



THE REPUBLIC OF UGANDA

IN THE MATTER OF TRADEMARK APPLICATIONS NOS. 2021/73609 MOMEASY (AND LOGO) IN CLASS 10 AND 2021/73610 MOMEASY (AND LOGO) IN CLASS 21 IN THE NAME OF MOMEASY ENTERPRISES LTD AND OPPOSITION THERETO BY PROCTER AND THE GAMBLE COMPANY

PROCTER & GAMBLE COMPANY :.....OPPONENT

VERSUS

MOMEASY ENTERPRISES LTD :.....APPLICANT

RULING

BEFORE: BIRUNGI DENIS: ASST. REGISTRAR TRADEMARKS


Representation


Mr. Brian Kajubi of MMAKs Advocates, Counsel for the opponent

Dr. Anthony C.K. Kakooza of Byenkya Kihika and Co Advocates



A. BACKGROUND

1. This is a consolidated opposition to trademark applications number 2021/73609 Momeasy (and logo) in class 10 and 2021/73610 Momeasy (and logo) in class 21 in the name of Momeasy Enterprises Ltd.
2. The applicant applied for trademark 73610 and 73609 on 29 November 2021. The gazette notices were subsequently issued and published in URSB Journal No. URSB.IP.2021.031. The opponent objects to the registration of both marks. The opposed marks are indicated below;



Trademark No.	Representation	Class	Goods
UG/T/2021/073609	 Momeasy	10	Baby feeding bottles, water bottles & pacifiers; baby teethers & sterilisers; thermometers

UG/T/2021/073610	 Momeasy	21	Baby powder puff, training cups; bottle brushes, hair brushes & combs; feeding bowls & powder milk containers.
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3. The opponent is the proprietor of trademark numbers 40041 in class 5, 45747 in class 3 and 45748 in class 5, 045749 in class 3 and 45750 in class 5. The opponent filed oppositions objecting to the registration of the applicant's marks on grounds that they are confusingly similar to its own trademarks. The opponent's trademarks are indicated below;

No	Trademark No.	Representation	Class	Goods
1.	UG/T/2012/045750		5	Disposable diapers made of paper and/or cellulose
2.	UG/T/2012/045749		3	Pre-impregnated wipes made of paper and/or cellulose.



3.	UG/T/2009/040041 ¹		5	Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.
4.	UG/T/2012/045747		3	Pre-impregnated wipes made of paper and/or cellulose.

¹ While the opponent in its grounds of opposition and submissions, indicates this trademark to be registered in class 16 for paper products for household and sanitary use, the registry record shows it is registered in class 5 for the goods indicated in the table above. The Registrar will accordingly consider the official record.



5.	UG/T/2012/045748		5	Disposable diapers made of paper and/or cellulose.
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4. The opponent is an American multinational company specializing in manufacture and sale of personal care and hygiene goods including baby care products such as pre-impregnated wipes and disposable diapers. The opponent is also the proprietor of PAMPERS trademark used in relation to disposable diapers since 1960. The same trademark is used for baby wipes. The opponent contends that its PAMPERS trademark and heart rayed-logo  is an original, artistic work within the meaning of section 5 (1) of the Copyright and Neighboring Rights Act, 2006 and that the opponent has copyright over the individual components of the mark.
5. The applicant on the other hand is a company limited by shares incorporated under the laws of Uganda as a subsidiary of Guangzhou Ideal Houseware Co.Ltd. Guangzhou Idea Houseware Co. Ltd is a Chinese company, which holds the international registration for  mark under registration number 1153411 and is the parent company to the applicant company. The applicant company is authorized by its parent company, to make the opposed trademark application in Uganda.
6. The opponent objects to the application for registration of the applicant's marks as shown in paragraph 3.

B. ISSUES

7. When advocates for both parties appeared before me for scheduling on the 27th April 2023, the following issues were agreed for consideration;
 - I. *Whether the applicant's marks are confusingly similar to the opponent's registered trademarks?*
 - II. *Whether the applicant's marks are sufficiently distinctive to distinguish the applicant's mark from those of the opponent?*
 - III. *Whether the applicant's applications were made in bad faith?*
 - IV. *Remedies*



C. ANALYSIS.

1. ***Whether the applicant's marks are confusingly similar to the opponent's registered trademarks?***



8. In his written submissions, Counsel for the opponent contends that the applicant's trademarks are confusingly similar to the opponent's marks and hence there is a likelihood of confusion. Confusing similarity is determined by conducting a global assessment of a series of factors, including the degree of recognition of the mark, the association the public might make between the disputed marks, the degree of similarity between the signs and the goods, among others. Counsel cited the authority of **Canon Kabushiki Kaisha and Metro-Goldwyn-Meyer Inc. Case No C-39/97** where the European Court of Justice held that:

