



UGANDA REGISTRATION SERVICES BUREAU

THE TRADEMARKS ACT, 2010

**IN THE MATTER OF TRADEMARK REGISTRATION No. 48063 “NAIROBI
JAVA HOUSE” IN CLASS 43 BY NAIROBI JAVA HOUSE LTD**

AND

**IN THE MATTER OF AN OPPOSITION OF REGISTRATION BY MANDELA
AUTO SPARES LIMITED**

BEFORE: AGABA GILBERT, ASST. REGISTRAR TRADEMARKS

- 1- On the 15th September 2013, Nairobi Java House Limited (whom I shall refer to as the applicant) applied for registration in Part B of two trademarks “NAIROBI JAVA HOUSE” and “JAVA HOUSE CAFE” in class 43. The applications were allowed to be published in the gazette with disclaimers to the words “NAIROBI”, “JAVA”, “HOUSE” and “CAFE”. The applications were published in the gazette on the 30th September 2013.
- 2- On 26th November 2013, Mandela Auto Spares Limited (whom I shall refer to as the Opponent) filed a notice of opposition to the registration of the Applicant’s marks on the grounds inter alia that the Applicant’s trademarks are confusingly similar to the Opponent’s registered marks. The Opponent is the registered proprietor of trademark numbers 29297 JAVAS in class 30; 40162, 47765, 47766, 47767 all CAFÉ JAVAS in classes 30, 21, 32 and 43 respectively.
- 3- On 18th December 2013, the Applicant filed their counterstatement stating that the word “JAVA” was descriptive and that the Applicant’s and Opponent’s trademarks are distinguishable or alternatively that the Applicant’s and Opponent’s marks are capable of concurrent usage.

EVIDENCE

- 4- Both parties submitted their evidence via statutory declarations sworn by Mr. Mohammed Mohideen for the Opponent and Mr. Kevin Ashley for the Applicant.

- 5- Mr Mohideen asserted that:
 - i. The Opponent is the registered proprietor of the trademarks JAVAS and CAFÉ JAVAS hereinabove mentioned.
 - ii. The Opponent has used the marks on their restaurant establishments at various locations around Kampala for atleast six years and through continuous use they have acquired substantial reputation and goodwill.
 - iii. The Applicant's mark is confusingly similar to the Opponent's marks and is therefore, likely to cause confusion among the public. And although the Applicant's mark does not encompass all the Opponent's marks features, the marks are used in the same services as a result of which a member of the public will associate the Applicant with the Opponent's business.
 - iv. The use of the Applicant's marks takes advantage of the Opponent's reputation and goodwill and amounts to passing off; conduct that Mr Mohideen says is in bad faith.
 - v. The Applicant's marks are not well known in Uganda on account of use of said marks in Kenya.
 - vi. The Opponent exhibited printouts of online information including images of the various establishments known as Café Javas.

- 6- In response Mr. Ashley asserted that:
 - i. The Applicant is a chain of coffee houses and exporters based in Nairobi, Kenya who has been trading as Nairobi Java House for 15years and have registered their trademark in Kenya.

- ii. Java is a word synonymous with coffee shops around the world. Internet search results for the word 'Java' were submitted in support of this assertion.
- iii. The word 'Java' is not an invented word but a geographical origin.
- iv. The Opponent's and Applicant's marks are distinguishable by the kind of consumer to whom the service is targeted and therefore, no likelihood of confusion will arise.
- v. The Applicant's conduct is not in bad faith as they have been using the mark for many years in Kenya.
- vi. Alternatively, the Applicant's mark and the Opponent's marks are capable of concurrent usage.

7- In response to Mr Ashley's evidence, Mr Mohideen submitted evidence stating that there is confusion on the part of the public; first from Senyondwa Andrew Tendo who stated that he thought Java coffee and tea (the Applicant's establishment) was a branch of Café Javas, the Opponent's establishment; second was a newspaper clipping of an article in the Newvision newspaper of June 27, 2014 telling a story of a person who thought the Applicant's establishment was a branch of the Opponent.

8- In the meantime, both parties agreed that the decision in trademark application No. 48063 will be binding upon application No. 48062 which the Applicant seemed to have abandoned on account of failure to pay counterstatement fees. Nonetheless, the decision in this application will be binding upon the proceedings in TM No. 48062.

ISSUES

9- It is not in dispute that the Opponent is the registered proprietor of the marks JAVAS and CAFÉ JAVAS above mentioned. Of the Opponent's marks, trademark 47767 CAFÉ JAVAS with a device of smoking cup over the right side of the word JAVAS is registered in class 43. The Opponent claims that they have been using the marks on restaurant services; the same services for which the applicant is seeking registration of their trademark.

