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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. 127223 “TESON” (WORD &
DEVICE) IN CLASSES 1,2,3,4,7,16 & 17**

IN THE NAME OF FILTEX MARKETING SDN. BHD

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

BACKGROUND

On 5th April 2023, Filtex Marketing Sdn. Bhd (hereinafter referred to as “the Applicant”) filed an application to register the mark “TESON” (word & device), T.M.A No. 127223. The application was filed in respect to goods in classes 1, 2, 3, 4, 7, 16 & 17 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 letter dated 23rd June 2023, the Trade Marks Examiner issued a refusal notice indicating that the mark had been refused registration on the grounds that it is similar to two other marks existing on the Trade Marks Register with the following particulars:

TM No. 104048- ‘TESON (Word/Device)’, in class 4

TM No. 104049- ‘TESON (Word/Device)’, in class 7

Through a letter dated 21st September 2023, the Applicant filed written submissions against the Trade Marks Examiner’s refusal notice and submitted inter alia as follows:

1. That the Applicant is a leading company with a specialization in developing and manufacturing a wide range of professional products including Gasket Makers, Epoxy Compound, Household Adhesive Products, Thread Lockers & Cyanoacrylic Products, Industrial and Automotive Cleaning Products, Fuel and Oil Treatment Products, Repair & Maintenance Products, Car Care Products, Engine Oils and Lubricants for the automotive aftermarket, marine, construction, manufacturing, DIY household and furniture industry among others.
2. That since its incorporation in 2003, the company continues to offer these wide range of products which are marketed and distributed worldwide to over 50 countries through appointed distributors.
3. That Al Khair Auto Spare Parts Co LLC (the “Distributor”), the registered proprietor of the Cited Prior Marks, is one of the distributors of the Applicant’s products in many countries, including Kenya.
4. That the Applicant seeks to have the Provisional Refusal withdrawn and the Applicant’s Mark approved for registration and protection in Kenya on the strength and basis of the arguments advanced through this considered reply.
5. That the Applicant is the bona fide owner and proprietor of the ‘TESON’ mark in various classes across the world, including in Kenya.
6. That in Kenya, the Applicant is the Registered Proprietor of Trade Mark No. 58840 “TESON” in class 17 registered since 22 March 2006.
7. The Applicant uses one of its related companies, Amerseal Industrial Sdn Bhd (Amerseal), to export its products, including “TESON” branded products, to various countries through its designated distributors. The Distributor is one of the Applicant’s said designated distributors.
8. That the Applicant has enclosed official copies of the register of directors in relation to Amerseal and the Applicant (Form 49 of Malaysian Company’s Act) as proof that Amerseal and the Applicant are related companies through common directorship.
9. That through Amerseal, the Applicant has been supplying products bearing the “TESON” mark to the Distributor as for distribution to various countries, including to Kenya. While there is no formal distributorship agreement between the Applicant and the Distributor (the Parties), an implied

agreement and a long established relationship between the parties can be proved and confirmed through the sale of the Applicant's products to the Distributor over a long period of time.

10. That without the Applicant's consent or authorization, the Distributor applied for registration, and in some cases registered itself as the proprietor of "TESON" mark in different classes in various countries. One such case is in Rwanda where the Distributor sought for the registration of the "TESON" mark in classes 4, 12 and 17, trade mark application "RW/T/2018/700". However, following an opposition by the Applicant, this trade mark application was withdrawn.
11. That in Kenya, the Distributor allegedly registered the Cited Prior Marks on 18 September 2018 (an alleged fact which the Applicant does not hereby or elsewhere admit).
12. That it is on this basis that the Parties are currently negotiating a worldwide agreement to the effect that the Distributor should cease owning or applying for the registration of "TESON" mark or any other marks that could be confusingly similar to the "TESON" mark.
13. That the Applicant takes note from the Provisional Refusal that the Applicant's mark was refused for registration on the ground that it is similar to the Cited Prior Marks already existing in the Register of Trade Marks.
14. That the Applicant further takes note of Section 15 of the Trade Marks Act which prohibits the registration of identical and resembling trade marks. In Particular, sub-section (1) states 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."
15. That Sub-section (2) goes further to provide that:

"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.”

16. That as such, while the law prohibits the registration of identical or resembling trade marks in respect of the same goods or description of goods by more than one proprietor, the law also gives the Registrar the discretion to permit such registrations in light of other proper special circumstances.
17. That in his judgement in the case of L.A Group (PVT) Ltd v Wardrobe Collections [2019] eKLR, Justice Tuiyott held that:

“Once an Opponent to registration has demonstrated that an impugned mark is similar or nearly resembles his registered mark in respect of the same goods or services then an Applicant who wants to benefit from the provisions of subsection 2 (of Section 15) bears the burden of proving that circumstances exist that brings the application within the ambit of the exemptions.”
18. That in this regard, the Applicant submits that the nature of the relationship between the Applicant and the Distributor (the distributorship arrangement), the fact that the Applicant is the registered proprietor of the TESON mark in different classes across different jurisdictions including in Kenya, as well as the circumstances under which the Cited Prior Marks were registered (without the consent or authorization of the Applicant), as has been demonstrated in the preceding paragraphs and the enclosed documents, qualifies as proper special circumstances as envisaged under the above-mentioned legal provision that would permit the registration of similar marks in respect of the same goods or description of goods by different proprietors.
19. That in light of the foregoing, and pursuant to Section 15(2) of the Trade Marks Act, the Applicant Requests that:
 - (a) The Provisional Refusal be withdrawn; and
 - (b) The Applicant's mark be approved for further prosecution up to and until registration subject to the due procedure as provided under the applicable

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 issues for determination are as follows:

- 1) Is the Applicant's mark T.M.A No. 127223 "TESON" (word & device) similar to the cited marks T.M.A No. 104048 "TESON" (word & device) and T.M.A No. 104049 (word & device)?
- 2) Are there other special circumstances that would warrant the registration of the Applicant's mark as per Section 15(2) of Trade Marks Act.

