



**REPUBLIC OF KENYA**

**IN THE HIGH COURT OF KENYA AT NAIROBI**

**MILIMANI LAW COURTS**

**CIVIL APPEAL NO 123 OF 2014**

**GLOBAL INVESTMENTS DEVELOPMENT LIMITED.....APPELLANT**

**VERSUS**

**TRICLOVER INDUSTRIES (K) LIMITED.....RESPONDENT**

**(Being an appeal from the Ruling and Order of the Assistant**

**Registrar of Trademarks delivered on 7<sup>th</sup> February 2014)**

**JUDGMENT**

**INTRODUCTION**

1. In her decision of 7<sup>th</sup> February 2014, Eunice Njuguna, Assistant Registrar of Trademarks came to the following conclusion:-

- a. On a balance of probabilities, the Opponents have not succeeded in these opposition proceedings;**
- b. The Applicants' trade mark no. KE/T/2011/071011 "SUPA MANDAZI" (WORDS AND DEVICE) shall proceed to registration;**
- c. I award the costs of these proceedings to the Applicants.**

2. Her decision was pursuant to a Notice of Objection against the registration of a Trade Mark No KE/T/2011/07011 "SUPA MANDAZI" (Words and Device) (hereinafter referred to as "the Mark") which was applied for by the Respondent in class 30 in respect of "Baking Powder."

3. Being dissatisfied with her decision the Appellant filed an Amended Memorandum of Appeal dated 15<sup>th</sup> April 2014 on 17<sup>th</sup> April 2019. It relied on fifteen (15) grounds of Appeal.

4. The Appellant's Written Submissions were dated and filed on 30<sup>th</sup> October 2018 while those of the Respondent were dated 30<sup>th</sup> November 2018.

5. The parties requested the court to render its decision based on their respective Written Submissions which they relied upon in their entirety. The Judgment herein is therefore based on the said Written Submissions.

**THE APPELLANT'S CASE**

6. The Appellant was the registered proprietor of Trade Mark No 15660 "CHAPA MANDASHI" for baking powder in class 30 Schedule III (hereinafter referred to as "the trademark"). It stated that it had been manufacturing and selling "Chapa Mandashi" Baking powder for over thirty (30) years and it had enjoyed unrivalled popularity with its consumers in Kenya and East and Central Africa.

7. It was marked in blue and yellow packets with the words "CHAPA MANDASHI" printed in capital letters. It also depicted a tray of buns in an open container under which were the words "CHAPA MANDASHI."

8. It contended that the Respondent had sought a trade mark "SUPA MANDAZI" that was so phonetically similar so as to offend its

Trademark. It also pointed out that the size and colour scheme of the Respondent's packet were identical and that the information, ingredient, bar code were on the same side as that of "CHAPA MANDASHI."

9. It was its averment that the similarity was designed to pass to the Respondent's SUPA MANDAZI as its CHAPA MANDASHI. It further stated that there was an obvious distinction between the level of resemblance between "SUPA MANDAZI" and "CHAPA MANDASHI" and the level of resemblance between "KENSABI MANDAZI", "MARIANDAZI", "MANDAZI BORA" in comparison to "CHAPA MANDAZI" as their colour scheme were clearly distinguishable. They were also not phonetically similar.

10. It stated that the consumers of "CHAPA MANDASHI", were the less and non-educated members of the society who could only identify the baking powder by its appearance.

11. It therefore urged this court to allow its Appeal herein.

### **THE RESPONDENT'S CASE**

12. The Respondent stated that the Appellant filed the initial Record of Appeal in 2014 and it was not only in 2018 that it filed an Amended Memorandum of Appeal which was testimony to the fact that the Appellant was not bothered by its Trademark which was already in the market.

13. It stated that there was no similarity between "CHAPA MANDASHI" and "SUPA MANDAZI" and that the low level of distinctiveness would be adequate in preventing confusion amongst consumers.

14. It averred that consumers stick to their brands and that consumers would be inclined to be attentive and particular in purchasing food products that determines how the end food will taste. It was emphatic that there was no evidence of actual confusion.

15. It therefore urged this court to dismiss the Appellant's appeal.

### **LEGAL ANALYSIS**

16. The circumstances of this case did not call for the tendering of oral evidence. The Assistant Registrar of Trademarks relied on the documentation that was placed before her so as to arrive at the decision that she did.

17. Be as it may, the principle of analysis of the evidence that was adduced by the said Registrar would be similar to the approach adopted by courts in analysing the oral and documentary evidence that is adduced during trial.

18. This was aptly stated in the cases of **Selle vs Associated Motor Boat Company Ltd[1968] EA 123** and **Peters vs Sunday Post Limited [1985] EA 424** where in the latter case, the court therein rendered itself as follows:-

***"It is a strong thing for an appellate court to differ from the findings on a question of fact, of the judge who had the advantage of seeing and hearing the witnesses...But the jurisdiction to review the evidence should be exercised with caution: it is not enough that the appellate court might have come to a different conclusion..."***

19. Having looked at the parties' Written Submissions and documentation that were placed before it and the Assistant Registrar of Trademarks, it appeared to this court that the only issue that it was being asked to determine was whether or not she arrived at a correct conclusion that the Appellant had not succeeded in the objection proceedings and that the Respondent could proceed with registration of its trademark No KE/T/2011/07/011 "SUPA MANDAZI" (WORDS AND DEVICE").

