



Dear Client,

Welcome to the newly revamped eighth issue of the IP monthly, filled with interesting news articles and developments. We hope that you will find the features in this newsletter informative.

Developments in the Intellectual Property arena

Trademark

Company denies Polo trademark breach

Local fashion retailer Wardrobe Collections has denied breaching Johannesburg-based LA Group's trademarks by supplying clothes labelled Classic Polo, which the South African firm says is too similar to its Polo brand.

To read this story click [here](#)

Source: Business Daily

Kenya's Little Cab Gets a Little Hiccup Resulting in Name Change

Little Cab, an app and taxi service by Craft Silicon and Safaricom is onto its first hurdle, (well, if you count the massive price drop by Uber, it's the second one) that of trade mark.

To read this story click [here](#)

Source: techweez

Jägermeister faces dilution claims over 'Kühl as ice' advert

Alcoholic drinks maker Jägermeister has been sued for trademark infringement by an outdoor wear company over an advert featuring the word "Kühl".

To read this story click [here](#)

Source: WIPR

BMW Still shaping trade mark law

It is safe to say that BMW protects its trademarks fiercely. As a result, the company has done more than its fair share to shape South African trade mark law. A recent UK trade mark decision involving BMW will therefore be of considerable interest to businesses in South Africa.

To read this story click [here](#)

Source: Mondaq

Patents

Copyright

Research project produces first map of Nairobi's informal transport system

Thanks to a novel research project in Nairobi, headed up by Digital Matatus, in collaboration with MIT, Columbia University, the University of Nairobi, and consulting firm, Groupshot Design, Kenyan researchers were deployed, equipped with only smartphones, to collect and subsequently analyse data from the network of matatus that services Nairobi.

To read this story click [here](#)

Source: Design Indaba

Court bars MCSK from collecting music royalties

The court ruled the case in accordance with the Copyright Act as stipulated in the constitution, which states that "no person or association of persons shall commence or carry on the business of a copyright collecting society except under or in accordance with a certificate of

Under Armour wins year-long TM case in China

Clothing company Under Armour has won its trademark infringement case in China against Uncle Martian, winning approximately \$300,000 in damages.

To read this story click [here](#)

Source: WIPR

Tiffany & Co victorious in trademark litigation case with Costco

A decision has been made by a federal judge this week about an ongoing litigation battle between Costco and Tiffany & Co. The case stemmed from Costco selling generic solitaire diamond engagement rings marketed as "Tiffany"

To read this story click [here](#)

Source: Trademark Lawyer Magazine

SCOTUS asked to consider whether 'Google' trademark is generic

Two men are trying to take a case to the US Supreme Court to prove that Google has become a generic term that can't be protected under trademark law.

To read this story click [here](#)

Source: WIPR

Trump loses trademark battle over iTrump

The President of the

The costs of patenting in Africa: A tale of three Intellectual Property systems

The African economy, which is home to more than a billion people, has tripled since the year 2000 (Michael Lalor; 2014) and currently houses nine of the 15 fastest growing economies in the world (Spoor & Fisher; 2016), presenting immense business opportunities.

To read this story click [here](#)

Source: IP watchdog

Intellectual Property 101 for techies

You have an idea! You've heard about intellectual property. That apparently you could protect this idea and keep it from others who may intend to 'steal it'! You've probably asked, "can I patent my idea?", well, that's every IP lawyer's nightmare.

To read this story click [here](#)

Source: techweez

Theft ovation: Facebook 'Likes' copying ideas

Recently the Wall Street journal published an article detailing Facebook chief executive and founder, Mark Zuckerberg, directing employees to not let pride get in their way and to copy rivals in the industry. The Wall Street journal reported that one particular employee present at this all employees meeting said that after this

registration."

To read this story click [here](#)

Source: Capital News

A sight for sore eyes: Penguin and Simon & Schuster secure picture books copyright win

Penguin Random House and Simon & Schuster secured a win against two authors late last week, after a US judge ruled that picture books based on famous novels infringe copyright.

