

**RE: UGANDA - TRADEMARK APPLICATION NO. 2013/48063 NAIROBI JAVA HOUSE COFFEE & TEA AND 2013/48062 JAVA HOUSE AND JAVA SUN IN CLASS 43 IN THE NAME OF NAIROBI JAVA HOUSE LIMITED AND OPPOSITION THERETO BY MANDELA AUTO SPARES LIMITED.**

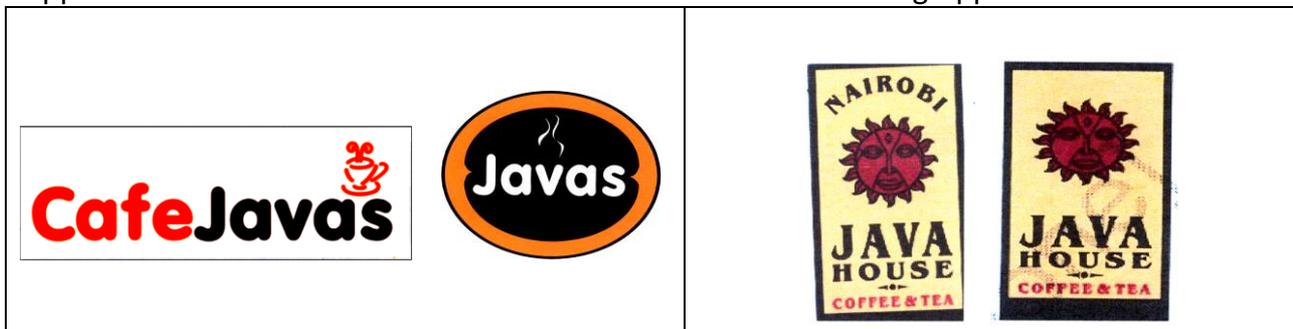
On 21<sup>st</sup> May 2015, the Registrar of Trademarks delivered a landmark ruling on descriptiveness, likelihood of confusion and concurrent use in an opposition to the registration of trademarks. MMAKS Advocates was pleased to represent the Opponent, Mandela Auto Spares Limited.

Background

The Applicant sought to register the device trademarks Nairobi Java House Coffee & Tea and Java House and Java Sun in respect of services in class 43 “the offending applications”. The Opponent is the registered owner of trademarks Café Javas in classes 30, 32, 43 and 21 and Javas in class 30 dating back 7 years ago and operates several restaurants and eateries around Kampala, Uganda. The relevant class to this opposition was class 43 in respect of; “*services for providing food; restaurant, catering services; booking and reservation services for restaurants.*” The actual marks are shown below;

Opponent’s marks

Offending Applications



The Opponent’s main ground of opposition was that the offending applications were confusingly similar to the Opponent’s earlier used and registered trademarks.

The Applicant argued that its marks were distinctive, not likely to cause confusion as the relevant consumers were of superior discernment, that the Opponent could not be allowed exclusive use of the generic word “Java” and in the alternative the trademarks were capable of concurrent use.

Registrar’s ruling:

Descriptiveness:

The Applicant submitted that the word ‘Java’ was synonymous with coffee shops and did not serve the essential function of a trademark that is to identify the origin of the services.

The Registrar held that it was not the descriptive nature of the mark that was decisive but current usage in trade sectors covering trade in the services for which the marks were sought to be registered. The word 'Java' means coffee, an Indonesian island or a computer programming language. It does not mean coffee shops nor does it describe restaurants or the relevant activity of provision of food and drink services. The word Java is used by different restaurant enterprises (in Uganda by the Opponent) to distinguish their services and not to describe them. There was no evidence to show that the consumers in Uganda perceive the word 'Java' to refer to restaurant services or that anyone apart from the Opponent had used the word 'Java' to describe their restaurant business. Java was therefore not descriptive or a generic reference to coffee shops or restaurants in Uganda.

#### Likelihood of confusion

The Opponent argued that there was likelihood of confusion considering the overall impression of the marks and similarity between the services offered by the parties. The Applicant argued that confusion was unlikely because the consumers of the relevant services had superior levels of discernment and mere association did not amount to confusion.

The Registrar held that discernment is not measured based on the consumer but rather on the services consumed. For purposes of assessing discernment, the goods or services define the consumer and not the other way around. Therefore, for basic restaurant services, the reasonable consumer was an average person. Except where the particular kind of services defined a typical consumer, middle or upper class was irrelevant. Therefore, the consumers in this case were average with average discernment necessary for the services specified.

The Registrar agreed that visually and placed side by side, the marks differed. However, there were some conceptual similarities that impacted the overall impression of the marks. Both marks had the word or letters 'Java' as a dominating element which played a very conspicuous role in the perception of the marks. As submitted by the Opponent, it was probable that its restaurants were referred to as 'JAVAS' because of the overshadowing impact of the word 'Java'. Consequently, the word 'Java' maintained a standout role in the relevant marks so much so that there was likelihood that the services of the Applicant would be associated or otherwise regarded as related with the Opponent.

However, a likelihood of association was not enough to lead to a likelihood of confusion. The Opponent led evidence to show that there were consumers who had been confused and not merely associated the Applicant's establishment and services to the Opponent. The Registrar found that the confusion of these people was reasonable to be expected on an average member of the public.

Further, the Registrar held that the lesser degree of similarity between the marks was offset by a greater degree of similarity with regard to the services. Both parties offered services in class 43 for providing food and drink. A service is perceived not only by its physical features but also through the overall impression created by the food served, the ambience, décor, menus or otherwise the standard of service, the type of service, cost of service, manner of provision of

the service and any other business practice and get-up that distinguishes the provision of essentially similar services offered by that entity from other entities. The mark then embodies these features that constitute provision of a particular service by a particular entity.

Having visited both parties' restaurants, the Registrar held that they both had similar décor, colours, sitting arrangement, mode of dining, meal prices and similar locations. In other words the surrounding circumstances in the provision of services made the establishments similar rather than different. The most outstanding difference was that the Applicant offered pork based meals while the Opponent served strictly Halal meals. However, this difference was not significant enough to distinguish the services of the parties. It was therefore reasonable that a member of the public would likely be confused as to the source of both services and in this case to the detriment of the Opponent since it was the Opponent that had built a reputation in Uganda over the years.

#### Concurrent use

The Applicant argued in the alternative that they should be permitted to register as concurrent users because of their honest use of the offending applications in Kenya for fifteen years. The Opponent insisted that relevant use should be restricted to Uganda.

The Registrar held that use was a question of fact, which was whether the mark in question was actually being used in the trademark sense. 'Use' referred to use in connection with the services provided in Uganda prior to the date on which the applications were made. There was no evidence from the Applicant of relevant use in Uganda. The principle of territoriality defeated the Applicant's argument that use and goodwill in Kenya amounted to use and goodwill in Uganda. Therefore, the question of honest concurrent use did not arise.

For the above reasons, the oppositions succeeded.

#### Conclusion:

This was a landmark ruling by the Trademarks Registry on the principles of descriptiveness, likelihood of confusion and concurrent use in an opposition. It will be expected to impact trademark registrations and the growing number of opposition hearings in Uganda.