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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. 129310 “THE ART OF MUSIC”
(WORD & DEVICE) IN THE NAMES OF ELIZABETH WAMUNI NJOROGI AND IRENE NJOKI
MUKIRI**

RULING BY ASSISTANT REGISTRAR OF TRADE MARKS

BACKGROUND

On 4th August 2023, Elizabeth Wamuni Njoroge and Irene Njoki Mukiri, (hereinafter referred to as “the Applicants”) filed an application to register the mark “THE ART OF MUSIC”, T.M.A No. 129310. The application was filed in respect to goods and services in classes 16 & 41 of the International Classification of Goods and Services as follows:

Class(es)	Goods/Services
16	Calendars, printed matter, books, stationery
41	Organization and presentation of live performances of music and other cultural events; Entertainment and entertainment services; orchestral services; music composition services; education, training and instruction services; vocational guidance in conjunction with education and training advice.

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 September 2023, the Trade Marks Examiner issued a refusal notice indicating that the mark had been refused registration on the grounds that **it lacks essential elements as provided for under Section 12 (a, b, c, and d) of the Trade Marks Act. That Although the mark consists of figurative elements that confer upon it a degree of stylisation, they do not endow the mark as a whole with any distinctive character hence the sign is not capable of performing the essential function of a trade mark which is to distinguish the goods and services of one undertaking from those of other undertakings.**

On 6th October 2023, the Applicant filed written submissions against the Trade Marks Examiner's refusal notice and submitted inter alia as follows:

1. The Applicants agree to enter disclaimers for the words "ART" and "MUSIC" each separately and apart from the mark as a whole.
2. That a trade mark is registered on the basis that it is distinctive and can therefore distinguish the goods and services of one undertaking in comparison to the goods and services of another undertaking without causing any confusion.
3. That the Applicants' mark has met the conditions prescribed under Section 12 of the Act, in that its mark has the requisite distinctive character to identify the goods and services on which the Applicants' mark is to be applied as originating from the Applicants' and consequently, to distinguish them from the goods and services of other undertakings. That the Applicant's mark is registrable on the basis that it is unique, distinctive and invented mark.
4. That the accepted rule applied by the Kenya trade marks registry and confirmed in rulings by different Registrars and Assistant Registrars of Trade Marks is that in examining a mark the Examiner must consider the mark as a whole and not split up its different words and elements.
5. That the Applicants' mark when considered as a whole individualises the goods and services of the Applicants, is inherently distinctive and is adapted to distinguish the goods and services of the Applicants from the goods and services of other undertakings. The fact that the Examiner has not cited any

similar registered marks in classes 16 and 41 against the Applicants' mark confirms this.

6. That 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 similar trade mark upon or in connection with their own goods or services.*
7. That the Applicants see no reason why any other traders would be likely to desire to use, an identical or closely similar mark for their goods and services unless with an improper motive. Therefore, no trader will be unfairly disadvantaged by the exclusive registration of the Applicants' mark in favour of the Applicants for the goods and services in classes 16 and 41 which are covered by the specification under the Application.
8. That paragraph 532 of the KIPI Trademarks Manual of Examination procedures (KIPI Manual) provides that *a mark is said to be inherently distinctive if by virtue of use, it does not disable competitors from describing their goods or services nor deplete the language of terms necessary to provide information about the goods or services...*
9. The Applicants submitted that the Applicants' mark if registered would not disable the Applicants' competitors from describing their goods and services and for this reason the examiner cannot justifiably regard the Applicants' mark as lacking distinctiveness.
10. That in **Scandecor developments AB v Scandecor Marketing AV and others and One Other Action [2001] UKHL 21 (4th April, 2001)** it was stated that *...the function of a trade mark is to distinguish goods having one business source from goods having a different business source. It must be 'distinctive'. That is to say, it must be recognisable by a buyer of goods to which it has been affixed as indicating that they are of the same origin as other goods which bear the mark and whose quality has engendered goodwill."*
11. The Applicants submitted that their mark as a whole has the requisite distinctive character in relation to the goods and services in classes 16 and 41

for which it is to be applied and it is capable of distinguishing the Applicants' Mark from the marks of other undertakings.

RULING

I have considered the documents on record including the Applicants' Written Submissions against the Examiner's refusal notice.

I am of the view that the issue for determination is whether the Applicants' mark has the essential elements for registration as provided for under Section 12 (a, b, c and d), and therefore registrable as a trade mark.

The provisions of Section 12(1) of the Trade Marks Act provide as follows:

- 1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars-
 - (a) the name of a company, individual or firm, represented in a special or particular manner;
 - (b) the signature of the Applicant for registration or some predecessor in his business;
 - (c) an invented word or invented words;
 - (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
 - (e) any other distinctive mark, but a name, signature or word or words, other than such as fall within the descriptions in paragraphs (a), (b), (c), and (d), shall not be registrable under this paragraph except upon evidence of its distinctiveness.

