



**UGANDA REGISTRATION SERVICES BUREAU
THE TRADEMARKS ACT, 2010
IN THE MATTER OF TRADEMARK APPLICATION NO.
UG/T/2010/40921“EVE CARE” IN CLASS 5 IN THE NAME OF HIMALAYA
GLOBAL HOLDINGS LTD
AND
OPPOSITION THERETO BY NANOOMAL ISSARDAS MOTIWALA (U) LTD**

NANOOMAL ISSARDAS MOTIWALA (U) LTD:.....OPPONENT.

VERSUS

HIMALAYA GLOBAL HOLDINGS LTD:..... APPLICANT

Before: Birungi Denis: Assistant Registrar of Trademarks

Ruling

(a) Background

1. The applicant—a company incorporated and headquartered in Dubai, United Arab Emirates, filed application number UG/T/2010/040921 for registration of the word “EVE CARE” as a trademark in class 5 of the Nice Classification of Goods and Services in respect of pharmaceutical and veterinary preparations; sanitary preparations for medical purposes, dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides. The applicant is also the registered owner of the disputed trademark in India, Mongolia, Bulgari, the European Union, Nepal, Myanmar, Cost Rica and Nicaragua, South Korea and Lao Peoples Democratic Republic.

2. The opponent, on the other hand, is a company incorporated in Uganda and the registered proprietor of trademark Number A40309 “EVE” and the device registered in class 5, in respect of pharmaceutical and veterinary preparations,

sanitary operations for medical purposes, diabetic substances adapted form medical use, food for babies, plasters, materials for dressings, materials for stopping teeth, dental wax, disinfectants, preparations for destroying vermin, fungicides and herbicides. The opponent's mark is indicated below alongside that of the applicant.



3. The opponent objects to the registration of the applicant's mark on grounds that the mark is similar with its registered mark No. A40309 "EVE", and is likely to deceive and cause confusion between the goods of the opponent and those of the applicant. According to its statement of grounds for opposition, the opponent contends that the prevalence of the word—EVE—in both marks is likely to cause confusion considering that both entities are using it for the same or similar goods. For this reason, the opponent contends that the applicant's mark is not adapted to distinguish its goods from those of the opponent and lacks distinctiveness within the meaning of section 9 of the Trademarks Act, 2010 hence not eligible for registration.
4. When this matter came up for scheduling on 14 December 2023, Counsel Brian Kajubi of MMAKs Advocates appeared for the opponent while Counsel Namuyanja Lillian of Sipi Law Associates appeared for the applicant. The following issues were raised.
 - (1) Whether the applicant's trademark is confusingly similar to the opponent's trademark number 40309
 - (2) Whether the applicants mark is distinctive
 - (3) Whether the opponent's mark offends section 23 of the Trademarks Act,2010
 - (4) Remedies

Determination of the issues.

5. The main issue of contention is the use of the word “EVE” in the applicant’s mark and whether its use makes the applicant’s mark similar to that of the opponent to lead to a likelihood of confusion among ordinary consumers. The issue of whether the applicant’s mark lacks distinctiveness and whether it is likely to deceive and hence offend section 23 of the Trademarks Act, are both premised on the question of similarity and likelihood of confusion between the two marks. I will therefore address all the issues concurrently.
6. Section 25 of the Trademarks Act prohibits the registrar from registering similar or identical marks that are likely to cause confusion in the market. It states;

“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.

(2) Subject to [section 26](#), a trademark relating to services shall not be registered in respect of services or description of services 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 services;
(b) the same description of services; or
(c) goods or a description of goods which are associated with those services or services of the description.”

7. Section 25 (1) which applies to goods, is what is relevant in the circumstances of this case. It prohibits registration of trademarks similar or identical with a trademark that is already on the register. Under that provision, it is not enough that the trademarks are similar. The goods for which the subsequent mark is sought to be registered must be the same or of the same description or must be

services or description of services associated with the goods. This nexus between the similarity of the disputed marks and the nature of goods in question is the basis for determination of likelihood of confusion. Consequently, there is no likelihood of confusion where the marks in question are similar but the goods are very different, for example a similar mark for medicines would not be deemed confusing if it was sought to be registered in respect of vehicle spare parts.


8. In the instant case, the goods are the same or similar as indicated in paragraph 1 and 2. The question to determine is whether the marks are similar.

