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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. 102903 “URBAN CRUISER”
(WORD) IN CLASS 12**

**IN THE NAME OF TOYOTA JIDOSHA KABUSHIKI KAISHA (ALSO TRADING AS
TOYOTA MOTOR CORPORATION)**

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

BACKGROUND

On 4th July 2018, Toyota Jidosha Kabushiki Kaisha (hereinafter referred to as “the Applicant”) filed an application to register the mark “URBAN CRUISER” (word), T.M.A No. 102903. The application was filed in respect to goods in class 12 of the International Classification of Goods and Services as follows:

Class 12: Automobiles and structural parts thereof.

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 27th October 2018, the Trade Marks Examiner requested the Applicant to disclaim the right to the exclusive use of the word “Urban” separately and apart from the mark as a whole before the same could be allowed to proceed to publication.

On 11th February 2019, the Applicant filed written submissions against the Trade Marks Examiner’s disclaimer request and submitted inter alia as follows:

1. That the Oxford Dictionary, 11th revised edition, defines the word “Urban” as “relating to or characteristic of a town or city”.
2. That based on the definition above, neither does the word “Urban” have a direct reference to automobiles nor does it describe the characteristics of automobiles. As such, there is no nexus between the word “Urban” and the goods in class 12 i.e. vehicles, apparatus for locomotion by land, air or water.
3. That automobiles may be found in many other environments and are not immediately associated with the word “Urban”. The most common association would be in relation to buildings that form the structure in an urban environment. It is therefore unlikely that any consumer would immediately associate the word “Urban” with the goods provided under class 12. Indeed, the average consumer upon seeing the word “Urban”, would not automatically conclude that the Applicant’s trade mark refers to the goods in class 12.
4. That given the scope of the Applicant’s specification, and indeed the nature of its business as a whole, it is clear that the Applicant’s mark “Urban Cruiser” is distinctive, or otherwise capable of distinguishing the Applicant’s goods from those of its competitors.
5. That the Applicant has successfully registered its trade mark in several countries including Myanmar, EUTM, France, Peru and Mexico without the requirement for a disclaimer. That while the Applicant acknowledges that the Registrar in Kenya is not bound by the decisions of other trade marks offices, the Applicant submits that this information is useful to convince the Registrar that the disclaimer is not necessary.
6. That if despite the above submissions the Registrar still believes that a disclaimer is required, the Registrar to please provide the Applicant with the reasons and statutory basis thereof.

RULING

I have studied the documents on record and considered the Applicant’s 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 publication with

or without a disclaimer of the word “URBAN” 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.

The Supreme Court, in *the Registrar of Trade Marks vs Ashok Chandra Rakhit Ltd* on 15th April, 1955 stated that “real purpose of requiring a disclaimer is to define the rights of the proprietor under the registration so as to minimize, even if it cannot wholly eliminate, the possibility of extravagant and unauthorized claims being made on the score of registration of the trade marks.”

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.

The Applicant submitted that its mark “URBAN CRUISER” is distinctive or otherwise capable of distinguishing its goods from those of its competitors.

In the case of *Canon Kabushiki Kaisha v. Metro-Goldwyn Mayer (1999) RPC 117* the ECJ stated that:

“The essential function of the trade mark is to guarantee the identity of the origin of the marked product to the consumer or end user by enabling him,

without any possibility of confusion, to distinguish the product or service from the other which have another origin. For the trade mark to be able to fulfil its essential role... it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality”.

According to online Collins Dictionary at <https://www.collinsdictionary.com/> the word “URBAN” is defined as “*belonging to, or relating to, a town or city*”.

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 considering the Register of Trade Marks, I have taken note of the fact that there is a trade mark consisting of the word “URBAN” which has been registered with a disclaimer of the word “URBAN” in respect to goods in class 12. I wish to cite the said mark below:

T.M.A NO.	Trade Mark	Class & Goods
67659	KENYA URBAN ROADS AUTHORITY KURA (word and device) Registered with a disclaimer of the word “URBAN”.	Class 12 in respect to Vehicles

It is apparent from the above information that it is common practice for a proprietor of a mark in class 12 to use the word “URBAN”. This signifies that the word is common to the trade in respect to goods in class 12. It is therefore important for the Registrar to avoid granting an unjustified monopoly over a word that should remain available for use by other traders dealing with goods in class 12. A disclaimer is therefore necessary and appropriate.

DECISION

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

1. The Applicant's application for registration of the mark "URBAN CRUISER", TMA No. 102903 shall not proceed to publication in the Industrial Property Journal without a disclaimer of the word "URBAN" separately and apart from the mark as a whole.
2. The Trade Marks Examiner's report dated 27th October 2018, requiring the Applicant to disclaim the right to the exclusive use of the word "URBAN", is hereby upheld.

Ruling delivered at Nairobi this 13th day of June 2025



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CONCILIA WERE

ASSISTANT REGISTRAR OF TRADE MARKS