



LAWS OF KENYA

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# THE TRADE MARKS ACT

CHAPTER 506

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**CHAPTER 506**

## THE TRADE MARKS ACT

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## CHAPTER 506

### THE TRADE MARKS ACT

*Commencement: 1<sup>st</sup> January, 1957*

#### **An Act of Parliament relating to the registration of trade marks**

#### PART I - PRELIMINARY

Short title.

**1.** This Act may be cited as the Trade Marks Act.

Interpretation.

**2.** (1) In this Act, except where the context otherwise requires -

7 of 1990,  
 5 of 1994,  
 4 of 2002,  
 7 of 2007.

“a convention country” means a country, other than Kenya, that is party to the Paris Convention;

“appointed day” means the 1st January, 1957;

“ARIPO” means the African Regional Industrial Property Organization;

“assignment” means assignment by act of the parties concerned;

“court” means the High Court;

No. 3 of 2001.

“Director” means the Managing Director of the Kenya Industrial Property Institute appointed under section 11 (1) of the Industrial Property Act, 2001;

“distinguishing guise”, in relation to goods, means the shape or configuration of containers of the goods;

No. 3 of 2001.

“Institute” means the Kenya Industrial Property Institute established by section 3 of the Industrial Property Act, 2001;

“International Classification of Goods and Services” as regards Registration of Marks, means the classification, in accordance with the Nice Agreement of the 15th June, 1957, as revised and amended from time to time, establishing an international classification of goods and services;

“International Classification of the Figurative Elements of Marks” means the classification established by the Vienna Agreement establishing an international classification of the Figurative Elements of Marks, of the 12th June 1973, as revised and amended from time to time;

“Journal” means the Industrial Property Journal published by the Institute;

“licensee” means a person who is for the time being registered as such under section 31;

“limitations” means any limitations of the exclusive right to the use of a trade mark given by the registration of a person as proprietor thereof, including limitations of that right as to mode of use, as to use in relation to goods to be sold, or otherwise traded in, in any place within Kenya, or as to use in relation to goods to be exported to any market outside Kenya;

“mark” includes a distinguishing guise, slogan, device, brand, heading, label, ticket, name, signature, word, letter or numeral or any combination thereof whether rendered in two-dimensional or three-dimensional form;

“permitted use” has the meaning assigned to it by subsection (1) of section 31;

“prescribed” means, in relation to proceedings before the court, prescribed by rules of court, and, in other cases, prescribed by this Act or the rules;

“profession” means a calling or occupation, not being a trade or handicraft, carried on by an individual person being a member of a lawfully established body of persons each of whom is qualified and licensed by that body as having acquired and holding the specialized knowledge necessary to enable that person to practice in the particular department of learning or science with which such body is concerned;

“register” means the register of trade marks kept under this Act;

“registered trade mark” means a trade mark that is actually on the register;

“Registrar” means the Registrar of Trade Marks appointed under

section 3;

“services” are services within the meaning of this Act where they are normally provided for remuneration, in so far as they are not governed by the provisions of any written law relating to freedom of movement for goods, capital and persons and in particular include activities of an industrial or commercial character or of craftsmen and of the professions;

“surname” includes a name by which a person is customarily known by members of the community to which he belongs;

“the Paris Convention” means the Paris Convention for the Protection of Industrial Property, of the 20th March 1883, as last revised;

“the rules” means rules made by the Minister under section 39 or section 41;

“the WTO Agreement” means the agreement establishing the World Trade Organization, signed at Marrakesh, Morocco, on the 15th April 1994;

“trade” means any type of profession or other business occupation in which a mark may be used in the manner prescribed by this Act;

“trade mark” means (except in relation to a certification trade mark) a mark used or proposed to be used -

- (a) in relation to goods for the purpose of indicating a connection in the course of trade between the goods and some person having the right either as proprietor or as licensee to use the mark, whether with or without any indication of the identity of that person or distinguishing goods in relation to which the mark is used or proposed to be used from the same kind of goods connected in the course of trade with any person;
- (b) in relation to services for the purpose of indicating that a particular person is connected, in the course of business, with the provision of those services, whether with or without any indication of the identity of that person or distinguishing services in relation to which the mark is used or proposed to be used from the same kind of services connected in the course of business with any other person;

“transmission” means transmission by operation of law, devolution

on the personal representative of a deceased person and any other mode of transfer not being assignment;

“tribunal” means the court or, subject to the provisions of section 53, the Registrar;

(2) Any reference in this Act to the use of a mark shall be construed-

(a) as a reference to the use of a printed or other visual representation of the mark and, in the case of a distinguishing guise, to the use of such distinguishing guise;

(b) if the mark is capable of being audibly reproduced, as including a reference to the use of an audible reproduction of the mark;

(c) in relation to goods, as a reference to the use thereof upon or in physical or other relation to goods; and

(d) in relation to services, as a reference to the use thereof in relation to the performance of such services.

**3.** (1) The Director shall be the Registrar of Trade Marks under and for the purposes of this Act.

Appointment of Registrar and other officers.  
13 of 1978, Sch.,  
7 of 1990,  
7 of 2007,  
No. 3 of 2001.

(2) The appointment of the officers required for the purposes of this Act shall be made in accordance with the provisions of the Industrial Property Act, 2001.

(3) The Registrar shall have a seal of such device as may be approved by the Minister.

(4) Impressions of such seal or stamp shall be judicially noticed and admitted in evidence.

(5) Any act or thing directed to be done by or to the Registrar may be done by or to the Deputy Registrar of Trade Marks or any Assistant Registrar of Trade Marks.

(6) The Minister may, on the recommendation of the Board, whenever he deems it necessary or appropriate, appoint an advocate of the High Court of Kenya with at least seven years' working experience in matters relating to intellectual property, to assist the Registrar in the performance of any of the functions or the exercise of any of the powers conferred upon the Registrar under this Act with respect to the conduct of hearings relating to opposition to applications for registration or

rectification of the register.