"a global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trademarks and between these goods or services. Accordingly, a less degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks and vice versa"


9. The opponent, it is contended, owns prior registered trademarks in Uganda, containing a heart-rayed device; that these marks are of distinctive character, are well known in relation to the opponent's goods that are intended for use for babies and young children.
10. Regarding similarity between the opponent's and the applicant's marks, Counsel refers to a side-by-side comparison as demonstrated in the statutory declaration in support of the opposition, and submits that there is similarity between the applicant's and the opponent's marks. This assessment, as per the case of **Sabel v Puma AG (1998) RPC 199**, considers the disputed marks visual, phonetic and conceptual similarity, looking at overall impression created by the marks and bearing in mind their distinctive and dominant components. The category of goods, and the manner in which they are marked and sold, is a critical factor to consider in this assessment.
11. Counsel supported the above arguments with the authority of case No. **9049/2022: The Procter and the Gamble Company v Madiscom**, decision of the Moroccan Commission, whose facts are similar to the current facts. In that case, the



Commission ruled that MOMEASY is not distinguishable from the opponent's mark because of the inclusion of the heart-rayed device, owned by the opponent.

12. In these proceedings, it is submitted that the location of the heart-rayed device at the beginning of the applicant's  trademark is intended to cause confusion with the applicant's products. Counsel contends that the remaining words "OMEASY" are disproportionate in size compared to the heart-rayed device at the beginning and hence should be considered negligible in the assessment of likelihood of confusion. To augment this argument, Counsel cites the authority **EL CORTE INGLES, SA V OHIM, Case T-183** for the proposition that attention of the consumer is usually directed to the beginning of the word.
13. It is also argued for the opponent, that goods of the applicant, and those of the opponent, are similar and have the same end users. Counsel relied on the case of **Canon Kobushiki (supra)**, where other factors to be considered in assessment of similarity of two marks, were held to include; the nature and use of the respective goods, the goods' end-users and whether or not the goods are in competition with each other. For the applicant, the goods applied for are baby care products. Counsel for the applicant submits that these goods are in direct competition with the opponent's goods and hence will cause confusion in the market.
14. For the applicant, it is submitted that the get up of the applicant's marks is different from those of the opponent. The opponent's focus on the heart-rayed device as the dominant element likely to cause confusion is denied. Instead, Counsel for the applicant avers that the applicant's  trademark should not be assessed based on the heart-rayed device alone. First, it is denied that the applicant uses a heart-rayed device and hence the applicant's mark cannot be divided into portions to be analyzed, but should rather be looked at as a whole and that when looked at as a whole, the trademark is not confusingly similar. Counsel referred to the writing in *Kerly on Trademarks (13th Edition)* at page 609, para 609, which states that;






"The trademark is a whole thing—the whole picture in relation to each of the marks being compared has to be considered. There may be differences in the part of each mark, but it is important to consider the mode in which the parts are put together and to judge whether the dissimilarity of the parts or parts is enough to make the whole dissimilar". Other cited authorities in support of this proposition include Erectico case, **Eletrolux Ld. V. Electrix Ld.** and another (1954)71.R.P.C.23 at p.40 and **Sabel BV. Puma AG, Rudolf Dassler Sport** CASE C-251/95 all supporting the view that likelihood of confusion is based on the mark as a whole taking into account their distinctive and dominant components. It is therefore submitted that the distinctiveness of the applicant's  mark lies in the whole of it as represented and that the fact that the first letter of the applicant's mark bears similarity with the opponent's heart-rayed device, is insufficient to cause confusion.

15. Secondly, Counsel for the applicant submits that there is no dominant element in the applicant's marks likely to cause confusion with the opponent's marks and hence the marks should be considered as a whole.
16. Third, is submitted that the risk of confusion arises where there is a possibility that customers buy one product believing it to be the other (direct confusion) or buy a product believing that it has a different commercial source (indirect confusion). The authority of **Sabel BV. Puma Ag** is cited for the proposition that likelihood of confusion is to be appreciated globally taking into account factors relevant to the case and includes a global appreciation of the visual, aural or conceptual similarity—based on overall impression given by the marks, but always bearing in mind their distinctive and dominant components. The perception of the marks in mind of the average consumer plays a decisive role in global appreciation of likelihood of confusion and that the average consumer normally perceives a mark as a whole and does not analyze its various details.
17. Based on the above authorities, Counsel submits that an average consumer would not look out for letter "M" at the beginning of the applicant's mark but rather the whole trademark. In response to the authority of the Moroccan Commission relied on by Counsel for the opponent, Counsel for the applicant submits that the



applicant's mark is successfully registered in China, United Kingdom, Kenya, Algeria, Tanzania, Indonesia, Russia, Cambodia, Peru, Philippines and Spain, and that a similar challenge by the opponent in the Republic of Cambodia was dismissed. Consequently, Counsel argued that the applicant's mark has a global appreciation in the same countries where opponent's heart-rayed device is existing.

