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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. 130550 “KLEENGUARD”**

**(WORD) IN CLASS 9**

**IN THE NAME OF KIMBERLY-CLARK WORLDWIDE, INC**

**RULING BY ASSISTANT REGISTRAR OF TRADE MARKS**

**BACKGROUND**

On 18<sup>th</sup> October 2023, Kimberly-Clark Worldwide, Inc. (hereinafter referred to as “the Applicant”) filed an application to register the mark “KLEENGUARD” (word), T.M.A No. 130550. The application was filed in respect to goods in class 9 of the International Classification of Goods and Services as follows:

Class 9: Disposable protective garments such as lab coats, jackets, coveralls, aprons, shoe and boot covers, headwear; disposable protective gloves; protective eyewear; disposable protective face masks.

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 21<sup>st</sup> May 2024, the Trade Marks Examiner issued a refusal notice indicating that the mark had been refused registration on the grounds that it is similar to another mark existing on the Trade Marks Register with the following particulars:

TM No. 27844- ‘KLEEN GUARD (Word)’, in class 3 related to the goods the Applicant was applying for, in the name of Alberto- Culver Company, existing on the register as from 29/09/1980.

On 21<sup>st</sup> August 2024, the Applicant filed written submissions against the Trade Marks Examiner's refusal notice and submitted inter alia as follows:

1. That the provisional refusal was issued pursuant to Section 15(1) of the Trade Marks Act Chapter 506 of the Laws of Kenya that 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 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.”

2. That the Registered Mark and the Applicant's Mark are not too similar as to cause confusion in the market, with the aim of having the two marks co-exist in the Register.
3. That in determining the likelihood of confusion, the Courts have determined the criteria for determining similarity by listing the following:
  - a) Visual similarity;
  - b) Phonetic/ aural similarity; or
  - c) Contextual similarity.
4. That in the Matter of T.M.A. Number 60347 “RAHA TEA” in Class 30 in the name of M.A. Pandit & Co. Limited, the Registrar elaborated the above criteria further as below:
  - a) The appearance of the two marks;
  - b) The sound of the two marks;
  - c) The goods or services to which the mark is applied;
  - d) The kind of customer likely to buy the goods or use the services; and
  - e) The surrounding circumstances.
5. The Applicant submitted that all these elements of similarity are not present in respect of the Registered Mark and the Applicant's Mark.
6. That the visual element of a trade mark is a branding issue and determines how the consumer views the mark.

7. That the Registered Mark is a word mark only while the Applicant's mark is a word and device. The two marks therefore have visual and conceptual differences.
8. That the Registered Mark is a one-word mark while the Applicant's mark is a two-word mark, further distinguishing the two marks even more. The space between the words in the Applicant's Mark "KLEEN GUARD" makes it look quite different from the Registered Mark "KLEENGUARD".
9. That in the matter of TMA No. 67484 "AMOLIN" in Class 5 in the name of Beta Healthcare International Limited and opposition by Glaxo Group Limited, the Assistant Registrar of Trade Marks stated that:

*A mark may still possess sufficient distinctiveness notwithstanding an element which is common or the same as an element of another mark.*
10. That it follows that it is possible for the two marks to co-exist together.
11. That in fact, the Applicant's mark and the Registered Mark currently already co-exist in various jurisdictions across the world, including big commercial markets such as USA, Nicaragua, BES Islands (Bonaire, Saint Eustatius, Saba), Montenegro and Taiwan, without causing any confusion in the market to consumers.
12. That the Applicant humbly submits, that the two marks existing in other jurisdictions without any confusion is further proof that the two marks are different enough to coexist in respect of their respective industries and target markets in Kenya as well.
13. That in the Matter of Trade Mark Application No. KE/T/2009/065815 "SUBLIME" (SB) (Device) in Class 26 in the name of Amina Togo Sarl and opposition thereto by Strategic Industries Limited, the Registrar stated that the existence of the two marks in the same class of goods would be a violation of Section 15 of the Trade Marks Act. We submit that the import of this would be that the existence of even two similar marks, in different classes, would not be a violation of the said Section.
14. That in any case, the World Intellectual Property Handbook, in Paragraph 2.458 states that:

*“The test of whether goods are similar is based on the assumption that identical marks are used. Even 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”*

15. That the Applicant’s mark covers “disposable protective garments such as lab coats, jackets, coveralls, aprons, shoe and boot covers, headwear; disposable protective gloves; protective eyewear; disposable protective face masks” all in class 9. These goods are all garments that are designed to protect persons, rather than just cover, and that have a specific purpose, namely to shield from harm. The fact that these protective goods are disposable clearly shows that they are designed for single use. The reference to lab, being an abbreviation for laboratory, also shows where these goods are usually used.
16. That the Applicant sells its KLEENGUARD products through its Kimberley-Clark Professional range, which offers a range of workplace solutions for a variety of industries, from food processing to manufacturing facilities. It is clear that the products are generally aimed at companies to purchase for use by their employees, and these are not general items that ordinary members of the public will buy for their own personal use at home.
17. That the Registered mark however covers the following goods in Class 3: “Cleaning, waxing and polishing preparations, furniture polish, dusting spray, all-purpose cleaner and rug cleaner and all the goods in Class 03”. These goods covered by the Registered Mark are all household preparations designed to clean, that will be purchased in grocery stores by ordinary members of the public for use in their homes.

