

TRADEMARK REGISTRATION & ENFORCEMENT

LA. 05/22

Legal Alert

14th November, 2022

Introduction: What is Trademark?

A distinctive identity sign that a company associates with goods or services it provides or offers. Registrable trademarks include any distinctive word, letter, slogan, device, brand-name, heading, label, ticket, name, signature or numeral or any combination.

How are Trademarks Registered?

Registration is done by the Kenya Intellectual Property Institute (KIPI) while regional and international trademarks are registered at the African Regional Intellectual Property Organization (ARIPO) and the World Intellectual Property Organization (WIPO) respectively. Upon registration KIPI issues a Certificate of Registration. In Kenya trademarks are governed by the Trademarks Act, CAP 506 Laws of Kenya.

What is the period of protection?

A registered trademark is protected for a period of 10 years. Upon the lapse of 10 years the registrar will issue notices to the proprietor inviting the proprietor to renew the registration for a further 10 years.

Why should you register a Trademark?

Trademarks registration protects the company's brand and prevents other businesses from taking advantage of the company by using a similar name, sign or mark. Further it accords the company an exclusive right to prevent others from marketing identical or similar products under the same or a confusingly similar mark. Trademark protection equates a monopoly in the use of the trademark thereby generating goodwill and brand recognition.

How can a Proprietor enforce trademark rights?

Rights of the proprietor of a registered trademark maybe enforced in the following ways:

a) Opposition

Opposition proceedings are filed with the Registrar of trademarks and serve to prevent infringement of registered trademarks and the intellectual property rights of the registered proprietor. A proprietor of a registered trademark may oppose registration of a similar or confusing mark after the trademark has been advertised in the KIPI journal. The proprietor has to give notice to the Registrar of opposition to the registration within 60 days from the date of the advertisement in the Journal.

After the hearing the opposition the registrar shall issue a decision for registration of the trademark or may bar its registration.

Any party aggrieved by the decision of the registrar may appeal against the decision to the High Court within 60 days. The court will hear and determine the matter and issue an order for registration or deny registration.

b) Infringement proceedings

Infringement proceedings may be instituted at the High Court only in respect of registered trademarks. Remedies under these proceedings include:

- i. Restraining injunctions directing the infringing party to cease the infringing act.

- ii. An account of profits by the infringing party.
- iii. An order for delivery and destruction of the infringing goods.
- iv. Damages

c) Passing-off proceedings

Passing off of a trademark denotes the deliberate or unintentional misrepresentation of one's goods or services as those belonging to another party. Passing off often damages the goodwill of the registered trademark and its associated business thereby occasioning financial or reputational damage. Another form of passing off is extended passing off where misrepresentation of a particular quality of a good or service causes harm to a registered trademarks goodwill and reputation.

An aggrieved party whose trademark has been subjected to passing off may institute proceedings at the High Court. Remedies issued by the High Court are similar to those issued in cases of infringement as discussed above.

d) Cancellation of a registered licensee

A company may license a registered trademark; the company otherwise known as the licensor allows another party, called a licensee, to make and distribute specific products or services under the licensor's trademark as per a formal agreement between the licensor and licensee. The licensee pays consideration at a rate agreed upon. Therefore, the company reaps financial benefit from licensing the trademark to several licensees.

A registered licensee may be cancelled from the register by the registrar upon an application in writing by the registered proprietor of the trademark. Upon cancellation of the licensee from the register, the licensee has no right to deal with the registered trademark and any action will be an infringement of the trademark.

Conclusion

Registration of a trademark protects the proprietor's intellectual property rights in relation to the trademark. Additionally, the proprietor's rights are enforceable against third parties as discussed above. We advise that registration of a trademark is important to enable the proprietor reap the full benefit of the trademark.

Prepared By:

Lindah Nechesah, Advocate

Email: lnechesah@mumakanjama.com

Hezbon Ooko, Lawyer

Email: hooke@mumakanjama.com

Should you need further advice or an introductory meeting with us, contact us on:



Email: info@mumakanjama.com

Tel: +254-20-2216889/2211437

Charles Kanjama, SC; ckanjama@gmail.com;

Lindah Nechesah; lnechesah@mumakanjama.com

Or 020-2716548/9; +254 726604935

Or info@mumakanjama.com