9. The test for assessing the degree of similarity so as to lead to likelihood of confusion, was propounded by Parker J in **Pianotist Co's application (1906) 23 RPC 774** at page 777 where he stated;

"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" (emphasis mine).

10. In assessing similarity and likelihood of confusion, the two marks must be compared in terms of their visual, aural and conceptual similarity and the overall impression created in the mind of the ordinary consumer, bearing in mind the dominant elements. (See the decision of this office in opposition to trademark application No. 40233 "JJABARI).


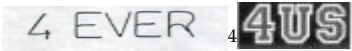



11. In applying this test, I note that visually, the applicant's mark "EVECARE" is

similar to the opponent's  trademark because of general impression of the word "eve" which is dominant and distinctive part of the opponents mark. The applicant's EVECARE mark is the word "EVE" with "CARE" added to form the word "EVECARE". It should be noted that the added

word "CARE" is not distinctive within the meaning of section 9 of the Trademarks Act, 2010, for it merely describes that character of the goods, namely to give "care". Because of the non-distinctiveness of the word "CARE", the differences in the opponent's mark such as the italicized letters "e" in white color, with lever "v" in color green artistically designed to appear like a tick symbol in the middle of the two letters creating an artistic impression of the word "EVE" and the added blue device, are not sufficient to remove the similarity.

12. The common dominant feature in the two marks is the word "eve". Several precedents have affirmed the principle that a trademark should be looked at as a whole. Resort to considering the dominant part, as was held in the case of **Specsavers International Health care Limited v Asda Stores Limited [2012] EWCA Civ 24**, should be done "*only when all the other components of a complex mark are negligible*". I have already analyzed the other components, including the italicization of the word "eve", the background color, the shape of the device and colors of letter "e". I find them negligible in determining the question of similarity because the overall impression created by the mark is that of the word "EVE". It should be noted that an ordinary consumer normally perceives a mark as a whole and does not proceed to analyze its various details (*See Sabel v Puma*). In this case, the ordinary consumer would perceive the word "EVE", not the background device, and other minor details highlighted.
13. With regard to phonetic similarity, the case of **Sabel v Puma AG (1998) RPC 199** cited by Counsel for the applicant affirm the principle that similarity might be visual, phonetical or conceptual. Phonetic similarity refers to the degree of resemblance between two trademarks in their pronunciation or sound. The similarity is in sound and what is heard when a consumer or salesperson mentions the name of the product. For the applicant's mark, the sound is that of "evicare" while for the opponent's mark, the sound is mere "eve". Phonetically, the italicized letters and the styled letter "v" do not create distinction if the consumer is only paying attention to the phonetics. The sound will always be that of "eve" regardless of the stylization and device added. Considering phonetics alone, the words "eve" and "evicare" do not create the same sound. This is because the word "evicare" is a single word and not two separate words to lead the consumer to mention the beginning part of the mark "eve", without completing its full name by adding "care".

14. In most cases where courts have found phonetic similarity to exist, the letters have had common phonetics or syllables in their combination and sequence throughout the word or words in question. Examples include “Feathers” and “featlhers”¹, “DANIELLA” and “DANIELA”² “CAMEA” and “BALEA”³ marked as low level

similarity,  and  and  regarded as average and  and  ⁵considered low level similarity.

15. The key elements for determining the overall phonetic impression of a trademark are the syllables and their particular sequence and stress. The assessment of common syllables is particularly important when comparing marks phonetically, as a similar overall phonetic impression will be determined mostly by those common syllables and their identical or similar combination.

16. Applying the above principle, I do not find the word “EVECARE” as having the common syllables, and arranged in the same sequence and stress as the opponent’s mark “EVE” and hence I do not find the two marks phonetically similar. However, this, in and of itself, is not definitive. The principle is that a mark should be analyzed as a whole in terms of its visual, aural and conceptual similarity to ascertain the overall impression created by the mark.

17. I now turn to conceptual similarity. Two signs are identical or similar conceptually when they are perceived as having the same or analogous semantic content in the public (See **C-251/95 Sabel**). If the signs refer to similar concepts, they are conceptually similar.

18. In the present case, the applicant’s mark is a word “EVECARE” while that of the opponent is “EVE” as represented, together with the device. Counsel for the opponent contends that the meaning of the word “EVE”, common in both marks, brings the concept of a female name—EVE—and also invokes a biblical connotation of the first woman “EVE” in Christian historical doctrine of the beginning of man—where according to the bible, God created Adam and Eve.

