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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. 100955 “PRIME VIDEO”

(WORD & DEVICE) IN CLASSES 9, 38 & 41

IN THE NAME OF AMAZON TECHNOLOGIES, INC.

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

BACKGROUND

On 19th February 2018, Amazon Technologies, Inc. (hereinafter referred to as “the

Applicant”) filed an application to register the mark “”, T.M.A No. 100955. The application was filed in respect to goods and services in classes 9, 38, and 41 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 report dated 26th May 2018, the Trade Marks Examiner requested the Applicant to disclaim the right to the exclusive use of the words “Prime” and “Video” each separately and apart from the mark as a whole before the same could be allowed to proceed to publication.

Through a letter dated 7th November 2019, the Applicant filed written submissions in response to the Examiner’s disclaimer requests stating inter alia as follows:

1. **THAT** the Applicant agrees to disclaim the right to the exclusive use of the word “VIDEO” and will file an application for amendment in this regard.

2. **THAT** the Applicant respectfully submits that entering a disclaimer on the word “**PRIME**” is both unnecessary and prejudicial to the Applicant’s rights.

i. Disclaimer Requirements

THAT according to Section 17 (b) of the Trade Marks Act, Cap 506 Laws of Kenya (“the Act”), a disclaimer is required when a trade mark contains any part not separately registered by the proprietor as a trade mark or contains matter common to the trade or to the provision of services of that description or otherwise of a non-distinctive character.

THAT “**PRIME**” is capable of distinguishing the goods and services of the Applicant from those of another trader because the term “**PRIME**” is inherently distinctive as to the applied-for goods and services. That it has also acquired secondary meaning as a well-known Amazon house mark among Kenyan consumers through extensive prior use and spill over advertising.

THAT the term “**PRIME**” is a dominant component of the “**PRIME VIDEO**” trade mark and distinctive of the origin of the goods and services in question. That as a result the Applicant is entitled to rights to the term “**PRIME**” and that a disclaimer to the said term “**PRIME**” will be prejudicial to these rights.

The Applicant relied on the case of *Registrar of Trade Marks v W. and G. Du Cros Ltd. (1913)*, where Lord Parker stated ‘the question to be asked in order to test whether a word is adapted to distinguish one trader’s goods from the goods of all others is whether the word is one which other traders are likely, in the ordinary course of their businesses and without any improper motive, to desire to use upon or in connection with their goods’.

THAT another trader in the Applicant’s industry could not honestly say that it desires to apply the word “**PRIME**” to its goods or services for the sake of the signification which the word ordinarily possesses. That the Applicant submits that if the word “**PRIME**” has any meaning in relation to the Applicant’s particular goods and services, it is “allusive or metaphorical,” as the term “**PRIME**” does not naturally collocate with the term “**VIDEO**” in the English language. “Prime Video” has no dictionary or other known meaning apart from acting as the Applicant’s trade mark.

THAT by requiring the Applicant to disclaim the right to the exclusive use of the word “PRIME”, the word would be unjustifiably available for use by third parties in relation to their goods and services in classes 9, 38 and 41, and the Applicant’s trade mark shall be incapable of distinguishing the Applicant’s goods and services from those of other providers of similar goods and services in those classes.

- ii. THAT when applied to the very specific goods and services related to the media industry, the term “PRIME” is inherently distinctive because “PRIME” cannot describe any related character or quality.

THAT the Applicant’s application is filed in relation to very specific goods and services related to hardware, software and provision of services connected to the media industry.

THAT moreover, the core use of the Applicant’s trade mark application is in relation to video on demand services provided over the internet, as can be seen at the Applicant’s website (<https://www.primevideo.com/>) and online in a recently published article by Business Insider titled “25 movies that prime members can watch for free right now on Amazon Prime Video” at <https://www.businessinsider.com/best-movies-on-amazon-prime-video>.

Therefore, when applied to the very specific goods and services related to the media industry and especially the streaming video industry, the term “PRIME” is inherently distinctive because “PRIME” cannot describe any character or quality of the applied for goods and services.

- iii. THAT PRIME VIDEO is an extension of Amazon’s famous brand name PRIME.

The Applicant, Amazon Technologies, Inc., is a subsidiary of Amazon.com, Inc. (Amazon). That “PRIME” is a crucial part of Amazon’s business and has been considered a famous brand by WIPO in proceedings regarding the Uniform Domain-Name Dispute Resolution Policy.

That “PRIME” is a famous mark in all industries in which Amazon operates and PRIME VIDEO should be viewed in this context.

- iv. **THAT** when applied to the Applicant's goods and services, the word "PRIME" in the applied for mark is arbitrary.

The Applicant submitted that the word "PRIME" is not matter common to the trade or to the provisions of services of that description. The mark is therefore arbitrary; a consumer unaware of Amazon's PRIME brand would not be able to form a reasonable association between the word "PRIME" and video software and related services.

- v. **THAT** "PRIME" is not a term that has direct reference to the character or quality of the Applicant's goods and services.

