



REPUBLIC OF KENYA

IN THE HIGH COURT OF KENYA AT NAIROBI

COMMERCIAL AND ADMIRALTY DIVISION

MISC. NO.225 OF 2017

IN THE MATTER OF TRADE MARKS ACT CAP 506 OF THE LAWS OF

KENYA

L.A GROUP (PTY) LTD.....APPELLANT

VERSUS

WARDROBE COLLECTIONS.....RESPONDENT

JUDGMENT

1. This is an appeal arising out of the decision of the Assistant Registrar of Trade marks dated 17th March 2017. In that decision the Assistant Registrar of Trade Marks dismissed opposition proceedings by L.A Group (PYT) Limited (hereinafter L.A Group or the Appellant). In the same decision, the Assistant Registrar allowed the application by Wardrobe Collection Limited (Wardrobe or the Respondent) to proceed with registration of Trade Mark N0. KE/T/2014/81686 “CLASSIC POLO” (words and device).

2. L.A Group is a Company duly incorporated according to the company laws of the Republic of South Africa. It states that it has, from at least early 1970’s, used the word ‘POLO’ mark as well as ‘POLO PONY’ device mark. It states that the marks are used for high quality products that are coveted by stylish and fashion conscious consumers from all sections of the purchasing public. Further that the products are upmarket brands with a reputation for style, quality and elegance.

3. In the opposition proceedings filed through a Notice of Opposition on 17th January, 2015, L.A Group asserted that it is a leader in the sourcing and distribution of branded clothes, accessories, foot wear products and in corporate clothing and brand management. Secondly, that it has a number of subsidiary companies to which it has granted licences for the use of its marks. And that, in particular, it has licenced the use of those marks to its wholly owned subsidiaries namely Polo management, PYT Limited and Polo distribution PYT Limited which cover Sub-saharan Africa including Kenya.

4. L.A Group is the registered proprietor of two Trade Marks in Kenya. One is Trade Mark POLO under registration No.55887 filed on 29th April 2004 in respect to classes 14, 18, 25 and 35. Also Trade Mark No. 55535 POLO PONY device filed on 16th January 2004 in respect to classes 18, 25 and 35.

5. L.A Group asserts that it promotes its marks by way of in-store branding, online advertising, word of mouth and display by satisfied customers. It states that it has sold products under and bearing its Trade Marks in Kenya through a number of distributors and retailers. L.A Group boasts of strong online presence on social media applications such as facebook and twitter.

6. The Appellant or L.A Group avers that it has advertised, marketed and promoted its Trade Mark through websites at www.polo.co.za and www.polosa.com. That the sites are accessible in Kenya.

7. In terms of promotion, it is also the case of L.A group that the Trade Marks are promoted in Kenya and the whole of Africa through sponsorships. One such sponsorship is of outfits worn by one Bruce Whitefield who is a financial market commentator. Of him, it is said, he provides market updates throughout the day on CNBC Africa which is a paid for satellite television station available on DSTV at channel 410. This is channeled together with CNN on which the L.A Group also promotes its Trade Marks. It is contended that the TV channels can be accessed in Kenya. Again on advertisement and promotions, L.A Group asserts that it does so by means of sponsorship of various events. Once such events is the Capetown International Jazz festival of 2010, 2011 and 2012 which were attended by a variety of visitors including Kenyans.

8. Further, the Appellant asserts that it has spent considerable amount of time, money and effort in advertising, marketing and promoting its

goods under POLO trade mark. That the POLO mark is well known amongst Kenyan consumers and has acquired a reputation and common law Trade Mark Rights.

9. L.A Group was aggrieved by the application by Wardrobe to register mark 'CLASSIC POLO' in class 25. It is said that the mark of Wardrobe exists in the words 'CLASSIC' and 'POLO'. L.A Group argues that the word 'classic' is descriptive of the type of products that the trade mark will be applied in class 25. That the word merely indicates the clothing to which the trade is likely to be applied to. Further that the word is not intrinsic to the 'CLASSIC POLO' trade mark and is not on its own capable of distinguishing the trade mark of Wardrobe from those of other proprietors.

10. In addition, it is the case for L.A Group that the device and pictorial element placed between the words 'CLASSIC' and 'POLO' is not very visible and is indistinct. The element cannot be pronounced aloud at all and that given the size of the logo in relation to the words 'CLASSIC' and 'POLO' the element is a mere embellishment and incapable of function as badge of origin. It is argued that the inclusion of the word 'CLASSIC' and an indistinct device are not sufficient to distinguish that Trade Mark from that of L.A Group. It is thus submitted by L.A Group that a consumer will be deceived or confused into believing that the 'CLASSIC POLO' logo Trade Mark is associated or connected to its well-known Trade Mark. Further, that consumers familiar with its well-known Trade Mark are likely to assume that Wardrobe's mark is a sub-brand or related to those of L.A Group.

11. It is further argued that because its Trade Mark is well-known, the fame of the POLO Trade Mark is an additional element in the mind of the consumer when it encounters the Trade Mark of Wardrobe. This, it is said, will most likely result in deception and/or confusion.

12. In respect to goods in class 25, the contention by L.A Group is that the impugned mark is not capable of distinguishing the Appellant's goods from those of his opponents. An argument is made that the mark is not distinctive and cannot be registered in terms of section 14 of the Trade Marks Act. It is emphasized that the registration is sought in class 25 which is in respect of the very goods for which L.A Group has used and registered Trade Marks. That the goods are identical and sold through the same trade channels, the customers would be the same and the goods are for the same purpose.

