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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. 135570 “MTN ADS” (WORD)

IN CLASSES 9, 35, 38 & 42

IN THE NAME OF MTN GROUP MANAGEMENT SERVICES (PTY) LTD

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

BACKGROUND

On 24th September 2024, MTN Group Management Services (Pty) Ltd (hereinafter referred to as “the Applicant”) filed an application to register the mark “MTN ADS” (word), T.M.A No. 135570. The application was filed in respect to goods and services in classes 9, 35, 38 & 42 of the International Classification of Goods and Services as follows:

Class 9: Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media, computer software, blank digital or analogue recording and storage media; computer software and hardware for use in computer-aided software engineering; virtual and augmented reality training simulation software in the field of engineering; computer application software for use in implementing the Internet of Things [IoT]; IoT gateways; application software for cloud computing services; software; software applications; mobile applications; downloadable computer programs using artificial intelligence and machine learning to develop predictive models; downloadable computer programs using artificial intelligence in the field of online advertising; downloadable computer programs using artificial intelligence and machine learning to predict the

performance of the algorithms; artificial intelligence and machine learning software; machine learning software used in computer advertising programs; electronic navigation and geolocalization apparatus and instruments; computers and computer software for data collection, transmission, archiving, management and processing; computer hardware for the collection of location data; downloadable virtual goods; downloadable files authenticated by non-fungible tokens [NFTs]; mechanisms for coin-operated apparatus; cash registers, calculating devices; computers and computer peripheral devices.

Class 35: Marketing, advertising and promotion services; promoting the goods and services of others via computer and communication networks; digital advertising services; loyalty card services; organisation, operation and management of customer loyalty schemes; organisation, operation and supervision of sales and promotional incentive schemes; retail, wholesale, franchising and merchandising services; offering for sale and the sale of goods in the retail and wholesale trade; the bringing together, for the benefit of others, of a variety of goods and services enabling customers to conveniently view and purchase those goods and services, including such services provided on-line from a computer database, the internet or other electronic networks; provision of online platforms for the sale and purchase of goods and services; providing an online marketplace for buyers and sellers of goods and services; arranging and conducting of exhibitions for business purposes; business management, organization and administration; office functions.

Class 38: Telecommunication services; transmission of advertising programmes and media advertising communications via digital communications networks; geolocation services [telecommunications services]; mobile, fixed, satellite, cellular, mobile and radio telecommunication services; providing prepaid minutes for use on mobile phones; provision of internet access services; telecommunications services for location and tracking of persons and objects; tracking of mobile telephone via satellite signals; broadcast or transmission of radio or television programmes; providing telecommunications connections to computer databases, the internet or other electronic networks; provision of wireless electronic transmission of credit and debit card transaction data and wireless electronic savings and payment data via a global computer network; providing access to digital audio, video and data websites from a database, the internet, or other electronic network; streaming of audio and video material on the internet; telecommunication and communication database services, including enabling the consumer to download digital content from a network and server to an individual database; providing access to telecommunications infrastructures for other operators; providing and leasing access time to computer databases, computer bulletin boards, computer networks and interactive computer communications networks; information services relating to data communications; communication services for the Internet of Things [IoT]; advisory, information and consultancy services relating to all the aforementioned.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; software engineering services; cloud computing services; cloud-based data protection services; consultancy

services in the field of cloud computing; advisory services in the field of deploying cloud computing environments in the field of infrastructure as a service [IaaS]; application service provider (APS), including, providing, hosting, managing, developing, and maintaining applications, software, websites, and databases in the fields of wireless communication. mobile information access, and remote data management for wireless delivery of content to handheld computers, laptops and mobile electronic devices; providing temporary use of online non-downloadable software and applications; providing an online network service that enables users to transfer and share personal identity data among multiple online facilities; providing non-downloadable e-commerce software to allow users to perform electronic business transactions via global computer network; software as a service (SAAS).

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 25th October 2024, the Trade Marks Examiner requested the Applicant to disclaim the right to the exclusive use of the letters “M”, “T”, “N”, “A”, “D” and “S” each separately and apart from the mark as a whole.

Through a letter dated 25th November 2024, the Applicant filed written submissions in response to the Examiner’s disclaimer request stating inter alia as follows:

1. That Section 17 of the Trade Marks Act (the “Act”) provides, “a disclaimer is required where a trade mark contains matter common to the trade or to the provision of services of that description or otherwise of a non-distinctive character.” The letters “M”, “T”, “N”, “A”, “D” and “S” do not have a direct reference to the character or quality of the goods and services provided in the specified classes being 09, 35, 38 and 42. It is clear that there is no nexus between the mark and the specification of the goods and services in the aforementioned classes.
2. That the letters in question do not represent the goods or services in the aforementioned classes and would therefore not be deemed to contain matter common to the provision of goods and services in the classes.
3. Further, it is worth noting that the Applicant’s proposed trade mark is “MTN ADS” and not “M T N A D S”. In essence, the Applicant’s trade mark does not contain six separate letters but rather two words, i.e., “MTN” and “ADS”. The Applicant submitted that the request to individually disclaim the letters “M”, “T”, “N”, “A”, “D” and “S”, goes against the well-established principle in trade mark law that trade marks are viewed as wholes without dismembering their

constituent parts. In the UK case of *San Carlo Gruppo Alimentare Spa v Societe Des Produits Nestle S. A.* the Registrar of Trade Marks noted, "The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details."