To read this story click [here](#)

Source: WIPR

Knead for a re-think? BBC cooking show under fire over 'Bake Off' similarities

The BBC's new cooking show has reportedly come under fire from fellow broadcaster Channel 4 for ripping off "The Great British Bake Off". Broadcast on the BBC since 2010, "Bake Off" will be shown on channel 4 this year after the company won the rights to the amateur baking competition.

To read this story click [here](#)

Source: WIPR

Showtime begins clampdown on illegal McGregor v Mayweather streams

The exclusive owner of the US TV broadcasting rights of the Conor McGregor v Floyd Mayweather boxing match has applied to shut down 45 sites allegedly hosting illegal streams.

To read this story click [here](#)

United States of America – Donald J. Trump – has been the headline of many news stories over the past year or so, including many within the trademark industry. While he and his daughter Ivanka have been heavily criticized for using their power/influence to push forward trademark applications (especially in China), this week has certainly seen a turn in events when he was denied the right to trademark iTrump.

To read this story click [here](#)

Source: Trademark Lawyer Magazine

Date Announced For Thailand to Join the Madrid Protocol

It is now official; from **7 November 2017** you will have the choice when filing your mark in Thailand to either file it via the Madrid System or through filing a national application directly with the Department of Intellectual Property (DIP). To read this story click [here](#).

Source: Rouse, the Magazine

BBC settles trademark infringement case in India

The BBC has settled a trademark infringement case in India against the publisher of a cooking book. Kuldeep Singh, the owner of Brajindra Book Company, shortened the name of his business to 'BBC'

To read this story click [here](#)

meeting the internal slogan within Facebook became: "Don't be too proud to copy."

To read this story click [here](#)

Source: IP watchdog

Samsung reaches settlement over noise-cancelling patents

A company that sued both Apple and Samsung for patent infringement has announced that it has reached a settlement with Samsung

To read this story click [here](#)

Source: WIPR

Crocs lose rights to patent making them vulnerable to copycats

The rights to Crocs' iconic clog have been lost after the USPTO ruled patent D517789 invalid. The decision was based upon the fact that a similar design was published over a year before Crocs' application, meaning the classic design will now be open to copycats.

To read this story click [here](#)

Source: The Patent Lawyer Magazine

ITC launches investigation into Caterpillar over road machines

The US International Trade Commission (ITC) has announced it will launch a patent infringement investigation into engineering company Caterpillar over road milling machines and components.

Source: WIPR

Artist in copyright row over 'troubling' rape accusation scene

An artist at the centre of a copyright infringement dispute with the producers of the UK crime drama "Broadchurch" has rescinded her acceptance of a settlement offer worth £3,800 (\$4,900). Angela Hewitt, an artist from the Isle of Wight, UK, had threatened legal action against Kudos Productions for allegedly featuring her work without permission, according to documents seen by WIPR.

To read this story click [here](#)

Source: WIPR

Africa: The Next Global Music Opportunity

For understandable, but not necessarily justifiable reasons, Sub-Saharan Africa has been the scourge of the international recorded music industry for decades. Africa is a vast continent that has delivered comparatively little financially in return for investments.

To read this story click [here](#)

Source: Sheer Publishing Africa

Former NFL stars thrown into wrangle over image copyright

A photographer has sued sports news website Bleacher Report for allegedly using a photograph of two former National Football League (NFL) players without his permission.

To read this story click [here](#)

Source: WIPR

To read this story click [here](#)

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Interesting facts about August

- The month August was named after the first Roman Emperor Augustus in 8BC. Before this, it had been called Sextilis, as it was the sixth of ten months in the Roman calendar.
- Many parents actually like to name their toddler after Augustus Caesar, or maybe just the month August. August as a men's name has secured a place in the top 1000 men's name. August was the 55th most common name given to a baby boy in Sweden in 2014.
- Civil rights activist Martin Luther King, Jr.'s famous "I have a dream" speech was delivered on August 28, 1963.
- In the USA August is the month that has the highest birth rate
- Henry VI Part I and The Tempest are the only Shakespeare plays that mention the month of August. Cymbeline is The Bard's only play mentioning the Emperor Augustus or anyone else of that name.

