THE REPUBLIC OF UGANDA

THE TRADEMARKS ACT, CAP 225

IN THE MATTER OF TRADEMARK APPLICATION NO. UG/T/2023/081536 "SPARKLE SHINE" IN THE NAME OF KANGAROO BRANDS LIMITED (KENYA)

AND

IN THE MATTER OF AN OPPOSITION THERETO BY ISIMA SSEWANKAMBO T/A KANGAR SHOE CARE

ISIMA SSEWANKAMBO T/A KANGAR SHOE CARE .... OPPONENT

VS

KANGAROO BRANDS LIMITED (KENYA) .... APPLICANT

RULING

Before: Kukunda Lynette Africa, Asst. Registrar of Trademarks

Background:

1. On 16th December, 2023 Kangaroo Brands Limited, a company incorporated in Kenya (hereinafter the Applicant), applied for registration of the mark "SPARKLE SHINE" (and device) in Class 3 in respect of Shoe Polish/Shoe Cream. The mark was examined and proceeded to be published in the Uganda Gazette on 19th April, 2024.

2. On 18th June, 2024, Isima Ssewankambo T/A Kangar Shoe Care (hereinafter the Opponent) filed a notice of opposition against the registration of the Applicant's mark. The Opponent claims to be the registered proprietor of the trademark no. UG/T/2015/154469 “KANGAROO” in Class 3 in respect of polishing preparations, and No.

UG/T/2023/78281 “KANGAROO” in Class 35 in respect of advertising and business management.

3. The matter came up for hearing on 20th May, 2025. At that hearing, the Opponent was represented by Counsel Mandela Araali and Counsel Kabangira Richard of DAB Advocates while the Applicant was represented by Counsel Resty Nalwanga and Counsel Jacob Alituha of Angualia Busiku & Co. Advocates. At the hearing the Applicant raised preliminary objections to the propriety of the opposition, and the following issues were agreed upon:

   i. Whether the cause of action raised in the opposition falls within the jurisdiction of the Registrar?
   ii. Whether the opposition proceedings are barred by the *lis pendens* rule?
   iii. What remedies are available to the parties.

   Parties filed written submissions on the agreed issues.

Determination of the Preliminary Objections:

4. The Opponent’s grounds and arguments, though extensive, may be summarized as follows: that the Applicant's Kenyan business is fronted by, or connected to, individuals whom the Opponent had previously restrained by various court and settlement processes from dealing in shoe cream bearing the Opponent's KANGAROO mark or a colourable imitation of it. That although the Opponent accepts that the SPARKLE SHINE mark itself is visually and phonetically distinct from KANGAROO, the retention of the words *"Made in Kenya by Kangaroo Brands Limited"* on the Applicant's packaging, in the same position, colour and design previously used on infringing tins, perpetuates the very confusion those

court processes were meant to stop and that the choice of "Kangaroo Brands Limited" as the named proprietor of SPARKLE SHINE is itself calculated to keep the word "Kangaroo" actively visible before Ugandan consumers. The Opponent prayed that the application be refused, with costs.

5. In support of this narrative, the Opponent's opposition refers to, among others: a memorandum of reconciliation dated 2013 between Muwanga Richard Mugenyi and the Opponent arising from CID Case HQ 363/2023 (Uganda v Muwanga Richard Mugenyi), by which criminal charges of trading in counterfeit "Kangaroo" products were withdrawn on terms including forfeiture of seized stock; an interim order of 1st October, 2019 in High Court Miscellaneous Application No. 433 of 2019 (arising out of HCCS No. 454 of 2019), restraining Mirembe Ruth, Habomugisha Hamis, Jerad Munaawa, Walter Joogo and Sadik Guminkiriza from manufacturing, selling or importing shoe cream under "Kangato" or "Kangaroo" pending disposal of that suit; a consent judgment of August 2023 in HCCS No. 454 of 2019, by which the 3rd, 4th and 5th Defendants (Munaawa, Joogo and Guminkiriza) undertook, in exchange for a payment of Shs. 3,000,000/=, to cease dealing in shoe cream infringing KANGAROO Class 3 No. 54469, that suit apparently remaining live as against the 1st and 2nd Defendants (Mirembe Ruth and Habomugisha Hamis); and a consent judgment of August 2023 in HCCS No. 521 of 2023 (Ssewankambo v Muwanga Richard Mugenyi, Najjengo Lydia and Uganda Registration Services Bureau), by which a permanent injunction was entered against the 1st and 2nd Defendants and that suit, together with Miscellaneous Application No. 900 of 2023, was withdrawn.

