

**REPUBLIC OF KENYA**  
**IN THE HIGH COURT OF KENYA AT NAIROBI**  
**COOMMERCIAL AND TAX DIVISION**  
**CIVIL APPEAL NO. E584 OF 2022**

**HUGO BOSS TRADEMARK.....**  
**.....APPELLANT**

**VERSUS**

**FREDERICK OMONDI OWINO.....**  
**.....RESPONDENT**

*(Being an appeal from the Ruling dated 9<sup>th</sup> March 2022 by the Assistant Registrar of Trademarks in the matter of Trademark Application No. 96083 BUDABOSS (word and logo) in classes 16, 25 and 41 in the name of Frederick Omondi Owino)*

**JUDGMENT**

1. Before this Court for determination is the appeal stemming from the decision of the Registrar of Trademarks made on 9<sup>th</sup> March 2022, where the Registrar dismissed the Appellant's opposition to the Respondent's Trademark Application No. 96083 "BUDABOSS & Device".
2. The Notice of Motion dated 30<sup>th</sup> June 2022, is brought by the Appellant under Section 21 of the Trade Marks Act (Cap 506) and Rule 117 of the Trade Marks Rules. The Appellant seeks orders to set aside the decision of the Registrar of Trade Marks delivered on 9<sup>th</sup> March 2022 in respect of Trade Mark Application No. 96083 "BUDABOSS & Device", filed by the Respondent. The Appellant further seeks an order disallowing the said application, or in the alternative, for

rectification of the Register to delete the specification of goods in Class 25, should the registration have been completed by the time of determination.

3. The application is supported by the affidavit of Paul Anthony Daly, the authorized representative of the Appellant. It is averred that the Appellant is the registered proprietor of Trade Mark No. KE/T/1989/036913 "BOSS" in Class 25, registered on 16<sup>th</sup> February 1989. The Appellant asserts that the Respondent's subsequent application to register "BUDA BOSS & Device" in Classes 16, 25, and 41 is confusingly similar, particularly in Class 25, which relates to clothing.
4. The Respondent did not file a replying affidavit to the Appellant's motion but instead filed a Notice of Motion dated 18<sup>th</sup> January 2023 seeking to strike out the appeal on the grounds that the appeal had been overtaken by events, as a certificate of registration had already been issued pursuant to the Registrar's decision, and no stay of execution had been obtained. It was contended that the Court therefore lacks jurisdiction to entertain the appeal.
5. The Appellant opposed the said application through Grounds of Opposition dated 6<sup>th</sup> March 2023, asserting that the substratum of the appeal is not the issuance of a certificate of registration but the legality and propriety of the Registrar's decision dated 9<sup>th</sup> March 2022. It was argued that if the Registrar's decision is quashed, all consequential actions, including registration, would automatically be nullified.

6. The parties canvassed both applications by way of written submissions.
7. The Appellant maintains that the Trade Mark registration is similar and will likely cause confusion to the members of the public and that the Registrar in her ruling failed to prove any special circumstances which would have allowed the registration of the Respondent's trademark, despite finding that the two marks BUDA BOSS and BOSS contained a common and dominant element 'BOSS' and agreed that the goods in which the two marks were applied were similar and of the same nature and description.
8. On the other hand, the Respondent argues that the Registrar properly compared the marks as a whole, following the test in **The Pianotist Co. Ltd [1906] RPC 774** and **SA LTJ Diffusion v Sadas Vertbaudet C-291/00**, which require consideration of sight, sound, and surrounding circumstances. The Respondent's *BUDABOSS* mark has the prefix "BUDA" and includes figurative elements, unlike the Appellant's plain word mark *BOSS*. Under cases like **Faber Chimica Srl v OHIM (T-211/03)** and **Vedial v OHIM (T-110/01)**, word marks and composite (figurative) marks must be distinguished visually and conceptually. The Registrar correctly found that the prefix "BUDA" and the design elements make *BUDABOSS* visually and phonetically distinct from *BOSS*. It was submitted that consumers perceive marks as a whole, not dissected parts, and thus would not confuse *BUDABOSS* with *BOSS*. That the Appellant provided no evidence of actual confusion.