IMPORTANT DATES

- **First Sunday of August:** International Friendship Day
- **5 August:** International Forgiveness Day
- **12 August:** International Youth Day 2017
- **20 August:** World Mosquito Day
- **23 August:** International Day for the Remembrance of the Slave Trade and its Abolition
- **31 August:** African Traditional Medicine Day 2017

Counterfeits

Facebook offers tool to combat fake news in Kenya

Facebook rolled out a tool this week to help Kenyan users spot fake news ahead of a hotly-contested presidential election that has seen supporters of rival candidates trade bitter words online. Voters go to the polls on Tuesday to

Kenya presidential election cancelled by Supreme Court

The election commission had declared incumbent Uhuru Kenyatta the winner by a margin of 1.4 million votes. Raila Odinga, Mr Kenyatta's opponent, said the commission was "rotten" and demanded resignations and prosecutions.

Historical dates in August

- **2 August 1100:** King William II (Rufus) killed by a crossbow bolt in mysterious circumstances while hunting in the New Forest, his ghost is still said to haunt the woods.
- **5 August 1962:** Nelson Mandela imprisoned for attempting to overthrow

pick a president, parliament and regional representatives

To read this story click [here](#)

Source: Reuters

Counterfeit cancer drugs sold in Uganda

The National Drug Authority has issued an alert over two counterfeit cancer drugs being sold on the Ugandan market after impounding some of them from a hawkler near the Uganda Cancer Institute (UCI). The hawkler was arrested near UCI on July 17.

To read this story click [here](#)

Source: Daily Monitor 25

Kering and Alibaba Join Forces in Battle Against Counterfeits

French luxury goods group Kering has dropped a lawsuit filed in New York against Alibaba and Alipay and agreed instead to co-operate with the two companies to safeguard intellectual property rights and fight counterfeiting.

To read this story click [here](#)

Source: BOF

Kenya's Communications Authority Nabs Over 5000 Fake Phones in Mombasa County

The Communications Authority of Kenya (CA) has managed to seize more than 5000 fake mobile phones in Mombasa County. Apparently, the ICT watchdog has

To read this story click [here](#)

Source: BBC

Vodafone finalises transfer of 35% Safaricom stake to Vodacom

Vodacom Group has completed the ZAR34.6 billion (USD2.6 billion) acquisition of a 34.9% stake in Kenya's largest mobile operator by subscribers, Safaricom, after all regulatory approvals and conditions precedent in Kenya and South Africa were met.

To read this story click [here](#)

Source: TeleGeography

Airtel, CA permit renewal row goes to court

Telecoms operator Airtel Kenya has taken its renewal of operating permit fight with the Communications Authority of Kenya (CA) to the High Court, laying bare details of the vicious three-year battle whose secrets have remained closely guarded.

To read this story click [here](#)

Source: Business Daily, Kenya

Misuse of social media linked to mental illness

Almost all social media networks thrive on images which give them immense power to influence people's thoughts, emotions and moods.

To read this story click [here](#)

South Africa's apartheid rule.

- **14 August 1945:** Japan surrenders to the Allies, ending the Second World War.
- **8 August 1815:** Napoleon Bonaparte set sail for St. Helena to spend the remainder of his days in exile.
- **8 August 1876:** Thomas Edison received a patent for his mimeograph.
- **24 August 1949:** The North Atlantic Treaty went into effect.

Kenya: Historical Dates in August

- **August 1982:** The Kenyan Airforce attempts a military coup. A few days pass in uncertainty and 120 people are killed. Then forces loyal to the government put an end to the rebellion. Following the coup-attempt, 12 people are sentenced to death and 900 are jailed.
- **7 August 1998:** Al-Qaeda operatives bomb the US embassy in Nairobi, killing 224 people and injuring thousands.
- **4 August 2010:** Referendum where Kenyans voted in favour of the proposed new constitution
- **27 August 2010:** New constitution promulgated.

conducted the exercise in the coastal region, with focus on retailers who sell counterfeit handhelds to unsuspecting public.

