

**UGANDA REGISTRATION SERVICES BUREAU**

**THE TRADEMARKS ACT, 2010**

**IN THE MATTER OF TRADEMARK APPLICATION No. 32776 “BIG U”  
IN CLASS 30 BY MOYONI INTERNATIONAL LTD**

**AND**

**IN THE MATTER OF AN APPLICATION FOR CANCELLATION OF  
REGISTRATION BY WM. WRIGLEY JR COMPANY**

**BEFORE: AGABA GILBERT, ASST. REGISTRAR TRADEMARKS**

- 1- Wm. Wrigley Jr. Company (herein the Applicant) of 410 North Michigan Avenue, Chicago, Illinois 60611 USA and C/o MMAKS Advocates of P.O Box 7166, Kampala, on 17<sup>th</sup> July 2012 applied for expunging of trademark no. 32776 “BIG U” from the register on grounds that the trademark “BIG U” resembles a trademark “BIG G” already on the register in respect of the same goods and is likely to deceive or cause confusion.
- 2- Trademark number 32776 “BIG U” was registered as of 30<sup>th</sup> December 2009 in the names of Naman Enterprises Ltd in respect of goods in class 30 to-wit 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.
- 3- Naman Enterprises Ltd assigned the trademark to Moyoni International Ltd by way of assignment deed dated 10<sup>th</sup> August 2010. Moyoni International Ltd (herein the Respondent) was subsequently registered as proprietor on 21<sup>st</sup> September 2010.
- 4- The application to remove the BIG U mark from the register was transmitted to the Respondent, Moyoni International Ltd and service effected by registered post as per the affidavit of service by Chris Okurut, a process server, dated 28<sup>th</sup> August 2014. Unfortunately, the Respondent failed and or neglected to file their counterstatement.

5- Regulation 72(3) of the Trademark Regulations provides that:

*“Upon the application being made and a copy of it transmitted to the registered proprietor, if necessary, regulations 35 to 44 shall apply with the necessary modifications to the further proceeding on the application; but the registrar shall not rectify or remove the mark from the register only because the registered proprietor has not filed a counterstatement.”*

Accordingly, the Applicant was advised to file their evidence by way of statutory declaration. The statutory declaration was sworn by Mr. Innocent Obwino for the Applicant and was filed with the registry on 7<sup>th</sup> May 2015 whereupon the matter was fixed for hearing.

6- The hearing notice was served on both parties, the Respondent again being served by way of registered post according to the affidavit of service of a court process server Yusuf Cocoga dated 24<sup>th</sup> May 2016; did not appear at the hearing whereupon the matter proceeded ex parte.

7- The Applicant relied on sections 88, 9 and 25 of the Trademarks Act. Section 88 (1) of the Trademarks Act provides:

*“A person aggrieved by an omission, entry, error, defect or an entry wrongly remaining on the register, may apply in the prescribed manner to the court and subject to section 64, to the registrar, and the court or the registrar may make an order for making, expunging or varying the entry as the court or the registrar, as the case may be, may think fit.”*

8- Clearly the Registrar has power to rectify the register. The applicant has to show that first, there is an entry on the register; secondly, the said entry wrongly remains on the register and third that the applicant is aggrieved by continued remainder of the entry on the register.

9- The entry in question is trademark registration number 32776 “BIG U” registered as of 30<sup>th</sup> December 2009. The entry is still on the register.

10- The Applicant insists that it is an entry wrongly remaining on the register because the mark “BIG U” is not distinctive; there is a likelihood of confusion in using of the mark and that the Applicant is the proprietor of earlier registered marks resembling the mark in issue. In support of this assertion, evidence by way of statutory declaration was submitted Mr. Obwino to the effect that:

- a. The Applicant is the registered owner of trademark Nos. 23226 “BIG G” in class 30; 16868 “BIG G Bubble Gum logo” in class 30; 23225 “BIG G Bubble Gum Fresh Mint Wrap & Design” in class 34; and 24180 “BIG G (stylized)” in class 30;
- b. BIG G trademark through use (since 1974) and marketing has acquired substantial reputation and goodwill;
- c. BIG U is similar to BIG G and the public is being confused and or deceived as to source of the Applicant’s goods vis-à-vis the Respondent’s goods;
- d. BIG U was copied from BIG G; and
- e. The Respondent’s conduct is in bad faith.

11- The trademark was examined, published in the gazette and then registered without opposition from the Applicant.