18. Counsel further submits that the applicant's and the opponent's products are different and appear in different classes of the NICE Classification of Goods and Services. The opponent's ,  and  marks are in 3, 5 and 16 of the NICE Classification of goods and services covering disposable diapers, pre-impregnated wipes made of paper/and or cellulose, and paper products for household or sanitary use. The applicant's trademark on the other hand is under class 10 and 12 relating to household or kitchen utensils and containers, combs and sponges, brushes and brush making materials. It is argued that this is a different classification incapable of causing confusion.

2. Whether the applicant's marks are sufficiently distinctive to distinguish the applicant's mark from those of the opponent

19. On this issue, Counsel for the opponent contends that the applicant has failed to prove that their marks are not similar to the opponent's registered trademarks and that consequently, the applicant's trademarks lack distinctiveness. Counsel also submits that the applicant has failed to prove that it has rights in the trademarks it has applied to register. The basis of Counsel's arguments seems to be that because a different company owns the trademark in other countries, as per the applicant's evidence, then the applicant has no proprietary rights in it. In stressing the argument for lack of distinctiveness, Counsel avers that it is premised on whether there is a likelihood of confusion or deception and concludes that the applicant's mark fails the tests in section 25 and 23 of the Trademarks Act, 2010. For clarity, section 23 prohibits a registrar from registering a mark that is likely to deceive or would be



contrary to law, morality or any scandalous design. Section 25 on the other hand prohibits registration of identical or nearly resembling marks.

20. In reply, Counsel for the applicant submits that the applicant's mark is presented by **MOMEASY ENTERPRISES LTD**, the name of the company presenting the mark and that the words MOMEASY and the color combination are sufficiently and inherently distinctive and adapted to distinguish the applicant's goods from those of the opponent, within the meaning of section 9 of the Trademarks Act, 2010. To support this view, Counsel relied on the case of **Smith Kline and French and French Laboratories Ltd v Sterling—Winthrop group Ltd [1975] All ER page 578-586** where Lord Diplock stated that;

"The color combination have thus been shown by undisputed evidence to serve the business purpose of a trademark. They do precisely what a trademark is meant to do: they indicate to potential buyers that the goods were made by SKF and not by any other manufacturer". Counsel adds that in accordance with the principle in the case of **Pianotist Co's Application (1906) 23 RPC 774**, a side by side comparison of the applicant's and the opponent's marks would show that the applicant's mark is sufficiently distinctive to distinguish the applicant's goods from the opponent's goods which are in different classes.

21. As to the rights over the trademark, it is contended that the applicant is the authorized promoter, seller and importer of products from Guangzhou Ideal Houseware co. Ltd—the internationally registered holder of the mark. Consequently, it is argued that the applicant is a permitted user within the meaning of section 49 (1) of the Trademarks Act, 2010.

Issue 3: Whether the opposed application was made in bad faith?

22. Counsel for the applicant submits on the authority of section 23 of the Trademarks Act, 2010 that the applicant brought this application in bad faith. He also cites the authority of **Chicoladefabriken Lindt & Sprungli AG v Franx Hauswirth GmbH C-529/07**. The case sets the criteria for assessing bad faith in trademark disputes. The factors to consider are; (i) the applicant's knowledge of the opponents mark; (b)



the intention of the applicant; (c) the extent of the reputation enjoyed by the mark applied for. Counsel submits that these principles apply to this case in as far as the opponent has earlier rights to a heart-rayed device, has acquired reputation with the mark associated to its products and that the inclusion of a heart-rayed device on the applicant's mark is ill-intentioned and dishonest commercial behavior. Counsel has cited the case **Gromax Plasticulture Ltd v Don & Low Non Wovens Ltd (1999) RPC** defining bad faith "*as dishonesty and dealings that fall short of the standards of expected commercial behavior*". The opponent contends that the applicant uses its heart-rayed device different from the way it appears and has attached images of the applicant's products to prove intention to cause confusion. At paragraph 4.7 of the supporting statutory declaration, the applicant adduces images of the applicant's use of the mark on its website, which shows images of red hearts placed on different parts of the applicant's baby products. The opponent alleges that hearts appearing on the applicant's products are calculated intentionally to cause confusion with its products.

23. For the applicant, it is submitted that the basis for determining bad faith, is the intent of the applicant in applying for the trademark. Counsel disputes the opponent's claims that its marks are well known and that because of this, the applicant intended to ride on its well-established reputation. Counsel instead submits that protection for well-known marks is available only if the opponent falls within the parameters of section 47 of the Trademarks Act. In absence of this, Counsel submits that the opponent does not meet the requirements of section 47 (2) regarding protection of well-known marks.