¹ **Civil Suit No. 303 Of 2013: Vision Impex Ltd V Sansa Ambrose and another**
² **Civil Suit No.316 Of 2013 Strategic Industries Limited Solpia Kenya Limited (Klr)**
³ T-195/13, EU:T:2015:6
⁴ T-528/11, EU:T:2014:10
⁵ R 1071/2009-1

Counsel also submits that the alternative dictionary meaning of the word “Eve”, is the day before an important date, as for example “Christmas eve” or “wedding eve”. Counsel concludes that conceptually, the word “EVE” relates to a female name, but admits that the opponent’s addition of the device limits the conceptual similarity. The applicant’s Counsel argues that the effect of the differences caused by the stylization of the opponent’s mark, the fact that the applicant’s mark is not separate and the use of the device in the opponent’s mark are marked differences that remove any likelihood of confusion.

19. The question as to whether the word “EVE” belonging to the opponent and contained in applicant’s trademark is likely to cause confusion must be assessed with reference to the applicable principles. One consideration is the extent to which the shared element has retained its identity as an essential feature of the trade marks (*See Bulova Accutron Trade Mark [1969] RPC 102*). For example In *Energy Beverages LLC v Cantarella Bros Pty Ltd [2023] FCAFC 44 at [167-171]*, the court held that MOTHER and MOTHERSKY were deceptively similar, considering that one trademark is wholly incorporated into the other, MOTHER does not lose its identity as part of MOTHERSKY, and MOTHERSKY as a whole does not have a well understood meaning.
20. Another consideration is the distinctiveness of the common element and the distinctiveness of additional element/s. If the additional element changes the idea of the trademark, this may point towards a finding that the marks are not deceptively similar. For example in *Swancom Pty Ltd v The Jazz Corner Hotel Pty Ltd (No 2) [2021] FCA 328 (at [239])* JAZZ CORNER HOTEL and CORNER HOTEL were considered not to be deceptively similar because the idea had fundamentally changed.
21. In the instant case, the overriding idea and distinctive word is “EVE”. As I have already determined, the word “CARE” added by the applicant to the word “EVE”, in and of itself, is not distinctive. The online Oxford dictionary defines the word “care” to, among others, mean “*the provision of what is necessary for the health, welfare, maintenance, and protection of someone or something.*”⁶ The applicant seeks to register the mark under class 5 for health care products. The word “care”, being closely

⁶https://www.google.com/search?q=care+meaning&sca_esv=d49addb7d865e5f4&rlz=1C1JJTC_enUG1068UG1068&sxsrf=ADLYWIKBO1x4ybenfss3LhQzTY4bmDVPHg%3A1718171924975&ei=FDlpZuaVO46A9u8PwlqqqAs

associated to among others, health care services, does not add distinctiveness and hence does not change the impression of the mark to make it markedly distinct from that of the opponent.

22. Another consideration is the nature of the additional elements. If the additional elements are particularly distinctive and sufficiently alter the impression of the mark as a whole, then the marks will most likely not be deceptively similar, even though they share a common element. Similarly, if the additional element has a low level of distinctiveness then the marks are more likely to be deceptively similar. (See *Application by Coles Myer Ltd, (1993) 26 IPR 577*, comparing BRATS and BONZA BRATS). In the instant case, I have already determined that the addition of the word “CARE” does not create distinctiveness in the mark hence negligible in determination of the overall impression.
23. The third factor is the meaning behind the trademarks. Where an additional element changes the meaning of the trademark or the concept behind it then the trademarks are less likely to be deceptively similar. For instance, in *PDP Capital Pty Ltd v Grasshopper Ventures Pty Ltd [2020] FCA 1078* the court held that in the trade mark WICKED SISTER, neither WICKED nor SISTER were the clear essential feature of the mark, and as a whole, WICKED SISTER was not deceptively similar to WICKED in slightly stylised form because of the changed meaning. In the instant case, the addition of the word “CARE” does not alter the meaning of the mark because both the applicant’s and the opponent’s goods are healthcare products. A consumer is more likely to perceive the word “EVE CARE” as if the opponent has modified its mark and added word “CARE”.
24. Regardless of the minor prevalent differences—such as the italicization of the opponent’s word, the color combination and the added device, an ordinary consumer is likely to be confused by the fact that the applicant’s mark starts with the word “eve”. The test for an ordinary consumer, as stated in case of **Reed Plc v Reed Business Information 2004 [RPC] 40** is the one who is “*neither too careful nor too careless, but reasonably circumspect, well informed and observant...*” and as already mentioned, an ordinary consumer does not take time to analyze the details of the mark.
25. Conceptually therefore, I find it likely that an ordinary consumer will assume that the opponent, whose products are branded with “EVE” mark conceived as a