PART II - REGISTRATION, INFRINGEMENT AND OTHER  
SUBSTANTIVE PROVISIONS

*The Register*

The register of trade  
marks.  
7 of 2007.

4. (1) There shall continue to be kept at the office of the Registrar of Trade Marks for the purposes of this Act the record called the register of trade marks, wherein shall be entered all registered trade marks with the names, addresses and descriptions of their proprietors, notifications of assignments and transmissions, the names, addresses and descriptions of all licensees, disclaimers, conditions, limitations, and such other matters relating to registered trade marks as may be prescribed.

(2) The register shall continue to be divided into two parts called respectively Part A and Part B.

(3) The register shall be kept under the control and management of the Registrar and shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed.

*Effect of Registration and the Action for Infringement*

No action for  
infringement of  
unregistered trade  
mark.  
5 of 1994.

5. No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark, but nothing in this Act shall be deemed to affect rights of action against any person for passing off or the remedies in respect thereof.

Registration to be in  
respect of particular  
goods or services.  
5 of 1994,  
4 of 2002.

6. (1) A trade mark shall be registered in respect of particular goods or services, which shall be classified in the manner specified in subsection (2).

(2) The goods and services in respect of which registration of a mark is applied for shall be classified in accordance with the International Classification of Goods and Services and any figurative elements of the mark shall be classified in accordance with the International Classification of the Figurative Elements of Marks:

Provided that where goods or services belonging to several classes according to the International Classification of Goods and Services have been included in the same application, the Registrar shall incorporate the several classes of goods and services for the purpose of registration.

Right given by  
registration in Part

7. (1) Subject to the provisions of this section, and of sections 10 and 11, the registration (whether before or after 1<sup>st</sup> January, 1957)

of a person in Part A of the register as the proprietor of a trade mark if valid gives to that person the exclusive right to the use of the trade mark in relation to the goods or in connection with the provision of any services and without prejudice to the generality of the foregoing that right is infringed by any person who, not being the proprietor of the trade mark or a registered user thereof using by way of permitted use, uses a mark identical with or so nearly resembling it as to be likely to deceive or cause confusion in the course of trade or in connection with the provision of any services in respect of which it is registered, and in such manner as to render the use of the mark likely to-

A and infringement thereof.  
5 of 1994,  
4 of 2002,  
7 of 2007.

- (a) be taken either as being used as a trade mark;
- (b) be taken in a case in which the use is upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as licensee to use the trade mark or goods with which such a person is connected in the course of trade;
- (c) be taken in a case where the use is use at or near the place where the services are available for acceptance or performed or in an advertising circular or other advertisement issued to the public or any part thereof, as importing a reference to some person having the right either as proprietor or as licensee to use the trade mark or to services with the provision of which such a person as aforesaid is connected in the course of business;
- (d) cause injury or prejudice to the proprietor or licensee of the trade mark.

(2) The right to the use of a trade mark given by registration shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark in any mode, in relation to goods to be sold or otherwise traded in any place, in relation to goods to be exported to any market or services for use or available for acceptance in any place or country, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.

(3) The right to the use of a trade mark given by registration shall not be deemed to be infringed by the use of any such mark by any person -

- (a) in relation to goods connected in the course of trade with the proprietor or a licensee of the trade mark if, as to those

goods or a bulk of which they form part, the proprietor or the licensee conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark; or

- (b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact a connexion in the course of trade between any person and the goods;
- (c) in relation to services to which the proprietor of the trade mark or a licensee conforming to the permitted use has applied the trade mark, where the purpose and effect of the use of the trade mark is to indicate, in accordance with the fact, that those services have been performed by the proprietor or a licensee of the trade mark; or
- (d) in relation to services the provision of which is connected in the course of business with the proprietor or a licensee of the trade mark, where the proprietor or licensee has at any time expressly or impliedly consented to the use of the trade mark; or
- (e) in relation to services available for use with other services in relation to which the trade mark has been used without infringement of the right given by registration or might for the time being be so used, if-
  - (i) the use of the trade mark is reasonably necessary in order to indicate that the services are available for such use; and
  - (ii) neither the purpose nor the effect of the use of the trade mark is to indicate otherwise than in accordance with the fact that there is a connection in the course of business between any person and the provision of those services.

(4) The use of a registered trade mark, being one of two or more registered trade marks that are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration as aforesaid, shall not be deemed to be an infringement of the right so

given to the use of any other of those trade marks.

8. (1) Except as provided by subsection (2), the registration (whether before or after the commencement of this Act) of a person in Part B the register as proprietor of a trade mark if valid gives to that person the same right and the provisions of section 7 shall have effect in the same manner in relation to a trade mark registered in Part B of the register as they have effect in relation to a trade mark registered in Part A of the register.

Right given by registration in Part B and infringement thereof. 5 of 1994, 7 of 2007.

(2) In any action for infringement of the right to the use of a trade mark given by registration in Part B of the register, otherwise than by an act that is deemed to be an infringement by virtue of section 9, no injunction or other relief shall be granted to the plaintiff if the defendant establishes to the satisfaction of the court that the use of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connexion in the course of trade between the goods and some person having the right either as proprietor or as licensee to use the trade mark or in respect of services that a person having the right either as proprietor or as licensee to use the trade mark is connected in the course of business with the provision of the services.

9. (1) Where, by a contract in writing made with the proprietor or a licensee of a registered trade mark, a purchaser or owner of goods or a person performing the services, enters into an obligation to the effect that he will not do, in relation to the goods or services, an act to which this section applies, any person who, being the owner for the time being of the goods or the person performing the services and having notice of the obligation, does that act, or authorizes it to be done, in relation to the goods or services, in the course of trade, or with a view to any dealing therewith in the course of trade thereby infringes the right to the use of the trade mark given by the registration thereof, unless that person becomes the owner of the goods by purchase for money or money's worth or performs the services in good faith before receiving notice of the obligation or by virtue of a title claimed through another person who so became the owner thereof.