13. It is also stated that the impugned mark very closely resembles a mark which belongs to a different proprietor and is already in the register. It is therefore the argument by L.A Group that the registration of Wardrobe mark will contravene the provisions of section 15(1) of the Trade Marks Act. Further that the said application contravenes the provisions of section 15 A(4) of the Act which prohibits registration of a Trade Mark that takes unfair advantage of the reputation of a well-known Trade Mark.

14. In the proceedings before the Registrar, Wardrobe filed a counterstatement on 19th August, 2015. Wardrobe points out that L.A Group does not hold a monopoly over the name POLO as alleged despite the fact that it is the proprietor of the POLO trade mark no. 55887 in Kenya.

15. It is contended that the word POLO in reference to clothing refers to a shirt and is a descriptive word. Wardrobe quotes the meaning assigned to the word 'polo shirt' from Merriam Webster Dictionary :-

“Polo shirt:- a shirt with a collar and a few buttons at the neck that you put on by pulling over your head”.

16. The Registrar was asked to find that the name 'CLASSIC POLO' by Wardrobe is a clear and distinct mark from that of L.A Group. The Registrar was urged to find that the differences between names are clear and distinguishable from a basic glance.

17. Wardrobe asserted that its name contains a logo between the words 'CLASSIC' and 'POLO'. This is distinct from that of L.A Group which depicts a pony or a horse with a rider. In addition, an argument by Wardrobe is that the mark 'CLASSIC POLO' has been registered in various Countries, an example being India.

18. Elaborating, the Respondent asserts that its Trade Mark 'CLASSIC POLO' and that of L.A Group being 'RALPH LAUREN POLO' and 'US POLO' marks have coexisted in various jurisdictions in the world without any confusion whatsoever. It is stated that the owners of 'RALPH LAUREN POLO' and 'US POLO' have, without success attempted by way of opposition and law suits to prevent registration and use of the name 'CLASSIC POLO' in India and other jurisdictions.

19. The defence is that Wardrobe has adopted its mark 'CLASSIC POLO' independently and with *bona fides*. In addition, Wardrobe argues that L.A Group is a foreign entity registered in South Africa and its area of operation must be presumed in that Country. Wardrobe takes a view that based on jurisdiction and area of operation, it is even less likely that the two parties will cause any confusion over the distinct uses of their trade marks. Further that L.A Group has confirmed that it only promotes and markets the use of trade marks 'POLO' and 'POLO PONY' which are distinguishable from the Wardrobe mark of 'CLASSIC POLO'.

20. At the hearing of the opposition proceedings before the Registrar the Registrar framed two issues for determination as follows:-

1. Is the Applicants' trade mark 'CLASSIC POLO' (words and device) so similar to the Opponents' Trade Marks 'POLO' (word) and 'POLO PONY' (device) as to be likely to cause confusion in contravention of the provisions of section 15 (1) of the Trade Marks Act?

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

21. After discussing the various arguments made by the parties the Registrar made the following finding, first having adopted a common element to distinguish their goods in class 25, L.A Group ran a risk of failing to uphold the monopoly of the element. The Registrar

concluded that the element 'POLO' is not a strong mark. Secondly, that since both parties take the position that their products are purchased by consumers who value personal items, such consumers are quite discerning and it would be unlikely that the respective customers would be confused. Although she found that the two marks are conceptually similar, the Registrar held that the element 'POLO' when used with respect to goods in class 25 of the nice classification could be said to be distinctive of the goods.

22. In regard to whether the Trade Mark 'POLO' is well known in Kenya, the Registrar found that L.A Group had not furnished sufficient evidence to prove that assertion. The Registrar then came to a conclusion that the Trade Mark 'POLO' did not deserve a protection as a well known product in accordance with the provision of Section 15(1) of Trade Mark Act.

23. As I turn to consider the grounds of Appeal, I feel constrained to make a few observations about the jurisdiction and role of the High Court at an Appeal of this nature. The Appeal herein arises from the decision of the Registrar in respect to Opposition proceedings to registration of a Trade Mark. That Appellate jurisdiction is in subsections 6 to 10 of Section 21 of the Trade Marks Act which reads:-

“(6) The decision of the Registrar shall be subject to appeal to the court.

(7) An appeal under this section shall be made in the prescribed manner, and on the appeal the court shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions or limitations, if any, registration is to be permitted.

(8) On the hearing of an appeal under this section any party may, either in the manner prescribed or by special leave of the court, bring forward further material for the consideration of the court.

(9) On an appeal under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar, other than those so stated by the opponent, except by leave of the court; and, where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

(10) On an appeal under this section the court may, after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity thereof, but in any such case the trade mark as so modified shall be advertised in the prescribed manner before being registered”.

24. As to the latitude of this Court's intervention in an Appeal, section 52 provides:-

“In any appeal from a decision of the Registrar to the court under this Act, the court shall have and exercise the same discretionary powers as under this Act are conferred upon the Registrar”.

