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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. 126774  **(WORD**
& DEVICE) IN CLASS 3

IN THE NAME OF INDIGO BRAND HOLDINGS PROPRIETARY LIMITED

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

BACKGROUND

On 3rd March 2023, Indigo Brand Holdings Proprietary Limited (hereinafter referred

to as “the Applicant”) filed an application to register the mark  (word & device), T.M.A No. 126774. The application was filed in respect to goods in class 3 of the International Classification of Goods and Services as follows:

Class 3: Non-medicated cosmetics and toiletry preparations; non-medicated dentifrices; perfumery, essential oils; bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations.

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 5th March 2024, the Trade Marks Examiner issued an invitation to correct trade mark application indicating that the application is seen to be consisting of two separate marks. The

Examiner requested the Applicant to avail the amended copies of the mark that will be treated as one mark to enable the conclusion of the examination of the application.

On 4th June 2024, the Applicant filed written submissions against the Trade Mark Examiner's invitation to correct the application and submitted inter alia as follows:

1. That the Trade Mark Examiner has not provided the Section of the Trade Marks Act, or the specific Rule under the Trade Marks Rules, under which the request is made.
2. That the Examiner should take into account how the mark, as filed, is currently being used in the trade. Each mark consists of a word and logo element that should be viewed as a whole.



3. That the Applicant offers to enter the following blank space endorsement against the application:
"The applicant undertakes that, in use, the blank space appearing in the mark if occupied, will be occupied only by matter of a descriptive or non-distinctive character or by a trade mark registered in the name of the applicant in respect of the same goods, or by a trade mark of which the applicant is the registered user or licensee, in respect of the same goods or by a trade mark of a registered user or licensee with the consent of the proprietor of such mark, or the blank space will be left blank"
4. That the purpose of the proposed endorsement is to ensure that the trade mark will not be used in a manner which will cause deception and confusion in the marketplace.

5. That in South Africa, this is a standard request made by the Registrar, in respect of applications comprising nude labels, packaging or marks which have prominent blank spaces, which could be filled with other trade mark matter.
6. That the Applicant has applied for the mark in: Botswana, Ghana, Namibia, South Africa, Malawi, Mozambique, Mauritius, Maldives, Rwanda, Seychelles, Uganda, Angola, Madagascar, Zanzibar, Zambia and Zimbabwe. None of the respective Registries saw the marks as comprising two separate elements.
7. That the Applicant has registered rights in respect of the mark in Botswana, Namibia, Malawi, Mozambique, Mauritius, Maldives, Rwanda and Madagascar.
8. That the trade mark registrations owned by the Applicant in other countries have persuasive value in this instance.
9. That it is the Applicant's humble submission that the Proposed Mark be allowed to proceed to advertisement and subsequent registration on the proposed basis.

RULING

I have studied the documents on record and considered the Applicant's submissions against the Examiner's invitation to correct trade mark application. I am of the view that the issue for determination is whether the Applicant's application should proceed to further examination as is or as requested by the Examiner.

The Registrar of Trade Marks may accept an application for registration of a trade mark subject to certain conditions, amendments or modifications.

In considering the mark in question, the elements "I ♥" and "i LOVE Candy" are vertically arranged and in my view, they form a cohesive visual and conceptual expression. Although there is a blank space between the elements forming the mark, when considered as a whole, the representations communicate a single idea which the average consumer would interpret as a unified source identifier.

It is my opinion that the said mark should be allowed to proceed for further examination as per the application filed. I have taken note of the practice in South Africa. However, I am of the view that trade marks should be used in the market as

registered and the Applicant should therefore use the mark in the market as registered to avoid causing any confusion or deception in the marketplace.

The Applicant annexed copies of registration certificates and publication notice from different jurisdictions. This is however not binding upon the Registrar of Trade Marks in Kenya.

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 Mark Examiner's report dated 5th March 2024, is hereby revoked.



2. The Applicant's application for the registration of the mark (word & device), T.M.A No. 126774 is hereby allowed to proceed for further examination.

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 7th day of April 2025

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CONCILIA WERE

ASSISTANT REGISTRAR OF TRADE MARKS