Infringement by breach of certain restrictions. 5 of 1994, 7 of 2007.

(2) The acts to which this section applies are-

- (a) the application of the trade mark upon the goods after they have suffered alteration in any manner specified in the contract as respects their state or condition, get-up or packing;
- (b) in a case in which the trade mark is upon the goods, the alteration, part removal or part obliteration thereof;

- (c) in a case in which the trade mark is upon the goods, and there is also thereon other matter, being matter indicating a connexion in the course of trade between the proprietor or registered user and the goods, the removal or obliteration, whether wholly or partly, of the trade mark unless that other matter is wholly removed or obliterated;
- (d) in a case in which the trade mark is upon the goods, the application of any other trade mark to the goods;
- (e) in a case in which the trade mark is upon the goods, the addition to the goods of any other matter in writing that is likely to injure the reputation of the trade mark.

(3) In this section, references in relation to any goods to the proprietor, to a registered user, and to the registration, of a trade mark shall be construed, respectively, as references to the proprietor in whose name the trade mark is registered, to a registered user who is registered, and to the registration of the trade mark, in respect of those goods, and “upon” includes in relation to any goods a reference to physical relation thereto.

**10.** Nothing in this Act shall entitle the proprietor or a licensee of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date anterior -

- (a) to the use of the first-mentioned trade mark in relation to those goods by the proprietor or a predecessor in title of his; or
- (b) to the registration of the first-mentioned trade mark in respect of those goods in the name of the proprietor or a predecessor in title of his,

whichever is the earlier, or to object (on such use being proved) to that person being put on the register for that identical or nearly resembling trade mark in respect of those goods under subsection (2) of section 15.

**11.** No registration of a trade mark shall interfere with -

- (a) any bona fide use by a person of his own name or of the name of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business; or

Saving for vested rights.  
7 of 2007.

Saving for use of name, address or description of goods.

- (b) the use by any person of any bona fide description of the character or quality of his goods, not being a description that would be likely to be taken as importing any such reference as is mentioned in paragraph (b) of subsection (1) of section 7, or in paragraph (b) of subsection (3) of section 40.

*Registrability and Validity of Registration*

**12.** (1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars -

Distinctiveness  
requisite for  
registration in Part A.  
11 of 1965, s. 2,  
5 of 1994.

- (a) the name of a company, individual or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- (e) any other distinctive mark, but a name, signature or word or words, other than such as fall within the descriptions in paragraphs (a), (b), (c) and (d), shall not be registrable under this paragraph except upon evidence of its distinctiveness.

(2) For the purposes of this section, “distinctive” means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connexion subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration and in relation to services means to distinguish services with the provision of which the proprietor is or may be connected in the course of business, from services the provision of which he is not so connected.

(3) In determining whether a trade mark is adapted to distinguish, the court or the Registrar may have regard to the extent to which -

- (a) the trade mark is inherently adapted to distinguish; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish.

Capability of distinguishing requisite for registration in Part B. 11 of 1965, s. 3, 5 of 994.

**13.** (1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connexion subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration and in relation to services of distinguishing services with the provisions of which the proprietor of the trade mark is or may be connected in the course of business from services with the provision of which he is not so connected.

(2) In determining whether a trade mark is capable of distinguishing, the court or the Registrar may have regard to the extent to which-

(a) the trade mark is inherently capable of distinguishing; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing.

(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

Prohibition of registration of deceptive, etc., matter. 11 of 1965, s. 4.

**14.** No person shall register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

Prohibition of registration of identical and resembling trade marks. 5 of 1994.

**15.** (1) Subject to the provisions of subsection (2), no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or in respect of services, is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of the same services or description of services.

(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the court or the Registrar make it proper so to do, the court or the Registrar may permit the registration of trade marks that are identical or nearly resemble each other in respect

of the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as the court or the Registrar may think it right to impose.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks that are identical or nearly resemble each other, in respect of the same goods or description of goods or in respect of the same services or description of services, the Registrar may refuse to register any of them until their rights have been determined by the court, or have been settled by agreement in a manner approved by him or on an appeal by the court, as the case may be.

**15A.** (1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO Agreement as a well known trade mark, are to a mark which is well known in Kenya as being the mark of a person who-

Protection of well known trade marks. 4 of 2002.

- (a) is a national of a convention country; or
- (b) is domiciled in, or has a real and effective industrial or commercial establishment in, a convention country, whether or not that person carries on business or has any good will in Kenya.

(2) Subject to the provisions of section 38B, the proprietor of a trade mark which is entitled to protection under the Paris Convention or the WTO Agreement as a well known trade mark, is entitled to restrain by injunction, the use in Kenya of a trade mark which is identical or the essential part of which is identical or similar to his, in relation to identical or similar goods or services, where the use is likely to cause confusion among the users of the goods or services.

(3) Nothing in subsection (2) shall affect the continuation of any *bona fide* use of a trade mark begun before the commencement of this section.

(4) A trade mark shall not be registered if that trade mark, or an essential part thereof, is likely to impair, interfere with or take unfair advantage of the distinctive character of the well-known trade mark.

**16.** (1) In all legal proceedings relating to a trade mark registered in Part A of the register (including applications under section 35) the original registration in Part A of the register of the trade mark shall, after the expiration of seven years from the date of that registration, be taken to be valid in all respects, unless-

Registration in Part A to be conclusive as to validity after seven years.

- (a) that registration was obtained by fraud; or

(b) the trade mark offends against section 14.

(2) Nothing in subsection (1) of section 8 shall be construed as making applicable to a trade mark, being a trade mark registered in Part B of the register, the foregoing provisions of this section relating to a trade mark registered in Part A of the register.

Registration subject  
to disclaimer.  
5 of 1994, s. 11.

