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THE TRADE MARKS ACT

CAP. 506

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Kenya

Trade Marks Act

Cap. 506

Legislation as at 31 December 2022

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Trade Marks Act (Cap. 506)
Contents

Part I – PRELIMINARY 1
1. Short title 1
2. Interpretation 2
3. Appointment of Registrar and other officers 4
Part II – REGISTRATION, INFRINGEMENT AND OTHER SUBSTANTIVE PROVISIONS 4
The Register 4
4. The register of trade marks 4
5. No action for infringement of unregistered trade mark 4
6. Registration to be in respect of particular goods or services 4
7. Right given by registration in Part A, and infringement thereof 5
8. Right given by registration in Part B, and infringement thereof 6
9. Infringement by breach of certain restrictions 6
10. Saving for vested rights 7
11. Saving for use of name, address or description of goods 7
12. Distinctiveness requisite for registration in Part A 7
13. Capability of distinguishing requisite for registration in Part B 8
14. Prohibition of registration of deceptive, etc., matter 8
15. Prohibition of registration of identical and resembling trade marks 9
15A. Protection of well-known trade marks 9
16. Registration in Part A to be conclusive as to validity after seven years 9
17. Registration subject to disclaimer 10
18. Words used as name or description of an article or substance 10
19. Effect of limitation as to colour, and of absence thereof 11
Part III – PROCEDURE FOR AND DURATION OF REGISTRATION 11
20. Application for registration 11
21. Opposition to registration 12
22. Registration 13
23. Duration and renewal of registration 13
24. Registration of part of trade mark and of trade marks as a series 14
Part IV – ASSIGNMENT AND TRANSMISSION 15
25. Powers of, and restrictions on, assignment and transmission 15
26. [Deleted by Act No. 4 of 2002, s. 6.] 16
27. Power of registered proprietor to assign and give receipts 16
28. Registration of assignments and transmissions 16

Part V – USE AND NON-USE 16
29. Removal from register and imposition of limitations on ground of non-use 16
30. Defensive registration of well-known trade marks 17
31. Registered users 18
32. Proposed use of trade mark by corporation to be constituted, etc. 20
33. Use of one of associated or substantially identical trade marks equivalent to use of another 20
34. Use of trade mark for export trade 21
Part VI – RECTIFICATION AND CORRECTION OF REGISTER 21
35. General power to rectify entries in register 21
36. Power to expunge or vary registration for breach of condition 21
36A. Surrender of a registered trade mark 21
36B. Effect of Acquiescence 22
37. Correction of register 22
38. Alteration of registered trade mark 22
39. Adaptation of entries in register to amended or substituted classification of goods 23
Part VII – CERTIFICATION TRADE MARKS 23
40. Certification trade marks 23
Part VIIA – COLLECTIVE TRADE MARKS 25
40A. Collective trade marks 25
Part VIIB – INTERNATIONAL APPLICATIONS 25
40B. Marks registered under the Banjul Protocol and the Madrid Convention and Protocol 25
40C. Rules regarding regional and international applications 25
40D. Applications for registration of marks under the Banjul Protocol 26
Part VIII – RULES AND FEES 26
41. Power of Cabinet Secretary to make rules 26
42. Fees 26
Part IX – POWERS AND DUTIES OF REGISTRAR 27
43. Preliminary advice by Registrar as to distinctiveness 27
44. Hearing before exercise of Registrar's discretion 27
45. Power of Registrar to award costs 27
Part X – LEGAL PROCEEDINGS AND APPEALS 27
46. Registration to be prima facie evidence of validity 27
47. Certificate of validity 27
48. Costs of Registrar in proceedings before court, and payment of costs by Registrar 27
49. Trade usage, etc., to be considered 28

50. Registrar's appearance in proceedings involving rectification 28
51. Court's power to review Registrar's decision 28
52. Discretion of court in appeals 28
53. Procedure in cases of option to apply to court or Registrar 28
54. Mode of giving evidence 28
54A. Nice Agreement receivable in evidence 29
55. [Deleted by Act No. 11 of 1965, s. 5.] 29
56. [Deleted by Act No. 11 of 1965, s. 5.] 29
Part XI – OFFENCES, AND RESTRAINT OF REGISTRATION AND USE OF CERTAIN MARKS 29
57. Falsification of entries in register 29
58. Fine for falsely representing a trade mark as registered 29
58A. Interpretation of terms in Part XI 30
58B. Application 30
58C. Forgery of registered trade mark 31
58D. Prohibition of forgery of registered trade mark 31
58E. Prohibition of sale or importation of goods or performance of services with forged registered trade mark 32
58F. Aiding and abetting offence 32
58G. Evidence 32
58H. Forfeiture of goods 33
59. Restraint of registration and use of Olympic symbol 33
Part XII – MISCELLANEOUS 33
60. Change of form of trade connexion not to be deemed to cause deception 33
61. Jointly owned trade marks 34
62. Trusts and equities 34
63. Recognition of agents 34
64. Address for service 34
65. International arrangements 34
66. Provisions as to public holidays 35
67. Transitional provisions and savings 35
FIRST SCHEDULE [s. 40] 35
SECOND SCHEDULE 37
THIRD SCHEDULE [s. 67] 37

TRADE MARKS ACT

CAP. 506

Assented to on 18 November 1955

Commenced on 1 January 1957

[Amended by Kenya (Amendment of Laws) (Written Laws) Order, 1963 (Legal Notice 2 of 1964) on 12 December 1963]
[Amended by Kenya (Amendment of Laws) (Miscellaneous Amendments) (No.7) Order, 1964 (Legal Notice 374 of 1964) on 12 December 1964]
[Amended by Trade Marks (Amendment) Act (Act No. 11 of 1965) on 11 May 1965]
[Amended by Statute Law (Miscellaneous Amendments) Act, 1966 (Act No. 21 of 1966) on 12 July 1966]
[Amended by Statute Law (Miscellaneous Amendments) Act, 1978 (Act No. 13 of 1978) on 10 November 1978]
[Amended by Trade Marks (Amendment) Act, 1984 (Act No. 1 of 1984) on 18 May 1984]
[Amended by Statute Law (Repealed and Miscellaneous Amendments) Act, 1990 (Act No. 7 of 1990) on 22 June 1990]
[Amended by Trade Marks (Amendment) Act, 1994 (Act No. 5 of 1994) on 1 March 1995]
[Amended by Trade Marks (Amendment) Act, 2002 (Act No. 4 of 2002) on 23 August 2002]
[Amended by Statute Law (Miscellaneous Amendments) Act, 2007 (Act No. 7 of 2007) on 15 October 2007]
[Revised by 24th Annual Supplement (Legal Notice 221 of 2023) on 31 December 2022]

An Act of Parliament relating to the registration of trade marks

Part I – PRELIMINARY

1. Short title

This Act may be cited as the Trade Marks Act.

2. Interpretation

(1) In this Act, except where the context otherwise requires—

"a convention country" means a country, other than Kenya, that is party to the Paris Convention;

"appointed day" means the 1st January, 1957;

"ARIPO" means the African Regional Industrial Property Organization;

"assignment" means assignment by act of the parties concerned;

"certification trade mark" means a mark registered or deemed to have been registered under section 40;

"court" means the High Court;

"Director" means the Managing Director of the Kenya Industrial Property Institute appointed under section 11(1) of the Industrial Property Act (Cap. 509);

"distinguishing guise", in relation to goods, means the shape or configuration of containers of the goods;

"Institute" means the Kenya Industrial Property Institute established by section 3 of the Industrial Property Act, (Cap. 509);

"International Classification of Goods and Services" as regards Registration of Marks, means the classification, in accordance with the Nice Agreement of the 15th June, 1957, as revised and amended from time to time, establishing an international classification of goods and services;

"International Classification of the Figurative Elements of Marks" means the classification established by the Vienna Agreement establishing an international classification of the Figurative Elements of Marks, of the 12th June, 1973, as revised and amended from time to time;

"Journal" means the Industrial Property Journal published by the Institute;

"licensee" means a person who is for the time being registered as such under section 31;

"limitations" means any limitations of the exclusive right to the use of a trade mark given by the registration of a person as proprietor thereof, including limitations of that right as to mode of use, as to use in relation to goods to be sold, or otherwise traded in, in any place within Kenya, or as to use in relation to goods to be exported to any market outside Kenya;

"mark" includes a distinguishing guise, slogan, device, brand, heading, label, ticket, name, signature, word, letter or numeral or any combination thereof whether rendered in two-dimensional or three-dimensional form;

"permitted use" has the meaning assigned to it by subsection (1) of section 31;

"prescribed" means, in relation to proceedings before the court, prescribed by rules of court, and, in other cases, prescribed by this Act or the rules;

"profession" means a calling or occupation, not being a trade or handicraft, carried on by an individual person being a member of a lawfully established body of persons each of whom is qualified and licensed by that body as having acquired and holding the specialized knowledge

necessary to enable that person to practise in the particular department of learning or science with which such body is concerned;

"register" means the register of trade marks kept under this Act;

"registered trade mark" means a trade mark that is actually on the register;

"Registrar" means the Registrar of Trade Marks appointed under section 3;

"services" are services within the meaning of this Act where they are normally provided for remuneration, in so far as they are not governed by the provisions of any written law relating to freedom of movement for goods, capital and persons and in particular include activities of an industrial or commercial character or of craftsmen and of the professions;

"surname" includes a name by which a person is customarily known by members of the community to which he belongs;

"the Paris Convention" means the Paris Convention for the Protection of Industrial Property, of the 20th March, 1883, as last revised;

"the rules" means rules made by the Cabinet Secretary under section 39 or section 41;

"the WTO Agreement" means the agreement establishing the World Trade Organization, signed at Marrakesh, Morocco, on the 15th April, 1994;

"trade" means any type of profession or other business occupation in which a mark may be used in the manner prescribed by this Act;

"trade mark" means, (except in relation to a certification trade mark) a mark used or proposed to be used—

(a) in relation to goods for the purpose of indicating 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 identity of that person or distinguishing goods in relation to which the mark is used or proposed to be used from the same kind of goods connected in the course of trade with any person;

(b) in relation to services for the purpose of indicating that a particular person is connected, in the course of business, with the provision of those services, whether with or without any indication of the identity of that person or distinguishing services in relation to which the mark is used or proposed to be used from the same kind of services connected in the course of business with any other person;

"transmission" means transmission by operation of law, devolution on the personal representative of a deceased person and any other mode of transfer not being assignment;

"tribunal" means the court or, subject to the provisions of section 53, the Registrar.

(2) Any reference in this Act to the use of a mark shall be construed—

(a) as a reference to the use of a printed or other visual representation of the mark and, in the case of a distinguishing guise, to the use of such distinguishing guise;

(b) if the mark is capable of being audibly reproduced, as including a reference to the use of an audible reproduction of the mark;

(c) in relation to goods, as a reference to the use thereof upon or in physical or other relation to goods; and

(d) in relation to services, as a reference to the use thereof in relation to the performance of such services.

[Act 21 of 1966, Sch., Act No. 7 of 1990, Sch., Act No. 5 of 1994, s. 2, Act No. 4 of 2002, s. 2, Act No. 7 of 2007, Sch.]

3. Appointment of Registrar and other officers

(1) The Director shall be the Registrar of Trade Marks under and for the purposes of this Act.

