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Service beyond the call of duty

NEWS ALERT

CHALLENGES IN ENFORCEMENT OF TRADEMARK RIGHTS IN KENYA.

1. Introduction

A Trade Mark is a sign which serves to distinguish the goods or products of an industrial, commercial or organizational enterprise or a group of such enterprises from others in the same market. The sign may consist of one or more distinctive works, letters, numbers, drawings or pictures, monograms, signatures, colors or combination of colors.

The following marks can be registered in Kenya:

- a. Trademark for goods;
- b. Trademark for services;
- c. Collective trademarks;
- d. Certification trademarks;
- e. Defensive registrations;
- f. Parts of marks; and
- g. Series of marks

The advantages of the registration of a trade mark is that the registered owner gets the exclusive right to use the registered mark, distinguish between competing goods and services in the market and is entitled to institute proceedings and recover damages for infringement.

Kenya applies the Nice Classification (11th edition – 2017), and a trademark proprietor may apply to register a mark in more than one class through a single application. The registration process involves examination, advertisement and possible opposition by members of the public before issuance of the certificate of registration. Where a notice of opposition is filed against an application, the registration process will stop and opposition proceedings will commence in which the applicant bears the burden of proving that the opposition lacks merit or is not justified. Trademark registrations are valid for 10 years and may be renewed for further consecutive periods of 10 years each.

2. Legal Framework for Enforcement of Trademarks

National Framework	<ul style="list-style-type: none"> * The Constitution of Kenya, 2010 * The Trademarks Act (CAP 506) * Anti-Counterfeit Act (No. 13 of 2008) * Penal Code (CAP 63) * Trade Description Act (CAP 505) * Standards Act (CAP 496) * Competition Act (CAP 504) * Consumer Protection Act (No.46 of 2012) * Pharmacy and Poisons Act (CAP 244) * Food Drugs and Chemical Substances Act (CAP 254) * National Flag, Emblems and Names Act (CAP 99) * Industrial Property Act (No.3 of 2001)
International Framework	<ul style="list-style-type: none"> * Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) * Lusaka Agreement * East Africa Community Customs Management Act 2004 (EACCMA)

3. Institutional Framework for Enforcement of Trademarks

National Framework	<ul style="list-style-type: none"> * Kenya Industrial Property Institute * The Industrial Property Tribunal * Public Health Standards Board * Pharmacy and Poisons Board * National Police Service * Kenya Bureau of Standards (KEBS) * Anti-Counterfeits Agency * Kenya Revenue Authority
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	<ul style="list-style-type: none"> * Competition Authority * Judiciary
International Framework	<ul style="list-style-type: none"> * World Intellectual Property Organization * World Trade Organization * Africa Regional Intellectual Property Organization

4. Challenges in Enforcement of Trademarks

- a. The provisions governing Trade Marks are fragmented in different statutes.
- b. There are insufficient criminal sanctions. The penalties (both pecuniary and custodial sentence) for infringement of trademark rights are too lenient and do not act as a deterrent.
- c. There is no single institution primarily tasked with the role of enforcing trademarks. They each handle different aspects or types of infringements. This can lead to laxity, turf-wars and confusion as to which body to approach to enforce the trademarks rights.
- d. Lack of sufficient knowledge, expertise and capacity of trademark laws, rules and international best practices, by the enforcement institutions and the judiciary.
- e. Corruption is rampant. For example, counterfeit goods are allowed to pass through our borders illegally under the watch of the police and customs officials.
- f. There is limited funding and personnel at the enforcement agencies.

5. Recommendations

- I. The Kenyan legal framework should be amended to include types of infringement of the trademarks, to expand the statutory law on trademark infringement and to enhance trademark offences.
- II. The institutions tasked with trademark enforcement should be amalgamated to create a multi-sectorial agency to enforce the trademark rights.

- III. Different initiatives should be created for capacity building of enforcement institutions, through training and secondment of these officials in countries and international organizations that have exemplary trademark enforcement practices.
- IV. The judiciary should train and appoint specialized judicial officers who are knowledgeable and have expertise and diverse knowledge on trademarks in order for jurisprudence to be expanded in this area.

The Intellectual Property team is always available to provide more insight to the provisions of this Act. Should you have any queries or need clarifications on the contents of this alert, please contact Ms. Gakii Kaburu the Associate or Mr. Silas Gitari, the Managing Partner.



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