20. The court therefore dealt with all the grounds of appeal together as their determination would lead this court to agreeing either with the Appellant's or position that of the Respondent herein.

21. The Appellant referred this court to several cases in its Written Submission but only annexed copies of two (2) cases, to wit **Pastificio Lucio Garofalo S.P.A vs Debenham & Fear Ltd [2013] eKLR** to buttress its argument that the similarity between "CHAPA MANDASHI" and "SUPA MANDAZI" was so close as to cause its customers to be confused and purchase the wrong baking powder. It did not, however, show the relevance of the two (2) said cases in its Written Submission.

22. On its part, the Respondent annexed copies of the cases of **British American Tobacco Kenya Ltd vs Cut Tobacco Kenya Ltd [2007]e KLR** and **Pharmaken Ltd vs Laboratories Almirall S.A [2015]e KLR** to support its case.

23. It argued that the Appellant could not claim a monopoly over the mark "MANDAZI." It referred this court to the case of **British Tobacco Kenya Ltd vs Cut Tobacco Kenya Ltd** (Supra) where it was held that ***"... there can be no property in general words descriptive of goods... we now understand that generally smokers stick to their brand of cigarettes just the same way beer drinkers stick to their own brand of beer."***

24. It submitted that a court had to focus on the overall impression made by the respective signs and ***"not isolate one (1) element out of a graphic ensemble..."*** It referred to this as the global appreciation approach.

25. It pointed out that the dominant features on its baking powder were the word "CLOVERS" a derivate of "TRI CLOVERS" in a red-painted oval feature that had no comparison to the Respondent's mark and the device of brown mandazis and a doughnut were completely

distinctive from the device of yellow buns in the “CHAPA MANDASHI” packet and hence the overall visual impression on the minds of the consumers was that both marks were different.

26. It also referred to WIPO Intellectual Property Handbook: Policy, Law and Use on page 87 Clause 2.471 that states that:-

**“When trademarks with a common element are compared, it also has to be established whether there are other trademarks on the register and used by different owners that have the same common element. If so, the consumer will have become accustomed to the use of this element by different proprietors, and will no longer pay special attention to it as a distinctive element of the mark.”**

27. It was its submission that because there were other marks in class 30 all using blue and yellow colours, the yellow and blue colours and the word “MANDASHI” could not be said to be the distinguishing mark of the Appellant and others in the market.

28. It further argued that there was honest concurrent use of the marks “CLOVERS SUPA MANDAZI” (Words and Device) and “CAPA MANDASHI” for more than two (2) years and that since there has been no confusion during that time, it would be greatly inconvenienced if the registration of the mark was cancelled.

29. This court had occasion to look at the baking powder packets of “CHAPA MANDASHI”, “SUPA MANDAZI”, “KENSAFI MANDAZI”, “MARIANDAZ” and “MANDAZI BORA” which were submitted for its perusal and noted that they all used blue, yellow and white colours. The words and devices were distinctly different.

30. In the Appellant’s baking powder packet, the words were “CHAPA MANDASHI”, printed in capital letter in blue. The words “BAKING POWDER” in a straight line were below the device which was a container with the sign of steaming yellow buns. The directions for its usage were printed in white colour. There was a purple and red logo in a white square. The “CHAPA MANDASHI” baking powder was in a blue and yellow packet.

31. The Respondent’s baking powder packet was also blue and yellow. The words, “SUPA MANDAZI” were printed in lower case, in white. There were additional words, “perfect for baking” printed in white and encased in blue colour. The word “CLOVERS” was printed in white and was encased in a red oval. The word “Baking” was above the word “Powder”. The devices were two (2) brown mandazis and a doughnut. The directions on how to use the product were printed in black. The package also contained the words “THANK YOU” written in lower case. These words were slanted.

32. Section 15 (1) of the Trademarks Act Cap 506 (Laws of Kenya) provides 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, 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.”**

33. Having had due regard to the aforesaid provision of the law, this court found itself in agreement with the Assistant Registrar of Trademarks that the Appellant’s mark was not a strong mark and was incapable of being confused with the Respondent’s mark by any intelligent person who had exercised due care and attention in choosing the goods. There was also no similarity between the marks in appearance and suggestion, a determination that she correctly made or that there had been any actual confusion. Even without considering the global appreciation approach, the devices were completely distinct.

34. After carefully analysing her Ruling, this court found that the same was properly considered and represented the correct position. Infact, the words “CHAPA MANDASHI” and “SUPA MANDAZI” were so phonetically different that no reasonable man would have perceived them to be so close as to cause confusion at the time of purchase.

35. This court therefore fully associated itself with the cases that were relied upon by the Appellant. Those that were relied upon by the Respondent were clearly distinguishable from the facts of this case as there was clearly no similarity in appearance and phonetics between “CHAPA MANDASHI” and “SUPA MANDAZI.” In addition, the Appellant had also not demonstrated that there was any actual confusion or deception on the part of the Respondent.

## **DISPOSITION**

36. For the foregoing reasons, the upshot of this court’s decision was that the Appellant’s Appeal that was dated 15<sup>th</sup> April 2014 on 17<sup>th</sup> April 2019 was not merited and the same is hereby dismissed with costs to the Respondent.

37. Orders accordingly.

**DATED and DELIVERED at NAIROBI this 30<sup>th</sup> day of May 2019**

**J. KAMAU**

**JUDGE**