18. That Internet investigations show that the proprietor of the Registered Mark, being Alberto-Culver Company, no longer exists, as its various assets and brands were sold in 2010-2011 to Unilever PLC.
19. That it is quite clear that the respective marks are used in relation to very different goods that they are sold in completely different trade channels, for use in distinctive settings, to diverse types of customers.
20. That therefore, it is a correct conclusion for the Applicant to state that although the marks may at first glance, and when viewed in isolation appear to look almost similar, the fact that they cover very different goods and are in different classes, so there really is no likelihood at all that confusion can arise between the Registered Mark and the Applicant's Mark.
21. That from the excerpt of the Registered Mark attached to the Refusal Notice, it is clear that the Registered Mark expired on 26th September, 2021.
22. That Section 23(3) of the Trade Marks Act stipulates that the Registrar shall send a Renewal Notice to the Proprietor at the prescribed time before the expiration of the last registration of a trade mark and if at the time of the expiration the renewal fees has not been paid, the Registrar may remove the Trade Mark from the Register subject to restoration, if conditions are met.
23. That if reliance were to be placed on Section 23(3) of the Trade Marks Act as described above, then it would be a proper conclusion that the Registrar did indeed send a Renewal Notice to the Registered Proprietor and the Registered Proprietor has proved indolent in renewing the Registered Mark.
24. The Applicant indicated that there can be no prejudice in allowing the Applicant's mark to proceed to advertisement as the successors in title to the Registered Mark will still be afforded the usual opportunity to oppose the registration of the Applicant's mark, should it feel that it is necessary to do so.

25. That it is therefore in the interest of justice and the protection of the Applicant's rights that this Application be allowed and the Applicant's mark registered as is in the Register.

## **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 issue for determination is as follows:

Is the Applicant's mark T.M.A No. 130550 "KLEENGUARD" (word) similar to the cited mark T.M.A No. 27844 "KLEEN GUARD" (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 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 the case of **Lloyd Schuhfabrik Meyer & Co. GmbH V. Klijsen Handel BV (1999) ECR 13819** at paragraph 29 it was held:

'...a sign is identical to a trade mark where it reproduces, without any modification or addition, all the elements constituting the Trade Mark or where viewed as a

whole, it contains differences so insignificant that they may go unnoticed by an average consumer.’

I will analyse 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 “KLEENGUARD” (word) written in capital letters. The cited mark is “KLEEN GUARD” (word) written in capital letters too. The Applicant’s mark and the cited mark are not identical but are similar visually. The distinction lies in the fact that the cited mark consists of two words, “KLEEN” and “GUARD” while the Applicant’s mark consists of one word, “KLEENGUARD”.

In analysing the phonetic similarity relating to the Applicant’s mark and the cited mark, both marks 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 mark are conceptually similar.

## **2. Similarity of the goods**

Romer J in Jellinek’s Application<sup>1</sup>, 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 (2<sup>nd</sup> 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.’

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<sup>1</sup> (1946) 63 RPC 59 at 70

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 **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.”

In this matter, the Applicant seeks to register its mark in class 9 of the International Classification of Goods and Services as follows:

Class 9: Disposable protective garments such as lab coats, jackets, coveralls, aprons, shoe and boot covers, headwear; disposable protective gloves; protective eyewear; disposable protective face masks.

The cited mark on the other hand is registered in respect to class 3 of the International Classification of Goods and Services covering the following:

Class 3: Cleaning, waxing and polishing preparations, furniture polish, dusting spray, all purpose cleaner and rug cleaner and all the goods in Class 3.

In Kerly's Law of Trade Marks and Trade Names 12<sup>th</sup> 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 and the specification of goods relating to the cited mark, it is my view that the goods that the Applicant seeks to register are not the same as the goods in consideration in respect to the cited mark.

### **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 21<sup>st</sup> May 2024, is hereby revoked.
2. The Applicant's application for the registration of the mark "KLEENGUARD" (word), T.M.A No. 130550 is hereby allowed to proceed to publication in the Industrial Property Journal.

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 25<sup>th</sup> day of February 2025**



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**CONCILIA WERE**

**ASSISTANT REGISTRAR OF TRADE MARKS**