25. As the Registrar is a specialized quasi-judicial Tribunal, the Court should be ready to grant some deference to its decision unless there is a compelling cause to depart. In this regard the Singapore decision in Future Enterprises Pte Ltd vs. McDonald's Corp[2007] 2 SLR-845;2007 SGEA is relevant:-

“The smorgasbord of trade mark cases which has reached the appellate courts demonstrates the innumerable (and subjectively perceived) similarities and differences that can be conjured up and persuasively articulated by an imaginative and inventive legal mind. Expert and experienced judges, such as Laddie J, have described trade mark infringement as “more a matter of feel than science”. (in Wagamamu Ltd vs. City Centre Restaurants plc [1995] FSR 713 at 732), and Chao Hick Tin JA (as he then was) similarly alluded to it as a matter of “perception” (in The Polo/Lauren subjective nature of assessing similarity and the likelihood of confusion. We agree with the approach that an appellate court should not disturb the findings of fact of a trade mark tribunal unless there is a material error of principle”.

26. Of the same view was Pumfrey J. in the decision of South Cone Incorporated vs. Jack Bessant & others [2001] EWHC ch 420, quoted in The matter of Application No.2132617 by Royal County of Berkshire Polo Club Limited to register a series of Four Trade Marks in class 3 and In the matter of Opposition thereto under No. 47418 by the Polo/Lauren Company Ltd, in which his Lordship said:-

“My approach will be as follows. Findings of primary fact will not be disturbed unless the hearing officer made an error of principle or was plainly wrong on the evidence. His inferences from the primary facts may be reconsidered but, weight will be given to his experience. No question of the exercise of a discretion arises. In this way, error will be corrected, but a different appreciation will not be substituted for that of the hearing officer if he has arrived at his conclusion without error”.

27. An appeal under the provisions of Section 21(6) of The Act is by way of Notice of Motion. In the Motion of 12th May, 2017, L.A Group listed the Registrar's errors as :-

1.1. affording insufficient weight to the similarity between the two marks, especially after agreeing that the two marks are confusingly (conceptually) similar.

1.2. taking into account material that had not been placed before here by the Respondent, and which is therefore not part of the record.

1.3. failing to consider the uncontroverted evidence that the Appellant, until very recently when the Respondent entered the market place was, in trade, the only proprietor trading in goods bearing a POLO trade mark.

1.4. affording insufficient weight to the fact that the Appellant has a registered POLO trade mark. The effect of this registration is an entitlement to the exclusive use of the word as a trade mark in respect of the goods covered by the registration.

1.5. affording no weight to the unquestioned fact that the respective marks would be used in respect of the same goods. It is thus not possible to discern between the respective parties' goods on this basis.

1.6. failing to find that the Appellant's POLO trade mark qualified as a well-known trade mark which is entitled to protection in terms of section 15(4) of the Trade Marks Act.

1.7. failing to take give any weight to the Appellant's sales figures and the uncontroverted evidence of a trade in the relevant business circle.

1.8. failing to consider the undisputed evidence that the Respondent is only a licensed distributor of a foreign licensor. It thus has no locus standi to file the opposed Mark, as pleaded at paragraphs 4.2 and 5 of the Appellant's statutory declaration in reply.

1.9. failing to consider section 14 of the Trade Marks Act, despite the Appellant's contentions at paragraphs 20 and 35 of its Notice of Opposition that the offending mark is contrary to section 14.

28. One matter that calls for the immediate attention of the Court is whether the issue of locus standi of Wardrobe to take out the application should be considered at all. At the opposition proceedings and so too before this Court, L.A Group submits that Wardrobe is not the proprietor of the 'CLASSIC POLO' mark and therefore lacks the standing to apply for the mark.

29. It is however common ground that the issue of proprietorship was not taken up in the Notice of opposition filed by L.A Group which in accordance to the Rules ought to include a statement of the grounds upon which the opponent objects to the registration. Yet again the issue as to whether Wardrobe was the proprietor of 'CLASSIC POLO' mark arose when, on 17th March 2016, it filed its statutory declaration pursuant to Rule 51 of the Rules.

30. In that statutory declaration Mr. Rajesh Jethwa, the Managing Director of Wardrobe makes the following declaration:-

"1. I am the Managing Director of the Wardrobe Collection Ltd. Clothing Store, the Applicant. The Wardrobe Collection Clothing Store is responsible for the sale, marketing and promotion of Classic Polo branded products in Kenya.

2. As the Managing Director of Wardrobe Collections Ltd. Clothing Store, I am involved with the oversee marketing and promotion of Classic Polo branded products.

3. I am duly authorized by the Applicant to depose to this affidavit, and my authority to do so stems from the annexed Authority to execute statutory declaration.

4. The facts to which I attest in this affidavit are true and correct and are within my personal knowledge, or are taken from those parts of the properly kept, continuous and accurate records of the Applicant, to which I have access. Save to the extent that they are extracted and set out below; these records are irrelevant to this application. Where I comment of legal issues, I do so from the advice of the Applicant's advocates on record, Kosgey and Masese Advocates.

5. I have read the Statutory Declaration filed by the Opponent. Where I do not address any specific averments, those averments are not admitted and are denied".

31. In the statutory declaration made in reply thereto, L.A Group filed a statutory declaration in which Mr. Duncan Kukard depones:-

"4.2. It is important to note that the Trade mark Applicant has alleged that it is responsible for only "the sale, marketing and promotion of Classic Polo branded products in Kenya". As will become evident later in Mr. Jetwa's affidavit, the Trade Mark Applicant is simply a retailer or distributor and not a bona fide proprietor of the CLASSIC POLO trade mark.