**17.** If a trade mark -

- (a) contains any part not separately registered by the proprietor as a trade mark; or
- (b) contains matter common to the trade or to the provision of services of that description or otherwise of a non-distinctive character,

the Registrar or the court, in deciding whether the trade mark shall be entered or shall remain on the register, may require, as a condition of its being on the register

- (i) that the proprietor shall disclaim any right to the exclusive use of any part of the trade mark, or to the exclusive use of all or any portion of any such matter, to the exclusive use of which the tribunal holds him not to be entitled; or
- (ii) that the proprietor shall make such other disclaimer as the tribunal may consider necessary for the purpose of defining his rights under the registration:

Provided that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

Words used as name  
or description of an  
article or substance.  
5 of 1994, s.12,  
7 of 2007.

**18.** (1) The registration of a trade mark shall not be deemed to have become invalid by reason only of any use, after the date of the registration, of a word or words which the trade mark contains, or of which it consists, as the name or description of an article or substance or of some activity:

Provided that, if it is proved either -

- (i) that there is a well-known and established use of the word or words as the name or description of the article or substance by a person or persons carrying on a trade therein, not being use in relation to goods connected in the course of trade with the proprietor or a licensee of the

trade mark or (in the case of a certification trade mark) goods certified by the proprietor; or

- (ii) that the article or substance was formerly manufactured under a patent, that a period of two years or more after the cesser of the patent has elapsed and that the word or words is or are the only practicable name or description of the article or substance;
- (iii) that there is a well-known and established use of the word or words as the name or description of some activity by a person providing services which include that activity, not being used in relation to services with the provision of which the proprietor or a licensee of the trade mark is connected in the course of business;

the provisions of subsection (2) shall have effect.

(2) Where the facts mentioned in the proviso to subsection (1) are proved with respect to any word or words, then -

- (a) if the trade mark consists solely of that word or those words, the registration of the trade mark, so far as regards registration in respect of the article or substance in question or of any goods of the same description or of the activity in question, shall be deemed for the purposes of section 35 to be an entry wrongly remaining on the register;
- (b) if the trade mark contains that word or those words and other matter, the court or the Registrar, in deciding whether the trade mark shall remain on the register, so far as regards registration in respect of the article or substance in question and of any goods of the same description or of the activity in question, may in case of a decision in favour of its remaining on the register require as a condition thereof that the proprietor shall disclaim any right to the exclusive use in relation to that article or substance and any goods of the same description or of the activity in question, of that word or those words, so, however, that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made; and
- (c) for the purposes of any other legal proceedings relating to the trade mark -
  - (i) if the trade mark consists solely of that word or those

words, all rights of the proprietor, whether under the common law or by registration, to the exclusive use of the trade mark in relation to the article or substance in question or to any goods of the same description or of the activity in question; or

- (ii) if the trade mark contains that word or those words and other matter, all such rights of the proprietor to the exclusive use of that word or those words in such relation as aforesaid,

shall be deemed to have ceased on the date at which the use mentioned in paragraph (i) of the proviso to subsection (1) first became well known and established, or at the expiration of the period of two years mentioned in paragraph (ii) of that proviso.

(3) No word which is the commonly used and accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark in respect of a chemical substance or preparation, and any such registration in force at the commencement of this Act or thereafter shall, notwithstanding anything in section 16, be deemed for the purposes of section 35 to be an entry made in the register without sufficient cause, or an entry wrongly remaining on the register, as the circumstances may require:

Provided that this subsection shall not have effect in relation to a word which is used to denote only a brand or make of the element or compound as made by the proprietor or a licensee of the trade mark, as distinguished from the element or compound as made by others, and in association with a suitable name or description open to the public use.

Effect of limitation as to colour, and of absence thereof.

**19.** (1) A trade mark may be limited in whole or in part to one or more specified colours, and in any such case the fact that it is so limited shall be taken into consideration by the court or the Registrar having to decide on the distinctive character of the trade mark.

(2) If and so far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.

### PART III - PROCEDURE FOR AND DURATION OF REGISTRATION

Application for registration.

**20.** (1) A person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it shall apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the register.

(2) Subject to the provisions of this Act, the Registrar may refuse the application, or may accept it absolutely or subject to such amendments, modifications, conditions or limitations if any, as he may think right.

(3) In the case of an application for registration of a trade mark (other than a certification trade mark) in Part A of the register, the Registrar may, if the applicant is willing, instead of refusing the application, treat it as an application for registration in Part B and deal with the application accordingly.

(4) In the case of a refusal or conditional acceptance, the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving thereat, and the decision shall be subject to appeal to the court.

(5) An appeal under this section shall be made in the prescribed manner, and on the appeal the court shall, if required, hear the applicant and the Registrar, and shall make an order determining whether, and subject to what amendments, modifications, conditions or limitations, if any, the application is to be accepted.

(6) Appeals under this section shall be heard on the materials stated by the Registrar, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar, other than those so stated by him, except by leave of the court; and, where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of costs on giving notice as prescribed.

(7) The Registrar or the court, as the case may be, may at any time, whether before or after acceptance, correct any error in or in connexion with the application, or may permit the applicant to amend his application upon such terms as the Registrar or the court may think fit.

**21.** (1) When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall, as soon as may be after acceptance, cause the application as accepted to be advertised in the prescribed manner, and the advertisement shall set forth all conditions and limitations subject to which the application has been accepted:

Opposition to registration.

Provided that the Registrar may cause an application to be advertised before acceptance if it is made under paragraph (e) of subsection (1) of section 12, or in any other case where it appears to him that it is expedient by reason of any exceptional circumstances so

to do, and where an application has been so advertised the Registrar may advertise it again when it has been accepted but shall not be bound so to do.

(2) Any person may, within the prescribed time from the date of the advertisement of an application, give notice to the Registrar of opposition to the registration.

(3) The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(4) The Registrar shall send a copy of the notice to the applicant, and within the prescribed time after receipt thereof the applicant shall send to the Registrar, in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and, if he does not do so, he shall be deemed to have abandoned his application.

(5) If the applicant sends a counter-statement, the Registrar shall furnish a copy thereof to the person giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions or limitations, if any, registration is to be permitted.