6. The Applicant on the other hand asserts that it is a Kenyan manufacturer of shoe and leather care products trading under the KANGAROO name since the year 2000 under the Kenyan company and trademark registrations. That it entered the Ugandan market in 2009 through a distributor, Habomugisha Hamis, and that it was in fact the Opponent who, in 2015, dishonestly appropriated the Applicant's pre-existing and notoriously popular KANGAROO name by registering it in Uganda in his own name, subsequently mounting a campaign of arrests, seizures and litigation against the Applicant's agents. It is this history, the Applicant says, that led it to rebrand its Ugandan product under the new mark "SPARKLE SHINE" and to seek its registration.

7. Before turning to the two substantive issues, it is necessary to dispose of a procedural complaint raised in the Applicant's rejoinder. The Applicant states that the Opponent's submissions in reply repeatedly invoke a "statutory declaration in rejoinder" that was never served on the Applicant, and asks that it be struck out for the purposes of these submissions. Regulation 33 of the Trademark Regulations, 2023 requires an Opponent who wishes to file evidence in reply to do so, and to serve copies on the applicant, within one month of receiving the applicant's statutory declaration, and that evidence being confined to matters strictly in reply.

8. The record before me contains no proof that the statutory declaration in rejoinder relied upon in the Opponent's submissions was ever served on the Applicant, whether within the time prescribed by Regulation 33 or otherwise. A party cannot be expected to respond to evidence it has not seen, and to permit reliance on such a document in these circumstances

would offend the basic requirement of a fair hearing. I accordingly find that, for the purposes of the preliminary objections now before me, the Opponent's statutory declaration in rejoinder cannot be relied upon and is disregarded.

Issue One: Whether the Opposition falls within the jurisdiction of the Registrar?

9. The Applicant's main contention is that, stripped of its rhetoric, the opposition does not challenge the registrability of the mark "SPARKLE SHINE," but complains of how the Applicant conducts its business and labels its goods in the market, which is a matter of passing off and unlawful competition, falling within the exclusive jurisdiction of the High Court. The Applicant relies on this office's own decision in **East African Roofing Systems Ltd v Metal Wood Industries Ltd, Opposition of Trademark Application No. UG/T/2021/072822**, to the effect that the Registrar's scope of inquiry in opposition proceedings is confined to matters that can prohibit registration such as lack of distinctiveness under Section 9 and the restriction on registration of identical or resembling marks under Section 25, the restriction on marks contrary to law or likely to deceive under Section 23, prohibited marks under Regulation 13, concurrent use under Section 27, and prior registration in the country of origin under Section 44. It further relies on **Megha Industries U Ltd v Royal Mabaati Uganda Ltd, Application for cancellation of Trademark No. 05981,** for the proposition that disputes as to how a mark is used in the market place fall outside the Registrar's jurisdiction, and on the Court of Appeal's statement in **Owners of Motor Vessel "Lillian" v Caltex Oil (Kenya) Ltd [1989] KLR 1**, cited with

approval by this office in **Elite Gold Limited v Indo-Bali Distributors Limited,** that a decision making body acting outside a jurisdiction not conferred by statute acts ultra vires, and that questions of jurisdiction must be resolved at the earliest opportunity.

10. The Opponent submits that his case is properly one concerning the registrability of the applied for mark, as it raises questions of likelihood of confusion and bad faith, matters which the Registrar is required to consider when determining whether a mark is capable of registration. The Opponent further contends that the essence of its opposition, as pleaded in paragraphs 16 to 18 of the Notice of Opposition, is that an ordinary Ugandan consumer, upon encountering the word "Kangaroo" on a shoe cream tin of similar appearance, is unlikely to distinguish between the respective trade sources. It is therefore argued that these issues fall squarely within the Registrar's mandate in assessing whether the mark satisfies the requirements for registration.

11. The difficulty with the Opponent's position, on his own pleadings, is that the very foundation of a complaint that a mark is likely to deceive or confuse, whether framed under Section 23 or as an allegation of bad faith, is that there is some degree of resemblance between the marks or the impressions they create. Yet the Opponent does not contend that "SPARKLE SHINE" resembles "KANGAROO". Indeed, this office's own decision in **East African Roofing Systems (supra),** which was cited by both parties, holds that similarity and likelihood of confusion are inextricably linked, that there can be no claim of confusion where there is no evidence of similarity of the marks and the goods and that bad faith cannot arise where the disputed mark has no resemblance so as to be likely to cause confusion in the market. So since the Opponent accepts,

as he does, that the two marks are not similar, the confusion of which he complains cannot arise from the mark “SPARKLE SHINE”. Instead, based on his own pleadings, the confusion he claims, stems from the phrase *"Made in Kenya by Kangaroo Brands Limited"* and the choice of that corporate name, labelled on the Applicant’s products in the market. However, those details only relate to how the goods are packaged and presented for sale, they have nothing to do with the registrability of the mark applied for.