D. DETERMINATION

24. I have read the grounds of opposition, the counterstatement, the evidence filed and the parties' submissions. I will now proceed to assess whether the opponent meets the criteria set out under the law to succeed with this opposition.

Issue 1; Are the applicant's marks are confusingly similar to the opponents registered trademarks?

25. First, the opponent must prove satisfactorily that the opposed marks are *identical* with or *nearly resembles* a trademark, which is already registered. Factors to



consider in assessing similarity of trademarks and likelihood of confusion were exhaustively set out in the case of *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] EWCA Civ 24 that adopts, with approval, a useful guide developed by the United Kingdom Trademark Registry to determine identity and likelihood of confusion. I will reproduce it extensively below;

- a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
- f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;



- h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;
- i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.

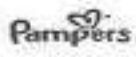


26. In examining the degree of similarity between the applicant and the opponent's marks I find the test propounded by Parker J in *Pianotist Co's application (1906) 23 RPC 774 at page 777 line 26* very persuasive and I hereby adopt it. It states; ***"You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy these goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trademarks is used in a normal way as a trade mark for the 10 goods by the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be confusion - that is to say, not necessarily that one man will be injured and the other gain illicit benefit, but there will be a confusion in the minds of the public which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse registration in that case"*** (emphasis mine).

27. In this case, the disputed marks are indicated below side by side in a manner in which they are applied to the products in the market.



Applicant's trademark	Opponent's trademark
	

28. The applicant's mark is sought to be registered in classes 10 for baby feeding bottles, water bottles & pacifiers; baby teethers & sterilisers; thermometers and class 21 for Baby powder puff, training cups; bottlebrushes, hairbrushes & combs; feeding bowls & powder milk containers. The opponent's marks on the other hand are

, , and  in 3, 5 and 16 of the NICE Classification of goods and services covering disposable diapers, pre-impregnated wipes made of paper/and or cellulose, and paper products for household or sanitary use. The applicant's mark is an artistic presentation of the word "Momeasy", with orange, green and blue colors. Two dominant characters exist in the mark in dark blue color. These are; letter "M", designed in a heart-like format with three rays on top and letter "Y" with a long "tail" connecting to the point of letter M. The remaining characters are presented in shades of yellow, orange and light green colors. On the other hand, the opponent's marks include an artistic drawing of the word 'Pampers' with a heart rayed device on top of it in class 3, a heart-like device with four rays and another with 3 rays, in class 5 and 16. While on the register, the opponent's heart-rayed marks appear in black, in the marked they are presented in yellow and orange as indicated above. The Pampers mark is presented in light blue color, with a yellow three-heart rayed device on top. The applicant has the word Momeasy, with three yellow shades, while the opponent's marks are presented in yellow, orange, with the Pampers mark, that has both light blue and yellow. Visually and phonetically, the opponent's marks are distinguishable from the applicant's mark.

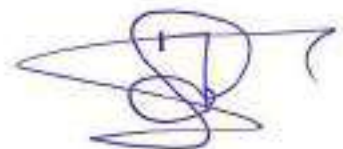
29. What is disputed is the design of letter "M" because of its resemblance with the opponent's heart-rayed devices. While there is some resemblance in the applicant's






letter "M" with the opponent's heart rayed-devices, the principle is that a trademark is not examined by looking at one component alone. A trademark is assessed as a whole. Each component must be looked at to get the overall impression. Authorities have stated however, that this does not mean, that one may not first examine each of the individual features of the get-up of the mark in turn and that it may be useful, in the course of the overall assessment, to examine each of the components of which the trade mark concerned is composed of. (see *Case C-286/04 P Eurocermex v OHIM [2005] ECR I-5797, paragraphs 22 and 23*). While an assessment of individual components is permissible, the purpose is to get an overall impression created by the mark for conclusive determination.

30. A key feature of the of the applicant's  trademark are the color combinations. Colors form part of a trademark. In assessing similarity and likelihood of confusion, colors cannot be ignored. I agree with the principle in the case of *Smith Kline and French laboratories Ltd (SKF) vs. Sterling Winthrop Group Ltd [1975] 2 All ER 578*, cited by Counsel for the applicant, where Lord Diplock stated that;

"The colour combinations have thus been shown by undisputed evidence to serve the business purpose of a trade mark. They do precisely what a trade mark is meant to do: they indicate to potential buyers that the goods were made by SKF and not by any other manufacturer". He added, *"My Lords, I see nothing in this context that requires one to exclude from the definition of 'trade mark' a mark which covers the whole of the visible surface of the goods to which it is applied. Such a mark is as capable of indicating a connection in the course of trade between the goods and the proprietor of the mark as it would have been if it had only covered half or three-quarters of the visible surface. No one has been able to point to any business purpose that would be served by drawing a distinction between marks that cover the whole and those which cover part of the surface. For my part I should be loath to ascribe to Parliament an intention to do anything so irrational."*



