

Mere Global Reputation Is Not Enough: High Court Emphasizes the Need for Local Recognition in Establishing Well-Known Marks in Kenya

Introduction

The Kaplan & Stratton team, led by Esther Kinyenje-Opiyo, Partner, successfully acted for the Respondent in *Livescore Limited v Oleksandr Vetluhin* (Judgment delivered on 22 April 2025), the High Court upheld the decision of the Registrar of Trade Marks, affirming that global recognition alone does not suffice to establish a mark as “well-known” under Kenyan law. The Court emphasized the necessity of demonstrating substantial reputation and market presence within Kenya to meet the threshold for well-known status under Section 15A of the Trade Marks Act.

Summary of facts

The appeal arose from a decision of the Registrar of Trade Marks in expungement proceedings relating to Trade Mark No. 104905 “LIVESCORE” in Class 35. The Appellant, challenged the registration of the mark by the Respondent, alleging that the Registrar had erred in several respects. Specifically, the Appellant argued that the Registrar failed to sufficiently consider the evidence and also failed to find that the “LIVESCORE” mark was confusingly similar to the Appellant’s internationally known mark. In response, the Respondent defended the registration, maintaining that the mark was lawfully acquired and that the Appellant had not demonstrated the mark’s well-known status in Kenya as required under the Trade Marks Act.

Decision

The main issue before the Court was whether the mark “LIVESCORE” qualified as a *well-known mark* in Kenya under Section 15A of the Trade Marks Act. The Appellants argued that the Respondent’s registration should be expunged on the basis that “LIVESCORE” is globally recognized and therefore entitled to protection as a well-known mark. However, the Court emphasized that international recognition alone is insufficient.

The Court relied on the case of *Sony Corporation v Sony Holding Limited [2018]*, where it made it clear that global recognition of a mark does not automatically translate to well-known status in the Kenyan context. The Appellants were required to produce concrete, independent evidence of the mark’s reputation in Kenya such as market surveys, consumer recognition, or substantial business presence which they failed to do. As a result, the Court found that the Appellants could not rely on international recognition alone to expunge the Respondent’s registration. Consequently, the Court held that “LIVESCORE” did not qualify as a well-known mark in the Kenyan context and could not benefit from the special protection accorded under Section 15A. The registration by the Respondent therefore remained valid, and the appeal was dismissed.

Conclusion

This decision serves as a critical precedent for the interpretation of what constitutes a well-known trade mark in Kenya. The High Court has made it clear that mere global fame or international presence is not conclusive. Instead, proprietors must provide evidence of recognition that show market activity in Kenya, and consumer association with the mark. The court herein clarified that mere assertions and secondary data do not confirm market penetration or consumer recognition within Kenya hence are not sufficient to prove that a mark is well known. The judgment underscores the need for a localized approach to the enforcement and protection of well-known trade marks in Kenya.

If you have any questions arising from this article, you can contact our intellectual property law team.



Esther Kinyenje – Opiyo, Partner

EWK@kapstrat.com



Georgette Thuku, Associate

GThuku@kapstrat.com