6.1 The allegations in this paragraph and the letter annexed as RJ3 to Mr. Jethwa's affidavit confirms that the Trade Mark Applicant is only a distributor and dealer of apparel bearing the mark CLASSIC POLO.

6.2 Annex RJ3 of Mr. Jethwa's affidavit clearly states that the mark CLASSIC POLO is registered by Royal Classic Mills Pvt Ltd, the Indian company. The Trade Mark Applicant apparently has a licence to use the CLASSIC POLO trade mark and no authority or consent has been granted to register the mark in Kenya. In fact, it is stated that the Trade Mark Applicant cannot manufacture, sub-licence or assign".

32. In the face of the above, L.A Group took, and maintained the position, that the issue of proprietorship (and therefore locus standi) was an issue that was properly pleaded and should have been addressed by the Registrar. Wardrobe react by arguing that it was not an issue that could properly arise at the opposition proceedings. What does this Court make of these conflicting arguments?

33. It is common ground that the opposition was triggered by the publication of Wardrobe's application for registration which appeared in the Industrial Property Journal 2015/14 of 30th April, 2015. L.A Group argues that it was entitled to presume that the details in the journal were kept substantially in the form required by law and it could not therefore be put on notice that Wardrobe was not the true owner of the

Trade Mark sought to be registered.

34. This Court accepts this position because the advertisement does not carry with it proof of proprietorship of the mark. There can be no begrudging L.A Group on the timing of the crucial discovery. The question that arises is how L.A Group should have taken up what could amount to a new but critical issue.

35. This requires the Court to set out the procedure for opposition to registration which is found in Rules 46 to 59 but of relevance would be Rules 46 to 52 which are pre hearing motions. The Rules read:-

“46. Any person may, within sixty days from the date of any advertisement in the Journal or Kenya Gazette of an application for registration of a trade mark, give notice in Form TM 6 to the Registrar of opposition to the registration.

47. (1) The notice shall include a statement of the grounds upon which the opponent objects to the registration.

(2) If the registration is opposed on the ground that the mark resembles marks already on the register, the notice shall set out—

(a) the numbers of those other marks; and

(b) references to the Journals or Kenya Gazettes in which those other marks were advertised.

(3) The notice shall be accompanied by a duplicate, which the Registrar shall forthwith send to the applicant.

48. (1) Within forty-two days from the receipt of the duplicate the applicant shall send to the Registrar a counter-statement in Form TM 7 setting out the grounds on which he relies as supporting his application.

(2) The applicant shall also set out what facts, if any, alleged in the notice of opposition he admits.

(3) The counter-statement shall be accompanied by a duplicate.

(4) Upon receipt of the counter-statement and duplicate the Registrar shall forthwith send the duplicate to the opponent.

49. (1) Within forty-two days after the receipt of the duplicate counter-statement, the opponent shall leave with the Registrar such evidence by way of statutory declaration as he desires to adduce in support of his opposition.

(2) The statutory declaration shall be in duplicate.

(3) Upon receipt of the statutory declaration and duplicate the Registrar shall forthwith send the duplicate to the applicant.

50. (1) Within forty-two days after the receipt of the statutory declaration of the opponent under rule 49, the applicant shall leave with the Registrar such evidence by way of statutory declaration as he desires to adduce in support of his application.

(2) The statutory declaration shall be in duplicate.

(3) Upon receipt of the statutory declaration and duplicate the Registrar shall forthwith send the duplicate to the opponent.

51. (1) Within thirty days after the receipt of the statutory declaration of the applicant under rule 50, the opponent may leave with the Registrar evidence, by way of statutory declaration, confined strictly to matters in reply.

(2) The statutory declaration shall be in duplicate.

(3) Upon receipt of the statutory declaration and duplicate the Registrar shall forthwith send the duplicate to the applicant.

52. No further evidence shall be left on either side, but, in any proceedings before the Registrar, he may at any time give leave to either the applicant or the opponent to leave any evidence upon such terms as to costs or otherwise as he may think fit”.

36. My reading of the Rules is that the grounds of opposition would ordinarily be in the statement accompanying the Notice of opposition as provided in Rule 47. The Applicant is then required by Rule 48 to set out the grounds he relies in support of his application. Ideally, therefore, the Statement accompanying the Notice and the Counterstatement constitutes the pleadings in opposition proceedings.

37. However, it seems to this Court that new matters may arise after the filing of the Statement and Counterclaim and which when placed before the Registrar for determination must be taken as properly pleaded for determination. After the filing of the counterclaim, the Opponent is required by Rule 49 to leave with the Registrar evidence in support of the Opposition which is then served on the Applicant. Subsequently, the Applicant is permitted by Rule 50 to file evidence in support of the application.

38. For the purposes of the matter at hand Rule 51 is critical and the Court again, reproduces it:-

“51. (1) Within thirty days after the receipt of the statutory declaration of the applicant under rule 50, the opponent may leave with the Registrar evidence, by way of statutory declaration, confined strictly to matters in reply”.

39. The Rule allows the opponent to file a further statutory declaration confined strictly to new matters raised in evidence in support of the application. In the matter before Court, the first time that the issue of proprietorship came up was in the evidence in support provided by Wardrobe. L.A Group then took it up as point of contention when it filed its further statutory declaration of 17th June 2016. The Court holds that proprietorship was raised as a further ground when the statutory declaration in reply of 17th June 2016 was filed and served upon Wardrobe.