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.'

Parker J. in Pianotist case stated as follows:

"You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks..."

In *Sabel BV v Puma AG*¹, it was stated that the visual, aural or conceptual similarity of the marks must be assessed by reference to:

"the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components...the perception of marks in the mind of the

¹ Rudolf Dassler Sport [1998] RPC 199 at 224

average consumer of the type of goods or services in question plays a decisive role...the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details”.

To make a determination on the issue of similarity, I shall consider the following;

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

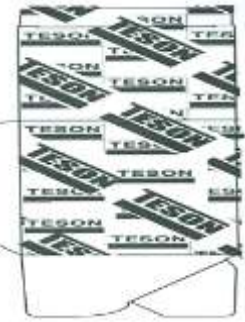
1. Similarity of the marks in appearance

In making a determination on the similarity of the marks, it is important to consider that the marks in question should be compared in their entirety. The overall or net impression of the two marks should be considered.

In *Clarke v Sharp*² 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”.

I will analyse the Applicant’s mark and the cited marks to determine whether they are similar in terms of their appearance.

Applicant’s Mark(127223)	Cited Marks	
	TM 104048 	TM 104049 

² (1898)15 RPC 141 at 146

From the above depictions, it is apparent that the Applicant's mark and the cited marks have an identical word "TESON", which in my view is the dominant element in the three marks and stands out when the marks are considered visually. In considering the phonetic similarity relating to the Applicant's mark and the cited marks, they have the same pronunciation and are therefore phonetically similar. As relates to the conceptual similarity, I am of the view that the Applicant's mark and the cited marks are conceptually similar.

2. Similarity of the goods

In Jellinek's Application³, 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 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

³ (1946) 63 RPC 59 at 70

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 WIPO Intellectual Property Handbook: Policy Law and Use, at page 86 states that:

“...identical marks are unlikely to create confusion as to the origin of the goods if the goods are very different. As a general rule, goods are similar if, when offered for sale under an identical mark, the consuming public would be likely to believe that they came from the same source. All the circumstances of the case must be taken into account, including the nature of the goods, the purpose for which they are used and the trade channels through which they are marketed, but especially the usual origin of the goods, and the usual point of sale.”

The Applicant seeks to register its mark in classes 1, 2, 3, 4, 7, 16 and 17 of the International Classification of Goods and Services.

The cited marks on the other hand are registered in respect to class 4 for TM No.104048 and class 7 for TM 104049.

In Kerly’s Law of Trade Marks and Trade Names 12th Edition, at paragraph 10-12, the test whether or not goods or services are “of the same description” would seem to be supplied by the question -Are the two sets so commonly dealt in by the same trade that his customers, knowing his mark in connection with one set and seeing it used in relation to the other, would be likely to suppose that it was so used also to indicate that they were his? That the matter should be looked at from a business and commercial point of view.

In analyzing the Applicant’s specification of goods proposed to be registered in classes 1, 2, 3, 4, 7, 16 and 17 and the specification of goods relating to the cited marks, it is my view that the goods that the Applicant seeks to register in classes 4 and 7 are similar to the cited marks goods in classes 4 and 7. As for the goods in classes 1, 2, 3, 16 and 17, I am of the view that the goods are different.

In *American Steel Foundries v Robertson*⁴ it was stated that nothing prevents the use of a similar or an identical trade mark by different proprietors provided that the respective goods and services are of a different description. The only property in a trade mark is the business or trade in connection with which the trade mark is used. Goods or services are generally considered to be similar when offered under a similar trade mark and where the purchaser may be likely to believe that the goods and services originate from the same source and where the channels used for the goods are similar.

The Applicant has cited the provisions of Section 15 (2) of the Trade Marks Act which 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.”

I have considered the evidence adduced by the Applicant on the various registrations of the “TESON” mark in various jurisdictions in various classes. The registration in Kenya being under TM 58840, in class 17. The Applicant has also highlighted the relationship that exists between Amerseal Industrial Sdn Bhd, Filtex Marketing Sdn. Bhd and Al Khair Auto Spare Parts Co LLC. I am, however of the view that the Applicant has not demonstrated the other special circumstances that would permit registration of the Applicant’s mark in respect to the same goods as those of the cited marks. The Applicant should have adduced substantial evidence to support this claim.

However, as earlier indicated, I have taken note of the fact that the Applicant’s goods in classes 1, 2, 3, 16 and 17 are different from the cited marks goods in classes 4 and 7.

⁴ 269 U.S. 372 (1926),

DECISION

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

1. The Trade Marks Examiner's refusal notice dated 23rd June 2023, is hereby revoked as far as goods in classes 1, 2, 3, 16 and 17 are concerned and upheld in so far as goods in classes 4 and 7 are concerned;
2. The Applicant to file an amendment to its specification of goods to delete goods in classes 4 and 7 of the International Classification of Goods and Services;
3. The Applicant's application for the registration of T.M.A No. 127223 will be allowed to proceed to publication in the Industrial Property Journal only in respect to goods in classes 1, 2, 3, 16 and 17 of the International Classification of Goods and Services.

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 13th day of June 2025



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CONCILIA WERE
ASSISTANT REGISTRAR OF TRADE MARKS