31. The opponent focuses on a heart-rayed device portraying it as a dominant element of the marks of both the applicant and the opponent. Where a general visual, aural and conceptual assessment is inadequate to determine similarity due to the complexity of the marks, consideration of the dominant elements is recommended. In the *Specsavers International Healthcare Ltd v Asda Stores Ltd (supra)* it was noted that **"the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements"**. I do not think the circumstances for resorting to assessing solely the dominant components of the marks arise in this case. The opponent claims that its heart-rayed device is dominant and will be confused with the applicant's mark because of its letter 'M' that resembles its heart-rayed device. I do not agree with this proposition. The applicant's mark is, when analyzed as a whole, an artistic word "Momeasy" with color combinations. The letter 'M' is part of the word and cannot be separated from the mark. An ordinary person, cannot in my view, confuse  with  or  even if they were placed in the same section in a supermarket. While for the former two heart-rayed marks of the opponent are dominant themselves, they are not similar when compared to the general impression created by the applicant's mark.

32. I take note of Counsel for the opponent's submission that the degree of similarity is increased where the goods enter the mark through the same trade channels, and that the applicant's and the opponent's goods will be encountered in the baby care section of any business establishment. A guideline of the European Union Intellectual Property Office (EUIPO) which states that **"if goods are made available through the same description channels, the consumer maybe more likely to assume that the goods or services are the same sector and possibly manufactured by the same entity. However, not much of emphasis should be placed on points of sale such as supermarkets and department stores, only**



when the goods are in question are offered in the same section of such shops where homogeneous goods are sold together, will this favor." Whereas I agree with this principle, I do not think it is applicable to the circumstances of this case. First, I have already determined that there is no similarity and likelihood of confusion between the opponent's trademark and that of the applicant. While the goods of the applicant and those of the opponent are used by the same end-users and maybe found in the same section of a shop or supermarket, they are not closely similar nor are they homogeneous goods sold together. Even if they were similar or homogeneous, their respective marks are sufficient to distinguish them. It is not likely for instance, that a person intending to purchase the opponent's pampers bearing its mark, will, upon finding the applicant's goods bearing Momeasy mark in the same section in the supermarket, be confused.

33. Likelihood of confusion involves both direct and indirect confusion. Direct confusion is determined considering the close resemblance of the marks in question. Indirect confusion occurs where there is a possibility of consumers associating the goods of one entity with those of the other, where by a customer might think that the goods originate from the same manufacturer. This type of confusion may affect the decision of the consumer especially if a particular manufacturer is known for producing high quality goods. In *Cannon Kabushiki Kaisha* supra, at para 28 and 29 of the ruling, Court explained this as follows; *"Moreover, according to the settled case-law of the Court, 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 others which have another origin. For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, 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 (see, in particular, Case C-10/89 HAG GF (HAG II) [1990] ECR I-3711, paragraphs 14 and 13)".* At para 29, Court adds *"accordingly, the risk that the public might believe that the goods or services in question*



linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see SABEL, paragraphs 16 to 18)"

34. With respect to indirect confusion, the UK High Court in the case **Sazerac Brands, Llc V Liverpool Gin Distillery Limited** [2020] EWHC 2424 (Ch) at para 75, noted as follows:

*"Confusion is more likely when a trade mark is distinctive. The test is whether that association between the mark and the sign creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings. I consider that there is such a risk because the product is identical, the names have marked similarity – indicative of a possible connection between them – and because the existence of connected brands using similar names is well-known to the public. In particular, once **American Eagle 4 year old** is established and becomes more widely known than **Eagle Rare**, having been positioned by the Defendants to compete with **Jack Daniels and the like** in the mass market, it will be natural for a consumer to assume that **Eagle Rare** is a special version of **American Eagle**."*

35. The Court was considering whether the trademarks "American Eagle" and "Eagle rare", both whiskies of rare brand, are confusingly similar. The products were identical and the names had marked similarity indicative of possible connection. In this case, while Counsel for the opponents maintains that both the applicant's and the opponent's marks are baby products, in my opinion the applicant's products are different from those of the opponent and serve different uses. In **Cannon Kabushiki Kaisha** (supra) at para 23, the EU Court noted that;

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users [should read intended purpose] and their method of use and whether they are in competition with each other or are complementary."