40. It has however been submitted by Wardrobe that the issue of proprietorship was not a direct issue as it required interrogation as the meaning of the word “proprietor” is not defined in the Trade Marks Act. Further that this was a substantive question that called for a substantive answer by way of evidence. The Court understands Wardrobe to be arguing that it did not have adequate opportunity to respond to the matter as both a factual and legal point.

41. As a matter of evidence, Rule 52 (though worded in the negative) allows either party to adduce further evidence with leave of the Registrar. If the position of Wardrobe was that it required to confront the new issue by way of evidence then Rule 52 afforded it an opportunity.

42. In terms of legal argument, L.A Group took up the issue of *bona fide* proprietorship in paragraphs 17 and 18 of its written submissions before the Registrar. Wardrobe on the other hand chose not to respond to the issue at all other than making the following statement,

“The Applicant herein, Wardrobe collection Limited, Clothing Store, is responsible for the sale, marketing and promotion of Classic Polo, a registered Trade Mark of Royal Classic Mills PUT Limited, India, branded products in Kenya”.

43. Significantly, Wardrobe did not protest that L.A Group had taken up arguments in regard to locus standi. That notwithstanding L.A Group rehashed the arguments in respect to proprietorship in paragraphs 3 and 4 of its written submissions in reply.

44. It is therefore the view of this Court, and also its holding, that the issue as to whether Wardrobe was a *bona fide* proprietor of the mark which was the subject of registration was a matter that was properly before the Registrar for determination. The Registrar therefore fell into error in not making any finding on it.

45. Turning now to the arguments in regard to the locus standi, the provisions of section 20(1) of the Act are of singular importance and read;-

“(1) A person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it shall apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the register”.

46. L.A Group is of the view that the above provisions requires that the Applicant to the registration of a Mark be a *bona fide* proprietor of the application.

47. Wardrobe on the other hand urges the Court to find that it is only registration of the Mark that confers proprietorship of a Mark to an Applicant. In this regard the definition of Trade mark under section 2 of the Act is relied on. It reads:-

“trade mark” means, (except in relation to a certification trade mark) a mark used or proposed to be used—

(a) in relation to goods for the purpose of indicating a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person or distinguishing goods in relation to which the mark is used or proposed to be used from the same kind of goods connected in the course of trade with any person;

(b) in relation to services for the purpose of indicating that a particular person is connected, in the course of business, with the provision of those services, whether with or without any indication of the identity of that person or distinguishing services in relation to which the mark is used or proposed to be used from the same kind of services connected in the course of business with any other person”.

48. On the part of this Court, I am unable to see any difficulty in construing the true effect of Section 20(1). But first this Court identifies itself with the holding of Lloyd Jacob J in Vitamins Trade Marks case [1956]RPCI in which he held;-

“A proprietary Right in a Mark sought to be registered can be obtained in a number of ways. The Mark can be originated by a person or can be acquired, but in all cases it is necessary that the person putting forward the application should be in a possession of some proprietary right which, if questioned, can be substantiated”.

49. For an Applicant to have locus standi to apply for registration of a Mark, that person must have a claim to proprietorship of the mark. If an Applicant cannot claim to be a proprietor of the mark, then it cannot have a standing to apply for its registration. So the simple question is whether Wardrobe could claim to be the proprietor of the Mark whose registration it had sought.

50. This is a matter that must cause some anxiety to Wardrobe. This is because Wardrobe lodged its application on 28th August, 2014 but it

was not until 1st April, 2015 that it was given express authority or licence to distribute and deal with the 'CLASSIC POLO' branded apparel by Royal Classic Mills PYT Ltd which is said to be the registered Trade mark owner in India and Singapore. It is therefore apparent that not being a licensee as at 20th August 2014, Wardrobe could not claim to be a proprietor of the mark sought to be registered as at the date of application. The Court makes this conclusion even on the assumption that a license to a mark hoists on the Applicant a right of a claim of proprietorship of the mark for purposes of registration of the mark in circumstances where the licensor has granted sanction to the application.

51. But I proceed to consider the other grounds in the event that the Court's conclusion on locus standi is erroneous.

52. The grounds raised in the Appeal can be discussed under the two themes framed by the Registrar:-

(1) Whether the Applicant's Trade mark is so similar to the Opponent's marks as would likely cause confusion in contravention with the provisions of Section 15(1) of The Act.

(2) Whether the Opponent's Trade mark "POLO" is a well-known mark and therefore deserving protection under the provisions of Section 15A of the Trade Marks Act.

53. Section 15 of the Trade Mark Act provides as follows:-

"(1) 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.

(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the court or the Registrar make it proper so to do, the court or the Registrar may permit the registration of trade marks that are identical or nearly resemble each other in respect of the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as the court or the Registrar may think it right to impose.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks that are identical or nearly resemble each other, in respect of the same goods or description of goods or in respect of the same services or description of services, the Registrar may refuse to register any of them until their rights have been determined by the court, or have been settled by agreement in a manner approved by him or on an appeal by the court, as the case may be."

54. It is common ground that L.A Group is the proprietor of 'POLO' Trade mark under Registration No. 55887 in classes 14,18,25 and 35. The Trade mark having been filed on 29th April, 2004. It is also the owner of Trade Mark 'POLO PONY' (word and device) under Registration No. 55535 filed on 16th January 2004 in classes 18, 25 and 35. In respect to class 25 it holds both Trade Marks on clothing, footwear, headgear, parts, accessories and accoutrements related to those products. Accoutrement is an uncommon word and means personal clothing or accessories.

