

THOMAS & FRIENDS decision clarifies nature and purpose of disclaimers

John Syekei and Brian Odiwuor Otieno

Bowmans

26 September 2023



KENYA

Legal updates: case law analysis and intelligence

- The registrar found that the word 'Thomas' was an English surname and did not describe the character of Class 28 goods
- There was no basis to require a disclaimer of the word 'Thomas'
- The fact that a term is common does not necessarily mean that a disclaimer must be entered

Introduction

A trademark disclaimer is a statement that shows that the applicant for trademark registration does not have exclusive rights over a part of or the whole of a mark that is common to the trade and has a descriptive or non-distinctive character. It is anchored in Section 17 of the [Trademarks Act, Cap 506 of the Laws of Kenya](#). The Kenyan courts have defined a descriptive trademark as one that literally describes a product, or the purpose or utility of the product.

The THOMAS & FRIENDS case

In a [recent ruling](#), the assistant registrar of trademarks considered an application for the registration of THOMAS & FRIENDS in Class 28 with respect to "games and playthings, gymnastics and sporting articles not included in other classes; decorations for Christmas trees; including toys". The registrar was requested to determine whether a call for a disclaimer of the word 'Thomas' had a proper basis.

In terms of Section 17 of the Trademarks Act, the registrar has discretion to require a disclaimer where an element within a trademark "is common to the trade... or otherwise of a non-distinctive character". In contesting the requirement for a disclaimer, the trademark applicant submitted, through its lawyers, that the word 'Thomas' was not common to the trade with respect to

goods in Class 28. Additionally, the trademark had been registered in other jurisdictions without the requirement to enter a disclaimer.

Citing various authorities, the registrar conceded that the purpose of a disclaimer is to delineate the rights of the trademark holder and not to confer a monopoly over the disclaimed elements. At the same time, a disclaimer informs other traders in similar trades that they are free to use the disclaimed elements of the mark.

Drawing guidance from the cited authorities, the registrar held that the word 'Thomas' was an English surname and did not describe the character of the goods in Class 28. As a result, the registrar opined that the requirement for a disclaimer of the word 'Thomas' was without basis and directed the trademark application to proceed to publication with no disclaimer.

Implications of the ruling

This decision of the registrar underscores the nature and purpose of trademark disclaimers. It is clear from the law that a disclaimer would be required where a particular element of a trademark is common in relation to the trade of particular goods or class of services, which would render the trademark non-distinctive in nature. However, the fact that a term is common does not necessarily mean that a disclaimer must be entered: the term must be common in relation to the goods or services in question. In the instant case, the word 'Thomas', although common as a surname in England, was not common in relation to the trade of goods in Class 28.

It is only where the element of the trademark is descriptive of the product and its utility that an applicant will be required to enter a disclaimer. Generally, a trademark disclaimer is required for portions of a mark that are, among other things:

- generic;
- associated with a specific geographic location;
- commonly associated with a particular type of business;
- informational words;
- merely descriptive or misdescriptive words; and
- laudatory words.

Conclusion

This decision is in line with the international best practice and affirms the position set out under Section 17 of the act. It breathes life into the meaning of the word 'common' as used in the act and highlights what constitutes a descriptive mark that would require a trademark disclaimer.

John Syekei

Author | Partner

john.syekei@bowmanslaw.com

Bowmans

Brian Odiwuor Otieno

Author

brian.otieno@bowmanslaw.com

Bowmans