
USE YOUR TRADE MARK OR LOSE IT

Introduction

In our 2nd series article published in May 2025, we outlined the key defenses against cancellation proceedings for non-use, namely proof of actual use, *bonafide* intention to use upon registration and special circumstances excusing non-use.

In this final part of our ‘**use your trade mark or lose it**’ series, we focus on what practical steps trademark owners can employ in-house to safeguard their brand rights and avoid loss through non-use.

We now summarize below these key useful practical steps as follows:

1. Actual and genuine use in commerce

To avoid cancellation of a trade mark for non-use, it is recommended that the owner puts the brand into genuine commercial use by offering the products or services associated with the brand to the public, in the course of trade.

2. Use with additions and/or alterations

Under the law, a trade mark is still considered in use even if it is used with minor additions or alterations from the trademark as originally registered, as long as these changes do not substantially affect the identity of the originally registered trademark.

Whilst slight variations are acceptable, owners are encouraged to use the mark as **registered** to minimize the risk of cancellation for non-use based on the argument that the alterations or additions made to the trademark as originally registered substantially alters the identity of the trademark as originally registered.

3. Registering altered mark as new trademark

Where trade mark owner rebrand or make substantial changes to their registered brands, the altered version will not count as use of the original registration.

To avoid the risk of cancellation for non-use, we strongly recommend that such trademark owners apply to register the substantially amended new form of the original registered brand for the goods or services of interest.

4. Licensing (registered user)

Licensing of a registered brand is, under the law, deemed to be used by the proprietor provided the license is registered at the trademark’s registry. Brand owners may not, for various reasons, be able to produce the goods or offer services sold under their registered brand(s).

In such cases, we recommend that they enter into a non-exclusive licensing arrangement for a specific

duration of time with a third party for the manufacture of the goods or the offering the services of the brand in order to protect the brand from cancellation for non-use.

5. Trademark portfolio management

Trademark owners are required to renew their registrations every 10 years. Further, during the trading life of a registered brand, third parties may imitate, adopt or use brands that may visually and/or phonetically deceptively be similar to that of a registered brand of an owner (or even apply for and register them).

In view of these mentioned potential risks, we recommend that the brand owners set up an internally managed portfolio management system or outsource this service in order to monitor their renewal dates and the market for any new conflicting or infringing brands for prompt necessary action.

Conclusion

It is clear, from the foregoing, that registration of a brand alone does not guarantee indefinite protection. Actual and genuine use of the brand remains a key requirement.

Accordingly, the business sector should adopt a rule of the thumb of; **register the brand, use the brand, monitor the brand renewal and potential infringers.**

A trade mark that is not actively protected or used may be lost not because it lacks value, but simply due to inaction.

Our trademark team is well-equipped to assist you with post-registration trade mark management and provide strategic advice on how to avoid or respond to cancellation proceedings based on non-use.

If you have any questions arising from our published above topical series, you can contact our intellectual property law team lead partner Patrick Ikimire at Pikimire@Kapstrat.com and associate Georgette Thuku at gthuku@kapstrat.com.



Patrick Ikimire, Partner

Pikimire@kapstrat.com



Georgette Thuku, Associate

Gthuku@kapstrat.com