12- The Applicant claimed and argued that they are aggrieved by the registration. In the case of **Ritz Hotel Ltd v Charles of the Ritz Ltd (1988) 15 NSWLR 158**, McLelland J on the meaning of aggrieved person stated:

*"Decisions of high authority appear to me to establish that the expression has no special or technical meaning and is to be liberally construed. It is sufficient for present purposes to hold that the expression would embrace any person having a real interest in having the Register rectified, or the trade mark removed in respect of any goods, as the case may be, in the manner claimed, and thus would include any person who would be, or in respect of whom there is a reasonable possibility of his being, appreciably disadvantaged in a legal or practical sense by the Register remaining unrectified, or by the*

400

*trade mark remaining unremoved in respect of any goods, as the case may be, in the manner claimed."*

- 13- On prima facie evidence that the Applicant is an aggrieved person.
- 14- The Applicant's 'grief', so to speak, is due to the entry on the register to-wit trademark registration number 32775 "BIG U" in the names of Moyoni International Ltd in class 30 contrary to the evidence of Mr. Obwino which refers to class 4 in paragraph 1.3 of his Statutory Declaration.
- 15- The Applicant insists that it is an entry wrongly remaining on the register because according to them, "BIG U" was not validly registered; "BIG U" is not distinctive; there is a likelihood of confusion from the continuous existence of "BIG U" on the register; and that "BIG G" the Applicant's brand marks were registered earlier.

#### **Validity of Registration**

- 16- The registration was effected under the Trademarks Act cap 217. Section 99 (2) Trademarks Act 2010 provides that:
- "Nothing in this Act shall affect an order, rule, regulation or requirement made, table of fees or certificate issued, notice, decision, determination, direction or approval given, application made or thing done under the Trademarks Act repealed by this Act; and every order, rule, regulation, requirement, table of fees, certificate, notice, decision, determination, direction, approval, application or thing shall, if in force at the commencement of this Act, continue in force and shall, so far as it could have been made, issued, given or done under this Act, have effect as if made, issued, given or done under the corresponding provision of this Act."*
- 17- Section 45 of cap 217 provides:
- "In all legal proceedings relating to a registered trademark (including applications under section 34), the fact that a person is registered as proprietor of the trademark shall be prima facie evidence of the validity*

*of the original registration of the trademark and of all subsequent assignments and transmissions of the trademark.*

- 18- The trademark “BIG U” was registered on 30<sup>th</sup> December 2009 and subsequently assigned to the Respondent. That registration was and is valid until proven otherwise. The onus is on the Applicant to prove as such.

### **Distinctiveness and Likelihood of Confusion**

- 19- The Applicant argues that the mark “BIG U” is not distinctive. And because it lacks distinctiveness, it is likely to cause confusion. The Applicant argued that “BIG U” resembles the Applicant’s stylized “BIG G” trademark number 24180; the only departure from this similarity being the use of letter “U” in place of “G”. That “BIG G” was already on the register at the time of registration of “BIG U” and they are all registered in class 30.

- 20- Section 9 (2)(a) of the Trademarks Act states:

*“For the purposes of this section, “distinctive” means— 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;...”*

- 21- Distinctiveness must be assessed first by reference to the goods or services for which they are registered and secondly, by reference to the perception of the relevant public which consists of average consumers of the products in issue who are themselves reasonably well informed and reasonably observant and circumspect. See **Koninklijke KPN Nederland (2004) ECR I-1619 at paragraph 34.**




- 22- Trademark number 32776 “BIG U” was registered in class 30 for 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.





23- “BIG G” marks specifically TM 16868 is also registered for goods in class 30 whereas TMs 23225, 23226 are registered for chewing gum in class 30 and TM 24180 is registered for confectionery including chewing gum. The “BIG G” marks and “BIG U” are both registered for goods in class 30.

**Applicant’s “BIG G” marks**

Trademark Number	Trademark Representation	Class	Registration date
23226	<b>BIG G</b>	30. Chewing gum	Registered 4 <sup>th</sup> May 2000
16868		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	Registered 19 <sup>th</sup> July 1988
23225		30. chewing gum	Registered 4 <sup>th</sup> May 2000
24180		30. Confectionery including chewing gum	Registered 13 <sup>th</sup> June 2001

24- The mark “BIG U” resembles the mark “BIG G” specifically TM 24180.

404

Respondent's Mark	Applicant's mark
TM 32776	TM 24180
	

25- Both marks comprise of the word BIG with a dotted "I". The whole representation is slightly slanted towards the left hand side. The letters "G" and "U" in the representations are much larger than the word BIG. With both marks the letter G in the word BIG slightly covers part of the letter U and G accordingly.