(2) The appointment of the officers required for the purposes of this Act shall be made in accordance with the provisions of the Industrial Property Act (Cap. 509).

(3) The Registrar shall have a seal of such device as may be approved by the Cabinet Secretary.

(4) Impressions of such seal or stamp shall be judicially noticed and admitted in evidence.

(5) Any act or thing directed to be done by or to the Registrar may be done by or to the Deputy Registrar of Trade Marks or any Assistant Registrar of Trade Marks.

(6) The Cabinet Secretary may, on the recommendation of the Board, whenever he deems it necessary or appropriate, appoint an advocate of the High Court of Kenya with at least seven years' working experience in matters relating to intellectual property, to assist the Registrar in the performance of any of the functions or the exercise of any of the powers conferred upon the Registrar under this Act with respect to the conduct of hearings relating to opposition to applications for registration or rectification of the register.

[L.N. 374/1964, Sch., Act No. 13 of 1978, Sch., Act No. 7 of 1990, Sch., Act No. 7 of 2007, Sch.]

Part II – REGISTRATION, INFRINGEMENT AND OTHER SUBSTANTIVE PROVISIONS

The Register

4. The register of trade marks

(1) There shall continue to be kept at the office of the Registrar of Trade Marks for the purposes of this Act the record called the register of trade marks, wherein shall be entered all registered trade marks with the names, addresses and descriptions of their proprietors, notifications of assignments and transmissions, the names, addresses and descriptions of all licensees, disclaimers, conditions, limitations, and such other matters relating to registered trade marks as may be prescribed.

(2) The register shall continue to be divided into two parts called respectively Part A and Part B.

(3) The register shall be kept under the control and management of the Registrar and shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed.

[Act No. 7 of 2007, Sch.]

EFFECT OF REGISTRATION AND ACTION FOR INFRINGEMENT

5. No action for infringement of unregistered trade mark

No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark, but nothing in this Act shall be deemed to affect rights of action against any person for passing off or the remedies in respect thereof.

[L.N. 2/1964, s 2, Act No. 5 of 1994, s. 3.]

6. Registration to be in respect of particular goods or services

(1) A trade mark shall be registered in respect of particular goods or services, which shall be classified in the manner specified in subsection (2).

(2) The goods and services in respect of which registration of a mark is applied for shall be classified in accordance with the International Classification of Goods and Services and any figurative elements of the mark shall be classified in accordance with the International Classification of the Figurative Elements of Marks:

Provided that where goods or services belonging to several classes according to the International Classification of Goods and Services have been included in the same application, the Registrar shall incorporate the several classes of goods and services for the purpose of registration.

[Act No. 5 of 1994, s. 4, Act No. 4 of 2002, s. 3.]

7. Right given by registration in Part A, and infringement thereof

(1) Subject to the provisions of this section, and of sections 10 and 11, the registration (whether before or after 1st January, 1957) of a person in Part A of the register as the proprietor of a trade mark if valid gives to that person the exclusive right to the use of the trade mark in relation to those goods or in connection with the provision of any services and without prejudice to the generality of the foregoing that right is infringed by any person who, not being the proprietor of the trade mark or a registered user thereof using by way of permitted use, uses a mark identical with or so nearly resembling it as to be likely to deceive or cause confusion in the course of trade or in connection with the provision of any services in respect of which it is registered, and in such manner as to render the use of the mark likely to—

(a) be taken either as being used as a trade mark;

(b) be taken in a case in which the use is upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as licensee to use the trade mark or goods with which such a person is connected in the course of trade;

(c) be taken in a case where the use is use at or near the place where the services are available for acceptance or performed or in an advertising circular or other advertisement issued to the public or any part thereof, as importing a reference to some person having the right either as proprietor or as licensee to use the trade mark or to services with the provision of which such a person as aforesaid is connected in the course of business;

(d) cause injury or prejudice to the proprietor or licensee of the trade mark.

(2) The right to the use of a trade mark given by registration shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark in any mode, in relation to goods to be sold or otherwise traded in any place, in relation to goods to be exported to any market or services for use or available for acceptance in any place or country, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.

(3) The right to the use of a trade mark given by registration shall not be deemed to be infringed by the use of any such mark by any person—

(a) in relation to goods connected in the course of trade with the proprietor or a licensee of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or the licensee conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark; or

(b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and

(c) in relation to services to which the proprietor of the trade mark or a licensee conforming to the permitted use has applied the trade mark, where the purpose and effect of the use

of the trade mark is to indicate, in accordance with the fact, that those services have been performed by the proprietor or a licensee of the trade mark; or

(d) in relation to services the provision of which is connected in the course of business with the proprietor or a licensee of the trade mark, where the proprietor or licensee has at any time expressly or impliedly consented to the use of the trade mark; or

(e) in relation to services available for use with other services in relation to which the trade mark has been used without infringement of the right given by registration or might for the time being be so used; if—

(i) the use of the trade mark is reasonably necessary in order to indicate that the services are available for such use; or

(ii) neither the purpose nor the effect of the use of the trade mark is to indicate otherwise than in accordance with the fact that there is a connection in the course of business between any person and the provision of those services.

(4) The use of a registered trade mark, being one of two or more registered trade marks that are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration as aforesaid, shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

[Act No. 5 of 1994, s. 5, Act No. 7 of 2007, Sch.]

8. Right given by registration in Part B, and infringement thereof

(1) Except as provided by subsection (2), the registration (whether before or after the commencement of this Act) of a person in Part B of the register as proprietor of a trade mark if valid gives to that person the same right and the provisions of section 7 shall have effect in the same manner in relation to a trade mark registered in Part B of the register as they have effect in relation to a trade mark registered in Part A of the register.

(2) In any action for infringement of the right to the use of a trade mark given by registration in Part B of the register, otherwise than by an act that is deemed to be an infringement by virtue of section 9, no injunction or other relief shall be granted to the plaintiff if the defendant establishes to the satisfaction of the court that the use of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connexion in the course of trade between the goods and some person having the right either as proprietor or as licensee to use the trade mark or in respect of services that a person having the right either as proprietor or as licensee to use the trade mark is connected in the course of business with the provision of the services.

[Act No. 5 of 1994, s. 6, Act No. 7 of 2007, Sch.]

9. Infringement by breach of certain restrictions

(1) Where, by a contract in writing made with the proprietor or a licensee of a registered trade mark, a purchaser or owner of goods or a person performing the services, enters into an obligation to the effect that he will not do, in relation to the goods or services, an act to which this section applies, any person who, being the owner for the time being of the goods or the person performing the services and having notice of the obligation, does that act, or authorizes it to be done, in relation to the goods or services, in the course of trade, or with a view to any dealing therewith in the course of trade thereby infringes the right to the use of the trade mark given by the registration thereof, unless that person becomes the owner of the goods by purchase for money or money's worth or performs the services in good faith before receiving notice of the obligation or by virtue of a title claimed through another person who so became the owner thereof.

(2) The acts to which this section applies are—

(a) the application of the trade mark upon the goods after they have suffered alteration in any manner specified in the contract as respects their state or condition, get-up or packing;

(b) in a case in which the trade mark is upon the goods, the alteration, part removal or part obliteration thereof;

(c) in a case in which the trade mark is upon the goods, and there is also thereon other matter, being matter indicating a connexion in the course of trade between the proprietor or licensee and the goods, the removal or obliteration, whether wholly or partly, of the trade mark unless that other matter is wholly removed or obliterated;

(d) in a case in which the trade mark is upon the goods, the application of any other trade mark to the goods;

(e) in a case in which the trade mark is upon the goods, the addition to the goods of any other matter in writing that is likely to injure the reputation of the trade mark.

(3) In this section, references in relation to any goods to the proprietor, to a licensee, and to the registration, of a trade mark shall be construed, respectively, as references to the proprietor in whose name the trade mark is registered, to a licensee who is registered, and to the registration of the trade mark, in respect of those goods, and "upon" includes in relation to any goods a reference to physical relation thereto.

[Act No. 5 of 1994, s. 7, Act No. 7 of 2007, Sch.]

10. Saving for vested rights

Nothing in this Act shall entitle the proprietor or a licensee of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date anterior—

(a) to the use of the first-mentioned trade mark in relation to those goods by the proprietor or a predecessor in title of his; or

(b) to the registration of the first-mentioned trade mark in respect of those goods in the name of the proprietor or a predecessor in title of his,

whichever is the earlier, or to object (on such use being proved) to that person being put on the register for that identical or nearly resembling mark in respect of those goods under subsection (2) of section 15.

[Act No. 7 of 2007, Sch.]

11. Saving for use of name, address or description of goods

No registration of a trade mark shall interfere with—

(a) any *bona fide* use by a person of his own name or of the name of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business; or

(b) the use by any person of any *bona fide* description of the character or quality of his goods, not being a description that would be likely to be taken as importing any such reference as is mentioned in paragraph (b) of subsection (1) of section 7, or in paragraph (b) of subsection (3) of section 40.

Registrability and Validity of Registration

12. Distinctiveness requisite for registration in Part A

(1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars—

(a) the name of a company, individual or firm, represented in a special or particular manner;

(b) the signature of the applicant for registration or some predecessor in his business;

(c) an invented word or invented words;

(d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;

(e) any other distinctive mark, but a name, signature or word or words, other than such as fall within the descriptions in paragraphs (a), (b), (c), and (d), shall not be registrable under this paragraph except upon evidence of its distinctiveness.

(2) For the purposes of this section, "distinctive" means adapted, in relation to the goods in respect of which a trade mark 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 connexion subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration and in relation to services means to distinguish services with the provision of which the proprietor is or may be connected in the course of business, from services the provision of which he is not so connected.

(3) In determining whether a trade mark is adapted to distinguish, the court or the Registrar may have regard to the extent to which—

(a) the trade mark is inherently adapted to distinguish; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish.

[Act No. 39 of 1962, s. 2, L.N. 374/1964, Sch., Act No. 11 of 1965, s. 2, Act No. 5 of 1994, s. 8.]

13. Capability of distinguishing requisite for registration in Part B

(1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing 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 connexion subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration and in relation to services of distinguishing services with the provisions of which the proprietor of the trade mark is or may be connected in the course of business from services with the provision of which he is not so connected.

(2) In determining whether a trade mark is capable of distinguishing, the court or the Registrar may have regard to the extent to which—

(a) the trade mark is inherently capable of distinguishing; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing.

(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

[Act No. 39 of 1962, s. 3, L.N. 374/1964, Sch., Act No. 11 of 1965, s. 3, Act No. 5 of 1994, s. 9.]

14. Prohibition of registration of deceptive, etc., matter

(1) No person shall register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

(2) *Deleted by Act No. 11 of 1965, s. 4.*

[Act No. 39 of 1962, s. 4, Act No. 11 of 1965, s. 4.]

15. Prohibition of registration of identical and resembling trade marks

(1) Subject to the provisions of subsection (2), no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or in respect of services, is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of the same services or description of services.

(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the court or the Registrar make it proper so to do, the court or the Registrar may permit the registration of trade marks that are identical or nearly resemble each other in respect of the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as the court or the Registrar may think it right to impose.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks that are identical or nearly resemble each other, in respect of the same goods or description of goods or in respect of the same services or description of services, the Registrar may refuse to register any of them until their rights have been determined by the court, or have been settled by agreement in a manner approved by him or on an appeal by the court, as the case may be.

