

Miss Onyango for Mrs. Opiyo for the Defendant

Collins Odhiambo – Court clerk.



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