(6) The decision of the Registrar shall be subject to appeal to the court.

(7) An appeal under this section shall be made in the prescribed manner, and on the appeal the court shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions or limitations, if any, registration is to be permitted.

(8) On the hearing of an appeal under this section any party may, either in the manner prescribed or by special leave of the court, bring forward further material for the consideration of the court.

(9) On an appeal under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar, other than those so stated by the opponent, except by leave of the court; and, where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

(10) On an appeal under this section the court may, after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity thereof,

but in any such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

(11) If a person giving notice of opposition or an applicant sending a counter-statement after receipt of a copy of such a notice, or an appellant, neither resides nor carries on business in Kenya, the court or the Registrar may require him to give security for costs of the proceedings before the court or the Registrar relative to the opposition or to the appeal, as the case may be, and in default of such security being duly given may treat the opposition or application, or the appeal, as the case may be, as abandoned.

**22.** (1) When an application for registration of a trade mark in Part A or in Part B of the register has been accepted, and either - Registration.

- (a) the application has not been opposed and the time for notice of opposition has expired; or
- (b) the application has been opposed and the opposition has been decided in favour of the applicant,

the Registrar shall, unless the application has been accepted in error, register the trade mark in Part A or Part B, as the case may be, and the trade mark, when registered, shall be registered as of the date of the application for registration, and that date shall be deemed for the purposes of this Act to be the date of registration:

Provided that the provisions of this subsection, relating to the date as of which a trade mark shall be registered and to the date to be deemed to be the date of registration, shall, as respects a trade mark registered under this Act with the benefit of any enactment relating to international or inter-imperial arrangements, have effect subject to the provisions of that enactment.

(2) On the registration of a trade mark, the Registrar shall issue to the applicant a certificate in the prescribed form of the registration thereof under the hand and seal of the Registrar.

(3) Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.

**23.** (1) The registration of a trade mark shall be for a period of ten years, but may be renewed from time to time in accordance with Duration and renewal of registration.

5 of 1994,  
4 of 2002.

the provisions of this section.

(2) The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of the trade mark for a period of ten years from the date of expiration of the original registration or of the last renewal of registration, as the case may be, which date is in this section referred to as the expiration of the last registration:

Provided that all the trade marks that were registered or the registration of which was renewed before the commencement of this section, shall remain in force until the expiry of the period of registration or renewal and thereafter, the provisions of this section shall apply.

(3) At the prescribed time before the expiration of the last registration of a trade mark, the Registrar shall send notice in the prescribed manner to the registered proprietor of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with, the Registrar may remove the trade mark from the register, subject to such conditions, if any, as to its restoration to the register as may be prescribed.

(4) Where a trade mark has been removed from the register for non-payment of the fee for renewal, it shall, nevertheless, for the purpose of any application for the registration of a trade mark during one year next after the date of the removal, be deemed to be a trade mark that is already on the register:

Provided that this subsection shall not have effect where the court or the Registrar is satisfied either-

- (i) that there has been no bona fide trade use or business use of the trade mark that has been removed during the two years immediately preceding its removal; or
- (ii) that no deception or confusion would be likely to arise from the use of the trade mark that is the subject of the application for registration by reason of any previous use of the trade mark that has been removed.

(5) The Registrar shall cause an application for registration of a trade mark to be published in the Journal or in the Kenya Gazette, in such manner as may be prescribed in the rules made under this Act.

to the exclusive use of any part thereof separately, he may apply to register the whole and any such part as separate trade marks. of trade mark and of trade marks as a series.

(2) Each such separate trade mark must satisfy all the conditions of an independent trade mark and shall, subject to the provisions of subsection (3) of section 26 and subsection (2) of section 33, have all the incidents of an independent trade mark.

(3) Where a person claiming to be the proprietor of several trade marks, in respect of the same goods or description of goods, which, while resembling each other in the material particulars thereof, yet differ in respect of -

- (a) statements of the goods in relation to which they are respectively used or proposed to be used; or
- (b) statements of number, price, quality or names of places; or
- (c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or
- (d) colour,

seeks to register those trade marks, they may be registered as a series in one registration.

#### PART IV-ASSIGNMENT AND TRANSMISSION

**25.** (1) A registered trade mark is assignable and transmissible either in connection with the goodwill of a business or not. Powers of, and restrictions on, assignment and transmission. 5 of 1994, s. 14.

(2) A registered trade mark is assignable and transmissible in respect of either all the goods or all the services in respect of which it is registered or of some only of those goods or services.

(3) The provisions of subsections (1) and (2) shall have the effect of an unregistered trade mark as they have effect in the case of a registered trade mark if at the time of the assignment or transmission of the unregistered trade mark it is or was used in the same business as a registered trade mark, and if it is or was assigned or transmitted at the same time and to the same person as that registered trade mark was assigned or transmitted.

(4) Notwithstanding anything in subsections (1), (2) and (3), a trade mark shall not be, or be deemed to have been, assignable or transmissible in a case in which as a result of an assignment or transmission there

would in the circumstances subsist, or have subsisted, whether under the common law or by registration, exclusive rights in more than one of the persons concerned to the use, in relation to the same goods or description of goods or services to be performed, of trade marks nearly resembling each other or of identical trade marks, if, having regard to the similarity of the goods or services to be performed and of the trade marks, the use of the trade marks in exercise of those rights would be, or have been, likely to deceive or cause confusion:

Provided that, where a trade mark is or has been assigned or transmitted in such a case, the assignment or transmission shall not be deemed to be, or to have been, invalid under this subsection if the exclusive rights subsisting as a result thereof in the persons concerned respectively are, or were, having regard to limitations imposed thereon, such as not to be exercisable by two or more of those persons in relation to goods to be sold, or otherwise traded in or services to be performed within Kenya (otherwise than for export therefrom) or in relation to goods to be exported to the same market outside Kenya.