Source: Business Daily, Kenya

Our Work

To read this story click [here](#)

Source: techweez

Amazon to Expand Counterfeit Removal Program in Overture to Sellers

Amazon.com Inc is expanding a program to remove counterfeit goods from its website this spring as part of a broader push to assure brand owners that the online retailer is an ally rather than a threat.

To read this story click [here](#)

Source: BOF

General News

Kenyan Elections and Alleged Hacking: A Look at the available evidence

Facebook rolled out a tool this week to help Kenyan users' spot fake news ahead of a hotly-contested presidential election that has seen supporters of rival candidates' trade bitter words online.

To read this story click [here](#)

Source: CIPIT Blog ~ Strathmore University Centre for Intellectual Property and Information Technology Law (CIPIT)

Japan paint maker takes over Sadolin Group for Sh10bn

Listed Japanese paint and coating

In the month of August we have:

- Filed approximately 30 trademark applications across East Africa;
- Assisted with approximately 18 trademark renewals, records of mergers, changes of names and assignments of trademarks; and
- Filed 5 renewal of patent annuity.

Our Work

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manufacturer Kansai Paints has acquired a 90 per cent stake in Sadolin Group for USD100 million (KES10.3 billion). The regional acquisition leaves local shareholders holding the balance of shares.

To read this story click [here](#)

Source: Business Daily, Kenya

Facebook switches on 600 Wi-Fi hotspots in Kenyan town

Facebook has switched on its low-cost Internet in more than 600 hotspots across the country since the launch of the service in March, the US tech giant has disclosed.

To read this story click [here](#)

Source: Business Daily, Kenya

EAC member states roll out single electronic passport

Kenya is Friday morning expected to begin issuance of single electronic East African Community (EAC) passports with the release in Nairobi of the first batch of the new generation documents.

To read this story click [here](#)

Source: Business Daily, Kenya

Recent Cases

A. In the Matter of Trade Mark No. KE/T/2011/70625 “KV” (WORD) IN CLASS 9 in the Name of Chloride Exide (K) Limited and Expungement Proceedings thereto by Thai Storage Public Company Limited

Case Summary: On 9 March 2011, Chloride Exide (K) Limited (the proprietors) filed an application to register their trademark no. KE/T/2011/70625 "KV" (WORD) (the mark) before the registrar of trademarks. The application was examined and the mark was published in the Industrial Property journal and, at the end of the sixty-day statutory period, the mark was entered in the register of trademarks.

On 19 June 2013 Thai storage public company limited (the applicants) filed an application for expungement of the mark on the grounds, inter alia, that they have been trading in batteries of different types all sold under different trade marks including "KV" and that the Applicants "KV" products have gained a voluminous amount of goodwill gained through extensive use.

In response, the proprietors stated, inter alia, that they trade and sell products under the "KV" trademark and that they registered their trademark "KV" on 9 March 2011 which is due for renewal on 9 March 2021. The proprietors also stated that "KV" is not a well-known mark and the applicants acquiesced to its use in Kenya by failing to register it. The Applicants also stated that the public recognises the mark as exclusively belonging to the Proprietors.

The issues for determination were narrowed down to:

- i. whether the Proprietors have a valid and legal claim to the mark "KV" (WORD) before applying to register the mark as provided for under section 20 (1) of the Trade Marks Act; and
- ii. whether the Applicants are aggrieved in accordance with the provisions of section 35 of the Trade Marks Act.

With regards to the issue whether the Proprietors have a valid and legal claim to the mark "KV" (WORD) before applying to register the mark as provided for under section 20 (1) of the Trade Marks Act, it was held that:

- i. it is instructive to note that trademarks are adopted or created for commercial purposes and that it is the person who takes the lead in using the mark commercially in the respective market that would be said to have a proprietary to the mark. Therefore, the use of the trade mark "KV" by the Applicants with respect to batteries was not random as alleged by the Proprietors;
- ii. where a trade mark entered into a register of trademarks is similar to an earlier mark in terms of use in the Kenyan market, then such a trademark would not be deemed to be "inherently adapted to distinguish" the goods of the Proprietors in the Kenyan market; and
- iii. having adopted a trademark similar to the Applicant's earlier one in respect of goods of similar description, the Proprietor's trademark "KV" (WORD) would not be able to act as a badge of origin.