- 10- The Applicant seeks registration of the mark “NAIROBI JAVA HOUSE” with a device of a face in a sun. Registration for this mark is sought in respect of services under class 43 as well.
- 11- The services provided in class 43 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of Registration of Marks comprise of the following description:

Services for providing food and drink; restaurant, catering services; booking and reservation services for restaurants.

Descriptiveness

- 12- The Applicant argues that the word ‘Java’ comprised in the trademarks in issue is not capable of distinguishing the services of the Opponent because ‘Java’ has become synonymous with coffee shops and restaurants worldwide. In other words the mark does not serve the essential function of a trademark that is to identify the origin of the services.
- 13- It was held in the case of ***Rewe Zentral v OHIM (LITE)[2002] ECR II-705*** that for a trademark to become a generic indication for specified goods or services, it has to lose by reason of use thereof by third parties, its capacity to perform the essential function of a trademark and in particular that of identifying the origin of goods or services. By way of analogy, the Trademarks Act’s section 43(2) puts it this way:

“...that there is a well known and established use of the word or words as the name or description of some activity by a person or persons providing services which include that activity, not being used in relation to services with the provision of which the owner or a registered user of the trademark is connected, in the course of business.”

- 14- In case ***C-517/99 Merz & Krell [2001] ECR 1-6959*** it was noted that it was not the descriptive nature of the mark that was decisive but current usage in the trade sectors covering trade in the goods or services for which marks are sought to be registered.
- 15- The Applicant provided various online dictionary meanings that define 'Java' to mean coffee or an Indonesian island or a computer programming language; internet search results were provided to show use of 'Java' together with other matter by various establishments.
- 16- From the Applicant's own definitions 'Java' clearly does not mean coffee shops - it means coffee or computer programs or an island which are totally different subjects. 'Java' does not describe restaurants or even the relevant activity in this case which is provision of food and drink services.
- 17- The Applicant provided internet searches to show the connection between 'Java' and coffee shops and restaurants. The Applicant searched for 'Java café' and not 'Java' and indeed if they had searched the word 'Java' they would have found that the word is used by all kinds of enterprises including restaurants [the date of my own search, notwithstanding].
- 18- Be that as it may the internet search evidence submitted by the Applicant only shows that different restaurant enterprises are using the word 'Java' in their trademark representations. This in my opinion is to distinguish their services not to describe them. Although 'Java' describes coffee it cannot be said to describe what coffee is used for or how it is sold or consumed or other usage. The fact that the mark describes coffee that is served in certain restaurants is not in itself sufficient to render the mark descriptive of the services themselves. 'Java' is therefore, not a generic reference to coffee shops or restaurants.

19- The **Coca Cola Co. of Canada Ltd v. Pepsi Cola Co of Canada Ltd (1942) 1 KB 615** case is not helpful. In that case, it was found that the word 'Cola' means an ingredient of soft drinks but also consumers in Canada conflated the word with said soft drinks. Indeed over 20 marks with the word 'Cola' or variations thereof had been registered for beverages. In these opposition proceedings there is no evidence that the consumers in Uganda perceive the word 'Java' to refer to restaurant services and neither is there evidence that anyone apart from the Opponent has used the word 'Java' to describe their restaurant business.

20- Similarly, **General Electric Co (of U.S.A) v General Electric Co Ltd (1972) 1 WLR 729**, the dispute related to existence of a mark on the register. This case does not support the Applicant's cause as I have already found that the word 'Java' is not descriptive of the specified services. At any rate the current proceedings are not challenging the registrations of the word 'Java' in as far as it comprises most of the Opponent's marks on the register.

Section 25

21- As regards the similarity of the trademarks, the Opponent insists that pursuant to section 25(2) Trademarks Act the Applicant's mark should not be allowed on the register as use is likely to cause confusion of the public as to the source of the Applicant's services vis-à-vis the Opponent's services and goods.

22- The Applicant on the other hand argued that section 25(2) Trademarks Act is subject to section 26 of the Act.

23- Section 25(2) provides:

"Subject to section 26, a trademark relating to services shall not be registered in respect of services or description of services that is

identical with or nearly resembles a trademark belonging to a different owner and already on the register in respect of—

(a) the same services;

(b) the same description of services; or

(c) goods or a description of goods which are associated with those services or services of the description.”

