

HIGH COURT DEALS WITH THE QUESTION OF TIME BARRED CLAIMS IN RESPECT OF TRADEMARK EXPUNGEMENT PROCEEDINGS

The Kaplan & Stratton team, led by **Esther Kinyenje-Opiyo**, Partner, successfully acted for the Plaintiffs in **Thermos Hong Kong Limited & another v Doshi Ironmongers Limited [2025] KEHC 15418 (KLR)**.

Background

The Defendants filed a counter-claim seeking the expungement of Thermos Hong Kong's trademarks in respect of the well-known and internationally recognized "THERMOS" trademark on the ground that there was no valid assignment. Thermos Hong Kong contended that its well-known marks were registered in Kenya in 1920 and 1975, and the assignments recorded in its favour in 2011.

The Court's Findings

The High Court held that **Section 16 (1)** of the Trademarks Act establishes clear time limits for challenging the registration or assignment of a trademark. Under the Act, a trademark registration becomes conclusive as to its validity after seven years, unless it was obtained by fraud or contravenes **Section 14** on deceptiveness.

The Court ruled in favour of the Plaintiffs by finding that no fraud had been proven by the Defendant and therefore the exception to the limitation period under **Section 16 (1)** did not apply. It emphasized that statutory time limits are not mere procedural formalities, but serve to promote certainty, stability, and finality in transactions involving proprietary rights recorded in the Trade marks Register.

It further ruled that allowing previously settled registrations particularly those uncontested for over a decade to be reopened without lawful cause would undermine predictability, create insecurity around registered rights, discourage investment in branding, and weaken the integrity of the Register as a definitive record of intellectual property rights.

Key Takeaway

This judgment strengthens confidence in the Trade marks Register as a definitive and reliable record of proprietary rights, assuring trademark owners that their registrations become legally secure after the statutory period of seven years.

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



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