For the above discussed reasons, the Assistant Registrar held that the Proprietors did not have a valid and legal claim to the trade mark "KV" (WORD) before applying to register the trade mark under the provisions of section 20 (1) of the Trade Marks Act.

With regards to the issue whether the Applicants are aggrieved in accordance with the provisions of section 35 of the Trade Marks Act, it was found that the two marks are similar and entry of two similar trade marks in the Kenyan Register would be contrary to the provisions of the Trade Marks Act. This means that as long as the Proprietor's trademark remains in the Register the Applicants cannot register their trademark. This amounts to a limitation of their legal right making them aggrieved persons under the provisions of section 35 of the Trade Marks Act.

Holding: the Registrar held that the Proprietors of the trade mark no. KE/T/2011/70625 "KV" (WORD) was entered in the Register of Trade Marks without

sufficient cause and in error since the Proprietors were not entitled to the same as required by law. The Registrar further held that the Register of Trade Marks is hereby rectified by expunging the said trade mark no. KE/T/2011/70625 "KV" (WORD) from the register under the provisions of section 35 of the Trade Marks Act. the costs of the expungement proceedings were awarded to the Applicants.

B. Webtribe Limited T/A Jambopay versus Jambopay Express Limited [Civil Suit No. 159 of 2014]

Case Summary: The suit was commenced by the Plaintiff, a company that operates an "online payment gateway", vide a Plaint filed on 24 April 2014 where it alleged that the Defendant infringed on its trade mark no. 67127 under class 36 (Financial affairs; monetary affairs) and that the Defendant's actions also amounted to passing off.

The Plaintiff registered JamboPay as a trademark on 17 December 2009 while the Defendant company was incorporated on 11 October 2012. Therefore, it was the Plaintiff's position that the defendant had infringed and continued to infringe on its JamboPay trademark by using the same name to offer the same services.

The Plaintiff sought orders that:

- i. An injunction to restrain the defendant, their agents, servants and employees from using, advertising, trading, contracting, infringing and/or engaging in any other way either directly or indirectly with the Jambopay trade mark;
- ii. Deregistration of JamboPay Express Limited by the registrar of companies;
- iii. Closure of its website;
- iv. General damages; and
- v. Costs of the suit.

The defendant denied the allegations made by the plaintiff and stated that the trademark relates to "JamboPay with Device" and not JamboPay on its own. In relation to passing off, the defendant stated that the name it was using is neither the name of the plaintiff company nor its business name.

The two main issues in the matter were:

- i. whether there was a breach of trademark; and
- ii. whether there was passing off.

As to whether there was a breach of trademark, the court held that the name "Jambo Pay Express" is sufficiently similar to the Plaintiff's trademark as to amount to breach of trademark and should not, of itself be preserved in a business name or company name.

As to the issue of passing off, the court held that it is clear from the evidence produced by the Plaintiff that the existence of the Defendant's name created confusion in the minds of customers and the claim had been made out.

Holding: it was held that the Defendant's actions amounted to breach of the Plaintiff's trademark. The registration of a company name so similar to the Plaintiff's trademark amounts to breach of the Plaintiff's trademark. As to allegations of passing off, it is clear from the evidence produced by the Plaintiff that the existence of the Defendant's name created confusion in the minds of customers and the claim had been made out.

With regard to the claim for damages, the court stated that it had not heard sufficient argument or evidence to be in a position to make such an assessment and held that the assessment be undertaken after the Parties have filed the evidence and authorities on which they seek to rely on.

The Court ordered that:

1. The defendant whether through its servants agents or howsoever is forbidden from infringing the plaintiff's trademark by using the name "JamboPay" in any format, not limited to a web-site within 28 days;
2. The registrar of companies is directed to de-register the name "JamboPay Express" within 60 days;
3. The defendant to pay the plaintiff's costs.

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