[L.N. 374/1964, Sch., Act No. 5 of 1994, s. 10.]

15A. Protection of well-known trade marks

(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO Agreement as a well known trade mark, are to a mark which is well known in Kenya as being the mark of a person who—

(a) is a national of a convention country; or

(b) is domiciled in, or has a real and effective industrial or commercial establishment in, a convention country, whether or not that person carries on business or has any goodwill in Kenya.

(2) Subject to the provisions of section 38B, the proprietor of a trade mark which is entitled to protection under the Paris Convention or the WTO Agreement as a well known trade mark, is entitled to restrain by injunction, the use in Kenya of a trade mark which is identical or the essential part of which is identical or similar to his, in relation to identical or similar goods or services, where the use is likely to cause confusion among the users of the goods or services.

(3) Nothing in subsection (2) shall affect the continuation of any *bona fide* use of a trade mark begun before the commencement of this section.

(4) A trade mark shall not be registered if that trade mark, or an essential part thereof, is likely to impair, interfere with or take unfair advantage of the distinctive character of the well-known trade mark.

[Act No. 4 of 2002, s. 4.]

16. Registration in Part A to be conclusive as to validity after seven years

(1) In all legal proceedings relating to a trade mark registered in Part A of the register (including applications under section 35) the original registration in Part A of the register of the trade mark shall, after the expiration of seven years from the date of that registration, be taken to be valid in all respects, unless—

(a) that registration was obtained by fraud; or

(b) the trade mark offends against section 14.

(2) Nothing in subsection (1) of section 8 shall be construed as making applicable to a trade mark, being a trade mark registered in Part B of the register, the foregoing provisions of this section relating to a trade mark registered in Part A of the register.

17. Registration subject to disclaimer

If a trade mark—

(a) contains any part not separately registered by the proprietor as a trade mark; or

(b) contains matter common to the trade or to the provision of services of that description or otherwise of a non-distinctive character,

the Registrar or the court, in deciding whether the trade mark shall be entered or shall remain on the register, may require, as a condition of its being on the register—

(i) that the proprietor shall disclaim any right to the exclusive use of any part of the trade mark, or to the exclusive use of all or any portion of any such matter, to the exclusive use of which the tribunal holds him not to be entitled; or

(ii) that the proprietor shall make such other disclaimer as the tribunal may consider necessary for the purpose of defining his rights under the registration:

Provided that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

[Act No. 5 of 1994, s. 11.]

18. Words used as name or description of an article or substance

(1) The registration of a trade mark shall not be deemed to have become invalid by reason only of any use, after the date of the registration, of a word or words which the trade mark contains, or of which it consists, as the name or description of an article or substance or of some activity:

Provided that, if it is proved either—

(i) that there is a well-known and established use of the word or words as the name or description of the article or substance by a person or persons carrying on a trade therein, not being use in relation to goods connected in the course of trade with the proprietor or a licensee of trade mark or (in the case of a certification trade mark) goods certified by the proprietor; or

(ii) that the article or substance was formerly manufactured under a patent, that a period of two years or more after the cesser of the patent has elapsed and that the word or words is or are the only practicable name or description of the article or substance;

(iii) that there is a well-known and established use of the word or words as the name or description of some activity by a person providing services which include that activity, not being use in relation to services with the provision of which the proprietor or a licensee of the trade mark is connected in the course of business,

the provisions of subsection (2) shall have effect.

(2) Where the facts mentioned in the proviso to subsection (1) are proved with respect to any word or words, then—

(a) if the trade mark consists solely of that word or those words, the registration of the trade mark, so far as regards registration in respect of the article or substance in question or of any goods of the same description or of the activity in question, shall be deemed for the purposes of section 35 to be an entry wrongly remaining on the register;

(b) if the trade mark contains that word or those words and other matter, the court or the Registrar, in deciding whether the trade mark shall remain on the register, so far as regards registration in respect of the article or substance in question and of any goods of the same description or of the activity in question, may in case of a decision in favour of its remaining on the register require as a condition thereof that the proprietor shall disclaim any right to the exclusive use in relation to that article or substance and any goods of the same description or of the activity in question of that word or those words, so, however, that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made; and

(c) for the purposes of any other legal proceedings relating to the trade mark—

(i) if the trade mark consists solely of that word or those words, all rights of the proprietor, whether under the common law or by registration, to the exclusive use of the trade mark in relation to the article or substance in question or to any goods of the same description or of the activity in question; or

(ii) if the trade mark contains that word or those words and other matter, all such rights of the proprietor to the exclusive use of that word or those words in such relation as aforesaid,

shall be deemed to have ceased on the date at which the use mentioned in paragraph (i) of the proviso to subsection (1) first became well known and established, or at the expiration of the period of two years mentioned in paragraph (ii) of that proviso.

(3) No word which is the commonly used and accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark in respect of a chemical substance or preparation, and any such registration in force at the commencement of this Act or thereafter shall, notwithstanding anything in section 16, be deemed for the purposes of section 35 to be an entry made in the register without sufficient cause, or an entry wrongly remaining on the register, as the circumstances may require:

Provided that this subsection shall not have effect in relation to a word which is used to denote only a brand or make of the element or compound as made by the proprietor or a licensee of the trade mark, as distinguished from the element or compound as made by others, and in association with a suitable name or description open to the public use.

[Act No. 5 of 1994, s. 12, Act No. 7 of 2007, Sch.]

19. Effect of limitation as to colour, and of absence thereof

(1) A trade mark may be limited in whole or in part to one or more specified colours, and in any such case the fact that it is so limited shall be taken into consideration by the court or the Registrar having to decide on the distinctive character of the trade mark.

(2) If and so far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.

Part III – PROCEDURE FOR AND DURATION OF REGISTRATION

20. Application for registration

(1) A person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it shall apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the register.

(2) Subject to the provisions of this Act, the Registrar may refuse the application, or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think right.

(3) In the case of an application for registration of a trade mark (other than a certification trade mark) in Part A of the register, the Registrar may, if the applicant is willing, instead of refusing the application, treat it as an application for registration in Part B and deal with the application accordingly.

(4) In the case of a refusal or conditional acceptance, the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving thereat, and the decision shall be subject to appeal to the court.

(5) An appeal under this section shall be made in the prescribed manner, and on the appeal the court shall, if required, hear the applicant and the Registrar, and shall make an order determining whether, and subject to what amendments, modifications, conditions or limitations, if any, the application is to be accepted.

(6) Appeals under this section shall be heard on the materials stated by the Registrar, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar, other than those so stated by him, except by leave of the court; and, where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of costs on giving notice as prescribed.

(7) The Registrar or the court, as the case may be, may at any time, whether before or after acceptance, correct any error in or in connexion with the application, or may permit the applicant to amend his application upon such terms as the Registrar or the court may think fit.

21. Opposition to registration

(1) When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall, as soon as may be after acceptance, cause the application as accepted to be advertised in the prescribed manner, and the advertisement shall set forth all conditions and limitations subject to which the application has been accepted:

Provided that the Registrar may cause an application to be advertised before acceptance if it is made under paragraph (e) of subsection (1) of section 12, or in any other case where it appears to him that it is expedient by reason of any exceptional circumstances so to do, and where an application has been so advertised the Registrar may advertise it again when it has been accepted but shall not be bound so to do.

(2) Any person may, within the prescribed time from the date of the advertisement of an application, give notice to the Registrar of opposition to the registration.

(3) The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(4) The Registrar shall send a copy of the notice to the applicant, and within the prescribed time after receipt thereof the applicant shall send to the Registrar, in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and, if he does not do so, he shall be deemed to have abandoned his application.

(5) If the applicant sends a counter-statement, the Registrar shall furnish a copy thereof to the person giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions or limitations, if any, registration is to be permitted.

(6) The decision of the Registrar shall be subject to appeal to the court.

(7) An appeal under this section shall be made in the prescribed manner, and on the appeal the court shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions or limitations, if any, registration is to be permitted.

(8) On the hearing of an appeal under this section any party may, either in the manner prescribed or by special leave of the court, bring forward further material for the consideration of the court.

(9) On an appeal under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar, other than those so stated by the opponent, except by leave of the court; and, where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

(10) On an appeal under this section the court may, after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity thereof, but in any such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

(11) If a person giving notice of opposition or an applicant sending a counter- statement after receipt of a copy of such a notice, or an appellant, neither resides nor carries on business in Kenya, the court or the Registrar may require him to give security for costs of the proceedings before the court or the Registrar relative to the opposition or to the appeal, as the case may be, and in default of such security being duly given may treat the opposition or application, or the appeal, as the case may be, as abandoned.

22. Registration

(1) When an application for registration of a trade mark in Part A or in Part B of the register has been accepted, and either—

(a) the application has not been opposed and the time for notice of opposition has expired; or

(b) the application has been opposed and the opposition has been decided in favour of the applicant,

the Registrar shall, unless the application has been accepted in error, register the trade mark in Part A or Part B, as the case may be, and the trade mark, when registered, shall be registered as of the date of the application for registration, and that date shall be deemed for the purposes of this Act to be the date of registration:

Provided that the provisions of this subsection, relating to the date as of which a trade mark shall be registered and to the date to be deemed to be the date of registration, shall, as respects a trade mark registered under this Act with the benefit of any enactment relating to international or inter-imperial arrangements, have effect subject to the provisions of that enactment.

(2) On the registration of a trade mark, the Registrar shall issue to the applicant a certificate in the prescribed form of the registration thereof under the hand and seal of the Registrar.

(3) Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.

23. Duration and renewal of registration

(1) The registration of a trade mark shall be for a period of ten years, but may be renewed from time to time in accordance with the provisions of this section.

(2) The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of the trade mark for a period of ten years from the date of expiration of the original registration or of the last renewal of

registration, as the case may be, which date is in this section referred to as the expiration of the last registration:

Provided that all the trade marks that were registered or the registration of which was renewed before the commencement of this section, shall remain in force until the expiry of the period of registration or renewal and thereafter, the provisions of this section shall apply.

(3) At the prescribed time before the expiration of the last registration of a trade mark, the Registrar shall send notice in the prescribed manner to the registered proprietor of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with, the Registrar may remove the trade mark from the register, subject to such conditions, if any, as to its restoration to the register as may be prescribed.

(4) Where a trade mark has been removed from the register for non payment of the fee for renewal, it shall, nevertheless, for the purpose of any application for the registration of a trade mark during one year next after the date of the removal, be deemed to be a trade mark that is already on the register:

Provided that this subsection shall not have effect where the court or the Registrar is satisfied either —

(i) that there has been no *bona fide* trade use or business use of the trade mark that has been removed during the two years immediately preceding its removal; or

(ii) that no deception or confusion would be likely to arise from the use of the trade mark that is the subject of the application for registration by reason of any previous use of the trade mark that has been removed.

(5) The Registrar shall cause an application for registration of a trade mark to be published in the Journal or in the Kenya *Gazette*, in such manner as may be prescribed in the rules made under this Act.

[Act No. 5 of 1994, s. 13, Act No. 4 of 2002, s. 5.]

