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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. 105289 “SAVANNA Bread” (WORD AND DEVICE) IN
THE NAME OF JUDWINA LIMITED**

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

BACKGROUND

On 14th December 2018, Judwina Limited (hereinafter referred to as the Applicant) filed an application for registration of the mark T.M.A No. 105289 “SAVANNA Bread” (word and device) in respect to class 43 of the International Classification of Goods and Services. Class 43: Services for providing food and drink.

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.

Through a letter dated 21st March 2019, the Trade Marks Examiner issued a refusal notice against registration of the said mark citing the reason that the mark is similar to another mark existing on the Register of Trade Marks with the following particulars:

TM No. 60915 “SAVANNA COFFEE LOUNGE” in class 30 & 43 in the name of Sasini Coffee House Ltd of P.O Box 55358-00200 Nairobi.

On 21st June 2019, the Applicant filed written submissions against the Examiner’s refusal notice citing the following:

1. Capability of distinguishing the goods: The Trade Mark for Savanna Bread is distinctive and distinguishes the goods of the proprietor of the Trade Mark. The name and the

logo specify that the good to be dealt with is bread. Therefore, this cannot be confused with the “Savanna Coffee Lounge” Trade Mark representing a restaurant and a place that mostly serves coffee and other beverages.

2. Difference in identity: The colour and the logos of both marks are different. The “Savanna Coffee Lounge” Trade Mark is imprinted in a deep red background and the word “Savanna” and the image are in the colours yellow and white respectively. Mark for “Savanna Bread” has a symbol for bread and wheat as a further implication of what the goods to be dealt with will be.
3. Location of trade: currently, Savanna Coffee Lounge has three known restaurants, all serving Nairobi County.

RULING

I have studied the documents on record and considered the Applicant’s submissions filed by Archer & Wilcock Advocates against the Examiner’s refusal notice.

I am of the view that the issue for determination is whether the Applicant’s mark T.M.A No.105289 “SAVANNA Bread” (word and device) is similar to the cited mark TM No. 60915 “SAVANNA COFFEE LOUNGE” (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 making a decision on the similarity of the marks, it is important to consider that the marks that are up for consideration should be compared in their entirety. The overall or net impression of the two marks should be taken into consideration.

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”.

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



The Applicant’s mark is . The cited mark on the other hand is “SAVANNA COFFEE LOUNGE” (word). It is apparent from the above that there is a common word “SAVANNA” which is present both in the Applicant’s mark and the cited mark. This word appears to me to be the dominant component in both marks. In considering the other elements in the two marks, it is my view that they are different.

When a mark contains a dominant component, the likely impact that is created on the mind of the customer must be considered. In most instances, marks are remembered by their general impressions or striking features rather than by the photographic recollection of the whole. It is important to strike a balance between the impact created by the dominant component of the mark and also consideration of the mark as a whole.

¹ (1898)15 RPC 141 at 146

2. Similarity of the goods

Romer J in *Jellinek's Application*², 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 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 Applicant proposes to register its mark in class 43 of the International Classification of Goods and Services in respect to Services for providing food and drink. The cited mark on the other hand is registered in respect to classes 30 and 43 of the International Classification of Goods and Services as follows:

Class 30: Beverages with coffee, cocoa and chocolate base.

² (1946) 63 RPC 59 at 70

Class 43: Services for providing food and drinks, temporary accommodation.

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.

From the analysis made on the Applicant's specification of services and the specification of services relating to the cited mark in class 43, I am of the view that the services which the Applicant seeks to register in class 43 are similar those of the cited mark in class 43.

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 21st March 2019, is hereby upheld.
2. The Applicant's application for registration of the mark T.M.A No.105289 "SAVANNA Bread" (word and device) in class 43 of the International Classification of Goods and Services hereby fails and registration of the said mark shall not be allowed to proceed.

Ruling delivered at Nairobi this 6th day of February 2025



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CONCILIA WERE
ASSISTANT REGISTRAR OF TRADE MARKS