



UGANDA REGISTRATION SERVICES BUREAU

THE TRADEMARKS ACT, CAP 225

IN THE MATTER OF TRADEMARK REGISTRATION NO. UG/T/2018/63632 “WAH”

AND THE DEVICE IN CLASS 30 IN THE NAMES OF MAAMA CARE

FOUNDATION

AND OPPOSITION THERETO BY PODRAVKA PREHRAMBENA INDUSTRIJA

D.D

Ruling



Before: Birungi Denis: Asst. Registrar Trademarks


Background

1. The applicant filed for trademark number 63632 “WAH” and the device in class 30 of the Nice Classification of Goods and Services, in respect of confectioneries. The applicant’s mark , as represented, is indicated below;



2. The opponent, a company incorporated in Croatia, filed an opposition against the registration of the applicant’s mark. The main ground for opposition is that the applicant’s mark is confusingly similar to the opponent’s registered marks, which are indicated in the table below.

Trademark No	Representation	Class	Goods
52412		29	Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.
52411		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
52413		35	Advertising; business management; business administration; office functions.

3. The opponent contends that registration of the applicant's mark offends section 23 of the Trademarks Act in as far as it is likely to deceive the public to confuse the goods of the opponent with those of the applicant as well as section 25, on grounds that the applicant's mark is confusingly similar with the opponent's marks, particularly those registered in class 30 and 29, which the opponent avers are in respect of the same category of foodstuffs.

Hearing and determination

4. The hearing for this opposition commenced on 22nd March 2023, with several adjournments requested by the parties to explore a negotiated settlement. The negotiations did not lead to an amicable settlement and on the 19th February 2025, the office proceeded with scheduling and issued timelines for filing submissions. The opponent was represented by Counsel Kyosimire

Dinah of SIPI law Associates, while the applicant was not represented. The earlier advocate for the Applicant on record was Counsel Gloria Kawino. However, she filed a notice of withdraw of instructions. After the withdrawal of instructions, the matter proceeded *ex parte*, with the office giving directions to the opponent's advocates to inform the applicant in writing of the issues and timelines for filing written submissions. This was done and the office was notified via email. The applicant did not file submissions in defence of its application. However, I note that the applicant had filed its defence via a counterstatement which I will take into account in determining the issues.

5. The issue for determination is whether the applicant's mark is confusingly similar to the opponent's trademark numbers 52412 in class 29, 52411 in class 30 and 52413 in class 35.
6. Before I proceed to determine that issue, let me first comment on the opponent's statutory declaration filed on 21ST October 2019. The greater part of the declaration discusses matters of law, citing sections of the Trademarks Act and decisions of court with lengthy quotations. It is trite law that a statutory declaration, just like an affidavit, should strictly state matters of fact and leave out matters of law. It should also not be argumentative. In this case, such matters could for instance be; evidence of the opponent's earlier registered marks and annexures of the same, evidence of similarity by placing contested marks side by side, goods of the opponent where such marks are applied, the trade channels of both goods of the opponent and the applicant where confusion is likely to arise, testimonies of actual confusion whenever possible, evidence of the opponent's advertising efforts and evidence of the distinctiveness of the opponent's mark.
7. Section 2 of the Statutory Declarations Act Cap 24, provides that: "*In every*

case to which [section 2](#) does not apply, a person wishing to depone to any fact for any purpose may do so by means of a statutory declaration.” Clearly, as stated under this provision, statutory declarations should depone matters of fact and not matters of law. The procedure for opposition and cancellation provides a platform for Counsel to make legal arguments through filing written submissions. Consequently, it is not necessary to make the same in a statutory declaration, which, depending on the degree, can make it defective.

8. Be that as it may, I will proceed to determine the question of similarity and likelihood of confusion. Section 25 of the Trademarks Act which prohibits registration of similar marks provides as follows;

“25. Prohibition of registration of identical and resembling trademarks (1)
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; or; (c) services or a description of services which are associated with those goods or goods of that description.”

9. In determining whether there is sufficient degree of similarity so as to lead to likelihood of confusion, I adopt the test propounded by Parker J in **Pianotist Co’s application (1906) 23 RPC 774 at page 777** where he stated; 4
“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 these goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trademarks is used in a normal way as a trademark for the goods by the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be confusion - that

is to say, not necessarily that one man will be injured and the other gain illicit benefit, but there will be a confusion in the minds of the public which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse registration in that case".