26- There are obviously some differences in the representation of both marks, the last letter of the marks is "G" and "U" for "BIG G" and "BIG U" respectively. "BIG U" is represented in red colours with black outlines upon an greenish-yellow background. "BIG G" on the other hand, is represented in black on a white background but that is where the differences stop with regard to TM 24180.

27- It is my opinion that the mark TM 24180 "BIG G" and is visually and conceptually similar to the "BIG U" mark. The differences earlier highlighted do not impact on the overall appearance of the mark to make the marks different in the eyes of a reasonable consumer. It is my opinion that the relevant public will not attach any significant importance to the letter U or G or the colours due to the strong conceptual resemblance between "BIG G" and "BIG U" (see **Prichard & Constance (wholesale) Ltd v. Amata Ltd and Others (3)(1925), 42 RPC. 63**).

28- Section 25 (1) provides:

*"Subject to section 27, a trademark relating to goods shall not be registered in respect of goods or description of goods 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 goods;*

*(b) the same description of goods; ...”*

29- The trademark “BIG U” was registered on 30<sup>th</sup> December 2009. Trademark No. 24180 “BIG G” was registered on 13<sup>th</sup> June 2001. Clearly at the time of registration of the “BIG U” mark, TM 24180 was already on the register.

30- However, TM 24180 is registered for only goods specified as confectionery including chewing gum whereas “BIG U” mark is registered for 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. These are not the same goods but are they the same description of goods?

31- In **J. Lyons & Coy. Ld.'s Application (Hostess) 1959 RPC 120 at 128** Evershed, M.R. held that in determining whether goods are of the same description;

*“regard will be had to such matters as the nature and composition of the goods, to their respective uses and functions, and, to the trade channels through which respectively they are marketed or sold; and in different cases one (but not always the same one) of these characteristics may have greater significance or emphasis than the others.”*

32- He further stated:

*“The matter falls to be judged...."in a business sense"... The question whether goods are or not goods of the same description must therefore (I think) be one to be answered in the context of that purpose”*

33- And that:

*“...the phrase" goods of the same " description" ought not to be given too restrictive a construction-not, at all events, so as to be limited to*

40h





*goods substantially analogous in kind, or commonly used as mere substitutes or alternatives the one for the other.”*

34- TM 24180 is registered for confectionery including chewing gum. According to Wikipedia<sup>1</sup> Confectionery also called sweets or candy, is sweet food. In general, confectionery is divided into two categories, bakers' confections and sugar confections. Bakers' confectionery, also called flour confections, includes principally sweet pastries, cakes, and similar baked goods. Sugar confectionery includes sweets, candied nuts, chocolates, chewing gum and bubblegum, sweetmeats, pastillage, and other confections that are made primarily of sugar.

35- Chewing gum is a confectionery. Some of the goods registered to the Respondent including bread, pastry and flour can be considered as confectioneries but I do not think that the Applicant's goods under TM 24180 are the same description as the Respondent's specified goods. Not in their nature and composition atleast.

36- That said, the Applicant is also registered proprietor of TM 16868 also "BIG G" which is registered for the same specified goods are the Respondent's mark.

TM 32776	TM 16868
	

37- Visually, they are different but conceptually the same. See the enlarged letters "U" and "G" respectively following the word BIG with a dotted "I".

38- In the **PIANOTIST CO LTD 23 RPC 77** Parker J said:

---

<sup>1</sup> <https://en.wikipedia.org/wiki/Confectionery> accessed on 14th February 2017.

400

*"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 those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trademarks is used in a normal way as a trade mark for the goods of the respective owners of the marks."*

39- Taking into account the surrounding circumstances including the fact that the Applicant is the registered proprietor of no less than four marks with the words "BIG G" in class 30, my conclusion is that the Respondent's mark resembles the Applicant's marks and specifically for TM 16868, the goods are identical.

40- Therefore, pursuant to section 25 of the Trademarks Act, 2010, TM 32776 "BIG U" should not have been registered. Accordingly, it is an entry wrongly remaining on the register.

41- As the Applicant has prayed, the Register shall be rectified by expunging trademark registration number 32776 "BIG U" registered to Moyoni International Ltd from the Register of Trademarks in Uganda. The Register shall be rectified accordingly.

42- The Respondent shall bear the costs of these proceedings.

Dated this 14<sup>th</sup> day of February 2017

  
  
**AGABA GILBERT**  
**AGABA GILBERT**  
**Asst. REGISTRAR TRADEMARKS**