55. The application by Wardrobe was for registration of 'CLASSIC POLO' logo in class 25 over clothing, footwear and headgear.

56. As is evident, Wardrobe's application was in respect to a Trade Mark over the same goods in which L.A Group was already a registered proprietor. If clarity is needed, it was over clothing, footwear and headgear in class 25 for which L.A Group was already a registered proprietor of two Trademarks. It being so, Section 15(1) would prohibit the registration of the Mark of Wardrobe if it was identical with or nearly resembled the marks belonging to L.A Group, unless Wardrobe could demonstrate concurrent use or other special circumstances to deserve exemption under Section 15(2).

57. The first task therefore of this Court is to examine whether the Registrar considered the sameness or resemblance of the competing Marks and if so, the conclusions drawn.

58. On this question the Registrar held:-

"The marks in comparison in these opposition proceedings is the Applicants' trade mark 'CLASSIC POLO' (WORDS AND DEVICE) and the Opponents' registered trade marks "POLO" (WORD) and "POLO POLONY" (DEVICE). The common element in both marks is the word "POLO". This means the two marks are conceptually similar".

59. Having made this finding, the Registrar proceeded to nevertheless observe that the Registrar had allowed other marks comprising the element "POLO" to co-exist in the Register. The Registrar then concluded that this demonstrated that co-existence could not be in contravention of the provisions of Section 15(1). The Registrar was making a finding, as I understand it, that there were deserving special circumstances under Section 15(2). The Court will return to this but back to the issue of similarity or otherwise.

60. Was the Registrar's finding that the Marks were conceptually similar supported by evidence and the law?

61. The submission by L.A Group is that Wardrobe's mark consists of the words 'CLASSIC POLO' and an indistinctive pictorial element between the two words. It is further argued that the word 'CLASSIC' is not distinctive not only because it is merely descriptive but also because it is not distinctive of the type of products applied for.

62. In respect to the pictorial element, L.A Group additionally submits that it is not very visible and cannot be verbally pronounced. That for those reasons it cannot be viewed other than a mere embellishment not capable of functioning as a badge of origin.

63. In the end, L.A Group contends that the remaining and memorable element of the Applicant's mark is the word "POLO" which is identical with its 'POLO' Trademark.

64. For Wardrobe it is argued that 'POLO' in reference to clothing refers to a shirt and sought to rely on the dictionary meaning of the word (see paragraph 15 of this decision). It then asserts that 'CLASSIC POLO' is a clear and distinct mark from that of L.A Group which only bears the name 'POLO'. That the two names are clear and distinguishable from a basic glance as its logo has the word 'CLASSIC' and 'POLO'. The latter being in reference to the type of apparel.

65. Wardrobe makes the further argument that the name contains an element between the words which is clear and distinct from that of L.A Group which depicts a pony or horse with a rider.

66. This Court is asked, as was the Registrar, to take cognizance that 'CLASSIC POLO' has been registered in various Countries of the world such as India and that the mark has co-existed with the mark 'POLO' of L.A Group, the 'RALPH LAUREN POLO' and 'US POLO' without confusion. The Court has been asked to note that the owners of these two Marks have, without success, attempted by way of opposition and lawsuit to prevent the registration and use of the name 'CLASSIC POLO' in India and other jurisdictions.

67. This Court has given due regard to the submissions made by the parties herein. The starting point is to set out the principles that will guide my hand in determining the question whether the competing marks are similar. In this regard it is common ground that the Trade Marks have a common element being 'POLO'. KIPI Trademark Manual of Examination Procedures (at paragraph 565) sets out the criteria for examining similarity where marks have a common element to be as follows:-

"The fact that where marks have a common element, that element may sometimes be disregarded, or have less attention paid to it when making comparison, does not mean that the dissection of marks in other circumstances is a legitimate practice. In determining whether marks are similar, an overall impression of the mark must be considered ie. visual, phonetic and conceptual similarity (referred to as global appreciation test, ECJ in Sabel case).

Further, in Erektico v. Erector Case (1935) 52 P.R.C. 136, Farewell, J, said;

"I do not think it is right to take a part of a word and compare it with a part of the other word; one word must be considered as a whole I think it is a dangerous method to divide the word up and seek to distinguish a portion of it from a portion of the other word".

68. The Sabel case referred to in the above manual is the decision in Sabel BV and Puma AG, Rudolf Dassler Sport case C 251/95 where the European Court held as follows:-

"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. The wording of Article 4(1)(b) of the Directive- '...there exists a likelihood of confusion on the part of the public ...' – shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyze its various details".

69. This global appreciation test is the test that this Court will adopt in determining whether the Registrar's finding that the two marks are 'conceptually similar' is tenable.

70. Admittedly "POLO" is the common element in the marks. The word "CLASSIC" as is relevant to this discussion means;

"1. judged over a period of time to be of the highest quality (of a garment) of a simple, elegant style not greatly subject to changes in fashion. 2. Remarkably typical; the classic symptoms of flu. 1. a work of art of recognized and established value. A very good example of its kind". (Concise Oxford Dictionary, 12th Edition)

71. To be discerned from this meaning is that the word 'CLASSIC' is ordinarily a descriptive word. Wardrobe who press for the registration of 'CLASSIC POLO' do not suggest otherwise. This Court is therefore constrained to agree with L.A Group that the element 'CLASSIC' is descriptive or at least not distinctive of clothing, footwear or headgear which are the subjects of the application by Wardrobe.