24. Registration of part of trade mark and of trade marks as a series

(1) Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and any such part as separate trade marks.

(2) Each such separate trade mark must satisfy all the conditions of an independent trade mark and shall, subject to the provisions of subsection (3) of section 26 and subsection (2) of section 33, have all the incidents of an independent trade mark.

(3) Where a person claiming to be the proprietor of several trade marks, in respect of the same goods or description of goods, which, while resembling each other in the material particulars thereof, yet differ in respect of—

(a) statements of the goods in relation to which they are respectively used or proposed to be used; or

(b) statements of number, price, quality or names of places; or

(c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or

(d) colour,

seeks to register those trade marks, they may be registered as a series in one registration.

Part IV – ASSIGNMENT AND TRANSMISSION

25. Powers of, and restrictions on, assignment and transmission

(1) A registered trade mark is assignable and transmissible either in connection with the goodwill of a business or not.

(2) A registered trade mark is assignable and transmissible in respect of either all the goods or all the services in respect of which it is registered or of some only of those goods or services.

(3) The provisions of subsections (1) and (2) shall have the effect of an unregistered trade mark as they have effect in the case of a registered trade mark if at the time of the assignment or transmission of the unregistered trade mark it is or was used in the same business as a registered trade mark, and if it is or was assigned or transmitted at the same time and to the same person as that registered trade mark was assigned or transmitted.

(4) Notwithstanding anything in subsections (1), (2) and (3), a trade mark shall not be, or be deemed to have been, assignable or transmissible in a case in which as a result of an assignment or transmission there would in the circumstances subsist, or have subsisted, whether under the common law or by registration, exclusive rights in more than one of the persons concerned to the use, in relation to the same goods or description of goods or services to be performed, of trade marks nearly resembling each other or of identical trade marks, if, having regard to the similarity of the goods or services to be performed and of the trade marks, the use of the trade marks in exercise of those rights would be, or have been, likely to deceive or cause confusion:

Provided that, where a trade mark is or has been assigned or transmitted in such a case, the assignment or transmission shall not be deemed to be, or to have been, invalid under this subsection if the exclusive rights subsisting as a result thereof in the persons concerned respectively are, or were, having regard to limitations imposed thereon, such as not to be exercisable by two or more of those persons in relation to goods to be sold, or otherwise traded in or services to be performed, within Kenya (otherwise than for export therefrom) or in relation to goods to be exported to the same market outside Kenya.

(5) The proprietor of a registered trade mark who proposes to assign it in respect of any goods or services in respect of which it is registered may submit to the Registrar in the prescribed manner a statement of case setting out the circumstances, and the Registrar may issue to him a certificate stating whether, having regard to the similarity of the goods or services and of the trade marks referred to in the case, the proposed assignment of the first-mentioned trade mark would or would not be invalid under subsection (4), and a certificate so issued shall, subject to the provisions of this section as to appeal and unless it is shown that the certificate was obtained by fraud or misrepresentation, be conclusive as to the validity or invalidity under that subsection of the assignment in so far as that validity or invalidity depends upon the facts set out in the case, but, as regards a certificate in favour of validity, only if application for the registration under section 28 of the title of the person becoming entitled is made within six months from the date on which the certificate is issued.

(6) Notwithstanding anything in subsections (1), (2) and (3), a trade mark shall not, on or after the appointed day, be assignable or transmissible in a case in which as a result of an assignment or transmission thereof there would in the circumstances subsist, whether under the common law or by registration, an exclusive right in one of the persons concerned to the use of the trade mark limited to use in relation to goods to be sold or otherwise traded in or services to be performed, in a place or places in Kenya and an exclusive right in another of those persons to the use of a trade mark nearly resembling the first-mentioned trade mark or of an identical trade mark in relation to the same goods or description of goods limited to use in relation to goods to be sold, or otherwise traded in or services to be performed, in another place or other places in Kenya:

Provided that, on application in the prescribed manner by the proprietor of a trade mark who proposes to assign it, or of a person who claims that a trade mark has been transmitted to him

or to a predecessor in title of his on or after the appointed day, in any such case, the Registrar, if he is satisfied that in all the circumstances the use of the trade marks in exercise of those rights would not be contrary to the public interest, may approve the assignment or transmission, and an assignment or transmission so approved shall not be deemed to be, or to have been, invalid under this subsection or under subsection (4), so, however, that in the case of a registered trade mark this provision shall not have effect unless application for the registration under section 28 of the title of the person becoming entitled is made within six months from the date on which the approval is given or, in the case of transmission, was made before that date.

(7) Where an assignment in respect of any goods of a trade mark that is at the time of the assignment used in a business in those goods is made, on or after the appointed day, otherwise than in connexion with the goodwill of that business, the assignment shall not take effect until the following requirements have been satisfied, that is to say, the assignee must, not later than the expiration of six months from the date on which the assignment is made or within such extended period, if any, as the Registrar may allow, apply to him for directions with respect to the advertisement of the assignment, and must advertise it in such form and manner and within such period as the Registrar may direct.

(8) Any decision of the Registrar under this section shall be subject to appeal to the court.

[Act No. 5 of 1994, s. 14.]

26. [Deleted by Act No. 4 of 2002, s. 6.]

27. Power of registered proprietor to assign and give receipts

Subject to the provisions of this Act, the person for the time being entered in the register as proprietor of a trade mark shall, subject to any rights appearing from the register to be vested in any other person, have power to assign the trade mark, and to give effectual receipts for any consideration for an assignment thereof.

28. Registration of assignments and transmissions

(1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall make application to the Registrar to register his title, and the Registrar shall, on receipt of the application and on proof of title to his satisfaction, register him as the proprietor of the trade mark in respect of the goods or services in respect of which the assignment or transmission has effect, and shall cause particulars of the assignment or transmission to be entered on the register.

(2) Any decision of the Registrar under this section shall be subject to appeal to the court.

(3) Except for the purposes of an appeal under this section or of an application under section 35, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of subsection (1) of this section shall not be admitted in evidence in any court in proof of the title to a trade mark except as between the parties to the document or instrument unless the court otherwise directs.

[Act No. 5 of 1994, s. 15.]

Part V – USE AND NON-USE

29. Removal from register and imposition of limitations on ground of non-use

(1) Subject to the provisions of section 30, a registered trade mark may be taken off the register in respect of any of the goods or services in respect of which it is registered on application by any

person aggrieved to the court or, at the option of the applicant and subject to the provisions of section 53, to the Registrar, on the ground that either—

(a) the trade mark was registered without any *bona fide* intention on the part of the applicant for registration that it should be used in relation to those goods by him, and that there has in fact been no *bona fide* use of the trade mark in relation to those goods by any proprietor thereof for the time being up to the date one month before the date of the application; or

(b) up to the date one month before the date of the application a continuous period of five years or longer elapsed during which the trade mark was a registered trade mark and during which there was no *bona fide* use thereof in relation to those goods by any proprietor thereof for the time being:

Provided that (except where the applicant has been permitted under subsection (2) of section 15 to register an identical or nearly resembling trade mark in respect of the goods in question or where the tribunal is of opinion that he might properly be permitted so to register such a trade mark) the tribunal may refuse an application made under paragraph (a) or (b) of this subsection in relation to any goods, if it is shown that there has been, before the relevant date or during the relevant periods as the case may be, *bona fide* use of the trade mark by any proprietor thereof for the time being in relation to—

(i) the services of the same description; or

(ii) goods associated with those services or services of that description, being services, or as the case may be, goods in respect of which the trade mark is registered.

(2) Where in relation to any goods or services in respect of which a trade mark is registered—

(a) the matters referred to in paragraph (b) of subsection (1) of this section are shown so far as regards non-use of the trade mark in relation to goods to be sold, or otherwise traded in, in a particular place in Kenya (otherwise than for export), or in relation to goods to be exported to a particular market; and

(b) a person has been permitted under subsection (2) of section 15 to register an identical or nearly resembling trade mark in respect of those goods under a registration extending to use in relation to goods to be sold, or otherwise traded in or services to be performed, in that place (otherwise than for export), or in relation to goods to be exported to that market, or the court or the Registrar is of opinion that he might properly be permitted so to register such a trade mark,

on application by that person to the court, or, at the option of the applicant and subject to the provisions of section 53, to the Registrar, the court or the Registrar, as the case may be, may impose on the registration of the first-mentioned trade mark such limitations as the court or the Registrar thinks proper for securing that that registration shall cease to extend to the last-mentioned use.

(3) An applicant shall not be entitled to rely for the purposes of paragraph (b) of subsection (1), or for the purposes of subsection (2), on any non-use of a trade mark that is shown to have been due to special circumstances in the trade or in relation to particular services and not to any intention to abandon the trade mark to which the application relates.

[Act No. 5 of 1994, s. 16.]

30. Defensive registration of well-known trade marks

(1) Where a trade mark consisting of an invented word or invented words has become so well known as respects any goods in respect of which it is registered and in relation to which it has been used that the use thereof in relation to other goods would be likely to be taken as indicating a connexion in the course of trade between those goods and a person entitled to use the trade mark in relation to the first- mentioned goods, then, notwithstanding that the proprietor registered in respect of the first-mentioned goods does not use or propose to use the trade mark in relation to those other goods and notwithstanding anything in section 29, the trade mark may, on the application

in the prescribed manner of the proprietor registered in respect of the first-mentioned goods, be registered in his name in respect of those other goods as a defensive trade mark and, while so registered, shall not be liable to be taken off the register in respect of those goods under that section.

(2) The registered proprietor of a trade mark may apply for the registration thereof in respect of any goods as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any goods otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods as a defensive trade mark, in lieu in each case of the existing registration.

(3) A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same proprietor shall, notwithstanding that the respective registrations are in respect of different goods, be deemed to be, and shall be registered as, associated trade marks.

(4) On application by any person aggrieved to the court or, at the option of the applicant and subject to the provisions of section 53, to the Registrar, the registration of a trade mark as a defensive trade mark may be cancelled on the ground that the requirements of subsection (1) of this section are no longer satisfied in respect of any goods in respect of which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark, or may be cancelled as respects any goods in respect of which it is registered as a defensive trade mark on the ground that there is no longer any likelihood that the use of the trade mark in relation to those goods would be taken as giving the indication mentioned in subsection (1) of this section.

(5) The Registrar may at any time cancel the registration as a defensive trade mark of a trade mark of which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trade mark.

(6) Except as otherwise expressly provided in this section, the provisions of this Act shall apply in respect of the registration of trade marks as defensive trade marks and of trade marks so registered as they apply in other cases.

31. Registered users

(1) Subject to the provisions of this section, a person other than the proprietor of a trade mark may be registered as a licensee thereof in respect of all or any of the goods in respect of which it is registered or in respect of services with the provision of which he is connected in the course of business (otherwise than as a defensive trade mark) and either with or without conditions or restrictions; and the use of a trade mark by licensee thereof in respect of which for the time being the trade mark remains registered and he is registered as a licensee, being use such as to comply with any conditions or restrictions to which his registration is subject, is in this Act referred to as the permitted use thereof.

(2) The permitted use of a trade mark shall be deemed to be use by the proprietor thereof, and shall be deemed not to be use by a person other than the proprietor, for the purposes of section 29 and for any other purpose for which such use is material under this Act or at common law.

