

The Importance of Registering a Trademark and How To Protect Your Mark Part I

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Executive Summary

In this two part series our IP team discusses the do's and don'ts of trademarks in Kenya. In this first part the team discusses the importance of registering a trademark; how to defend a registered or unregistered trademark; matters to be aware of when using a registered mark with variations.

Why Register a Trademark?

In modern day business good branding is an essential requirement to secure the marketability of a business against competitors. Big brands like Bata, Coca Cola, and M-Pesa provide well known goods and services in the Kenyan market and are recognizable to the Kenyan consumer primarily through the branding of their goods / service. Brands therefore have intrinsic commercial value that requires legal protection like any other business asset which can be achieved through a trademark.

In Kenya trademarks are registered under the Kenya Trademarks Act at the Trademarks Registry (the “**Registry**”). Trademarks are registered for either goods or services under specific ‘classes’ listed in the International (Nice) Classification of Goods and Services. An application for registration of a mark must specify the particular class and particular goods or services for which the mark is to be used. If the mark is to be used on goods it is termed “a trademark”. If it is to be used in connection with provision of services it is termed “a service mark”.

The registration of a mark under the Kenya Trademarks Act is *prima facie* evidence of ownership of the mark and gives the registered owner an exclusive right to use that mark for goods or services for which it is registered.

The protection granted by registration of a trademark lasts for 10 years from the date on which the application for registration of the mark is filed at the Registry. Registration can be renewed for consecutive 10 year periods by filing renewal applications at the Registry and paying the relevant official renewal fees without having to prove use of the registered mark.

Defending Your Registered Mark

As stated above; registration of a mark is *prima facie* evidence of ownership. If a third party attempts or uses an identical or confusingly similar mark the owner of a registered mark can take infringement proceedings in the High Court of Kenya

In such a case the owner of a registered mark merely has to rely on the trademark registration certificate for the mark and prove that the defendant in the proceedings is using an identical or confusingly similar mark to his registered mark for similar goods or services and causing confusion or deception.

Defending Your Unregistered Mark

If the mark is not registered the owner of the unregistered mark can lodge a passing off case in the High Court of Kenya against a third party who copies and uses the offending mark. The right of an owner of an unregistered mark to take passing off action is recognised under section 5 of the Trademarks Act. In order to succeed in such a passing off case the owner of the unregistered mark must prove that:

- he has used his mark in Kenya on similar goods or services for a sufficiently long period to have established goodwill or a reputation in his mark;
- this goodwill / reputation needs to be amongst a wide section of the Kenya public over a fairly wide spread area of Kenya;
- the use of the mark needs to be prior to the third party starting to sell similar goods or services under the offending mark;
- his trademark has acquired sufficient reputation through such use for members

of the public to be misled by a defendant's conduct into thinking that the defendant's goods or services originate from the owner of the unregistered mark.

The need for production of evidence of such use of an unregistered mark involves the proprietor of the unregistered mark undertaking the laborious process of compiling evidence of sales and use of his mark. He will also need to produce confidential information on volumes and value of sales of the goods or services on which he has used his mark which he may not wish competitors to know.

Next Series

In our next publication we will look at the consequences of not using your registered trademark; using a variation of your registered mark; possible options to permit others to use your mark either through licensing or sale; and guarding against dilution of your mark.

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