24- Clearly identical or resembling trademarks with regards to same services, description of services or associated goods and services should not be registered except as provided under section 26 or upon the discretion of the Registrar under section 27.

25- Section 26 and specifically subsection 1 provides:

“Where separate applications are made by different persons to be registered by the owner as a trademark or if in the case of a trademark relating to—

(a) ...; or

(b) services it contains matter common to the provision of services of that description or otherwise of non-distinctive character, the registrar or the court, in deciding whether the trademark shall be entered or shall remain on the register, may require, as a condition of its being on the register—

(i) that the owner shall disclaim any right to the exclusive use of any part of the trademark or to the exclusive use of all or any portion of the matter, to the exclusive use of which the registrar or court holds him or her not to be entitled; or

(ii) that he or she shall make such other disclaimer as the registrar or court may consider necessary for the purpose of defining his or her rights under the registration.”

26- Contrary to the arguments of the Opponent, I think section 26 is applicable owing to the alternative introduced by use of the word “or” in the first sentence under the section. However, this does not help the Applicant’s case as I have already found above that the word ‘Java’ is not descriptive of services of trade in food and drink and it is not a word commonly used in the provision of the specified services in Uganda.

Likelihood Of Confusion

27- With regards to likelihood of confusion, the Opponent argues that there is a likelihood of confusion as the trademarks in issue nearly resemble basing on the similarities between the marks, overall impression and similarity between the services. The Opponent submitted evidence from Mr Senyondwa and a newspaper article which are exhibits “A” and “B” respectively.

28- The Applicant on the other hand argues that there is no likelihood of confusion because the consumers of the relevant services have superior levels of discernment and that the evidence submitted by the Opponent from Mr Senyondwa and the newspaper article only show a mere association whereas the combined surrounding circumstances create differences that the public can tell to distinguish both services.

29- The Applicant is seeking to register their trademark comprising of the words “ NAIROBI JAVA HOUSE” with device for services of providing food and drink in class 43 under part B. The mark is represented herewithbelow;



30- The Opponent is the registered owner and therefore, the person with the exclusive right to use the following trademarks in Uganda;

No.	Trademark	Class	Date of Registration
29297		30 -Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice	November 3, 2006
40162		30 -Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and	July 17, 2009

		preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice	
47765		21 -Cups; plates, porcelain; Chinaware.	July 2, 2013
47766		32 - mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages.	July 2, 2013
47767		43 - Services for providing food and drink; restaurant, catering services; booking and reservation services for restaurants.	July 2, 2013

31- Confusion results from use of a trademark, the exclusive right of which belongs to the registered proprietor. Section 37(1) Trademarks Act provides that:

“Subject to sections 41 and 24, the registration of a person as owner of a trademark ... in respect of services, shall, give to that person in Part A of the register the exclusive right to the use of the trademark in relation to those services.”

32- The Opponent submitted evidence showing usage of the above trademarks, see paragraph 6 and 7 of Mr Mohideen statutory declaration as well as exhibits A1 to A6. The Opponent has exclusive right to use the above trademarks.

33- In the same vein registration of the Applicant’s mark will allow them to exclusively use that mark in Uganda. The Applicant has established a restaurant in Uganda using a variation of the trademark 48063 and had applied for its registration pursuant to trademark application no. 48062. The mark is shown herewith below.



The variation is a distinction without a difference since the varied word to-wit “NAIROBI” cannot be separately registered by the Applicant but is available for any other interested party to use. I have therefore, not made a distinction in between trademark number 48062 and 48063 for these proceedings.

34- When considering the likelihood of confusion, case law in well settled in this area as provided in ***Anglo Fabrics (Bolton) Ltd & Anor v. African***

Queen Ltd & Anor CS-632/2006, Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc [1999] RPC 117, Marca Mode CV v. Adidas AG & Adidas Benelux BV [2000] E.T.M.R 723, Lloyd Schuhfabrik Meyer & Co GmbH v. Klijsen Handel B.V. [2000] F.S.R. 77, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C- 120/04 and Shaker di L. Laudato & C. Sas v. OHIM C-334/05 P that:

- i. Likelihood of confusion is the probability that a reasonable consumer in the relevant market will be confused or deceived, and will believe the infringer's goods or services come from, or are sponsored or endorsed by, the complainant or that the two are affiliated;
- ii. 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 they have kept in their mind, and whose attention varies according to the category of goods or services in question;
- iii. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- iv. 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 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; nevertheless, the overall impression conveyed to the public by a composite trademark may, in certain circumstances be dominated by one or more of its components;

- v. Where the overall impression created by a mark depends heavily on the dominant features of the mark, it is possible that in a particular case an element corresponding to earlier trademark may retain an independent distinctive role in a composite mark without necessarily constituting a dominant element in that mark;
- vi. A lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa;
- vii. There is a greater likelihood of confusion where the earlier trademark has a highly distinctive character, either per se or because of the use that has been made of it;
- viii. Mere association, in the sense that the later mark brings the earlier mark to mind is not sufficient;
- ix. 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;
- x. If the association between the mark 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.