9. The Respondent submits that the Appellant failed to prove that *BOSS* is well-known in Kenya. Evidence produced related mostly to foreign promotions and not local marketing or recognition. Internet postings are insufficient to prove reputation within Kenya without proof of Kenyan viewership or sales. No invoices or advertising expenditure were tied to the Kenyan market (**Sony Corporation v Sony Holding Ltd [2018] KEHC 6604**). That the cited *Business Daily* article is hearsay and fails to show the goods in question.
10. Other existing *BOSS* marks in Kenya show that the term is not exclusively distinctive to the Appellant. The Respondent contends that the Assistant Registrar correctly found the marks dissimilar and that *BOSS* is not well-known in Kenya. Accordingly, the appeal should be dismissed with costs.

### **Analysis and determination**

11. Having carefully considered the pleadings and rival submissions, the following issues arise for determination:
- i. Whether this Court has jurisdiction to entertain the appeal notwithstanding the issuance of a certificate of registration; and*
  - ii. Whether the Registrar erred in law and fact in allowing registration of Trade Mark No. 96083 "BUDA BOSS & Device" in Class 25 despite the existence of the Appellant's prior mark "BOSS".*

12. Rule 117 of the Trade Mark Rules provides that: *When a person intends to appeal to the court, the appeal shall be made by motion in the usual way, and no such appeal shall be entertained unless Notice of Motion is given within sixty days from the date of the decision appealed against or within such further time as the Registrar shall allow.*
13. The Respondent contends that the appeal is overtaken by events since the certificate of registration has already been issued. However, under **Section 21(6) to 21(10)** of the **Trade Marks Act**, it is provided that:

***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 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 by 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.***

14. Section 52 in turn provides for the latitude that this Court enjoys in an appeal from the Registrar, providing that the Court shall have and exercise the same discretionary powers as are conferred upon the Registrar. I, however remain cognizant of the fact that the Registrar is a specialized quasi-judicial Tribunal, and therefore the need for the Court to grant some deference to the Registrar's decision unless there is a compelling cause to depart.

15. Section 35(1) of the same Act empowers the Court to make orders for rectification of the register where an entry has been made without sufficient cause or wrongly remains therein.

16. The fact that a certificate of registration has been issued does not oust the jurisdiction of this Court to review

the decision of the Registrar or to rectify the register if necessary. This position was affirmed in **Sony Corporation v Sony Holding Limited ML HCCA No. 376 of 2015 [2018] eKLR**, where the Court held that:

***“It has to be remembered that the Registrar of Trademarks is a specialized quasi-Judicial Tribunal and so the Courts discretionary jurisdiction must be circumscribed so that some deference is given to the decision of the Tribunal. One object of setting up specialized Tribunals is that they will be constituted by persons who have technical competence in their areas and a good appreciation of matters that come before them. Ordinarily therefore, short of a compelling cause, their appreciation of a dispute ought to be respected.”***

17. Accordingly, I find that this Court is properly seized of jurisdiction to entertain the appeal.
18. ***On whether the Registrar erred in allowing registration of “BUDA BOSS & Device”***, the Appellant’s case is that the Respondent’s mark “BUDABOSS & Device” is confusingly similar to its mark “BOSS.” It is argued that the Registrar failed to give due weight to the common and dominant element “BOSS,” despite acknowledging that both marks cover identical goods under Class 25 (clothing). The Appellant maintains that the continued use or registration of the Respondent’s mark would cause confusion among consumers as to the source or affiliation of the goods.

19. The test for similarity of marks is well settled. In **The Pianotist Co. Ltd's Application [1906] 23 RPC 774**, Parker J. stated:

***"You must take the two words and judge of them both by their look and by their sound; consider the goods to which they are to be applied, the nature and kind of customer who would be likely to buy those goods, and all the surrounding circumstances."***

20. This test remains instructive in assessing the likelihood of confusion under Kenyan trademark jurisprudence

21. **Section 14(1)** of the **Trade Marks Act** provides that:

***"A trade mark shall not be registered if it is identical with or nearly resembles a trade mark belonging to a different proprietor already on the register in respect of the same goods or description of goods, if the use of the mark would be likely to deceive or cause confusion."***

22. The principle of "likelihood of confusion" has been judicially interpreted in **Parker-Knoll Ltd v Knoll International Ltd [1962] RPC 265**, and applied by Kenyan courts in **Societe Des Produits Nestlé S.A. v Cadbury Kenya Ltd [2009] eKLR**. The test is whether a reasonable consumer with imperfect recollection would likely be deceived or confused as to the source of the goods.