12. That is, in substance, a complaint of passing off and deceptive packaging falling in the realm of unlawful competition. It asks not whether “SPARKLE SHINE” is distinctive, deceptive, or confusingly similar to an earlier registered mark, but whether the Applicant's trading conduct in the market place, taken as a whole, is liable to mislead or confuse consumers as to trade origin. Passing off is provided for under Section 35 of the Trademarks Act which states that:

> ***Nothing in this Act*** ***shall be taken to affect a right of action against a person for*** ***passing off goods or services*** *as the goods or services of another or the remedies in respect of* ***the right of action.*** *[emphasis mine]*

13. Section 35 above essentially preserves the common law action of passing off independently of the statutory trademark registration system. In practical terms, it means that the Trademarks Act does not take away a person's right to protect the goodwill and reputation they have built in relation to particular goods or services merely because their mark, name, getup, or other identifier is not registered as a trademark.

14. Passing off protects a trader's goodwill from misrepresentation in the marketplace and is traditionally established through the "classical trinity" of goodwill, misrepresentation and damage. A claimant must demonstrate that they have acquired goodwill or reputation in relation to particular goods or services, that the defendant has made a representation likely to cause the public to believe that the defendant's goods or services are those of, or are associated with, the claimant, and that such misrepresentation has caused or is likely to cause damage to the claimant's goodwill. This test was authoritatively articulated in **Reckitt & Colman Products Ltd v Borden Inc. [1990] 1 WLR 491,** where the House of Lords confirmed that passing off may protect distinctive product get up and packaging even in the absence of a registered trademark, provided the three elements are established.

15. Section 35 is a saving provision. When it states that nothing in the Trademarks Act affects a "right of action" for passing off or the remedies available in respect of that action, it preserves the claimant's common law right to institute proceedings before a competent court. The Registrar does not exercise the court's jurisdiction to determine a standalone tort of passing off and award the traditional remedies such as damages, injunctions or an account of profits.

16. Section 24 (a) of the Trademarks Act, moreover, entitles a trader to use its own name in the course of trade, so the presence of the words "*Kangaroo Brands Limited",* which is the Applicant's corporate name, on its packaging is not a matter the Trademarks Act treats as a bar to registration. Whether the manner of that use nonetheless amounts to actionable passing off or unlawful competition is a question requiring findings on goodwill, reputation, getup and the effect of trade conduct in

the market, precisely the kind of inquiry this office, in **Megha Industries (supra),** held to be outside its jurisdiction and reserved to the High Court.

17. I am conscious that jurisdiction, being fundamental to this office's authority to adjudicate at all, is a matter to be resolved at the earliest opportunity, as the Court of Appeal held in **Owners of Motor Vessel "Lillian" (supra).** Having examined the grounds of opposition as pleaded, and the Opponent's own submissions explaining them, I find that none of the twenty five grounds set out in the notice of opposition is sustainable as a ground of opposition for which the Registrar can adjudicate under Sections 9, 23, 25, 27 or 44 of the Trademarks Act or Regulation 13 of the Trademark Regulations. Each of the grounds raised, restates the same underlying grievance of passing off and unlawful competition through market conduct.

18. I accordingly find that this opposition does not disclose a cause of action within the jurisdiction of the Registrar, and I uphold the Applicant's preliminary objection on this ground.

19. Given my finding on jurisdiction, I find it unnecessary to determine the Applicant's alternative objection founded on the *lis pendens* rule.

Remedies Available

20. Having found that the opposition discloses no cause of action within the jurisdiction of the Registrar of Trademarks, the opposition is accordingly dismissed.

21. The dismissal of this opposition is without prejudice to whatever rights the Opponent may have, and is in fact already pursuing, before the High

Court in HCCS No. 303 of 2025 and any surviving claims in HCCS No. 454 of 2019, which remains the proper forum for resolution of the parties' underlying dispute over passing off and unlawful competition.

22. Trademark Application No. UG/T/2023/081536 “SPARKLE SHINE” shall proceed to registration upon application and payment of the requisite fees.

23. Section 57 of the Trademarks Act, Cap 225 empowers the Registrar to award costs. Accordingly, the Applicant is awarded costs to be paid by the Opponent.

I so order.

Dated at Kampala this 20th day of August, 2026

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UGANDA REGISTRATION SERVICES BUREAU
Kukunda Lynette Africa
REGISTRAR

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Kukunda Lynette Africa

ASSISTANT REGISTRAR OF TRADEMARKS