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

AND

**IN THE MATTER OF T.M.A NO. 94903 “DBI SALA” (WORD) IN THE NAME OF 3M
COMPANY**

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

BACKGROUND

On 21st November 2016, 3M Company a corporation of the State of Delaware (hereinafter referred to as “the Applicant”) filed an application to register the mark T.M.A No. 94903 “DBI SALA” (word). The application was filed in respect to goods in class 9 of the International Classification of Goods and Services. The goods were as follows:

Class	Goods
9	Safety apparatus for the prevention of accident or injury; safety clothing, headgear, eyewear or footwear; industrial safety instruments for the protection of workmen against accident or injury; industrial safety apparatus; fall arrest, fall protection, and rescue equipment; safety lifelines; self-retracting lifelines; horizontal lifeline systems; vertical lifeline systems; ladder safety systems; nets for protection against accidents; safety harness; lanyards, workseats, body belts being for industrial safety; shock absorbers and energy absorbers being parts of the industrial safety systems.

The application was duly examined by the Registrar of Trade Marks in accordance with the provisions of the Trade Marks Act, Cap 506 of the Laws of Kenya. By an examination

report dated 15th April 2017, the Trade Marks Examiner requested the Applicant to disclaim the right to the exclusive use of the word “SALA” and the letters “D”, “B” and “I” each separately and apart from the mark as a whole.

Through a letter dated 14th July 2017, the Applicant filed written submissions against the Examiner’s disclaimer request.

The Applicant submitted inter alia as follows:

1. That the mark DBI SALA should be viewed as a whole. The words DBI SALA are inherently distinctive and do not in any way describe the goods found in class 9 and particularly the goods as described in the trade mark application form.
2. That the criteria provided for under Section 17(b) is not satisfied because the Applicant’s mark is not descriptive of the goods or services in class 9. The request for a disclaimer is therefore unnecessary.
3. That the Applicant’s mark should be looked at as a whole in relation to the actual use of the mark in the market and how the mark is actually perceived by consumers of the products denoted by the mark.
4. That the requirement for a disclaimer therefore amounts to artificial dissection of the Applicant’s mark.
5. That the word “SALA” is very distinctive and any use of the word whether separately or together with words will lead to the class of persons who use the Applicant’s products to associating such products that the word is used on to be associated with the Applicant.
6. Members of the public can use the letters “D”, “B” and “I” separately or together with the words to mark the same type of products to which the Applicant’s mark is used. The Applicant suffers real prejudice if the dominant parts of the Applicant’s mark are disclaimed given that the public can use the disclaimed letters and words with this not amounting to infringement.

7. That without prejudice to the above submissions, the Applicant could agree to disclaim the individual letters “D”, “B” and “I” each separately and apart from the mark as a whole. That the Applicant is not willing to disclaim the element “SALA” in that there is no basis for the Applicant to disclaim this element.

The Applicant requested that the Applicant’s mark be allowed to proceed to advertisement and subsequent registration without a disclaimer condition on the word “SALA” and the letters “D”, “B” and “I”.

That in the alternative, the Applicant would be willing to accept a disclaimer of the individual letters “D”, “B” and “I” separately and apart from the mark as a whole but not the element “SALA”.

RULING

I have considered the documents on record and the Applicant’s written submissions against the Examiner’s disclaimer request. I am of the view that the issue for determination is whether the Applicant’s mark should proceed to advertisement with or without disclaimer of the word “SALA” and the letters “D”, “B” and “I” each separately and apart from the mark as a whole.

The Registrar of Trade Marks is empowered under Section 17 of the Trade Marks Act to require a proprietor of a trade mark to make such disclaimer as the Registrar may consider necessary for the purposes of defusing the rights of such a proprietor under registration.

The Section provides two particular circumstances when the Registrar may hold the proprietor not to be entitled to the exclusive rights that registration would otherwise confer upon him. These are:

If a trade mark-

- a) Contains any part not separately registered by the proprietor as a trade mark;
or
- b) Contains matters common to the trade or to the provision of services of that

description or otherwise of a non-distinctive character.

Page 62 of the KIPI Trade Marks Manual of Examination Procedures states that the purpose of a disclaimer is to prevent proprietors of a mark to claim exclusive rights to the parts of marks that are non-distinctive or common to the particular trade.

In *Paco Holdings Ltd and opposition thereto by Paco Rabanne Parfums [1999]*, the Registrar's Principal Hearing Officer was of the view that the entry of the disclaimer should be regarded as an admission by the proprietor that the disclaimed matter is not to be regarded distinctive as in itself, of the trade origin of the proprietor's goods or services.

Lord Parker in *W & G du Cros' Application [1913] 30 RPC 660* stated that the right to registration should largely depend on whether other traders in the course of their business and without any improper motive desire to use the same or a similar trade mark upon or in connection with their own goods and services.

In looking at the provisions of Section 17 and considering the Examiner's request for the disclaimer of the individual letters "D", "B" and "I" each separately and apart from the mark as a whole, I am in agreement with the Examiner that the individual letters "D", "B" and "I" should be disclaimed each separately and apart from the mark as a whole.

As relates to the word "SALA", the online Merriam Webster dictionary defines the word "SALA" to mean "*a large or important room or hall*". The Collins online dictionary defines the word "SALA" to mean "*room, ward or hall*". In considering the goods that the Applicant seeks to register, I am of the view that the word "SALA" is not descriptive of the goods that the Applicant seeks to register. Having perused the register of trade marks, and considered class 9 goods, I am of the opinion that the word "SALA" is not a word that is common to the trade of goods in class 9.

I have noted that the Applicant has not provided an English translation of the word "SALA" in the application for registration. The Applicant should provide an English translation of the word "SALA", and indicate the language from which the word

emanates.

For the above-mentioned reasons and having taken into account all the circumstances of this case, I hereby rule as follows:

1. The Applicant's application for the registration of T.M.A No. 94903 shall not proceed to publication in the Industrial Property Journal without a disclaimer of the letters "D", "B" and "I" each separately and apart from the mark as a whole.
2. The Trade Mark Examiner's report dated 15th April 2017 requiring the disclaimer of the word "SALA" separately and apart from the mark as a whole is hereby revoked.

The Applicant should however note that these proceedings 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 16th day of January 2025



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CONCILIA WERE
ASSISTANT REGISTRAR OF TRADE MARKS