(5) The proprietor of a registered trade mark who proposes to assign it in respect of any goods or services in respect of which it is registered may submit to the Registrar in the prescribed manner a statement of case setting out the circumstances, and the Registrar may issue to him a certificate stating whether, having regard to the similarity of the goods or services and of the trade marks referred to in the case, the proposed assignment of the first-mentioned trade mark would or would not be invalid under subsection (4), and a certificate so issued shall, subject to the provisions of this section as to appeal and unless it is shown that the certificate was obtained by fraud or misrepresentation, be conclusive as to the validity or invalidity under that subsection of the assignment in so far as that validity or invalidity depends upon the facts set out in the case, but, as regards a certificate in favour of validity, only if application for the registration under section 28 of the title of the person becoming entitled is made within six months from the date on which the certificate is issued.

(6) Notwithstanding anything in subsections (1), (2) and (3), a trade mark shall not, on or after the appointed day, be assignable or transmissible in a case in which as a result of an assignment or transmission thereof there would in the circumstances subsist, whether under the common law or by registration, an exclusive right in one of the persons concerned to the use of the trade mark limited to use in relation to goods to be sold or otherwise traded in, or services to be performed, in a place or places in Kenya and an exclusive right in another of those persons to the use of a trade mark nearly resembling the first-mentioned trade mark or of an identical trade mark in relation to the same goods or description of goods limited to use in relation to goods to be sold,

or otherwise traded in, or services to be performed, in another place or other places in Kenya:

Provided that, on application in the prescribed manner by the proprietor of a trade mark who proposes to assign it, or of a person who claims that a trade mark has been transmitted to him or to a predecessor in title of his on or after the appointed day, in any such case, the Registrar, if he is satisfied that in all the circumstances the use of the trade marks in exercise of those rights would not be contrary to the public interest, may approve the assignment or transmission, and an assignment or transmission so approved shall not be deemed to be, or to have been, invalid under this subsection or under subsection (4), so, however, that in the case of a registered trade mark this provision shall not have effect unless application for the registration under section 28 of the title of the person becoming entitled is made within six months from the date on which the approval is given or, in the case of transmission, was made before that date.

(7) Where an assignment in respect of any goods of a trade mark that is at the time of the assignment used in a business in those goods is made, on or after the appointed day, otherwise than in connexion with the goodwill of that business, the assignment shall not take effect until the following requirements have been satisfied, that is to say, the assignee must, not later than the expiration of six months from the date on which the assignment is made or within such extended period, if any, as the Registrar may allow, apply to him for directions with respect to the advertisement of the assignment, and must advertise it in such form and manner and within such period as the Registrar may direct.

(8) Any decision of the Registrar under this section shall be subject to appeal to the court.

**26.** *(Repealed by 4 of 2002, s.6.)*

**27.** Subject to the provisions of this Act, the person for the time being entered in the register as proprietor of a trade mark shall, subject to any rights appearing from the register to be vested in any other person, have power to assign the trade mark, and to give effectual receipts for any consideration for an assignment thereof.

Power of registered proprietor to assign and give receipts.

**28.** (1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall make application to the Registrar to register his title, and the Registrar shall, on receipt of the application and on proof of title to his satisfaction, register him as the proprietor of the trade mark in respect of the goods or services in respect of which the assignment or transmission has effect, and shall cause particulars of the assignment or transmission to be entered on

Registration of assignments and transmissions.  
5 of 1994.

the register.

(2) Any decision of the Registrar under this section shall be subject to appeal to the court.

(3) Except for the purposes of an appeal under this section or of an application under section 35, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of subsection (1) of this section shall not be admitted in evidence in any court in proof of the title to a trade mark except as between the parties to the document or instrument unless the court otherwise directs.

#### PART V - USE AND NON-USE

Removal from register and imposition of limitations on ground of non-use. 5 of 1994.

**29.** (1) Subject to the provisions of section 30, a registered trade mark may be taken off the register in respect of any of the goods or services in respect of which it is registered on application by any person aggrieved to the court or, at the option of the applicant and subject to the provisions of section 53, to the Registrar, on the ground that either -

- (a) the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him, and that there has in fact been no bona fide use of the trade mark in relation to those goods or services by any proprietor thereof for the time being up to the date one month before the date of the application; or
- (b) up to the date one month before the date of the application a continuous period of five years or longer elapsed during which the trade mark was a registered trade mark and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time being;

Provided that (except where the applicant has been permitted under subsection (2) of section 15 to register an identical or nearly resembling trade mark in respect of the goods or services in question or where the tribunal is of opinion that he might properly be permitted so to register such a trade mark) the tribunal may refuse an application made under paragraph (a) or (b) of this subsection in relation to any goods or services, if it is shown that there has been, before the relevant date or during the relevant periods as the case may be, *bona fide* use of the trade mark by any proprietor thereof for the time being in relation to-

- (i) the services of the same description; or

- (ii) goods associated with those services or services of that description, being services, or as the case may be, goods in respect of which the trade mark is registered;

(2) Where in relation to any goods or services in respect of which a trade mark is registered -

(a) the matters referred to in paragraph (b) of subsection (1) of this section are shown so far as regards non-use of the trade mark in relation to goods or services to be sold, or otherwise traded in, in a particular place in Kenya (otherwise than for export), or in relation to goods or services to be exported to a particular market; and

(b) a person has been permitted under subsection (2) of section 15 to register an identical or nearly resembling trade mark in respect of those goods or services under a registration extending to use in relation to goods or services to be sold, or otherwise traded in, or services to be performed in that place (otherwise than for export), or in relation to goods or services to be exported to that market, or the court or the Registrar is of opinion that he might properly be permitted so to register such a trade mark,

on application by that person to the court, or, at the option of the applicant and subject to the provisions of section 53, to the Registrar, the court or the Registrar, as the case may be, may impose on the registration of the first-mentioned trade mark such limitations as the court or the Registrar thinks proper for securing that that registration shall cease to extend to the last-mentioned use.