(3) Subject to any agreement subsisting between the parties, a licensee of a trade mark shall be entitled to call upon the proprietor thereof to take proceedings to prevent infringement thereof, and, if the proprietor refuses or neglects to do so within two months after being so called upon, the licensee may institute proceedings for infringement in his own name, as if he were the proprietor, making the proprietor a defendant; and a proprietor so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

(4) Where it is proposed that a person should be registered as a licensee of a trade mark, the proprietor and the proposed licensee shall apply in writing to the Registrar in the prescribed manner and shall

furnish him with a statutory declaration made by the proprietor, or by some person authorized to act on his behalf and approved by the Registrar—

(a) giving particulars of the relationship, existing or proposed, between the proprietor and the proposed licensee, including particulars showing the degree of control by the proprietor over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed licensee shall be the sole licensee or that there shall be any other restriction as to persons for whose registration as licensees application may be made;

(b) stating the goods or services in respect of which registration is proposed;

(c) stating any conditions or restrictions proposed with respect to the characteristics of the goods or services, to the mode or place of permitted use or to any other matter; and

(d) stating whether the permitted use is to be for a period or without limit of period, and if for a period the duration thereof,

and with such further documents, information or evidence as may be required under the rules or by the Registrar.

(5) When the requirements of subsection (4) have been complied with, if the Registrar, after considering the information furnished to him under that subsection, is satisfied that in all the circumstances the use of the trade mark in relation to the proposed goods or services or any of them by the proposed licensee subject to any conditions or restrictions which the Registrar thinks proper would not be contrary to the public interest, the Registrar may register the proposed licensee as a licensee in respect of the goods or services as to which he is so satisfied subject as aforesaid.

(6) The Registrar shall refuse an application under the foregoing provisions of this section if it appears to him that the grant thereof would tend to facilitate trafficking in a trade mark.

(7) The Registrar shall, if so required by an applicant, take steps for securing that information given for the purposes of an application under the foregoing provisions of this section (other than matter entered in the register) is not disclosed to rivals in trade.

(8) Without prejudice to the provisions of section 35, the registration of a person as a licensee may be—

(a) varied by the Registrar as regards the goods or services in respect of which, or any conditions or restrictions subject to which, it has effect, on the application in writing in the prescribed manner of the registered proprietor of the trade mark to which the registration relates;

(b) cancelled by the Registrar on the application in writing in the prescribed manner of the registered proprietor or of the licensee or of any other licensee of the trade mark; or

(c) cancelled by the Registrar on the application in writing in the prescribed manner of any person on any of the following grounds—

(i) that the licensee has used the trade mark otherwise than by was of the permitted use, or in such a way as to cause, or to be likely to cause, deception or confusion;

(ii) that the proprietor or the licensee misrepresented, or failed to disclose, some fact material to the application for the registration, or that the circumstances have materially changed since the date of the registration;

(iii) that the registration ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested.

(9) Provision shall be made by the rules for the notification of the registration of a person as a licensee to any other licensee of the trade mark, and for the notification of an application under subsection (8) to the registered proprietor and each licensee (not being the applicant) of the trade mark, and for giving to the applicant on such an application, and to all persons to whom such an application is notified and who intervene in the proceedings in accordance with the rules, an opportunity of being heard.

(10) The Registrar may at any time cancel the registration of a person as a licensee of a trade mark in respect of any goods or services in respect of which the trade mark is no longer registered.

(11) A decision of the Registrar under the foregoing provisions of this section shall be subject to appeal to the court.

(12) Nothing in this section shall confer on a licensee of a trade mark any assignable or transmissible right to the use thereof.

[Act No. 5 of 1994, s. 17, Act No. 7 of 2007, Sch.]

32. Proposed use of trade mark by corporation to be constituted, etc.

(1) No application for the registration of a trade mark in respect of any goods or services to be performed shall be refused, nor shall permission for such registration be withheld, on the ground only that it appears that the applicant does not use or propose to use the trade mark if—

(a) the court or the Registrar is satisfied that a body corporate is about to be constituted, and that the applicant intends to assign the trade mark to the corporation with a view to the use thereof in relation to those goods or services to be performed by the corporation; or

(b) the application is accompanied by an application for the registration of a person as a licensee of the trade mark, and the court or the Registrar is satisfied that the proprietor intends it to be used by that person in relation to those goods or services to be performed and the court or the Registrar is also satisfied that that person will be registered as a licensee thereof immediately after the registration of the trade mark.

(2) The provisions of section 29 shall have effect, in relation to a trade mark registered under the power conferred by subsection (1) of this section, as if for the reference, in paragraph (a) of subsection (1) of that section, to intention on the part of an applicant for registration that a trade mark should be used by him there were substituted a reference to intention on his part that it should be used by the corporation or licensee concerned.

(3) The court or the Registrar may, as a condition of the exercise of the power conferred by subsection (1) in favour of an applicant who relies on intention to assign to a corporation as aforesaid, require him to give security for the costs of any proceedings before the court or the Registrar relative to any opposition or appeal, and in default of such security being duly given may treat that application as abandoned.

(4) Where a trade mark is registered in respect of any goods under the power conferred by subsection (1) in the name of an applicant who relies on intention to assign to a corporation as aforesaid, then, unless within such period as may be prescribed, or within such further period not exceeding six months as the Registrar may on application being made to him in the prescribed manner allow, the corporation has been registered as the proprietor of the trade mark in respect of those goods, the registration shall cease to have effect in respect thereof at the expiration of that period, and the Registrar shall amend the register accordingly.

[Act No. 5 of 1994, s. 18, Act No. 7 of 2007, Sch.]

33. Use of one of associated or substantially identical trade marks equivalent to use of another

(1) Where under this Act use of a registered trade mark is required to be proved for any purpose, the court or the Registrar may, if and so far as the court or the Registrar thinks right, accept use of a trade mark with additions or alterations not substantially affecting its identity, as an equivalent for the use required to be proved.

(2) The use of the whole of a registered trade mark shall for the purposes of this Act be deemed to be also a use of any registered trade mark, being a part thereof, registered in the name of the same proprietor by virtue of subsection (1) of section 24.

[Act No. 4 of 2002, s. 7.]

34. Use of trade mark for export trade

The application in Kenya of a trade mark to goods to be exported from Kenya, and any other act done in Kenya in relation to goods to be so exported or services to be performed outside which, if done in relation to goods to be sold or otherwise traded in Kenya or services to be performed within Kenya would constitute use of a trade mark therein, shall be deemed to constitute those goods or services for any purpose for which such use is material under this Act or at common law.

[Act No. 5 of 1994, s. 19.]

Part VI – RECTIFICATION AND CORRECTION OF REGISTER

35. General power to rectify entries in register

(1) Any person aggrieved by the non-insertion in or omission from the register of an entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the court or, at the option of the applicant and subject to the provisions of section 53, to the Registrar, and the court or the Registrar may make such order for making, expunging or varying the entry as the court or the Registrar may think fit.

(2) The court or the Registrar may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connexion with the rectification of the register.

(3) In case of fraud in the registration, assignment or transmission of a registered trade mark, the Registrar may himself apply to the court under this section.

(4) Any order of the court rectifying the register shall direct that notice of the rectification shall be served in the prescribed manner on the Registrar, and the Registrar shall on receipt of the notice rectify the register accordingly.

(5) The power to rectify the register conferred by this section shall include power to remove a registration in Part A of the register to Part B.

36. Power to expunge or vary registration for breach of condition

On application by any person aggrieved to the court, or, at the option of the applicant and subject to the provisions of section 53, to the Registrar, or on application by the Registrar to the court, the court or the Registrar may make such order as the court or the Registrar may think fit for expunging or varying the registration of a trade mark on the ground of any contravention of, or failure to observe, a condition entered on the register in relation thereto.

36A. Surrender of a registered trade mark

(1) A proprietor may surrender a registered trade mark in respect of some or all of the goods or services for which it is registered.

(2) The Cabinet Secretary may make rules for the surrender of a registered trade mark and for protecting persons with rights in the registered trade mark.

[Act No. 4 of 2002, s. 8.]

36B. Effect of Acquiescence

(1) A proprietor of an earlier trade mark or any other earlier right, who has acquiesced for a continuous period of five years in the use of a registered trade mark in Kenya, being aware of that use, shall cease to be entitled, on the basis of that earlier trade mark or earlier rights—

(a) to apply for a declaration that the registration of the latter trade mark is invalid; or

(b) to oppose the use of the latter trade mark in relation to the goods or services in relation to which it has been so used, unless the registration of the latter trade mark was applied for in bad faith.

(2) Where subsection (1) applies, the proprietor of the latter trade mark shall not be entitled to oppose the use of the earlier trade mark or the exploitation of the earlier right, as the case may be, notwithstanding that the earlier trade mark or right, may no longer be invoked against his latter trade mark.

[Act No. 4 of 2002, s. 8.]

37. Correction of register

(1) The Registrar may, on request made in the prescribed manner by the registered proprietor—

(a) correct any error in the name, address or description of the registered proprietor of a trade mark;

(b) enter any change in the name, address or description of the person who is registered as proprietor of a trade mark;

(c) cancel the entry of a trade mark on the register;

(d) strike out any goods or services or classes of goods or services, as the case may be, from those in respect of which a trade mark is registered; or

(e) enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of the trade mark.

(2) The Registrar may, on request made in the prescribed manner by a licensee of a trade mark, correct any error, or enter any change, in the name, address or description of the licensee.

(3) Any decision of the Registrar under this section shall be subject to appeal to the court.

[Act No. 5 of 1994, s. 20, Act No. 7 of 2007, Sch.]

38. Alteration of registered trade mark

(1) The registered proprietor of a trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter the trade mark in any manner not substantially affecting the identify thereof, and the Registrar may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.

(2) The Registrar may cause an application under this section to be advertised in the prescribed manner in any case where it appears to him that it is expedient so to do, and where he does so, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar in the prescribed manner of opposition to the application, the Registrar shall, after hearing the parties if so required, decide the matter.

(3) A decision of the Registrar under this section shall be subject to appeal to the court.

(4) Where leave under this section is granted, the trade mark as altered shall be advertised in the prescribed manner, unless it has already been advertised, in the form to which it has been altered, in an advertisement under subsection (2).

39. Adaptation of entries in register to amended or substituted classification of goods

(1) The Cabinet Secretary may from time to time make such rules, prescribe such forms and generally do such things as he thinks expedient, for empowering the Registrar to amend the register, whether by making or expunging or varying entries therein, so far as may be requisite for the purpose of adapting the designation therein of the goods or classes of goods or services or classes of services in respect of which trade marks are registered to any amended or substituted classification that may be prescribed.

(2) The Registrar shall not, in exercise of any power conferred on him for the purpose referred to in subsection (1), make any amendment of the register that would have the effect of adding any goods or classes of goods to those in respect of which a trade mark is registered (whether in one or more classes) immediately before the amendment is to be made, or of ante-dating the registration of a trade mark in respect of any goods:

Provided that this subsection shall not have effect in relation to goods as to which the Registrar is satisfied that compliance with this subsection in relation thereto would involve undue complexity and that the addition or ante-dating, as the case may be, would not affect any substantial quantity of goods and would not substantially prejudice the rights of any person.