36. While the end-users of both the applicant's and the opponents products may be the same, the applicant's goods are not similar to the opponent's goods. The



applicant's goods include baby feeding bottles, water bottles & pacifiers; baby teethers & sterilisers; thermometers, baby powder puff, training cups; bottle brushes, hairbrushes & combs; feeding bowls & powder milk containers. The purpose is also different from the opponent's goods which are disposable diapers, pre-impregnated wipes made of paper/and or cellulose, and paper products for household or sanitary use. The opponent's products are largely sanitary products for baby care while the applicant's products cover different categories including toys, baby utensils, and baby cosmetics and health care products (thermometers). The method of use of the applicant's and the opponent's products are different. It is therefore less likely that consumers would be confused by use of both marks on the applicant and opponent's goods. The first issue is therefore answered in the negative. The applicant's marks are not confusingly similar to the opponent's marks.

Issue 2: Whether the applicant's marks are sufficiently distinctive to distinguish the applicant's goods from those of the opponent?

37. The Trademarks Act, 2010 stipulates the criteria and test for registration of a trademark. Section 4, provides for protectable subject matter that qualifies to be registered as a trademark to include; (1) a sign or combination of signs, capable of distinguishing goods or services of one undertaking from those of other undertakings. (2) where a sign is not inherently capable of distinguishing the relevant goods or services, qualification for registration shall depend on distinctiveness acquired through use.
38. The test for distinctiveness has two underlying aspects—ability of the mark to distinguish goods or services of one enterprise from that of others, and two, where that ability is absent, then registration depends on the acquired distinctiveness through use. The second aspect must be proved by admission of evidence of widespread use and acquired distinctiveness.
39. Section 9 of the Trademarks Act, 2010, sets considerations for distinctiveness. It provides, in paragraph (d) that for a mark to be registered in part A, it shall contain a word or words having no direct reference to the character or quality of the goods or services, and not being according to its ordinary signification, a geographical



name or a surname. While section 9 (2) explains the meaning of distinctiveness as follows; "For the purposes of this section, "distinctive" means—

(a) in the case of a trademark relating to goods, adapted in relation to the goods in respect of which the trademark is registered or proposed to be registered, to distinguish goods with which the owner of the trademark is or may be connected, in the course of trade, from goods in the case of which no connection subsists or,

(b) in the case of a trademark relating to services, adapted in relation to services in respect of which the trademark is registered or proposed to be registered, to distinguish services with which the owner of the trademark is or may be connected in the course of trade, from services with the provision of which he or she is not connected, generally or, where the trademark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(3) In determining whether a trademark is adapted to distinguish as goods or services, the registrar or the court may have regard to the extent to which—

(a) the trademark is inherently adapted to distinguish goods or services; and

(b) by reason of the use of the trademark or of any other circumstances, the trademark is in fact adapted to distinguish goods or services."

40. Counsel for the applicant's submissions on the issue seem to be hinged on the fact that the applicant is not the original owner of the mark, it being registered and owned Guangzhou Ideal Houseware co. Ltd. In response, Counsel for the applicant submitted that the applicant is a permitted user within the meaning of section 49 of the Trademarks Act. It provides;

"Subject to this section, a person other than the owner of a trademark may be registered as a permitted user in respect of all or any of the goods or services in respect of which it is registered otherwise than as a defensive trademark with or without conditions or restriction.

(2)The use of a trademark by a permitted user in relation to goods or services with which he or she is connected in the course of trade and in respect of which for the time being the trademark remains registered and he or she is registered as permitted user, complying with any conditions or restrictions to



which his or her registration is subject, is in this Act referred to as the "permitted use".

(3)The permitted use of a trademark shall be taken to be used by the owner of the trademark and shall be taken not to be used by a person other than the owner for the purposes of section 46 and for any other purpose for which the use is material under this Act....."

41. Counsel further argues based on territoriality principle, that the international registration held by Guangzhou Ideal House Co.ltd does not affect its right to register in Uganda. I agree with both arguments—based on section 49 and the territoriality principle, that the applicant's mark does not lack the distinctiveness necessary for registration on the basis that the marks is internationally associated with a different entity.

42. I do not see how the applicant's mark fails the test of distinctiveness under section 9 of the Trademarks Act. It is neither descriptive, nor does it refer to the quality and character of the goods to which it is associated. It falls within the definition of a trademark under the Act, which is, "a sign or mark or combination of signs or marks capable of being represented graphically and capable of distinguishing goods or services of one undertaking from those of another undertaking".

43. I also take note of the fact that while the applicant's mark has been successfully opposed in Morocco in the case of the **Procter & Gamble v Madison** on grounds of similarity of the heart rayed-device, another case in Colombia—Case No. sd2021/0084794 has held otherwise due to the lack of a competitive relationships between the applicant's and the opponent's goods. As submitted by Counsel for the applicant, the applicant and the opponent's products have co-existed in different jurisdictions without causing confusion, and I have no doubt that they can co-exist in Uganda.