Reasonable Consumer

35- The Applicant asserted that the services are targeted on the middle to upper class who have “superior levels of discernment”. I do not agree with this assertion, in my opinion discernment is not measured based on the consumer but it is rather based on the goods or services consumed. In other words, for purposes of assessing discernment, the goods or service defines the consumer and not the other way round. In this case, these are basically restaurant services, a reasonable consumer is an average person [*usual, ordinary, typical are some other definitions in English*], whether

middle or upper class is irrelevant except where the particular kind of service defines a typical consumer. I am therefore, not persuaded that the consumers targeted by Applicant and Opponent have a superior level of discernment because of their 'class'. They have average discernment necessary for those specified services.

36- The question is how is the provision of this kind of service discerned by the person who consumes these services. To start with both the Applicant's and Opponent's establishments are identified by their respective trademarks including the variation above.

37- The Applicant's mark comprises of the words "NAIROBI JAVA HOUSE; COFFEE & TEA" and a variation thereof which is without the word 'NAIROBI'. In the middle of the Applicant's trademark representations is a device of a face in a red sun all of which are on a yellow background in a rectangular shape with black outlines. Application for this mark and its variation was made on September 15, 2013.

38- The Opponent's mark in the relevant class 43 comprises of the stylized words "CAFÉ JAVAS" with CAFÉ in black colour and JAVAS in orange colour as well as a device of a smoking cup over the right hand corner of the word JAVAS. The Opponent's mark was registered from July 2nd, 2013.



Applicant's marks

Opponent's mark

39- Visually the marks do not resemble, the Applicant's marks on the left, in addition to the words have a red device of a face in a sun and the whole representation is positioned vertically with black borders against a yellow background whereas the Opponent's mark on the right comprises of a device of a smoking cup over stylized words in orange and black, the whole representation is positioned horizontally. Placed side by side, the marks differ.

40- However, there are some conceptual similarities that impact on the overall impression of the marks. Both marks have a dominating element of the letters or word 'Java' which in both marks stands out and plays a very conspicuous role in the perception of the mark. According to paragraph 9 of Mr Mohideen statutory declaration, members of the public refer to the Opponent's restaurants as 'JAVAS', although there is no evidence of this I am inclined to believe that it is very probable because of the overshadowing impact of the word 'Java'.

41- Also both marks utilize what I may call light colours that is yellow and orange respectively but most importantly both word marks contain additional matter that is not distinctive. The Opponent's mark was registered with a disclaimer for the word "CAFE" whereas the Applicant applied for registration of their mark subject to disclaimers of the words "NAIROBI," "JAVA", "HOUSE" and "COFFEE & TEA" (The disclaimer for the word 'Java' was unnecessary for reasons I have already given hereinbefore). The said words were disclaimed because they are common in the provision of the specified services or otherwise are not distinctive; a combination with the distinctive word, 'Java' is what gives them the capability/adaptability to distinguish.

42- As a consequence, the word 'Java' therefore, maintains a standout role in the Applicant's composite mark as well as the Opponent's mark so much so that there is a likelihood that the services of the Applicant will be

associated or otherwise regarded as related with the Opponent's services upon use.

- 43- Obviously the similarity of this dominating element is not sufficient to lead to a likelihood of confusion in the strict sense; yes, there is a likelihood of association in that that word 'Java' comprised in the Applicant's mark brings to mind the Opponent's mark but this is not enough to lead to a likelihood of confusion, yet on the otherhand there is evidence of two people stating that they were confused as to the source of the Applicant's service.
- 44- According to exhibit "A" of Mr Mohideen's statutory declaration in response; Mr Senyondwa stated in paragraph 4 that he thought the Applicant's establishment was "*a branch or sister outlet*" of CAFÉ JAVAS. This confusion is reinforced by the newspaper article wherein it is stated by the author that they learnt that JAVA COFFEE & TEA and CAFÉ JAVAS were two different establishments after clarification from the manager of the restaurant. The Applicant argues that this was mere association and not confusion.
- 45- I donot agree with the Applicant, clearly these two people were confused as to the source of the service but they are just two people and no evidence of a survey was submitted to ascertain the level of confusion! So, is the confusion of these two people reasonable to be expected on an average member of the public? I think the answer is yes.
- 46- As it was stated in the case of ***Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*** (supra) a lesser degree of similarity between the marks is offset by a greater degree of similarity with regard to the services. The Opponent's mark is registered in class 43 as earlier highlighted, the Applicant seeks to register their mark in class 43 for only services for providing food and drink. I had the opportunity of visiting the establishments by which the Applicant and Opponent are providing these

