



REPUBLIC OF KENYA

IN THE HIGH COURT OF KENYA

AT NAIROBI

CIVIL APPEAL NO. 583 OF 2012

RALSON (INDIA) LIMITED.....APPELLANT

V E R S U S

DOSHI IRONMONGERS LIMITED.....RESPONDENT

(Being an appeal against the ruling of the Registrar of Trade Marks in the matter of

Trade Mark Application No. TMA 55577 in the name of Doshi Iron Mongers

Limited and the opposition by Ralson (India) Limited delivered on 6th July 2009)

JUDGEMENT

1) On 22nd June 2004, **Ralson (India) Ltd**, the appellant herein, filed an application before the Registrar of Trademarks seeking for the registration of “RALSON” as a trademark in Kenya under Trademark Application no. 56150, in class 12. Upon receipt of the application, the Registrar of Trademarks noted that there was a prior Trademark application no. 55577 ‘RALSON’ filed by the **Doshi Iron Mongers Ltd**, the respondent herein, dated 2.2.2004.

2) The appellant filed opposition proceedings before the Registrar of Trademarks to challenge the Trademark on the basis that the trademark belonged to the appellant who has been using it in Kenya since 1987.

3) The Registrar of Trademarks delivered his ruling on 6th July 2009 in which he dismissed the appellant’s opposition and directed that the respondent’s Trademark application no. 55577 proceeds to registration.

4) The appellant was dissatisfied with registrar’s ruling hence it preferred this appeal and put forward the following grounds:

i. The Registrar of Trademark did not consider the evidence of the appellant provided in their Statutory Declarations dated 27th September 2007 and 20th November, 2007 nor did he deal with it.

ii. The Registrar of Trade Marks misdirected himself in law in interpreting the provisions of Section 15A (1) and (2) of the Trade Mark Act Chapter 506 of the Laws of Kenya and the Paris Convention as well as failed to consider the evidence in respect to promotion of the mark and corresponding goods and subsequently finding that Ralson was not a well-known mark.

iii. The Registrar of Trade Marks erred in finding that there was no effect of extra-territorial registration of the Ralson Mark in favour of the appellant.

iv. The Registrar of Trade Marks erred by overlooking the invoices of the appellant in their entirety disregarding their evidential value in allowing the respondent’s submissions on the alleged authenticity of the appellant’s invoices when this issue had not been previously pleaded or raised.

v. The Registrar of Trade Marks erred in finding that all the invoices produced by the appellant had no evidential value.

vi. Without prejudice to paragraph 5 above, the Registrar of Trade Marks erred in disregarding the invoices whose authenticity was not questioned by the respondent.

vii. *The Registrar of Trade Mark erred in finding that the summary of the annual sales figures provided by the appellant in their Statutory Declaration dated 30th April, 2007 in respect to the products sold in Kenya and around the world were of no evidential value.*

viii. *The Registrar of Trade Marks erred in concluding that the only evidence before him was that of the advertisements of the Ralson Mark in Kenya by the Appellant finding that the advertisements produced by the appellant did not link it to the Ralson mark.*

ix. *The Registrar of Trade Marks erred in finding that there was no link between East African Produce Company and the appellant despite the evidence of the invoices before him.*

x. *The Registrar of Trade Marks erred in finding that the appellant did not have prior use of the Ralson Mark in Kenya.*

xi. *The Registrar of Trade Marks erred in not finding and should have found that the mark had become exclusively associated with the appellant's goods.*

xii. *The Registrar of Trade Marks misdirected himself in law as to the criteria for establishing whether the appellant's mark was well-known.*

xiii. *The Registrar of Trade Marks erred in not finding and should have found, that the respondent's mark applied to the same goods and/or goods of a similar description to those of the appellant.*

xiv. *The Registrar of Trade Marks erred in not finding and should have found, that the respondent's mark was identical to or nearly resembled the appellant's mark and was likely to deceive and/or cause confusion between the appellant's and the respondent's goods which fall in the same class.*

xv. *The Registrar of Trade Marks erred in not finding and should have found, that the respondent had adopted a mark confusingly similar to that of the appellant and applied for its registration.*

xvi. *The Registrar of Trade Marks erred in fact and in law in arriving at the decision that the respondent's mark should proceed to registration.*

xvii. *The Registrar of Trade Marks erred in law in finding that the respondent was entitled to costs in the circumstances.*

5) When the appeal came up for hearing, learned counsels appearing in the matter recorded a consent order to have the appeal determined by written submissions. I have re-evaluated the arguments which were made before the Registrar of Trademarks and I have further considered the rival written submissions. Though the appellant put forward several grounds of appeal, the parties to this appeal agree that the following two main issues commend themselves for determination.