(3) A proposal for the amendment of the register for the purpose referred to in subsection (1) shall be notified to the registered proprietor of the trade mark affected, shall be subject to appeal by the registered proprietor to the court, shall be advertised with any modifications, and may be opposed before the Registrar by any person aggrieved on the ground that the proposed amendment contravenes subsection (2), and the decision of the Registrar on any such opposition shall be subject to appeal to the court.

(4) *Deleted by Act No. 39 of 1962, s. 5.*

[Act No. 39 of 1962, s. 5, Act No. 5 of 1994, s. 21.]

Part VII – CERTIFICATION TRADE MARKS

40. Certification trade marks

(1) A mark adapted in relation to any goods to distinguish in the course of trade goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic from goods not so certified shall be registrable as a certification trade mark in Part A of the register in respect of those goods in the name, as proprietor thereof, of that person:

Provided that a mark shall not be so registrable in the name of a person who carries on a trade in goods of the kind certified.

(2) In determining whether a mark is adapted to distinguish, the court or the Registrar may have regard to the extent to which—

(a) the mark is inherently adapted to distinguish in relation to the goods in question; and

(b) by reason of the use of the mark or of any other circumstances, the mark is in fact adapted to distinguish in relation to the goods in question.

(3) Subject to the provisions of subsections (4), (5) and (6) of this section, and of sections 10 and 11, the registration of a person as proprietor of a certification trade mark in respect of any goods shall, if valid, give to that person the exclusive right to the use of the trade mark in relation to those goods, and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a person authorized by him under the regulations in that behalf using it in accordance therewith, uses a mark identical with it or so nearly resembling it as to be likely to deceive of cause confusion, in the course of trade,

in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either—

(a) as being used as a trade mark; or

(b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or by his authorisation under the relevant regulations to use the trade mark or to goods certified by the proprietor.

(4) The right to the use of a certification trade mark given by registration shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark in any mode, in relation to goods to be sold or otherwise traded in any place, in relation to goods to be exported to any market, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.

(5) The right to the use of a certification trade mark given by registration shall not be deemed to be infringed by the use of any such mark by any person—

(a) in relation to goods certified by the proprietor of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or another in accordance with his authorization under the relevant regulations has applied the trade mark and has not subsequently removed or obliterated it, or the proprietor has at any time expressly or impliedly consented to the use of the trade mark; or

(b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact that the goods are certified by the proprietor:

Provided that paragraph (a) shall not have effect in the case of use consisting of the application of any such mark to goods, notwithstanding that they are goods mentioned in that paragraph, if that application is contrary to the relevant regulations.

(6) Where a certification trade mark is one of two or more registered trade marks that are identical or nearly resemble each other, the use of any of those trade marks in exercise of the right to the use of that trade mark given by registration shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

(7) There shall be deposited at the office of the Registrar in respect of every trade mark registered under this section regulations for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods and to authorize the use of the trade mark, and may contain any order provisions that the Registrar may require or permit to be inserted therein (including provisions conferring a right of appeal to the Registrar against any refusal of the proprietor to certify goods or to authorize the use of the trade mark in accordance with the regulations); and regulations so deposited shall be open to inspection in the same manner as the register.

(8) A certification trade mark shall not be assignable or transmissible otherwise than with the consent of the court.

(9) The provisions of the First Schedule shall have effect with respect to the registration of a mark under this section and to marks so registered.

Part VIIA – COLLECTIVE TRADE MARKS

40A. Collective trade marks

(1) A mark capable of distinguishing, in the course of trade, the goods or services of persons who are members of an association, from goods or services of persons who are not members of such association, shall on application in the prescribed manner, be registerable as a collective trade mark or service mark in respect of the goods or services in the name of such an association.

(2) An application for registration of a collective trade mark shall designate the mark as a collective trade mark and the application shall be accompanied by a copy of the rules governing the use of the mark.

(3) In subsection (2) "rules" means the rules made by a person under whose control the collective mark may be used.

(4) The registered owner of a collective trade mark shall notify the Registrar, in writing, of any changes made in respect of the rules governing the collective trade mark.

(5) Geographical names or other indications of geographical origin may be registered as collective trade marks or service marks.

(6) The provisions of this Act shall, except insofar as may otherwise be provided, apply to a collective trade mark or service mark.

[Act No. 4 of 2002, s. 9.]

Part VIIB – INTERNATIONAL APPLICATIONS

40B. Marks registered under the Banjul Protocol and the Madrid Convention and Protocol

In this Part—

"International Bureau" means the International Bureau of the World Intellectual Property Organization, established by the convention signed at Stockholm on the 14th July, 1967;

"international trade mark" means a trade mark which is entitled to be protected in Kenya under the Madrid Agreement and the Madrid Protocol;

"the Banjul Protocol" means the Protocol on Marks adopted by the Administrative Council of ARIPO held in Banjul, The Gambia in 1993, and it includes all the amendments or revisions thereof;

"the Madrid Convention" means the Agreement relating to the International Registration of Marks, adopted in Madrid in April, 1891;

"the Madrid Protocol" means the protocol relating to the Madrid Agreement adopted in Madrid on 27th June, 1989.

[Act No. 4 of 2002, s. 9.]

40C. Rules regarding regional and international applications

(1) The Cabinet Secretary may, in rules, make appropriate provisions to give effect, in Kenya, to the provisions of the Banjul Protocol and the Madrid Agreement and the Madrid Protocol.

(2) The rules referred to in subsection (1) may, in particular, provide for—

(a) the filing of applications for international registration of marks through the Institute;

(b) the procedures to be followed where the basic application in Kenya fails or ceases to be in force;

(c) the communication of information to ARIPO or the International Bureau;

(d) the payment of fees in respect of applications for regional or international registration and renewals.

[Act No. 4 of 2002, s. 9.]

40D. Applications for registration of marks under the Banjul Protocol

(1) A trade mark in respect of which Kenya is a designated state, registered by ARIPO by virtue of the Banjul Protocol, shall have the same effect and enjoy the same protection in Kenya, as a trade mark registered under this Act, unless the Registrar communicates to ARIPO, in respect of the application, a decision in accordance with the provisions of that Protocol, that if a mark is registered by ARIPO, that mark shall have no effect in Kenya.

(2) The Institute shall act as a receiving office, for the purpose of filing an application under the Banjul Protocol, where a regional application is filed with it and the applicant is a national or a resident of Kenya.

(3) Where there is a conflict between the provisions of this Act and the provisions of the Banjul Protocol on Marks, this Act shall prevail.

(4) The provisions of this Act with respect to legal proceedings and appeals relating to registered trade marks shall apply to international trade marks.

[Act No. 4 of 2002, s. 9.]

Part VIII – RULES AND FEES

41. Power of Cabinet Secretary to make rules

The Cabinet Secretary may make such rules, prescribe such forms and generally do such things as he thinks as he thinks expedient—

(a) for regulating the practice under this Act, including the service of documents;

(b) for classifying goods and services for the purposes of registration of trade marks;

(c) for making or requiring duplicates of trade marks and other documents;

(d) for securing and regulating the publishing and selling or distributing, in such manner as the Cabinet Secretary thinks fit, of copies of trade marks and other documents;

(e) generally, for regulating the business of the Registrar in relation to trade marks and all things by this Act placed under the direction or control of the Registrar.

[Act No. 39 of 1956, Sch., Act No. 5 of 1994, s. 22.]

42. Fees

There shall be paid in respect of applications and registration and other matters under this Act such fees as may be prescribed by the Cabinet Secretary.

Part IX – POWERS AND DUTIES OF REGISTRAR

43. Preliminary advice by Registrar as to distinctiveness

(1) The power to give to a person who proposes to apply for the registration of a trade mark in Part A or Part B of the register advice as to whether the trade mark appears to the Registrar *prima facie* to be inherently adapted to distinguish, or capable of distinguishing, as the case may be, shall be a function of the Registrar under this Act.

(2) A person who is desirous of obtaining such advice shall make application to the Registrar therefor in the prescribed manner.

(3) If on an application for the registration of a trade mark as to which the Registrar has given advice in the affirmative, made within three months after the advice is given, the Registrar, after further investigation or consideration, gives notice to the applicant of objection on the ground that the trade mark is not adapted to distinguish, or capable of distinguishing, as the case may be, the applicant shall be entitled, or giving notice of withdrawal of the application within the prescribed period, to have repaid to him any fee paid on the filing of the application.

44. Hearing before exercise of Registrar's discretion

Where any discretionary or other power is given to the Registrar by this Act or the rules, he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark in question without (if duly required so to do within the prescribed time) giving to the applicant or registered proprietor an opportunity of being heard.

45. Power of Registrar to award costs

(1) In all proceedings before the Registrar under this Act, the Registrar shall have power to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may, be leave of the court or a judge thereof, be enforced in the same manner as a judgment or order of the court to the same effect.

(2) The Chief Justice may make rules in regard to the amount of and generally as to costs.

Part X – LEGAL PROCEEDINGS AND APPEALS

46. Registration to be *prima facie* evidence of validity

In all legal proceedings relating to a registered trade mark (including applications under section 35), the fact that a person is registered as proprietor of the trade mark shall be *prima facie* evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.

47. Certificate of validity

In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided in favour of the proprietor of the trade mark, the court may certify to that effect, and if it so certifies then in any subsequent legal proceedings in which the validity of the registration comes into question the proprietor of the trade mark on obtaining a final order or judgment in his favour shall have his full costs, charges and expenses as between advocate and client, unless in the subsequent proceeding the court certifies that he ought not to have them.

48. Costs of Registrar in proceedings before court, and payment of costs by Registrar

In all proceedings before the court under this Act, the costs of the Registrar shall be in the discretion of the court, but the Registrar shall not be ordered to pay the costs of any other of the parties.

49. Trade usage, etc., to be considered

In any action or proceeding relating to a trade mark or trade name, the court or the Registrar shall admit evidence of the usages of the trade concerned and of any relevant trade mark or trade name or get-up legitimately used by other persons.

50. Registrar's appearance in proceedings involving rectification

(1) In any legal proceeding in which the relief sought includes alteration or rectification of the register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the court.

(2) Unless otherwise directed by the court, the Registrar in lieu of appearing and being heard may submit to the court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting it or of the practice of the office of the Registrar in similar cases or of such other matters relevant to the issues, and within his knowledge as Registrar, as he thinks fit, and the statement shall be deemed to form part of the evidence in the proceeding.

51. Court's power to review Registrar's decision

The court, in dealing with any question of the rectification of the register (including all applications under the provisions of section 35), shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.

52. Discretion of court in appeals

In any appeal from a decision of the Registrar to the court under this Act, the court shall have and exercise the same discretionary powers as under this Act are conferred upon the Registrar.

53. Procedure in cases of option to apply to court or Registrar

Where under any of the foregoing provisions of this Act an applicant has an option to make an application either to the court or to the Registrar—

(a) if an action concerning in the trade mark in question is pending, the application shall be made to the court;

(b) if in any other case the application is made to the Registrar, he may, at any stage of the proceedings, refer the application to the court, or he may after hearing the parties determine the question between them, subject to appeal to the court.