(3) An applicant shall not be entitled to rely for the purposes of paragraph (b) of subsection (1), or for the purposes of subsection (2), on any non-use of a trade mark that is shown to have been due to special circumstances or in relation to particular services and not to any intention to abandon the trade mark to which the application relates.

**30.** (1) Where a trade mark consisting of an invented word or invented words has become so well known as respects any goods in respect of which it is registered and in relation to which it has been used that the use thereof in relation to other goods would be likely to be taken as indicating a connexion in the course of trade between those goods and a person entitled to use the trade mark in relation to the first-mentioned goods, then, notwithstanding that the proprietor registered in respect of the first-mentioned goods does not use or propose to use the trade mark in relation to those other goods and notwithstanding anything in section

Defensive registration of well known trade marks.

29, the trade mark may, on the application in the prescribed manner of the proprietor registered in respect of the first-mentioned goods, be registered in his name in respect of those other goods as a defensive trade mark and, while so registered, shall not be liable to be taken off the register in respect of those goods under that section.

(2) The registered proprietor of a trade mark may apply for the registration thereof in respect of any goods as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any goods otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods as a defensive trade mark, in lieu in each case of the existing registration.

(3) A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same proprietor shall, notwithstanding that the respective registrations are in respect of different goods, be deemed to be, and shall be registered as, associated trade marks.

(4) On application by any person aggrieved to the court or, at the option of the applicant and subject to the provisions of section 53, to the Registrar, the registration of a trade mark as a defensive trade mark may be cancelled on the ground that the requirements of subsection (1) of this section are no longer satisfied in respect of any goods in respect of which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark, or may be cancelled as respects any goods in respect of which it is registered as a defensive trade mark on the ground that there is no longer any likelihood that the use of the trade mark in relation to those goods would be taken as giving the indication mentioned in subsection (1) of this section.

(5) The Registrar may at any time cancel the registration as a defensive trade mark of a trade mark of which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trade mark.

(6) Except as otherwise expressly provided in this section, the provisions of this Act shall apply in respect of the registration of trade marks as defensive trade marks and of trade marks so registered as they apply in other cases.

**31.** (1) Subject to the provisions of this section, a person other than the proprietor of a trade mark may be registered as a licensee thereof in respect of all or any of the goods in respect of which it is registered or in respect of services with the provision of which he is connected in the

course of business (otherwise than as a defensive trade mark) and either with or without conditions or restrictions; and the use of a trade mark by a licensee thereof in respect of which for the time being the trade mark remains registered and he is registered as a licensee, being use such as to comply with any conditions or restrictions to which his registration is subject, is in this Act referred to as the permitted use thereof.

(2) The permitted use of a trade mark shall be deemed to be use by the proprietor thereof, and shall be deemed not to be use by a person other than the proprietor, for the purposes of section 29 and for any other purpose for which such use is material under this Act or at common law.

(3) Subject to any agreement subsisting between the parties, a licensee of a trade mark shall be entitled to call upon the proprietor thereof to take proceedings to prevent infringement thereof, and, if the proprietor refuses or neglects to do so within two months after being so called upon, the licensee may institute proceedings for infringement in his own name, as if he were the proprietor, making the proprietor a defendant; and a proprietor so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

(4) Where it is proposed that a person should be registered as a licensee of a trade mark, the proprietor and the proposed licensee shall apply in writing to the Registrar in the prescribed manner and shall furnish him with a statutory declaration made by the proprietor, or by some person authorized to act on his behalf and approved by the Registrar -

- (a) giving particulars of the relationship, existing or proposed, between the proprietor and the proposed licensee, including particulars showing the degree of control by the proprietor over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed licensee shall be the sole licensee or that there shall be any other restriction as to persons for whose registration as licensees application may be made;
- (b) stating the goods or services in respect of which registration is proposed;
- (c) stating any conditions or restrictions proposed with respect to the characteristics of the goods or services, to the mode or place of permitted use or to any other matter; and
- (d) stating whether the permitted use is to be for a period or

without limit of period, and if for a period the duration thereof,

and with such further documents, information or evidence as may be required under the rules or by the Registrar.

(5) When the requirements of subsection (4) have been complied with, if the Registrar, after considering the information furnished to him under that subsection, is satisfied that in all the circumstances the use of the trade mark in relation to the proposed goods or services or any of them by the proposed licensee subject to any conditions or restrictions which the Registrar thinks proper would not be contrary to the public interest, the Registrar may register the proposed licensee as a licensee in respect of the goods or services as to which he is so satisfied subject as aforesaid.

(6) The Registrar shall refuse an application under the foregoing provisions of this section if it appears to him that the grant thereof would tend to facilitate trafficking in a trade mark.

(7) The Registrar shall, if so required by an applicant, take steps for securing that information given for the purposes of an application under the foregoing provisions of this section (other than matter entered in the register) is not disclosed to rivals in trade.

(8) Without prejudice to the provisions of section 35, the registration of a person as a licensee may be -

- (a) varied by the Registrar as regards the goods or services in respect of which, or any conditions or restrictions subject to which, it has effect, on the application in writing in the prescribed manner of the registered proprietor of the trade mark to which the registration relates;
- (b) cancelled by the Registrar on the application in writing in the prescribed manner of the registered proprietor or of the licensee or of any other licensee of the trade mark; or
- (c) cancelled by the Registrar on the application in writing in the prescribed manner of any person on any of the following grounds -
  - (i) that the licensee has used the trade mark otherwise than by way of the permitted use, or in such a way as to cause, or to be likely to cause, deception or confusion;
  - (ii) that the proprietor or the licensee misrepresented, or

failed to disclose, some fact material to the application for the registration, or that the circumstances have materially changed since the date of the registration;

- (iii) that the registration ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested.

(9) Provision shall be made by the rules for the notification of the registration of a person as a licensee to any other licensee of the trade mark, and for the notification of an application under subsection (8) to the registered proprietor and each licensee (not being the applicant) of the trade mark, and for giving to the applicant on such an application, and to all persons to whom such an application is notified and who intervene in the proceedings in accordance with the rules, an opportunity of being heard.

