THE REPUBLIC OF UGANDA

IN THE MATTER OF THE TRADEMARKS ACT CAP 217

AND

IN THE MATTER OF THE TRADEMARK RULES S1 –217-1

AND IN THE MATTER OF OPPOSITION TO REGISTRATION OF TRADE MARK NO. 28212 "LIFESTYLE" IN CLASS 16 PART. A

NEW VISION PRINTING & PUBLISHING CO. LTD.....OPPONENTS

Versus

NATION MEDIA GROUP LTD.....APPLICANT

RULING

Before me: Juliet Nassuna, Asst. Registrar Of Trade Marks

BRIEF FACTS

The applicant filed an application for registration of Trademark Number: 28212 "**LIFESTYLE**" in Class 16 under Part A of the register. The application was duly lodged and advertised in the gazette of 2nd December 2005.

The opponent filed a notice of opposition and statement of grounds of its opposition on the 11th April 2006.

A scheduling conference was held on the 8th day of April 2008 and the agree issued were as follows;

ISSUES:

i. Whether the trademark **LIFESTYLE** is registrable?
ii. Whether there are any remedies available.

I have read the written submissions of both parties and hereby make my ruling in consideration of the same.

Before I handle the issues at hand, I would like to first respond to the preliminary issue as raised by the applicant as to whether the opponent has *locus standi* to bring this action.

LOCUS STANDI

The procedure by which an opposition is to be conducted is regulated by **Section 20 Of The Trade Mark Act Cap 217** and **Rule 46 Of The Trademarks Rules S I 217- 1.** According to the rule;

> *"**Any person may** within sixty days from the date of any advertisement in the Gazette of an application for registration of a trademark give notice on Form TM 6 the register of opposition to the registration."*

When the mark has been accepted and advertised, any person may oppose the registration on the ground that for any reason it ought not to be registered (**T.A BLANCO AND ROBIN JACOB, Kerly's law on trade marks, 12th edition, pg. 43)**

Therefore the opponent has *locus standi* since it is aggrieved by the application.

ISSUE 1: WHETHER THE TRADEMARK "LIFESTYLE" IS REGISTRABLE.

The basic definition of what constitutes a registrable mark has been significantly widened. The **Trade Marks Act, Cap 217, Section (1)** defines a trade mark as being:

> *any sign capable of being represented graphically which is capable of distinguishing goods and services of one undertaking from those of other undertakings.*

A trade mark means, except in relation to a certification trademark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identify of that person, and means, in relation to a certification trade mark, a mark registered or deemed to have been registered under Section 39. **(Section 1(I) Of The Trade Marks Act Cap 217)**

The sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings and the importance was stressed in **Kaisha v Metro Goldwyn Mayer Inc. [1999] FSR 332.** If the sign of trademark cannot be distinguished then it is not registrable.

The applicant refers to **"Nation LIFESTYLE"** as the trademark in question in their submissions. This is not proper because according to the application that was lodged at the trademark registry the trademark in question is **"LIFESTYLE"** and not **"Nation LIFESTYLE".**

Therefore reference will be made to trademark **"LIFESTYLE"** as per the application and gazette advert. The applicant should not confuse the parties by introducing a new mark that is not in question.

According to the opponent, "**LIFESTYLE**" is not a registrable trademark. The opponents grounds for opposition are as follows;

1. That ~~Wednesday~~ Lifestyle is a universal and frequently used word which can not be set apart or registered to uniquely identify as of right with the applicants goods.

2. That registration of the said mark will result in an unfair gain, unfair competition and benefit from a universal word.

3. That ownership/ exclusive use ought to be accredited to an inventor, author or originator of a word.

4. That the offending mark is not a mark registrable in Part A of the register.

On the issue of whether the trade mark ~~Wednesday~~ Lifestyle is registrable, the elements to be considered in this case is the definition of trademark, what amounts to a trade mark among others.

In order for a trademark to be registrable in Part A of the register, it must contain at least one of the essential particulars.. *an invented word or words*, word(s) that have no direct reference to the character or quality of the goods and not being according to its ordinary signification a geographical name or surname and any other distinctive mark, but a name, signature, or word or words that does not fall in this category is not registrable except upon evidence of distinctiveness. **(Section 11, Trademarks Act Cap 217)**

Every trade mark *must be distinctive*, that is, capable of distinguishing the goods from those of other persons. Distinctive means adapted, in relation to the goods in respect of which a trademark is registered or proposed to be registered, to distinguish goods, with which the proprietor of the trade mark is or may be connected in the course of trade, from goods in the case of which no such connection subsists...**(Section 11 (2))**

The intention of the requirement that a name should be presented in a special and particular manner is obviously to prevent that name from being so taken as a trade mark that any one in business might unintentionally infringe it by an honest use. **(T.A BLANCO AND ROBIN JACOB, Kelly's law on trade marks, 12th edition, pg. 77)**

According to **Section 11(c)** of the Trademarks Act, for a word to qualify to be registered as a trade mark, it must be invented. Therefore, I don't think the use of an English word "**LIFESTYLE**" amounts to an invented word if to the eye or to the ear the same idea would be conveyed by the word in its ordinary form as was held in **Eastman [1898] A.C 571: 15 R.P.C -Solio case)**. There must be invention of words and the words should clearly and substantially be different from any word in ordinary use and common use.**[Hallgarten (1948) 66 R.P.C 105]**

In the case of **Philips Electronics NV v Remington Consumer Products Ltd [199] RPC 809; MESSIAH FROM SCRATCH Trademark [2000] RPC 44**, Aldous LJ held that Section 3(1)b (which is equivalent to Section 11 of the Trademarks Act Cap 217) is to the effect that a trademark shall not be registered if it devoid of any distinctive character. This section prevents registration of a mark, without proof of distinctiveness, which is so wholly lacking in the present case.

Having looked at the submissions of both counsel , I find that "**LIFESTYLE**" is not an invented word but an English word that is commonly used and it is not distinctive mark within the meaning of the Trademarks Act.

It is therefore my considered opinion that the application for registration "**LIFESTYLE**" trademark be disallowed for the reasons stated herein above.

Both parties should bear their own costs.

Delivered this.....5th.....day.....AUGUST.....2009

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Juliet Nassuna

Asst. Registrar Of Trade Marks