54. Mode of giving evidence

(1) In any proceeding under this Act before the Registrar, the evidence shall be given by statutory declaration in the absence of directions to the contrary, but, in any case in which the Registrar thinks it right so to do, he may take evidence *viva voce* in lieu of or in addition to evidence by declaration.

(2) Any such statutory declaration may in the case of appeal be used before the court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

(3) In case any part of the evidence is taken *viva voce*, the Registrar shall, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as a magistrate.

54A. Nice Agreement receivable in evidence

The Nice Agreement concerning the International Classification of Goods and Services for the purpose of the Registration of Trade Marks of 15 June, 1957 and all revisions thereof together with the publications of the World Intellectual Property Organization of Geneva relating to the Agreement may be received in evidence before any court or Registrar and shall be taken into account by the Registrar in relation to his duties under this Act.

[Act No. 5 of 1994, s. 23.]

55. [Deleted by Act No. 11 of 1965, s. 5.]

56. [Deleted by Act No. 11 of 1965, s. 5.]

Part XI – OFFENCES, AND RESTRAINT OF REGISTRATION AND USE OF CERTAIN MARKS

[Act No. 1 of 1984, s. 2.]

57. Falsification of entries in register

If any person makes or causes to be made a false entry in the register, or a writing falsely purporting to be a copy of an entry in the register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty or an offence and liable to imprisonment for a term not exceeding five years or to a fine not exceeding ten thousand shillings, or to both such imprisonment and fine.

58. Fine for falsely representing a trade mark as registered

(1) Any person who makes a representation—

(a) with respect to a mark not being a registered trade mark, to the effect that it is a registered trade mark; or

(b) with respect to a part of a registered trade mark not being a part separately registered as a trade mark, to the effect that it is so registered; or

(c) to the effect that a registered trade mark is registered in respect of any goods in respect of which it is not registered; or

(d) to the effect that the registration of a trade mark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations entered on the register, the registration does not give that right,

shall be guilty of an offence and liable to a fine not exceeding five thousand shillings.

(2) For the purposes of this section, the use in Kenya in relation to a trade mark of the word "registered", or of any other word referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration in the register, except—

(a) where that word is used in physical association with other words delineated in characters at least as large as those in which that word in delineated and indicating that the reference is to registration as a trade mark under the law of a country outside Kenya, being a country under the law of which the registration referred to is in fact in force;

(b) where that word (being a word other than the word "registered") is of itself such as to indicate that the reference is to the last-mentioned registration; or

(c) where that word is used in relation to a mark registered as a trade mark under the law of a country outside Kenya and in relation to goods to be exported to that country.

58A. Interpretation of terms in Part XI

In this Part—

"apply to," in relation to goods, means—

(a) to emboss, impress, engrave, etch, stamp, write, photocopy or otherwise cause to be applied to or printed upon; or

(b) to weave or otherwise work into; or

(c) to annex or affix to,

such goods;

"covering" means any bottle, box, capsule, case, cask, frame, vessel, wrapper or other container or cover and includes a band label, ticket or reel;

"forged", in relation to a registered mark, means made or falsified as described in section 58C;

"sell" includes—

(a) to expose for sale; and

(b) to have in possession for the purpose of sale or for any purpose of trade or commerce.

[Act No. 5 of 1994, s. 24.]

58B. Application

(1) A trade mark is applied to goods if—

(a) it is applied to the goods themselves; or

(b) it is applied to a covering on, in or attached to which the goods are sold; or

(c) the goods are placed in or around, enclosed by or annexed to any covering to which the trade mark or other mark has been applied; or

(d) it is used in any manner likely to lead to the belief that the goods in connection with which it is used are designated by that trade mark or other mark.

(2) Goods delivered in pursuance of an offer or request made by reference to a trade mark or other mark appearing in any sign, advertisement, invoice, list, catalogue, business letter, business paper, price-list or other commercial documents, for the purposes of paragraph (d) of subsection (1) are goods in connection with which the trade mark or other mark is used.

(3) A trade mark is applied in relation to services if it is used in any manner likely to lead to the belief that the services in connection with which it is used are designated by that trade mark.

(4) A registered trade mark is falsely applied to goods or in relation to services if, without the consent of the proprietor or the authority of this Act, the registered trade mark or a mark so nearly resembling it as to be likely to deceive or cause confusion is applied to the goods or in relation to the services, as the case may be.

[Act No. 5 of 1994, s. 24.]

58C. Forgery of registered trade mark

For the purpose of this Part, a person forges a registered trade mark if—

(a) without the consent of the proprietor of the registered trade mark or the authority of this Act, he makes that trade mark or a mark so nearly resembling that trade mark as to be likely to deceive or cause confusion; or

(b) he falsifies a registered trade mark, whether by alteration, addition, effacement or otherwise.

[Act No. 5 of 1994, s. 24.]

58D. Prohibition of forgery of registered trade mark

(1) Subject to subsection (2), any person who—

(a) forges a registered trade mark; or

(b) falsely applies a registered trade mark to goods or in relation to services; or

(c) makes a die, block, machine or other instruments, for the purpose of forging, or of being used for forging, a registered trade mark; or

(d) disposes of, or has in his possession, a die, block, machine or other instrument for the purpose of forging or of being used for forging, a registered trade mark; or

(e) without the consent of the proprietor of a registered trade mark—

(i) makes, imports or has in his possession any device for applying that registered trade mark to goods or in relation to services or representations of that trade mark; or

(ii) makes any reproduction, replicas or representations of that trade mark; or

(iii) imports any reproductions, replicas or representations of that trade mark otherwise than on goods to which they have been applied; or

(f) makes, imports or has in his possession—

(i) any device for applying to any goods or in relation to any services a mark so nearly resembling a registered trade mark as to be likely to deceive or cause confusion; or

(ii) any reproduction, replica or representation of a mark so nearly resembling a registered trade mark as to be likely to deceive or cause confusion, for the purpose of applying it to goods or in relation to services contrary to the provisions of this Part; or

(iii) any covering bearing a mark so nearly resembling a registered trade mark as to be likely to deceive or cause confusion, for the purpose of using it to cover or contain, or in relation to, goods contrary to the provisions of this Part,

shall be guilty of an offence, and liable to a fine not exceeding two hundred thousand shillings or to imprisonment for a term not exceeding five years or to both.

(2) It is a sufficient defence to any charge—

(a) under subsection (1), if the person concerned proves that he acted without intent to defraud; or

(b) under paragraph (b) or (c) of subsection (1), if the person concerned proves that—

(i) in the ordinary course of his business he was employed on behalf of other persons, either to make dies, blocks, machines or other instruments for making or being used in making trade marks or, as the case may be, to apply trade marks to goods or in relation to services and that, in the case which is the subject of the charge, he was so employed by some other person and was not interested in the goods or services by way

of profit or commission dependent on the sale of such goods or performance of such services; and

(ii) he took reasonable precautions against committing the offence charged; and

(iii) he had, at the time of the commission of the alleged offence, no reason to suspect that the trade mark was not genuine; and

(iv) on request made by a police officer, he gave to that police officer information in his power with respect to the person on whose behalf the trade mark was applied.

[Act No. 5 of 1994, Section 24, Act No. 4 of 2002, Section 10.]

58E. Prohibition of sale or importation of goods or performance of services with forged registered trade mark

(1) Subject to the provisions of subsection (2), any person who sells or imports any goods or performs any services to which—

(a) a forged registered trade mark is falsely applied; or

(b) a registered trade mark is falsely applied,

shall be guilty of an offence, and liable to a fine not exceeding two hundred thousand shillings or to imprisonment for a term not exceeding five years or to both.

(2) It is a defence to any charge under subsection (1) if the person concerned proves that having taken all reasonable precautions against committing an offence under this Part—

(i) he had, at the time of the sale, no reason to suspect that the trade mark was not genuine; and

(ii) on request made by a police officer or customs officer, he gave to that officer all the information in his power with respect to the person from whom he obtained such goods.

[Act No. 5 of 1994, s. 24, Act No. 4 of 2002, s. 11.]

58F. Aiding and abetting offence

Any person who within Kenya procures, counsels, aids, abets or is accessory to the commission outside Kenya of an offence which, if committed within Kenya would be an offence under this Part, is himself guilty of an offence and liable to a fine not exceeding two hundred thousand shillings or to imprisonment for a term not exceeding five years or to both.

[Act No. 5 of 1994, s. 24, Act No. 4 of 2002, s. 12.]

58G. Evidence

(1) Any invoice or other document submitted or used by an importer or any other person in connection with the importation of goods in respect of which a prosecution is brought under this Part may be produced as evidence in any criminal proceedings without calling the person who prepared or signed it.

(2) In any prosecution for an offence under this Part, evidence that any imported goods were shipped at any port of call shall be *prima facie* evidence that those goods were grown, manufactured or produced in the country within which that port is situated.

(3) Where, in any prosecution for an offence under this Part, the consent of the proprietor of a trade mark is a relevant issue, the onus of proving the consent of such proprietor lies on the accused.

[Act No. 5 of 1994, s. 24.]

58H. Forfeiture of goods

(1) On conviction of any person for an offence under this Part, the court may, in addition to any sentence passed, declare any goods in respect of or by means of which the offence was committed to be forfeited to the Government, unless the owner of the goods or any person acting in his behalf or any other person interested in the goods shows cause to the contrary.

(2) After any goods in respect of or by means of which it is suspected an offence under this Part has been committed are seized by a police officer and no prosecution is instituted following that seizure —

(a) the magistrate shall, on application by a police officer, cause a notice to be published in the *Gazette* and in a newspaper circulating in the area stating that unless cause is shown to the contrary at the time and place specified in the notice such goods will be declared forfeited; and

(b) at the time and place referred to in paragraph (a) the magistrate may, unless the owner of the goods or any person on his behalf or other person interested in the goods shows cause to the contrary declare such goods to be forfeited to the Government.

[Act No. 5 of 1994, s. 24.]

59. Restraint of registration and use of Olympic symbol

(1) Subject to an authorisation by or on behalf of the International Olympic Committee, no sign consisting of or containing the Olympic symbol, as defined in the Charter of the International Olympic Committee and consisting of five interlaced rings, whether delineated in a single colour or in different colours, shall be registered as a mark, or used for commercial purposes as a mark or other sign; and where such a sign has been registered as a mark that registration shall be void.

(2) Nothing in subsection (1) shall prevent the use of the sign or design where it is made by the mass media for the purposes of informing the public about the Olympic movement.

(3) The Cabinet Secretary may, by notice in the *Gazette*, suspend the operation of subsection (1) during any period during which there is not agreement in force between the International Olympic Committee and the Kenya Olympic Association concerning the conditions under which authorisation for the use of the Olympic symbol may be made.

(4) Notwithstanding the provisions of section 5, an interested party may institute proceedings to—

(a) prevent the use or registration of a sign referred to in subsection (1) contrary to the provisions of that subsection;

(b) obtain the removal from the register of a sign registered as a mark contrary to the provisions of subsection (1);

(c) claim damages or other available civil remedy arising out of the matters referred to in paragraph (a) or (b).

[Act No. 11 of 1965, s. 6, Act No. 1 of 1984, s. 3.]