Issue 3: Whether the applicant's opposed trademark application was made in bad faith?

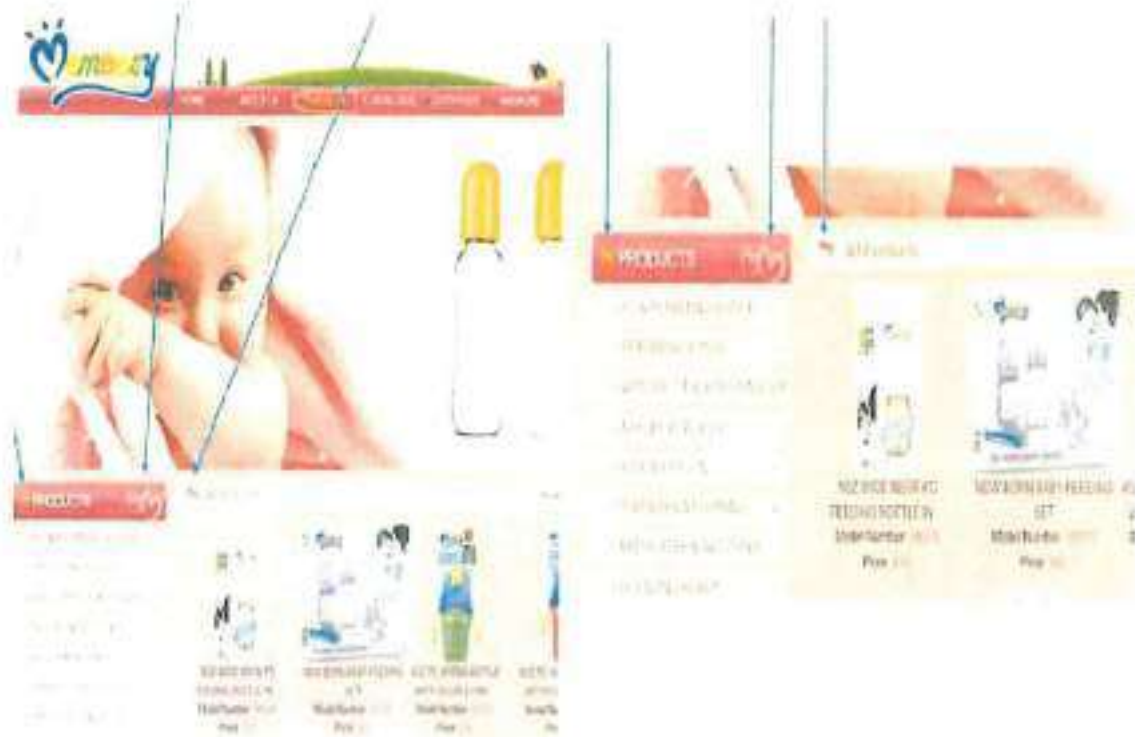
44. It is a cardinal rule of procedural law that bad faith must be specifically pleaded and proved. This includes clearly stating the particulars of bad faith in the pleading, in this case, the grounds for the opposition. The only reference to what the opponent



considers bad faith is paragraph 13 and 14 of the statement of grounds. Paragraph 13 refers to website extracts where the opponent is allaged to have used heart symbols on its products advertised on the website. Paragraph 14 states that the use of the heart-rayed device by the applicant indicates intention of the applicant to confuse the public. The statutory declaration include the same statements. The statement of grounds does not state particulars of bad faith. In proceedings of this nature, the Registrar normally adopts generally applied principles and procedures of due process applied by Courts and other tribunals in administration of justice. Bad faith, fraud, misrepresentation, breach of trust, willful default or undue influence are causes of action that are required to be specifically pleaded and proved. (*See HCT-00-CC-CS-0588 OF 2003 Robert Mwesigwa and Another v Bank of Uganda*)


45. While the opponent has not stated particulars of bad faith, I will evaluate the available evidence to whether the applicant acted in bad faith in filing for registration of the disputed marks. As submitted by Counsel for the opponent, the Trademarks Act, 2010 does not define bad faith. Guidance is therefore sought in case law. In explaining the nature of bad faith, Lindsay J in *Gromax Plasticulture Ltd v Don & Low Non Wovens Ltd [1999] RPC*, at para 47 noted: "*I shall not attempt to define bad faith in this context. Bad faith is dishonesty. Plainly it includes dishonesty and as I would hold, includes also so dealings which fall sort of standards of acceptable commercial behavior observed by reasonable and experienced men in the particular area being examined.*" Counsel for the opponent has submitted that bad faith by the applicant is inferred from applicant's use of the heart-rayed device on its products, which he says, offends section 23 of the Trademarks Act in as far as the applicant's use of the heart-rayed device is intended to deceive. Counsel has referred me to exhibits at para 13 of its grounds of opposition as well as para 4.8 of the statutory declaration. I will reproduce the images below;