72. Can the same be said about 'POLO'? The argument by Counsel for Wardrobe is that the word 'POLO' is a generic name because it connotes a particular category of garments in textiles. In support of that argument, Counsel cited the decision of the Indian Intellectual Property Appellate Board in The POLO/LAUREN COMPANY, LP VS. ROYAL CLASSIC MILLS – ORA/118/2007/TM/CH 1[2008] INIPA31 (19 March 2008).

73. For some reason, Counsel gave this Court the incomplete decision and from my reading of the entire decision, the portion relied on by Counsel was in fact the arguments of the parties!

74. The finding of the Board on this issue is to be found in paragraph 18 of the decision in which it rendered itself as follows:-

“The plea that POLO is a dictionary word, not devoid of meaning and is a generic term is unacceptable to the extent that the meaning of polo as contained in the Concise Oxford English Dictionary does not designate the kind, quality, quantity, intended purpose or value of the goods covered by the mark POLO. According to the Chambers Dictionary (New Edition) the word “generic”, *adj* means general, applicable to any number of a group or class; of or belonging to a genus; (of a drug, etc) not patented or sold as a proprietary name; (of the name of a brand) that has come to be used as a general name for that type of product (*eg Biro* for the ballpoint pen, *hoover* for vacuum cleaner).-*n* a generic drug, etc; a product sold without a brand-name, in plain packaging, and with no promotion or advertising; a generic brand-name. While taking this dictionary meaning of the word generic in relation to POLO, one must bear in mind that we are not considering the word Polo Shirt but the word POLO only. From this, we are unable to persuade ourselves to agree that the POLO is a generic word. A number of trade mark registrations obtained by the appellant world over with word POLO or consisting of word in any form support our view that if the word POLO would have been generic, some where in some country, some authority in the world would have held it to be so”.

75. What is the meaning assigned to the word Polo and Polo shirt. In Oxford dictionary (*supra*), Polo means,

“a game of Eastern origin with rules similar to hockey, played on horseback with a long-handled mallet.

While Polo shirt means,

“a casual short-sleeved cotton shirt with a collar and several buttons at the neck”.

76. Before the Registrar, Wardrobe attempted to demystify the strength of the element “POLO” by making arguments around the Polo shirt in reference to clothing. Pressing the argument that the differences in its mark and that of L.A Group is that the “*Applicant’s name has ‘CLASSIC’ in it and ‘POLO’ in reference to the type of apparel’*”. This argument, I am afraid, must suffer the same fate as that made in Polo/Lauren Company (*supra*). Just as in that matter, the Court here is not considering the word ‘POLO SHIRT’ but the element ‘POLO’. In that sense therefore the word “POLO” is not a generic word. It is distinctive.

77. In closing on this aspect, the Court observes that neither the Registrar nor this Court were invited to consider the element ‘POLO’ from the perspective that the word means “*a game of eastern origin with rules similar to hockey, played on horseback with a long-handed mallet*”. For this reason I say no more in that respect.

78. There is a third element to Wardrobe’s mark. It is a pictorial element between the words ‘CLASSIC’ and ‘POLO’. This Court has looked at the entire logo and it observes that the element is not striking and may not be distinctive enough as to catch the attention of an average customer. The element is literally the size as the letter ‘O’ on the word ‘POLO’ in the logo and does not stand out with any sufficiency. This Court is unable to find it distinctive.

79. The conclusion to be drawn is that neither the word ‘CLASSIC’ nor the pictorial element are distinctive while on the other hand the element ‘POLO’ in relation to clothing is distinctive. For that reason this Court comes to the conclusion that in respect to the mark ‘CLASSIC’ (WORDS AND DEVICE), Trade Mark ‘POLO’ (WORD) and ‘POLO PONY’ (DEVICE), the common element ‘POLO’ is distinctive and dominant. While the marks may not have a visual and aural similarity they nevertheless are conceptually similar.

80. In arriving at this conclusion this Court has considered the decision in Royal County of Berkshire Polo Club Ltd vs. Polo/Lauren Comp Ltd referred to by Wardrobe, in which the following holding of Hobbs QC in 10 Royal Berkshire Polo Club Trade Mark [2001] RPC 32 was quoted;-

“... I am satisfied that the use of the word POLO of the applicant’s mark does not capture the distinctiveness of the opponent’s earlier trade marks. I do not think that people exposed to the use of the applicant’s mark would notice that it contained the word POLO without also noticing that it contained the words ROYAL BERKSHIRE and CLUB. The message of the mark comes from the words in combination and that is not something that I would expect people to overlook or ignore in the ordinary way of things”.

81. In that matter the Tribunal was comparing the mark ‘ROYAL COUNTY OF BERKSHIRE POLO CLUB’ and ‘POLO’ and ‘RALPH LAUREN’. The Tribunal found that the words ‘ROYAL COUNTY OF BERKSHIRE’ and ‘CLUB’ are unlikely to be overlooked by an average consumer and so there was dissimilarity between that Trade Mark and the Trade Mark ‘POLO’. Here, however, the word ‘CLASSIC’ which would have provided a dissimilarity in the marks is merely descriptive. It could be understood to be describing the mark ‘POLO’ as being elegant or of quality. It may not be understood as being a different brand. Simply, the word ‘CLASSIC’ does not distinguish the two Marks. For that reason the competing marks nearly resemble.