As indicated above, the provisions of Section 12(d) of the Trade Marks Act provide that for a trade mark to be registrable in part A of the register, the mark should be a word or words having no direct reference to the character or quality of the goods,

and not being according to its ordinary signification a geographical name or a surname.

Section 12 (2) of the Trade Marks Act provides that ‘distinctive’ means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connexion subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration and in relation to services means to distinguish services with the provision of which the proprietor is or may be connected in the course of business, from services the provision of which he is not so connected.

The primary function of a registered trade mark is that of an indicator of origin and hence acts a guarantee of the quality for the consumer. This view was set out in the case of *Arsenal Football Club v. Matthew Reed (2003) CMLR 481* in the following words:

“..... the essential function of a trade mark is to guarantee the identity of origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin.”

In the case of *Koninklijke Philips Electronics v. Remington Products Ltd (2002)* the ECJ stated that the distinctive character of a mark must be assessed in relation to the goods or services in respect of which registration is applied for. The ECJ also stated that only marks having a distinctive character by their nature or by the use made of them are capable of distinguishing their goods from the goods of other undertakings and thereby capable of registration.

The distinctive character of the Applicants’ mark, “**THE ART OF MUSIC**” must therefore be assessed in relation to the goods and services which the Applicants seek to register, which in this case are goods in class 16 and services in class 41 of the International Classification of Goods and Services.

I am aware that in the examination of trade marks the marks have to be considered as a whole. I will however define the Words “Art” and “Music” separately to understand the meaning of those words.

According to the Cambridge Online dictionary, “Art” means *the making of objects, images, music, etc. that are beautiful or that express feelings*. It could also mean *the activity of painting, drawing, and making sculpture*.

As for the word “Music”, the Cambridge Online Dictionary indicates it as *a pattern of sounds made by musical instruments, voices, or computers, or a combination of these, intended to give pleasure to people listening to it*.

I have perused the Register of Trade Marks and note that there are other trade marks consisting of the words “ART” and “MUSIC” which have been registered. The Registrar of Trade Marks has previously asked for disclaimers of the words “ART” and “MUSIC” in respect to goods and services in classes 16 and 41. I wish to cite a few of the said marks that are registered subject to entry of disclaimers of the words “ART” and “MUSIC” as follows:

No.	T.M NO.	Trade Mark	Class(es)
1.	58027	<i>THE BEST MIX OF MUSIC (word) Registered with a disclaimer of the word “MUSIC”</i>	16, 35, 38 and 41.
2.	65003	<i>ENNOVATOR MUSIC (word) Registered with a disclaimer of the word “MUSIC”</i>	41
3.	69507	<i>DANCE MUSIC (word & device) Registered with a disclaimer of the word “MUSIC”</i>	9, 16, 25, 35, 38
4.	66032	<i>KENYA LITERATURE BUREAU ALPHA MUSIC AND MOVEMENT ACTIVITIES (word & device) Registered with a disclaimer of the word “MUSIC”</i>	16

5.	135308	<i>ART OF LUXURY(word) Registered with a disclaimer of the word “ART”</i>	14, 16, 25
6.	72688	<i>ART LIFE (word & device) Registered with a disclaimer of the word “ART”</i>	41
7.	94231	<i>ART AND FASHION MEETS PHOTOGRAPHY (word & device) Registered with a disclaimer of the word “ART”</i>	41

In the submissions filed, the Applicants have indicated that they agree to enter disclaimers for the words “ART” and “MUSIC” each separately and apart from the mark as a whole.

It has been observed in a number of cases, that the purpose of a disclaimer is to delineate the rights of the trade mark holder and not to confer a monopoly of the disclaimed elements. A disclaimer actually informs the other traders in a similar trade that they are free to use the disclaimed element(s) of the mark.

It is my view that other traders of goods and services in classes 16 and 41 would in the course of their businesses and without any improper motive desire to use the words “ART” and “MUSIC” in connection with their goods and services.

I have taken note of the stylization that is applied on the words “Art” and “Music”.

For the above-mentioned reasons and having taken into account all the circumstances of this case, I hereby rule as follows:

1. The Trade Mark Examiner’s refusal notice dated 5th September 2023 is hereby revoked.
2. The Applicant’s application for registration of the mark “THE ART OF MUSIC”, T.M.A No. 129310 (word & device) in classes 16 & 41 of the International Classification of Goods and Services shall only be allowed to proceed to publication in the Industrial Property Journal subject to the entry of

disclaimers of the words “ART” and “MUSIC” each separately and apart from the mark as a whole.

3. The Applicant is required to file Form TM 19 and pay the requisite fees to make the said amendments as relates to the disclaimers.

The Applicant should however note that these proceedings 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 5th day of March 2025



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CONCILIA WERE
ASSISTANT REGISTRAR OF TRADE MARKS