



**REPUBLIC OF KENYA**

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

**(MILIMANI LAW COURTS)**

**MISC CIVIL APPLICATION NO. 911 OF 2005**

**McGRAW-HILL COMPANIES INC. ....PLAINTIFF**

**VERSUS**

**NATION MEDIA GROUP LIMITED .....DEFENDANT**

**JUDGMENT**

This appeal is from the ruling of the Assistant Registrar of Trade Marks dated 13.6.2005. By that ruling she decided that neither the appellant nor the respondent could register the mark "Business Week" in respect of goods under Class 16 of the International Classification provided under Section 20 (1) of the Trade Marks Act, Chapter 506 of the Laws of Kenya

grounds for her decision were that neither the appellant nor the respondent had invented the words "business week" for use and registration as a mark in respect of goods under Class 16 of the International Classification and that the appellant's mark was not a well known mark in Kenya and was not therefore worthy of protection under Section 15A of the said Trade Marks Act.

The appellant has appealed against the said decision on the principal grounds that the Assistant Registrar erred in law and in fact in holding that the appellant did not have a justifiable and valid claim to the words "Business Week" so as to claim proprietary rights to the same; that she failed to appreciate that the appellant's mark "Business Week" was registered in 56 countries and the European Union and was a well-known trade mark within Section 15 A of the Trade Marks Act; that she erred in law and fact in holding that the appellant's mark "Business Week" was not distinctive within the meaning and purport of Section 12 of the Trade Marks Act and that she took into account extraneous matters in arriving at the decision to refuse registration of the appellant's trade mark "Business Week".

The respondent has not contested this appeal. That notwithstanding, a court sitting on appeal will not lightly differ with a decision made at the first instance. I will therefore examine whether conclusions reached by the learned Assistant Registrar were founded on material placed before her and whether or not she misapprehended the evidence or the applicable principles. In holding that the words "Business Week" are not available for registration, the learned Assistant Registrar observed that the words are commonly in use in the media and it would therefore be unfair to give any of the parties monopoly over commonly used words and in effect shut out all the other players in the print and the electronic media. With all due respect to the learned Assistant Registrar, the only players before her were the appellant and the respondent and not unnamed players and the entire electronic media. If the latter felt offended by the respondent's application for the said mark they would have no doubt filed objection or opposition to the application when the Registrar published the said application in the Kenya Gazette of 6.7.2001. It is clear that to both the appellant and the respondent, the words, "Business Week" were registrable. Indeed, none of them made any submissions on the registrability of the words "Business Week". It does not also escape my attention that when the respondent applied for the registration of the same words the Registrar was of the view that the same were available for registration subject to an appropriate disclaimer and it was only on the conclusion of the opposition proceedings that the Assistant Registrar on her own decided that the words "Business Week" were not registrable. That finding flew in the face of the material that was placed before the Assistant Registrar and which material she accepted as true. She accepted that the

appellant's magazine is distributed all over the world and in fact has been registered in 56 countries and the European Union which now covers 25 countries giving it a total coverage of 81 countries. She also found as true the fact that the mark "Business Week" was registered under Part B of the Register in the U.K. in 1979, under the U.K. Trade Marks Act which was then identical to the Trade Marks Act, Cap 506 of the Laws of Kenya. She also found that in Australia the said mark was also registered under Part B of the Register in 1957. She appreciated that Australia is a Commonwealth country whose Trade Marks Act in 1987 was similar to that of the U.K. and hence similar to that of Kenya. Although she held that decisions of the above registries were of persuasive value they were not binding. She however did not state why she was not persuaded that the said mark was registrable. She did not state the circumstances that led her to determine that the mark was not registrable.

In the premises, I find and hold that the Assistant Registrar erred in fact and in law in deciding that the words "Business Week" are not registrable as a mark for goods under Class 16 of the International Classification.

With regard to the Assistant Registrar's finding that the appellants' mark "Business Week" was not a well known mark in Kenya and did not therefore qualify for protection in Kenya under Section 15A of the Trade Marks Act, I have found as follows. The Assistant Registrar, found as I have already stated that the said trade mark was well known and had a worldwide coverage. However in her view, the subscription of 348 of the appellant's magazine in Kenya did not "amount to the degree of knowledge or recognition of the mark in the relevant sector of the public that would qualify the mark to be a well-known mark" in Kenya. The foundation of her finding was that that subscription was poor compared to the population of Kenya now standing at around 30 million. With all due respect to the learned Assistant Registrar, she did not appreciate that the appellant's publication is a periodical publication and the comparison between the subscription level and the population of Kenya was inappropriate taking into account the literacy level in the country and those that are too young or too old to read. The learned Assistant Registrar did not determine what amount of subscription would be sufficient for purposes of registration. There was however no dispute as between the appellant and the respondent that the mark "Business Week" was well-known as belonging to the appellant. Indeed, the learned Assistant Registrar was in no doubt that the appellant was using the said mark in other countries without ascertaining the level of subscription in those countries. Yet the same mark had been accepted in those countries for registration. In the premises, I find and hold that the Assistant Registrar of Trade Marks erred in law and in fact in failing to find that the appellant's mark "Business Week" was a well known trade mark within Section 15 A of the Trade Marks Act (Chapter 506 Laws of Kenya) and was also distinctive within the meaning and purport of Section 12 of the same Act. My above findings show that the decision of the learned Assistant Registrar must and is hereby set aside as sought by the appellant. The Assistant Registrar's decision that the appellant cannot register its trade mark "Business Week" in respect of goods under Class 16 of the International Classification provided under Section 20 (1) of the Trade Marks Act is hereby set aside and is substituted with an order that the appellants said mark "Business Week" be registered as sought by the appellant. The registration is however on condition that the appellant disclaims the right to exclusive use of the words "Business" and "Week". As the respondent lost interest in the appeal I order that each party bears its own costs of the appeal and of the opposition proceedings before the Assistant Registrar of Trade Marks.

Orders accordingly.

**DATED and DELIVERED** at Nairobi this **19<sup>TH</sup>** day of **April 2007**.

**F. AZANGALALA**

**JUDGE**

Read in the presence of:-