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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. 112289 “MARKETSID”**  
**(WORD) IN CLASS 32**

**IN THE NAME OF WALMART APOLLO, LLC**

**RULING BY ASSISTANT REGISTRAR OF TRADE MARKS**

**BACKGROUND**

On 10<sup>th</sup> June 2020, Walmart Apollo, LLC (hereinafter referred to as “the Applicant”)

filed an application to register the mark “”, T.M.A No. 112289. The application was filed in respect to goods in class 32 of the International Classification of Goods and Services.

Class 32: Beers; non-alcoholic beverages; mineral and aerated waters; fruit beverages and fruit juices; syrups and other non-alcoholic preparations for making beverages; fruit based beverages; orange juice beverages; drinking water; bottled drinking water; soft drinks; energy drinks containing caffeine.

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 25<sup>th</sup> September 2020, the Trade Marks Examiner requested the Applicant to disclaim the right to the exclusive use of the word “MARKET” separately and apart from the mark as a whole before the same could be allowed to proceed to publication.

Through a letter dated 8<sup>th</sup> January 2021, the Applicant filed written submissions in response to the Examiner's disclaimer request stating inter alia as follows:

1. **THAT** The word "MARKET" has no direct relevance to the character or quality of the goods covered in class 32. Whilst such goods may be sold in a market the variety of such goods sold in such locations means that when considering the word "MARKET" no specific goods are immediately associated with this word.
2. That the Applicant's position is supported globally by the number of registrations held by the Applicant which do not include such a disclaimer.
3. That notably, Trade Mark Number 89666 MARKETSIDE in classes 6, 20, 29, 30, & 31 has been registered with the Trade Marks Registry without the requirement to disclaim the word MARKET.

### **RULING**

I have studied the documents on record and considered the Applicant's written submissions against the Examiner's disclaimer request. The Examiner had in the examination report dated 25<sup>th</sup> September 2020 requested the Applicant to disclaim the right to the exclusive use of the word "MARKET" separately and apart from the mark as a whole.

I am therefore 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 "MARKET" 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 Applicant herein submitted that the word “Market” has no direct relevance to the character or quality of the goods covered in class 32. Moreover, whilst such goods may be sold in a market the variety of such goods sold in such locations means that when considering the word “MARKET” no specific goods are immediately associated with this word.

In *Xtreme Lashes LLC Vs Xtended Beauty Inc. 576, F3d 221,232 (5<sup>th</sup> Cir.2009)* in construing descriptiveness broadly stated in part that:

“(1) the marks dictionary definition corresponds with its meaning and context; (2) upon hearing the mark, one need not use “imagination, thought and perception to reach a conclusion as to the nature of goods;” (3) “competitors would be likely to need the terms used in the trade mark in describing their products;” and that (4) others have used the term in marketing a similar service or product.”

Distinctiveness under the Act is an essential element that the trade mark sought to be registered by the Applicant should possess.

I have taken note of the fact that T.M. No. 89666 “MARKETSIDE”, was registered without an entry of a disclaimer of the word “MARKET” in respect to goods in classes 6, 20, 29, 30 & 31 of the International Classification of Goods and 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.

Having considered the Applicant’s specification of goods proposed to be registered, it is my view that the Applicant’s application should proceed to registration without the disclaimer of the word “MARKET”.

## **DECISION**

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 registration of the mark "MARKETSIDE", T.M.A No. 112289 shall proceed to publication in the Industrial Property Journal without entry of a disclaimer of the word "MARKET" separately and apart from the mark as a whole.
2. The Examiner's report dated 25<sup>th</sup> September 2020 requiring the Applicant to disclaim the right to the exclusive use of the word "MARKET" separately and apart from the mark as a whole is hereby revoked.

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 30<sup>th</sup> day of May 2025**



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**CONCILIA WERE**  
**ASSISTANT REGISTRAR OF TRADE MARKS**