23. In the impugned decision, the Registrar found that both marks contained the common and dominant element "BOSS," that they were registered in the same class of

goods, and that the Appellant's mark was prior in time. Despite these findings, the Registrar held that the prefix "BUDA" sufficiently distinguished the Respondent's mark from that of the Appellant, and therefore permitted registration.

24. The WIPO Intellectual Property Handbook Policy Law and Use on page 87 clause 2.471 state 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."***

25. The Act recognizes and acknowledges registration of marks that could nearly resemble each other. **Section 15(2)** of the Act provides as follows:

***"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.”***

26. The Registrar relied on this provision in finding that consumers of the relevant goods are discerning and deliberate, and thus unlikely to be confused or deceived.
27. With respect, I find that the Registrar misdirected herself in that conclusion. The mere addition of a prefix or descriptive word does not necessarily remove the likelihood of confusion where the dominant feature of both marks remains identical or nearly identical. As held in **American Eagle Outfitters Inc. v East Africa Eagle Fashions Ltd [2018] eKLR**, the inclusion of additional words or devices does not negate confusion if the essential features of the marks are substantially the same.
28. Upon reviewing the impugned ruling, it is apparent that the Registrar acknowledged the shared element “BOSS” but considered the prefix “BUDA” and the device features as adequate differentiators. In my view, the Registrar did not sufficiently evaluate whether “BOSS” constitutes the dominant and distinctive element likely to remain in the mind of the average consumer.
29. It is a settled principle that the dominant element of a composite mark often dictates consumer perception, particularly where the remaining features are descriptive or decorative.

30. The term “BOSS” is short, strong, and inherently distinctive. It forms the core identity of the Appellant’s mark. The addition of “BUDA” functions as a descriptive modifier and does not substantially alter the commercial impression conveyed by “BOSS.” In the fashion industry, where brand recognition and impulse purchasing are prevalent the likelihood of confusion is real and significant.
31. On the Registrar’s finding that the mark “BOSS” is not well-known in Kenya, I note that while the Appellant’s evidence of reputation was not extensive, the Registrar erred in limiting her inquiry to local advertising. Section 15A(1) of the Trade Marks Act recognizes that a mark may be “well-known” if it is known to a relevant sector of the public in Kenya, whether through use or promotion elsewhere, consistent with Article 6b of the *Paris Convention*. Kenyan courts have recognized extraterritorial reputation where a mark enjoys global recognition
32. Accordingly, I find that the Appellant has demonstrated a likelihood of confusion within the meaning of Section 14(1) of the Act. The Registrar’s reliance on the prefix “BUDA” as a distinguishing feature was erroneous in law and in principle. The dominant impression conveyed by both marks remains “BOSS,” which is likely to deceive or confuse ordinary consumers as to the origin or affiliation of the goods.
33. I find that the Assistant Registrar erred in concluding that the prefix “BUDA” sufficiently distinguished the

Respondent's mark from the Appellant's mark "BOSS." The Registrar failed to properly apply the test for likelihood of confusion under Section 14(1) of the Trade Marks Act and misdirected herself in her appreciation of the dominant element within the marks.

34. Consequently, I am persuaded that the decision of the Registrar of Trade Marks delivered on 9<sup>th</sup> March 2022 in respect of Trade Mark Application No. 96083 "BUDABOSS & Device" was erroneous both in fact and in law.

35. Accordingly, I make the following orders:

- i. The appeal is allowed.***
- ii. The decision of the Assistant Registrar of Trade Marks dated 9th March 2022 allowing the registration of Trade Mark Application No. 96083 "BUDABOSS & Device" is hereby set aside.***
- iii. The Respondent's application for registration of the mark "BUDABOSS & Device" in Class 25 is refused under Section 14(1) of the Trade Marks Act (Cap 506) on the ground that it is confusingly similar to the Appellant's registered mark "BOSS."***
- iv. The costs of this appeal shall be borne by the Respondent.***

**JUDGMENT** delivered virtually, dated and signed at **NAIROBI**

This **30<sup>th</sup>** day of **October** 2025.

**P.M. MULWA**

**JUDGE**

**In the presence of:**

*Mr. Kimani. Kamau* for Appellant

*Ms. Omondi* for Respondent

Court Assistant: *Carlos*