THAT the words "PRIME VIDEO" in the applied-for mark would not be understood by the ordinary person as making direct reference to any attribute of the goods or services claimed. This is because, when applied to the Applicant's goods and services, the term "PRIME" adopts an incongruous meaning particularly when it is combined with the term "VIDEO" because "PRIME" and "VIDEO" do not normally collocate in normal English speech patterns. Therefore, "PRIME" does not have a singular, literal and direct meaning especially when applied to the Applicant's goods and services. As such, consumers would not be able to glean any meaningful description of the goods or services from the term "PRIME".

- vi. **THAT** PRIME VIDEO has also acquired secondary meaning through extensive use and spill over advertising.

That the Applicant has maintained use of the PRIME name and trade mark, continuously and extensively throughout the world, since the product launch in the United States of America approximately 15 years ago, in 2005. In Kenya, Amazon Studios' award winning shows and movies have received lots of local media coverage.

- vii. **THAT** PRIME AND PRIME VIDEO have been successfully registered by the Applicant in other jurisdictions without a disclaimer on the term PRIME in classes 9, 38 and 41.

Conclusion

In the circumstances, the Applicant respectfully submitted that the Applicant is entitled to obtain statutory protection for the word “PRIME” in relation to the goods and services for which it has applied. That as discussed above, “PRIME” is inherently distinctive because when applied to specific goods and services related to the media industry, “PRIME” does not immediately convey to consumers the character or quality of the referenced goods and services. Moreover, PRIME VIDEO is an arbitrary word because “PRIME” and “VIDEO” do not collocate in the English language and the word “PRIME” is not apt for describing video-on-demand services and related software. Therefore, consumers would not be able to glean any meaningful description of the goods or services from the term “PRIME”. Furthermore, PRIME VIDEO is an extension of Amazon’s well-known house mark PRIME and has been marketed in Kenya since 2016. Kenyan consumers are familiar with PRIME VIDEO because Amazon Studio’s award winning shows and movies have been widely featured by the media in Kenya, and are exclusively available on PRIME VIDEO.

The Applicant thus prayed that the Registrar of Trade Marks reconsiders the request for a disclaimer of the word “PRIME” and that the application be approved to proceed to advertisement.

RULING

I have studied the documents on record and considered the Applicant’s written submissions against the Examiner’s disclaimer requests. The Examiner had in the examination report dated 26th May 2018 requested the Applicant to disclaim the right to the exclusive use of the words “PRIME” and “VIDEO” each separately and apart from the mark as a whole. From the submissions filed, the Applicant has agreed to disclaim the right to the exclusive use of the word “VIDEO” and has accepted to file an application for amendment in this regard.

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 “PRIME” 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 herein submitted that the word “PRIME” is inherently distinctive because when applied to specific goods and services related to the media industry, “PRIME” does not immediately convey to consumers the character or quality of the referenced goods and services.

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”

Distinctiveness is a crucial element that the trade mark sought to be registered by the Applicant should possess.

According to the online Cambridge English Dictionary the term “PRIME” is defined as “most important, or of the best quality”. This therefore signifies something that is of great importance and of the best quality.

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 are other trade marks consisting of the word “PRIME” which have been registered with a disclaimer of the word “PRIME” in respect to goods and services in classes 9, 38 and 41. I wish to cite a few of the said marks as follows:

No.	T.M NO.	Trade Mark	Class(es)
1.	88281	WEEKEND PRIME (word and device) Registered with a disclaimer of the word “PRIME”	35, 38 and 41
2.	93966	NEON PRIME TAB 7 (word and device) Registered with a disclaimer of the word “PRIME”	9, 35, 38 and 41
3.	99785	GRAND PRIME (word) Registered with a disclaimer of the word “PRIME”	9
4.	108411	PRIME POWER (word and device) Registered with a disclaimer of the word “PRIME”	9 and 11

5.	85089	Mr. Prime (word and device) Registered with a disclaimer of the word “PRIME”	41
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It is clear from the above information that it is common practice for proprietors of marks in classes 9, 38 and 41 to use the word “PRIME”. This signifies that the word is common to the trade or provision of services in classes 9, 38 and 41.

The Applicant has indicated that trade marks consisting of the word “PRIME” have been registered by the Applicant, without entry of a disclaimer on the word “PRIME” in several jurisdictions in classes 9, 38 and 41. The fact that the marks consisting of the word “PRIME” have been registered in other jurisdictions without the requirement for disclaimer of the word “PRIME” is merely persuasive but not binding upon the Registrar of Trade Marks in Kenya.

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 “PRIME VIDEO”, TMA No. 100955 shall not proceed to publication in the Industrial Property Journal without disclaimers of the words “PRIME” and “VIDEO” each separately and apart from the mark as a whole.
2. The Examiner’s report dated 26th May 2018 requiring the Applicant to disclaim the right to the exclusive use of the words “PRIME” and “VIDEO” each separately and apart from the mark as a whole is hereby upheld.

Ruling delivered at Nairobi this 26th day of March 2025



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CONCILIA WERE
ASSISTANT REGISTRAR OF TRADE MARKS