Part XII – MISCELLANEOUS

60. Change of form of trade connexion not to be deemed to cause deception

The use of a registered trade mark in relation to goods between which and the person using it any form of connexion in the course of trade subsists shall not be deemed to be likely to cause deception or confusion on the ground only that the trade mark has been, or is, used in relation to goods between which and that

person or a predecessor in title of his a different form of connexion in the course of trade subsisted or subsists.

61. Jointly owned trade marks

(1) Where the relations between two or more persons interested in a trade mark are such that no one of them is entitled as between himself and the other or others of them to use it except—

(a) on behalf of both or all of them; or

(b) in relation to an article with which both or all of them are connected in the course of trade,

those persons may be registered as joint proprietors of the trade mark, and this Act shall have effect in relation to any rights to the use of the trade mark vested in those persons as if those rights had been vested in a single person.

(2) Subject to subsection (1), nothing in this Act shall authorize the registration of two or more persons who use a trade mark independently, or propose so to use it, as joint proprietors thereof.

62. Trusts and equities

(1) There shall not be entered in the register any notice of any trust express, implied or constructive, nor shall any such notice be receivable by the Registrar.

(2) Subject to the provisions of this Act, equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

63. Recognition of agents

(1) Where by this Act any act has to be done by or to any person in connexion with a trade mark or proposed trade mark or any procedure relating thereto, the act may, under and in accordance with the rules, be done by or to an agent of that person duly authorized in the prescribed manner.

(2) An applicant who ordinarily resides outside Kenya or has a principal place of business outside Kenya, may be represented by a trade mark agent.

(3) A person shall be qualified to act as a trade mark agent if such person—

(a) is a Kenyan citizen; and

(b) is an advocate of the High Court of Kenya; or

(c) is admitted to practise as an agent before the Institute in accordance with the provisions of the Industrial Property Act (Cap. 509).

[Act No. 4 of 2002, s. 13.]

64. Address for service

When an applicant for the registration of a trade mark or an agent does not reside or carry on business in Kenya, he shall give the Registrar an address for service in Kenya, and if he fails to do so the Registrar may refuse to proceed with the application until such address has been given.

65. International arrangements

(1) Where any person has registered or has applied for protection for any trade mark in any foreign state with the government of which the Government of Kenya has made arrangements for mutual protection of trade marks, that person or his legal representative or assignee shall be entitled to registration of his trade mark in priority to other applicants; and that registration shall have the same date as the date of application for protection in the foreign state if the application for

registration is made within six months from the date of the application for protection in the foreign state:

Provided that nothing in this section shall entitle that proprietor of a trade mark to recover damages for infringements happening prior to the actual date on which his trade mark is registered in Kenya.

(2) The registration of a trade mark shall not be invalidated by reason only of the use of the trade mark in Kenya during the period of six months.

(3) The application for the registration of a trade mark under this section shall be made in the same manner as an ordinary application under this Act:

Provided that any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act.

(4) The provisions of this section shall apply only to those foreign states to which the Attorney-General has by notice in the *Gazette* declared them to be applicable and so long only as the notice continues in force with respect to those states.

(5) *Deleted by Act No. 11 of 1965, s. 7.*

[Act No. 11 of 1965, s. 7.]

66. Provisions as to public holidays

Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document with or paying any fee to the Registrar falls on a Sunday or public holiday, the document may be left or the fee may be paid on the day next following the Sunday or public holiday.

67. Transitional provisions and savings

The transitional provisions and savings set out in the Third Schedule shall have effect with respect to the matters therein mentioned respectively.

FIRST SCHEDULE [s. 40]

CERTIFICATION TRADE MARKS

(1) An application for the registration of a mark under section 40 shall be made to the Registrar in writing in the prescribed manner by the person proposed to be registered as the proprietor thereof.

(2) The provisions of subsection (2) and of subsections (4) to (7) of section 20 shall have effect in relation to an application under section 40 as they have effect in relation to an application under subsection (1) of section 20.

(3) In dealing under the provisions of section 20 with an application under section 40, the court or the Registrar shall have regard to the same considerations, so far as relevant, as if the application were an application under section 20 and to any other considerations relevant to applications under section 40, including the desirability of securing that a certification trade mark shall comprise some indication that it is such a trade mark.

(4) An applicant for the registration of a mark under section 40 shall transmit to the Registrar draft regulations for governing the use thereof in accordance with subsection (7) of that section.

(5) The Registrar shall consider the application with regard to the following matters—

(a) whether the applicant is competent to certify the goods in respect of which the mark is to be registered;

(b) whether the draft regulations are satisfactory; and

(c) whether in all the circumstances the registration applied for would be to the public advantage,

and may either—

(i) refuse to accept the application; or

(ii) accept the application, and approve the regulations either without modification and unconditionally or subject to any conditions or limitations, or to any amendments or modifications of the application or of the regulations, which he thinks requisite having regard to any of the foregoing matters,

but, except in the case of a direction for acceptance and approval without modification and unconditionally, the Registrar shall not decide the matter without giving to the applicant an opportunity of being heard.

2. (1) When an application has been accepted, the Registrar shall, as soon as may be after acceptance, cause the application as accepted to be advertised in the prescribed manner, and the provisions of subsections (2) to (11) of section 21 shall have effect in relation to the registration of the mark as if the application had been an application under section 20:

Provided that, in deciding under the provisions of section 21, the Registrar shall have regard only to the considerations referred to in subparagraph (3) of paragraph 1 of this Schedule, and a decision under those provisions in favour of the applicant shall be conditional on the determination in his favour by the Registrar under subparagraph (2) of this paragraph of any opposition relating to any of the matters referred to in subparagraph (5) of paragraph 1.

(2) When notice of opposition is given relating to any of the matters referred to in subparagraph (5) of paragraph 1 of this Schedule, the Registrar shall, after hearing the parties, if so required, and considering any evidence, decide whether, and subject to what conditions or limitations, or amendments or modifications of the application or of the regulations, if any, registration is, having regard to those matters, to be permitted.

3. (1) The regulations deposited in respect of a certification trade mark may, on the application of the registered proprietor, be altered by the Registrar.

(2) The Registrar may cause an application for his consent to be advertised in any case where it appears to him that it is expedient so to do, and where the Registrar causes an application to be advertised, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar of opposition to the application, the Registrar shall not decide the matter without giving the parties an opportunity of being heard.

4. (1) The court may, on the application in the prescribed manner of any person aggrieved, or on the application of the Registrar, make such order as it thinks fit for expunging or varying any entry in the register relating to a certification trade mark, or for varying the deposited regulations, on the ground—

(a) that the proprietor is no longer competent, in the case of any of the goods in respect of which the trade mark is registered, to certify those goods;

(b) that the proprietor has failed to observe a provision of the deposited regulations to be observed on his part;

(c) that it is no longer to the public advantage that the trade mark should be registered; or

(d) that it is requisite for the public advantage that, if the trade mark remains registered, the regulations should be varied,

and the Registrar shall have no jurisdiction to make an order under section 35 on any of those grounds.

(2) The Registrar shall rectify the register and the deposited regulations in such manner as may be requisite for giving effect to an order made under subparagraph (1) of this paragraph.

5. Notwithstanding anything in section 45, the Registrar shall not have any jurisdiction to award costs to or against any party on an appeal to him against a refusal of the proprietor of a certification trade mark to certify goods or to authorize the use of the trade mark.

6. A decision of the Registrar under the provisions of this Schedule shall be subject to appeal to the court.

7. The following provisions of this Act shall not have effect in relation to a certification trade mark, that is to say, section 7, section 9, section 12, sections 20 and 21 (except as expressly applied by this Schedule), subsections (4) to (8) of section 25, sections 29 to 32, section 60 and any provisions the operation of which is limited by the terms thereof to registration in Part B of the register.

SECOND SCHEDULE

DELETED

[Act No. 39 of 1962, s. 6.]

[Deleted by Act No. 11 of 1965, s. 9]

THIRD SCHEDULE [s. 67]

TRANSITIONAL PROVISIONS AND SAVINGS

[L.N. 2/1964, Act No. 5 of 1994, s. 25, Act No. 7 of 2007, Sch.]

Assignments and Transmissions (Before Appointed Day) giving Exclusive Rights in Different Places in Kenya

1. The validity of an assignment or transmission of a trade mark effected or claimed to have been effected before the appointed day, in any such case as is mentioned in subsection (6) of section 25, shall be determined as if the provisions contained in subsections (1) to (5) of that section had not been enacted.

Saving as to Retrospective Provisions Relating to Assignments and Transmissions

2. The retrospective provisions contained in section 25 shall have effect without prejudice to any determination of the court or the Registrar that was made before the appointed day, or to the determination of any appeal from a determination so made, or to any title acquired for valuable consideration before the appointed day.

Association of Trade Marks Assignable or Transmissible as a Whole Only

3. Where immediately before the appointed day a trade mark was registered in Part B of the register subject to a condition rendering it assignable or transmissible only as a whole with another trade mark registered in the name of the same proprietor or with two or more other trade marks so registered, and not separately, the trade marks shall be deemed to be associated trade marks, and the entries in the register relating thereto may be amended accordingly.

Previous use of a Trade Mark by person becoming Registered User on Application made within one Year of Appointed Day

4. Where a person is registered as a licensee of a trade mark on an application made within one year from the appointed day, subsection (2) of section 31 shall have effect in relation to any previous use (whether before or after the appointed day) of the trade mark by that person, being use in relation to the goods in respect of which he is registered and, where he is registered subject to conditions or restrictions, being use such as to comply substantially therewith, as if such previous use had been permitted use.

[Act No. 7 of 2007, Sch.]

Use of Trade Mark for Export Trade before Appointed Day

5. Section 34 shall be deemed to have had effect in relation to an act done before the appointed day in relation to goods or services as it has effect in relation to an act done after the appointed day without prejudice, however, to any determination of the court or the Registrar which was made before the appointed day or to the determination of any appeal from a determination so made.

[Act No. 5 of 1994, s. 25.]

Savings in respect of the Repealed Trade Marks Act

6.

(1) Nothing in this Act shall be taken to invalidate the original registration of a trade mark which immediately before the appointed day was validly on the register.

(2) No trade mark which was upon the register on the appointed day and which, having regard to any differences as between the provisions of this Act and the provisions of the Trade Marks Act (Cap. 293 (1948)) (now repealed) whether as respects limitations which may be imposed on registration or as respects any other matter, was then a registrable trade mark under that Act shall be removed from the register on the ground that it was not registrable under the Act in force at the date of its registration.

(3) Nothing in this Act shall subject any person to any liability in respect of any act or thing done before the appointed day to which he would not have been subject under the repealed Act.

(4) Nothing in this Act shall affect any 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 repealed Act; and every such order, rule, regulation, requirement, table of fees, certificate, notice, decision, determination, direction, approval, application or thing shall, if in force at the appointed day, 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 enactment of this Act.

(5) Any document referring to any provision of the repealed Act shall be construed as referring to the corresponding provision of this Act.

7. In this Schedule the expression "the appointed day" means—

(a) in relation to a trade mark as defined in this Act prior to the date of commencement of the Trade Marks (Amendment) Act, 1994, 1st January, 1957; and

(b) in relation to a trade mark and in relation to services as defined in this Act after the date of commencement of the Trade Marks (Amendment) Act, 1994, the date of commencement of that Act.

[Act No. 5 of 1994, s. 25.]