female name, be it the first woman in the Bible or any woman bearing the name “EVE”, has added the word “care” to form “EVE CARE” and creating the conception in the minds of the consumer that the products are meant for health care. In **Madio Ag v Thomson Multimedia in case C-120/04**), the ECJ found that there would be *“likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and registered mark which has normal distinctiveness...”* In that case, the contested mark was THOMSON LIFE, alleged to be confusingly similar to “LIFE”. The present case does not differ much; the words “evecare” and “eve” are a juxtaposition with the word “care” merely added, only that the words are joined together.

26. Counsel for the opponent submits that a consumer might actually be confused to assume that products of the opponent and those of the applicant originate from the same undertaking. The argument is informed by the fact that confusion in the market takes two forms—direct and indirect confusion. Direct confusion is determined considering the close resemblance of the marks in question and whether an ordinary consumer would buy one product mistaking it to be the other. Indirect confusion on the other hand occurs where there is a possibility of consumers associating the goods of one entity with those of the other, where by a customer might think that the goods originate from the same manufacturer. This type of confusion may affect the decision of the consumer especially if a particular manufacturer is known for producing high quality goods.

27. In **Cannon Kabushiki Kaisha** (para 28 and 29), Court explained this as follows; *“Moreover, according to the settled case-law of the Court, the essential function of the trade mark is to guarantee the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. For th trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality (see, in particular, Case C-10/89 HAG GF (HAG II) [1990] ECR I-3711, paragraphs 14 and 13)”. At para 29, Court adds “accordingly, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see SABEL, paragraphs 16 to 18)”*

28. Further, the UK High Court in the case **Sazerac Brands, Llc V Liverpool Gin Distillery Limited** [2020] EWHC 2424 (Ch) at para 75, explained the issue of indirect confusion as follows;

“Confusion is more likely when a trade mark is distinctive. The test is whether that association between the mark and the sign creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings. I consider that there is such a risk because the product is identical, the names have marked similarity – indicative of a possible connection between them – and because the existence of connected brands using similar names is well-known to the public. In particular, once American Eagle 4 year old is established and becomes more widely known than Eagle Rare, having been positioned by the Defendants to compete with Jack Daniels...”

29. In rejoinder, Counsel for the opponents submits that there is a likelihood of the public perceiving the applicant’s goods as originating from the opponent. For indirect confusion to arise, the marks must be similar and the goods same or complementary as stated by the authorities cited above. In **Sazera Brands** (supra), the mark “America Eagle” was found to be likely to be associated with “Rare Eagle” because of the similarity of the goods and the distinctive character of “Eagle rare”. I have already determined that the distinctive word in the contested marks is “EVE”. The opponent’s mark largely perceived as “EVE” was registered in 2010 and has operated since then establishing its reputation in the Ugandan market. There is no doubt that the goods of the applicant and those of the opponent are similar. It is therefore likely that the public would be confused to believe that the products labelled EVECARE are originating from either the same undertaking producing EVE or economically linked undertakings.

30. Trademark law is aimed at ensuring that the consumers are not confused as to the source of a particular product. This way, the system benefits both the consumer and the manufacturer of the goods. The trademark communicates the quality and reputation of the goods originating from a particular undertaking to the consumer. The consumer is aided in making informed choice. The manufacturer benefits through increased sales and revenue. It is against this background that applications for trademarks with similarities to already registered marks that are

likely to confuse consumers as to the origin of the goods or services must be refused.

31. Having found that the applicant's mark is confusing similar to the opponent's mark, I also find the mark lacks distinctiveness within the meaning of section 9 of the Trademarks Act. The opposition accordingly succeeds. The application for registration of trademark number UG/T/2010/40921 is accordingly refused.
32. Each party shall bear its costs.

I so Order.

Given under my hand this 12th day of **June** 2024

Birungi Denis
Ass. Registrar of Trademarks