10. To determine similarity and likelihood of confusion, each mark must be looked at as a whole in comparison to the other, considering the visual, conceptual and phonetic similarity. The case of **Specsavers International Healthcare Ltd v Asda Stores Ltd [2012] EWCA Civ 24** provides an elaborate list of factors to be considered in determining identity and likelihood of confusion. I will reproduce it extensively;

- a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- b) 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 he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- d) 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 it 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;

- e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
 - f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
 - g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
 - h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
 - i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
 - j) 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;
 - k) if the association between the marks 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.
11. Keeping those guiding principles in mind, I proceed to analyze the marks to determine whether applicant's mark is confusingly similar to the opponent's mark. For better context, the applicant and the opponent's mark are placed side by side below;

Applicant's mark	Opponents mark
	

12. The applicant's mark is both a word and logo mark. The word "WAH" is presented in a stylized manner, with an exclamation mark (!) also presented in a stylized format. Behind the words, is the drawing of a baker's head, wearing a yellow toque hat, facing left and folding a thumb and an index finger. The baker's head is surrounded by a circular object, with a ribbon at the base. The whole mark of the applicant is colored in shades of yellow and red, with the baker's head in white color wearing a yellow toque hat. On the other hand, the opponent's mark is a picture of a baker's head, folding an index and thumb finger, facing the right direction. The baker's toque hat is white in color. The baker's head is enclosed in a circular device with dark blue color. Visually, with the exception of the picture of the baker's head, the two marks look different. The striking color differences, the addition of the word "WAH" and the ribbon below the circle on the applicant's mark is clearly distinct from the applicant's dark circular device.

13. I take keen note of the differences in colour combinations. Colour

combinations play an important part in a mark. In the case of **Smith Kline and French Laboratories Ltd (SKF) V Sterling Withrop Group Ltd [1975] 2 All ER 578**, Lord Diplock, while recognizing the impact of color in marks, noted;

"The color combinations have thus been shown by undisputed evidence to serve the business purpose of a trademark. They do precisely what a trademark is meant to do: they indicate to potential buyers that the goods were made by SKF and not by other manufacturer...My Lords, I see nothing in this context that requires one to exclude from the definition of a trademark, a mark that covers the whole of the visible surface of the goods to which it is applied. Such a mark is capable of indicating a connection in the course of trade between the goods and the proprietor of the mark as it would have been if it had only covered half of three quarters of the visible surface..."

14. Colour combination is therefore an important factor for consideration in assessing the visual and conceptual similarity of the mark. Therefore, in addition to the other differences such as the existence of the word "WAH" which in itself adds a phonetic difference, the striking colour differences between the applicant's and the opponent's mark reveal a marked visual and conceptual difference. It should be recalled that the test is that of an ordinary consumer; one that does not pay very keen attention to every minor difference. In this case however, the differences are marked and clearly visible for an ordinary consumer not to confuse the products bearing the two marks.

15. While I agree with Counsel for the Opponent's argument that in assessing the likelihood of confusion, the court, and in this case, the Registrar must consider the overall impression created by the marks, taking into account their distinctive and dominant components, I do not agree that this is a case for which the Registrar should resort to considering the dominant

components. The criteria for resorting to dominant components was stated in the case of **Specsavers International Healthcare Ltd v Asda Stores Ltd** where court noted that; *“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 it 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...” (Emphasis mine).*

16. In line with the above principle, it appears to me that resort to dominant components is akin to when a football match ends in a draw, requiring the referee to proceed to penalties to determine the winner. In this case, I have already analyzed all the other components of the two marks, including color differences, and the additional of the word “WAH” which creates a stronger distinctive feature phonetically and visually. In my view these are not negligible to require me to resort to considering the dominant part of the marks to decide this opposition. What the opponent considers to be the dominant component is the picture of the baker, appearing in both marks, with a slight difference, with the baker in the applicant’s mark wearing a yellow toque hat, while the one in the opponent’s mark is wearing a white toque hat.
17. I am mindful that under section 25 of the Trademarks Act, for confusion to arise, there should be double similarity; that is similarity between the marks and similarity between the goods or services associated with those marks, and where the alleged earlier mark is highly distinctive, evidence of similarity between the goods and services may be required. This position was stated in *Canon Kabushiki Kaisha Y Metro-Goldwyn-Mayer Case C-39/97* where, the ECJ stated;

“It is, however, important to stress that, for the purposes of applying Article 4(1) (b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered”

18. With respect to the goods, the applicant’s mark is for confectioneries in class 30 which generally includes products like chocolates, cakes, doughnuts, candy etc. The opponent’s goods in class 30 also include confectioneries, although, the opponent omits to include evidence of the actual goods where the mark is applied. In my view, double similarity does not arise as I have already determined that despite similarity in the baker’s head, the other differences are sufficient to create distinction between the two marks. Assessment of the similarity between the two signs in contention means more than taking just one component of a composite trademark and comparing it with another mark. However, this does not mean the overall impression that the mark makes on the relevant public cannot be controlled by one dominant element in the composite mark. The latter can only be preferred if all other components of the mark are negligible that the assessment of the similarity can be carried out solely based on the dominant element (see, C-251/95 SABEL). In this opposition the dominant parts are immaterial with respect to the goods in classes 30. I do not see how the likelihood of confusion would arise with respect to the opponent’s goods in class 29, and services in class 35 as these are clearly different from the applicant’s goods.

19. In light of the above, the opposition fails and is hereby dismissed. Each party shall bear its costs.

I so order.

Given under my hand this 02nd day of June 2025

Birungi Denis
Assistant Registrar of Trademarks