services. It was not clear whether the Opponent provides reservation services but that is irrelevant as the overall services in which both parties are involved are the same.

47- Also section 60 (2) Trademarks Act states that:

“In an action [in] respect of a trademark relating to services or business name, the registrar shall admit evidence of business usages in the provision of services in question and of any relevant trademark relating to services or business name or get-up legitimately used by other persons.”

48- 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.

49- Consumers will not stop to make direct comparisons of both marks but they will rely on an imperfect picture kept in their minds including the surrounding circumstances. To an average consumer both establishments are well set out with décor that tends from orange to dark brown in colour. The mode of dining in the Applicant’s and Opponent’s restaurants is a la carte with meals priced between Ug shs 15,000 and Ug shs 25,000 on average. The sitting arrangements range from booth seats to ordinary table and chair dining and both establishments tend to be located strategically to attract certain clientele given to frequenting specific locations or even to spending the above moneys on a single meal. In otherwords, the impact and impression made by the surrounding circumstances in the provision of these services is one of the similarities between the two entities rather what differentiates them.

50- There are ofcourse some differences, the most outstanding being that the Applicant serves among others pork based meals; whereas the Opponent serves the so called Halal meals only. This is not significant enough to distinguish the services of the Applicant from those of the Opponent. Infact a consumer who has to rely on this difference to distinguish the Applicant and Opponent has already been confused as to the source of both services.

51- For these reasons I must conclude that it is reasonable that a member of the public would likely be confused as to the source of both services and in this case the Applicant's services would be confused for those of the Opponent bearing in mind that the Opponent has built up a reputation for over six years here in Uganda.

Concurrent Usage

52- The Applicant argues in the alternative that they should be permitted on the register as concurrent users because they have been honestly using the mark "JAVA" in Kenya for fifteen years. The Applicant further argues that concurrent usage should be equated with the goodwill with regards to its pervasiveness that is not bound by country borders and as such that they have goodwill in Uganda.

53- The Opponent on the otherhand insists that use should be restricted to Uganda.

54- Section 27 Trademarks Act provides:

"The registrar or court may permit the registration by more than one owner, in a case of honest concurrent use or other special circumstances in respect of—

(a) the same goods or services;

(b) the same description of goods or services;

(c) goods and services or descriptions of goods and services which are associated with each other; or
(d) trademarks that are identical or nearly resemble each other, subject to such conditions and limitations as the registrar or the court may impose.”

- 55- It is not allowed under section 25 of the Trademarks Act to register identical or resembling marks except if the Registrar or Court exercised their discretion to register such a mark under section 27. I agree with the Applicant that section 27 requires a two stage analysis. First, is to determine whether there has been use, concurrent use and honesty of the concurrent use and secondly, to look at any other special circumstances.
- 56- Use is a question of fact, that is whether the mark in question is actually being used in the trademark sense that is to say whether the mark is being applied on services to distinguish those services by indicating their origin. ‘Use’ refers to use in connection with the services provided in Uganda prior to the date on which the application was made. There is no evidence from the Applicant of use of the trademark in Uganda and therefore, the question of honest concurrent use does not arise.
- 57- I do not accept the argument that use of the mark in another country like Kenya amounts to use in Uganda mainly because of the principle of territoriality (see section 37(3) Trademarks Act). Also the reference by the Applicant to goodwill to justify concurrent use is in this case unjustifiable, there is no shred of evidence of such goodwill of the Applicant’s services in Uganda.
- 58- For the above reasons, the Applicant’s bid to register trademark No. 48063 “NAIROBI JAVA HOUSE” with device and by extension trademark No. 48062 fails and the Opponent’s opposition succeeds.

59- Application for registration of trademark 48063 is hereby refused and following the prayer by the Opponent, the Applicant shall bear the costs of these proceedings.

Dated at Kampala this 21st day of May, 2015

AGABA GILBERT

Asst. REGISTRAR TRADEMARKS