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

AND

IN THE MATTER OF TRADE MARK APPLICATION NO. 87613, "HAI BROADBAND" (WORD) IN THE NAME OF LIQUID TELECOMMUNICATIONS LIMITED

EX-PARTE RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

PROCEDURAL BACKGROUND

On 29th May 2015, Liquid Telecommunications Limited, (hereinafter referred to as "the Applicant") filed an application to register the mark "HAI BROADBAND", T.M.A No. 87613. The application was filed in respect to Services in class 38 of the International Classification of Goods and Services.

The application was duly examined in accordance with the provisions of the Trade Marks Act, Cap 506 of the Laws of Kenya. By a report dated 5th November 2015, the Trade Marks Examiner issued a refusal notice against registration of the said mark on the ground that it is similar to another mark existing on the Register of Trade Marks with the following particulars:

T.M. No. 951518- "HAI SOCIETY" (Words) in Classes 3, 5, 9, 12,14,16,18,24,25,28,30,32,33,34,35,38,41 and 43 in the name of Distribution & Marketing GmbH of Petersbrunnstrasse, 17 A-5020 Salzburg, Austria.

Through a letter dated 5th April 2016, the Applicant filed written submissions against the Examiner's refusal notice stating inter alia as follows:

1. That it appears that the provisional refusal is based on Section 15(1) of the Trade Marks Act Chapter 506 of the Laws of Kenya that 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".

2. That it will be noted from Section 15(1) of the Act that a key criterion for refusal of a mark (in relation to an earlier registered mark) under the Section is:
    a) The marks must be identical or nearly resembling; and
    b) The goods/description of goods or services/description of services must be identical.
3. That the Applicant respectfully disagrees with the report and makes the submissions in order to overcome the provisional refusal, in order that the Applicant's mark can be advertised in the Industrial Property Journal and proceed to registration.

Dissimilarity of the Marks

a) That the marks are visually, phonetically and conceptually quite distinguishable. The marks have the word HAI in common but when considering the marks as a whole, HAI SOCIETY immediately evokes the (well known) phrase "HIGH" SOCIETY which has a difference meaning to HAI BROADBAND. The phrase (or mark) as a whole becomes memorable as opposed to HAI on its own.

b) That HAI (HIGH) SOCIETY is also somewhat laudatory, referring to a certain high standard of living, or particular wealth, whereas HAI BROADBAND does not invoke any such image at all. It is likely that a phonetic version of HIGH was used in an attempt to add distinctiveness to an otherwise common English phrase.
c) That HAI is not an acronym that is well known in the relevant industry, but rather a Swahili word meaning "I am alive".

Dissimilarity of Core Business Interest

a) HAI SOCIETY has been registered in respect of a vast number of classes: 03, 05,09,12, 14, 16, 18, 24, 25, 28, 30, 32, 33, 34, 35, 38, 41 and 43. Of these, only class 38 overlaps with the Applicant's application. Based on the information on the internet obtained from the following address: http://www.shdm.de/company/ the core business of the proprietor of the mark is "the trading of rights to documentaries, television, films and series, in addition to children's and music productions".
b) That the Applicant on the other hand, makes use of its HAI BROADBAND marks in Kenya in relation to services providing high speed internet access.
c) That the Applicant has been making use of its trademarks in Kenya and more information can be obtained at the following address: http://www.hai.co.ke

That in light of the above mentioned reasons, the Applicant submitted that the provisional refusal be rescinded and the Applicant's mark be allowed to proceed to advertisement and subsequent registration without any conditions.

RULING

I have studied the documents on record and considered the Applicant's submissions against the Examiner's refusal notice. I am of the view that the issue for determination is whether or not the Applicant's mark T.M.A No. 87613 "HAI BROADBAND" (word) is similar to the cited mark T.M. No. 951518 "HAI SOCIETY" (word).

Section 15(1) of the Trade Mark Act 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 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.'

To make a determination on the above issue, I shall consider the following factors;

1. Similarity of the marks in appearance; and
2. Similarity of the goods.

1. Similarity of the marks in appearance

In determining the issue of similarity of the marks in question, it is critical to consider that the marks should be compared in their entirety. The overall or net impression of the two marks should be highly regarded.

In ***Clarke v Sharp***[1] it was stated as follows:

"One must bear in mind the points of resemblance and the points of dissimilarity, attaching fair weight and importance to all, but remembering that the ultimate solution is to be arrived at, not by adding up and comparing the results of such matters, but by judging the general effect of the respective wholes".

The Applicant's mark is "HAI BROADBAND". The cited mark on the other hand is "HAI SOCIETY" (word). Looking at the two marks, there is an identical word "HAI" which is present in both marks. The Applicant's mark has the word "BROADBAND" while the cited mark has the word "SOCIETY". I am of the view that there are both points of similarity and differences between the marks in question.