4. The Applicant therefore submitted that the Registrar ought to reconsider the request for a disclaimer of the individual letters in line with the above principle and allow the Applicant's trade mark to proceed to advertisement.
5. The Applicant submitted that the MTN ADS trade mark, in its entirety, is inherently distinctive. The trade mark should not be dissected to such an extent that the individual letters are required to be disclaimed. That the entry of a disclaimer for the individual letters against the subject applications is unnecessary for the following reasons:
 - a. the letters "M", "T", "N", "A", "D" and "S" form part of the composite "MTN ADS" trade mark which is a unique combination of the Applicant's corporate brand "MTN" and the word "ADS";
 - b. the letters "M", "T", "N", "A", "D" and "S" individually are unlikely to become essential features of the trade mark as a whole;
 - c. the letters "M", "T", "N", "A", "D" and "S" are not descriptive of the goods and services covered by the application;
 - d. it is obvious that no exclusive rights can be obtained in the letters "M", "T", "N", "A", "D" and "S" on their own; and
 - e. there is no need for a specific disclaimer to be entered against the application for the individual letters "M", "T", "N", "A", "D" and "S"
6. That the Applicant has recently lodged applications to register its MTN ADS trade mark in several countries including Mauritius, Nigeria, Rwanda, Uganda and the United Arab Emirates and the same have all been accepted for publication.
7. That while the Applicant acknowledges that the Registrar in Kenya need not be bound by the decisions of other trade marks offices, this information is evidence of the fact that the mark has been deemed registrable without this condition in three countries.

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 25th October 2024 requested the Applicant to disclaim the right to the exclusive use of the letters "M", "T", "N", "A", "D" and "S" each 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 in the Industrial Property Journal with or without a disclaimer of the letters "M", "T", "N", "A", "D" and "S" each 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.

In *Paco Holdings Ltd and opposition thereto by Paco Rabanne Parfums [1999]*, the Registrar's Principal Hearing Officer was of the view that the entry of the disclaimer should be regarded as an admission by the proprietor that the disclaimed matter is not to be regarded distinctive as in itself, of the trade origin of the proprietor's goods or services.

The Applicant has in its submissions at Paragraph 3.4 indicated that it is obvious that no exclusive rights can be obtained in the letters "M", "T", "N", "A", "D" and "S" on their own.

The purpose of a disclaimer is to specify the non-distinctive element(s) within a mark that is non-registrable standing alone, and limit the scope of protection of the mark as a whole without separate protection of the non-distinctive element(s)¹.

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 registration of the Applicant's mark should not operate to inhibit the use by others of the elements to be disclaimed. The exclusive rights should subsist in the mark as a whole. It is my view that the letters "M", "T", "N", and the word "ADS" should not be used by the Applicant to the exclusion of other traders dealing with goods and services in classes 9, 35, 38 & 42 of the International Classification of Goods and Services.

I have perused the Register of Trade Marks and note that there are other "MTN" trade marks which have been previously registered with the disclaimer of the letters "M", "T" and "N" each separately and apart from the mark as a whole as follows:

No.	T.M NO.	Trade Mark	Class(es)
1.	69696	MTN (word) Registered with a disclaimer of the letters "M", "T" and "N"	9, 35, 36, 38 and 42
2.	69697	MTN (word & device) Registered with a disclaimer of the letters "M", "T" and "N"	9, 35, 36, 38 and 42

As relates to the word "ADS", there are trade marks registered with disclaimers as follows:

1.	126905	JOURNEY ADS (word) Registered with a disclaimer of the word "ADS"	35 and 42
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¹ <https://www.so-ipr.com/S-O-IP-I-HOME/insight/publications/trademark-disclaimer-practice-vietnam-lawfirm-ip-prosecution>

2.	107748	APPLE SEARCH ADS (word) Registered with a disclaimer of the word “ADS”	35
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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 “MTN ADS”, TMA No. 135570 shall not proceed to publication in the Industrial Property Journal without entry of disclaimers of the letters “M”, “T”, “N”, and the word “ADS” each separately and apart from the mark as a whole.
2. The Examiner’s report dated 25th October 2024 requiring the Applicant to disclaim the right to the exclusive use of the letters “M”, “T”, “N”, “A”, “D” and “S” each separately and apart from the mark as a whole is hereby upheld in so far as it required the disclaimer of the letters “M”, “T” and “N.

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 4th March 2025



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CONCILIA WERE

ASSISTANT REGISTRAR OF TRADE MARKS