46. A closer look at the images show hearts with rays in red and yellow. It is alluded that these images are extracts from the applicant's website. In paragraph 4.7 of the statutory declaration, Phillip Twum, who swore a statutory declaration in support of the opposition, states; ***"For ease of reference, that evidence, which is a screenshot of what appears to be the Applicant's official website at www.momeasy.co.ke is again set out below"***. First, by using the underlined words, the deponent is not sure whether that is the official website of the applicant or not. The evidence on that fact is therefore mere speculation, and not a confirmed fact. I have also attempted to open the link provided but the same takes me to a blank page. Second, even if the website was accessible, the domain name, ending with ".ke" appears to be a Kenyan company as .ke is the internet domain name for Kenya yet the applicant is a Ugandan company. The evidence of the screen shots cannot be verified and the exhibit is therefore not reliable.
47. As to the potential of the applicant's mark to deceive, I have already determined that the applicant's and the opponent's marks are not confusingly similar as to cause confusion. Regarding the intention of the use of the word Momeasy, the applicant has adduced evidence, and I agree, that the word is derived from its company name

Momeasy Enterprises Ltd. Albeit, this inquiry would be relevant only if the marks were found to be too similar so as to lead to a likelihood of confusion. In **Sock World International Ltd Trademark Application, R.P.C 11**, cited by Counsel for the opponent where the intention of the applicant was examined, the marks "BEKO Sport" and "BEKO" were found to be similar compared to the current ones. (See para 22). However, similarity alone and adoption of a resembling mark with knowledge of existing ones, was found not sufficient to prove bad faith. Hence at para 90 of the ruling, the Court stated; *"I have already determined that there was evidence, which was not adequately answered, that Stocks World adopted the mark in the knowledge of BEKO's marks and did so with the intention of trading off BEKO's reputation. To that extent, I have disagreed with the Hearing Officer. I am not, however, persuaded that such is either necessary or sufficient for a finding of bad faith"*. I do not see how this case supports the opponent's case as the Court reached a different conclusion having assessed all relevant factors. In absence of any cogent evidence, I am unable to find that the applicant filed this application in bad faith solely because of the use of letter "M" allegedly resembling the applicant's heart-rayed trademarks.

48. Before I take leave of this issue, let me address the opponents' arguments based on its ownership of a copyright in  logo. It is submitted that the logo is an original, artistic work within the meaning of section 5 (1) of the Copyright and Neighboring Rights Act, 2006 (CNRA) and that the opponent has copyright over the individual components of the mark. As such, registration of the applicant's mark will infringe section 46 of the CNRA. On this basis, Counsel submits that the use of the applicant's mark will be contrary to law within the meaning of section 23 (1) of the Trademarks Act and will breach Uganda's international obligations under article 6bis of the Paris Convention as well as article 16 (2) and (3) of the TRIPS Agreement.

49. First, it is doubtful whether the logo  can give rise to copyright under the Copyright Right and Neighboring Rights Act and whether the logo is sufficient to constitute copyrightable works or not under Ugandan law is not a question within my scope of inquiry. Sitting as a Registrar exercising powers under the Trademarks Act,



I do not have jurisdiction to determine whether the applicant's  mark infringes the copyright in the opponents mark, for me to arrive at the conclusion that its registration is contrary to law, within the meaning of section 23 (1) of the Trademarks Act, 2010. The best evidence that can be relied on is to submit a judicial decision that arrived at that conclusion for the Registrar to rely on in assessing whether the disputed mark is contrary to law. Allegation of copyright infringement constitute a separate dispute that requires independent judicial determination. It cannot be determined in this application. It is different from actions that, without any judicial determination, are contrary to law under section 23 on the face of it, for instance a trademark that would be used for sale of prohibited drugs. I therefore do not agree with Counsel's arguments that the opponent's ownership of copyright in the Pampers logo, would make registration of the applicant's mark contrary to law within the meaning of section 23 (1) of the Trademarks Act, 2010.

50. In conclusion therefore, I find as follows;

- (1) The applicant's trademarks are not confusingly similar to the opponents registered trademarks;
- (2) The applicant's marks are sufficiently distinctive to distinguish the applicant's goods in the market;
- (3) The applicant's trademark applications are not made in bad faith.

Issue 3: REMEDIES.

51. Having resolved the issues above, I dismiss this opposition with no order as to costs. The applicant shall proceed with registration of its trademark applications.

I so order.

Given under my hand, this 24th day of Oct 2023



Birungi Denis
Ass. Registrar of Trademark