As far as pronunciation is concerned, there is a similarity in pronunciation only as far as the word "HAI" is concerned. As for the other words, "BROADBAND" and "SOCIETY", the pronunciation is different.

2. Similarity of the Goods

In Jellinek's Application[2], Romer J proposed a three-fold test when assessing whether goods and services are similar to other goods and services, namely the nature and composition of the goods, the respective uses of the goods, and the trade channels through which the goods are bought and sold. It was indicated that no one

[1] (1898)15 RPC 141 at 146
[2] (1946) 63 RPC 59 at 70
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factor was considered conclusive and it was not considered necessary for all three factors to apply.

In the **Intellectual Property Law** book by Lionel Bentley and Brad Sherman (2nd Edition) at page 859 the authors state as follows:

'The question of whether goods or services are similar depends on the facts of the case. When deciding whether or not a trade mark application falls foul of the relative grounds for refusal, the comparison is normally between the goods or services to which the application relates…. This requires the Court to interpret the specification and then to characterize the goods or services and see if they fall within the specification.'

The **WIPO Intellectual Property Handbook: Policy Law and Use** at page 85 indicates the following:

"Trade marks are registered for goods in certain classes which have been established for purely administrative purposes. The classification of goods cannot therefore be decisive for the question of similarity. Sometimes, totally different goods are listed in the same class (for instance computers, eye glasses, fire extinguishers and telephones in class 9), while similar goods can clearly be listed in different classes (adhesives may fall into classes 1, 3, 5 and 16).

The cited mark is in respect to classes 3, 5, 9, 12,14,16,18, 24, 25, 28, 30, 32, 33, 34, 35, 38, 41 and 43 of the International Classification of Goods and Services. The Applicant on the other hand seeks to register its mark in respect to services in class 38 of the International Classification of Goods and Services. It is clear that class 38 is a common class in both the Applicant's mark and the cited mark.

The Applicant's specification of services is as follows:

Class 38: Telecommunications services; broadcasting services; electronic and communication transmission services; internet television, content and internet protocol television services; video on demand services; transmission of data documents, messages, images, sounds, voices, text, audio, video and electronic communications and data and information by digital, intern et protocol, electronic, computer, cable, radio, radiopaging, teleprinter, teleletter, electronic mail, facsimile machine, television, microwave, laser beam, communications satellite, microwave link, terrestrial

means, digital, cable, wireless, cellular or wirelink system communications means and wireless means; provision of text, data, pictures, images, video and messaging by means of telecommunications and communications devices including mobile telephones, the internet, computers, PDAs, TVs and radios; transmission, electronic mail services; carrier pre-selection services; telecommunication, communications and digital services relating to the Internet; telecommunication of information (including web pages), computer programs and data; providing Internet, digital and application services; providing user access to the Internet (service providers); providing telecommunications connections to the Internet or databases; telecommunication access services; communication services for the exchange of data in electronic form; computer data transmission services; data bank interconnection services; data screening; services for the electronic transmission of data; providing access to computer data bases; magnetic and digital storage of data equipment and services; provision of communication facilities for the interchange of data by electronic means; provision of communication facilities for the interchange and storage of digital data; provision of electronic data links; consultancy, provision of information and advice relating to all of the aforementioned services; services ancillary and related to the a foregoing.

On the other hand, the cited mark's specification of services in class 38 is as follows:

Telecommunications; transmission of radio and television programs; electronic bulletin board services; providing telecommunications connections to a global computer network, telecommunications routing and junction services, teleconferencing services, providing user access to a global computer network.

Looking at the Applicant's mark and the cited mark's specification of services, I am of the view that the Applicant's specification of services is similar to the cited mark's specification of services as far as class 38 is concerned.

However, having looked at the marks in question, the consumers of the Applicant's and cited mark's goods and services and considered all relevant factors, I am of the view that the Applicant's mark should be allowed to proceed to publication.

Based on the Applicant's submissions, the records at the Registry of Trade Marks and consideration of all the circumstances of this case, I hereby rule as follows:

1. The Trade Marks Examiner's refusal notice dated 5th November 2015 is hereby revoked.

2. The Applicant's application for registration of the mark "HAI BROADBAND" (word) T.M.A No. 87613 shall be allowed to proceed to publication in the

Industrial Property Journal.

The Applicant should however note that this decision and the subsequent decisions are not a bar to any opposition proceedings that may be filed under the provisions of the Trade Marks Act once the mark is duly published in the Industrial Property Journal. Should an opposition be filed, the same will be considered on its merits by the Registrar of Trade Marks in accordance with the provisions of the Trade Marks Act.

Ruling delivered at Nairobi this 6th day of January 2025

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CONCILIA WERE

ASSISTANT REGISTRAR OF TRADE MARKS