82. That said, the Court has to consider whether the mark by the Wardrobe can be excused by the exemptions carved out in Section 15(2). For purposes of focusing on this discussion the Court reproduces subsection 2 of section 15;-

“(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the court or the Registrar make it proper so to do, the court or the Registrar may permit the registration of trade marks that are identical or nearly resemble each other in respect of the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as the court or the Registrar may think it right to impose”.

83. Once an Opponent to registration has demonstrated that an impugned mark is similar or nearly resembles his registered mark in respect to the same goods or services then an Applicant who wants to benefit from the provisions of subsection 2 bears the burden of proving that circumstances exist that brings the application within the ambit of the exemptions. In this regard Wardrobe set up the following argument;-

“29. My Lord the Registrar was accurate in making her finding based on marks with similar element, borrowing from the WIPO: Intellectual Property Handbook, she rightly highlights that the Registrar’s decision to include other trademarks which are used by the different proprietors suggest that, the consumers would already be accustomed to the use and the common element by different proprietors and would not likely be deceived”.

84. This is an assertion that the LA Group does not deserve a monopoly over the element ‘POLO’ in respect to the goods.

85. On the strength of the marks by L.A Group the Registrar held that there were 7 other Trade Marks that are composed of the element ‘POLO’ registered in respect to goods in class 25 and all being goods of similar description. The Registrar further cited the provisions of Section 17 of the Act which reads:-

“If a trade mark—

(a) contains any part not separately registered by the proprietor as a trade mark; or

(b) contains matter common to the trade or to the provision of services of that description or otherwise of a non-distinctive character, the Registrar or the court, in deciding whether the trade mark shall be entered or shall remain on the register, may require, as a condition of its being on the register—

(i) that the proprietor shall disclaim any right to the exclusive use of any part of the trade mark, or to the exclusive use of all or any portion of any such matter, to the exclusive use of which the tribunal holds him not to be entitled; or

(ii) that the proprietor shall make such other disclaimer as the tribunal may consider necessary for the purpose of defining his rights under the registration:

Provided that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made”.

In respect of this the Registrar held,

“A disclaimer actually informs the other traders in similar trade that they are free to use the disclaimer elements of the mark”.

86. The Registrar then drew the following conclusion,

“,,,it is clear that the Opponent’s mark is not a strong mark and is therefore incapable of being confused with the Applicant’s trade mark. Having adopted a common element “POLO” to distinguish their goods in class 25 of the NICE classification, the opponents then run risk of failing to uphold a monopoly of the element”.

87. L.A Group takes issue with the Registrar’s reference to the 7 Trade mark contending that the existence of those marks were never an issue for adjudication. In this regard the Court observes that Wardrobe had raised the issue of co-existence of the POLO mark in other jurisdictions and not Kenya. Nevertheless Wardrobe took the view that the Registrar was entitled to determine the Opposition not only on facts and evidence brought before her by the parties but also based on material within her knowledge and information.

88. No doubt the Registrar being an expert in trade mark matters would have knowledge and information of facts and law which she can bring to bear in deciding a matter. However, and this would be particularly true when it comes to questions of fact, the Registrar should not use matters which have not been raised by the parties and which are of decisive nature in deciding the dispute, before giving the parties an opportunity of making observations or reacting to them.

89. Some dangers of not granting such opportunity come to mind. First, the parties may feel that they have not been accorded a fair hearing in respect to the new matter and second they may have information which successfully challenges the view or facts held by the Registrar. And this then leads me to the second grievance by L.A Group.

90. L.A Group have in its submission before this Court sought to demonstrate that the factual assumption of the Registrar was erroneous as it was based on incorrect facts. There lies a real danger of the approach taken by the Registrar! The supposed facts from which she drew one decisive conclusion has been challenged as incorrect and since there is no evidence on record in this respect, this Court is unable to make a finding one way or another.

91. In the circumstances the Court is constrained to find that the Registrar fell into an error of principle in holding that the mark of L.A Group was not strong on the basis of evidence not before her and whose veracity cannot be checked by this Court in these proceedings. This Court reaches a conclusion that Wardrobe did not demonstrate the existence of circumstances that would warrant the Registrar to permit the registration of its Mark under the provisions of section 15(2).

92. Being of the persuasion that the Trade Marks of LA Group are protected by registration and that the registration of the mark of Wardrobe would run afoul of the provisions of section 15 of the Act, this Court allows the Appeal. I do not deem it necessary to consider whether the Trade Marks of L.A Group are well-known Trade Marks.

93. The result is that the decision of the Assistant Registrar of Trade Marks dated 17th March 2017 in which it rejected the opposition of the

Appellant and allowed the registration of Trade Mark NO. 84273 'CLASSIC POLO' (word and device) in the name of the Respondent is hereby set aside. As a consequence the Certificate of Registration issued in respect to the said Mark is hereby cancelled and the mark removed from the Trade Marks register.

94. Costs of this Appeal and in the Opposition proceedings to the Appellant.

Dated, Signed and Delivered in Court at Nairobi this 28th day of June, 2019.

.....

F. TUIYOTT

JUDGE

Present

Wafula for Appellant

Adano h/b Okatch for Respondents

Nixon – Court Assistant