First, whether the mark "Ralson" is a well know Mark associated with the appellant.

Second, whether the respondent's mark is identical to or nearly resembles the appellant's "RALSON" mark.

6) On the first issue, it is the submission of the appellant that the trademark 'RALSON' has been registered by the appellant in numerous worldwide registrations and applications and that it has been extensively used, advertised and promoted in Kenya as well as many other countries hence it is entitled to protection under Section 15A of Trademarks Act.

7) It is further the submission of the appellant that the appellant is a company incorporated under the laws of Indian which has been a member of World Trade Organization (WTO) since 1st January 1995 and a signatory of the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPs Agreement).

8) The appellant also argued that the Paris Convention became binding on India as of 7.12.1998. It was also pointed out that Kenya is a party to both the Paris Convention and to the TRIPs Agreement they therefore form part of the Laws of Kenya.

9) Under the above circumstances, the appellant is of the submission that 'RALSON' qualifies as a well known mark protected in Kenya under Section 15A of the Trademarks Act even before its registration in Kenya.

10) The appellant argued that the Registrar of Trademarks erred in overstating the relevance of the degree of knowledge or recognition of the mark in the relevant sector. It is submitted that the Registrar ought to have looked at all the factors having regard to the circumstances of the particular case.

11) The appellant further argued that there was no effect of extra-territorial registration of the 'RALSON' mark in favour of the appellant. It is also the submission of the appellant that the Registrar erred in failing to consider the duration, extent and geographical area of promotion of 'RALSON' mark.

12) The respondent on the other hand is of the submission that at the time of applying for registration, RALSON mark was unregistered to any other proprietor in Kenya meaning that the said word mark was free to be registered by any proprietor in Kenya and that is why the respondent applied for registration. The respondent argued that the mark 'RALSON' was not a well known mark and the appellant made an

application for registration upon discovering that the respondent was in the process of registering the same mark. The respondent further argued that despite the claim by the appellant that 'RALSON' has been registered in numerous countries it is not relevant to the registrability of the same mark in Kenya.

13) Having considered the rival arguments, it is now clear in my mind that the appellant did not tender evidence to show how the mark 'RALSON' was used in Kenya and to what extent but the appellant merely tendered evidence of copies of trademark certificates of registration in various countries around the world. In my humble view, that in itself does not show that the mark 'RALSON' as well known in Kenya.

14) I have carefully perused the invoices produced by the appellant showing shipment and sale of RALSON branded goods into Kenya and the advertisements and promotional material depicting the RALSON'S mark in Kenya newspaper. With respect, I am persuaded by the decision of the Registrar of Trademarks to dismiss such piece of evidence.

15) I am convinced that the authenticity of those documents could not be ascertained. Some of those invoices bore RALSON mark while others did not. In the circumstances this court is entitled to infer that the documents may have been manufactured to be used in this dispute in favour of the appellant's case.

16) On the second issue as to whether the respondent's mark is identical to or nearly resembles the appellant's mark and ought not to be registered. It is the submission of the appellant that since the appellant and the respondent have used the identical mark 'RALSON', that in itself has caused confusion and deception.

17) The appellant argued that the Registrar erred when he failed to consider the evidence of the appellant that it established prior use of the 'RALSON' mark and had become exclusively associated with the appellant's goods.

18) The respondent was of the submission that both parties had differing ideas on the use of the mark 'RALSON'.

19) After a careful consideration of the parties' submissions, it is apparent that the respondent's application no.55577 was for purposes of goods in classes 8, 9 and 12 for hand tools, scientific instruments and vehicle apparatus for locomotion by land whereas that of the appellant no. 56150 was to register the trademark of goods in class 12 which relates to motor vehicles, apparatus for locomotion by land, air or water.

20) With respect, I am convinced by the respondent's submission that the 'Ralson' mark is not identical to or resembles the appellant's mark.

21) In the end, I find no merit in this appeal. The same is dismissed with costs to the respondent.

Dated, Signed and Delivered in open court this 16th day of November, 2018.

J. K. SERGON

JUDGE

In the presence of:

..... for the Appellant

..... for the Respondents