(10) The Registrar may at any time cancel the registration of a person as a licensee of a trade mark in respect of any goods or services in respect of which the trade mark is no longer registered.

(11) A decision of the Registrar under the foregoing provisions of this section shall be subject to appeal to the court.

(12) Nothing in this section shall confer on a licensee of a trade mark any assignable or transmissible right to the use thereof.

**32.** (1) No application for the registration of a trade mark in respect of any goods or services to be performed shall be refused, nor shall permission for such registration be withheld, on the ground only that it appears that the applicant does not use or propose to use the trade mark if -

Proposed use of trade mark by corporation to be constituted, etc. 5 of 1994, 7 of 2007.

- (a) the court or the Registrar is satisfied that a body corporate is about to be constituted, and that the applicant intends to assign the trade mark to the corporation with a view to the use thereof in relation to those goods or services to be performed by the corporation; or
- (b) the application is accompanied by an application for the registration of a person as a licensee of the trade mark, and the court or the Registrar is satisfied that the proprietor intends it to be used by that person in relation to those goods or services to be performed and the court or the Registrar is also satisfied that that person will be registered as a licensee thereof immediately after the registration of the trade mark.

(2) The provisions of section 29 shall have effect, in relation to a trade mark registered under the power conferred by subsection (1) of this section, as if for the reference, in paragraph (a) of subsection (1) of that section, to intention on the part of an applicant for registration that a trade mark should be used by him there were substituted a reference to intention on his part that it should be used by the corporation or licensee concerned.

(3) The court or the Registrar may, as a condition of the exercise of the power conferred by subsection (1) in favour of an applicant who relies on intention to assign to a corporation as aforesaid, require him to give security for the costs of any proceedings before the court or the Registrar relative to any opposition or appeal, and in default of such security being duly given may treat the application as abandoned.

(4) Where a trade mark is registered in respect of any goods under the power conferred by subsection (1) in the name of an applicant who relies on intention to assign to a corporation as aforesaid, then, unless within such period as may be prescribed, or within such further period not exceeding six months as the Registrar may on application being made to him in the prescribed manner allow, the corporation has been registered as the proprietor of the trade mark in respect of those goods, the registration shall cease to have effect in respect thereof at the expiration of that period, and the Registrar shall amend the register accordingly.

Use of one of associated or substantially identical trade marks equivalent to use of another.  
4 of 2002.

**33.** (1) Where under this Act use of a registered trade mark is required to be proved for any purpose, the court or the Registrar may, if and so far as the court or the Registrar thinks right, accept use of a trade mark with additions or alterations not substantially affecting its identity, as an equivalent for the use required to be proved.

(2) The use of the whole of a registered trade mark shall for the purposes of this Act be deemed to be also a use of any registered trade mark, being a part thereof, registered in the name of the same proprietor by virtue of subsection (1) of section 24.

Use of trade mark for export trade.  
5 of 1994, s. 19.

**34.** The application in Kenya of a trade mark to goods to be exported from Kenya, and any other act done in Kenya in relation to goods to be so exported or services to be performed outside which, if done in relation to goods to be sold or otherwise traded in Kenya or services to be performed within Kenya would constitute use of a trade mark therein, shall be deemed to constitute those goods or services for any purpose for which such use is material under this Act or at common law.

## PART VI - RECTIFICATION AND CORRECTION OF REGISTER

**35.** (1) Any person aggrieved by the non-insertion in or omission from the register of an entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the court or, at the option of the applicant and subject to the provisions of section 53, to the Registrar, and the court or the Registrar may make such order for making, expunging or varying the entry as the court or the Registrar may think fit.

General power to rectify entries in register.

(2) The court or the Registrar may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connexion with the rectification of the register.

(3) In case of fraud in the registration, assignment or transmission of a registered trade mark, the Registrar may himself apply to the court under this section.

(4) Any order of the court rectifying the register shall direct that notice of the rectification shall be served in the prescribed manner on the Registrar, and the Registrar shall on receipt of the notice rectify the register accordingly.

(5) The power to rectify the register conferred by this section shall include power to remove a registration in Part A of the register to Part B.

**36.** On application by any person aggrieved to the court, or, at the option of the applicant and subject to the provisions of section 53, to the Registrar, or on application by the Registrar to the court, the court or the Registrar may make such order as the court or the Registrar may think fit for expunging or varying the registration of a trade mark on the ground of any contravention of, or failure to observe, a condition entered on the register in relation thereto.

Power to expunge or vary registration for breach of condition.

**36A.** (1) A proprietor may surrender a registered trade mark in respect of some or all of the goods or services for which it is registered.

Surrender of a registered trade mark. 4 of 2002.

(2) The Minister may make rules for the surrender of a registered trade mark and for protecting persons with rights in the registered trade mark.

**36B.** (1) A proprietor of an earlier trade mark or any other earlier right, who has acquiesced for a continuous period of five years in the use of a registered trade mark in Kenya, being aware of that use, shall cease

Effect of Acquiescence. 4 of 2002.

to be entitled, on the basis of that earlier trade mark or earlier rights -

- (a) to apply for a declaration that the registration of the latter trade mark is invalid; or
- (b) to oppose the use of the latter trade mark in relation to the goods or services in relation to which it has been so used, unless the registration of the latter trade mark was applied for in bad faith.

(2) Where subsection (1) applies, the proprietor of the latter trade mark shall not be entitled to oppose the use of the earlier trade mark or the exploitation of the earlier right, as the case may be, notwithstanding that the earlier trade mark or right, may no longer be invoked against his latter trade mark.

Correction of  
register.  
5 of 1994.

**37.** (1) The Registrar may, on request made in the prescribed manner by the registered proprietor-

- (a) correct any error in the name, address or description of the registered proprietor of a trade mark;
- (b) enter any change in the name, address or description of the person who is registered as proprietor of a trade mark;
- (c) cancel the entry of a trade mark on the register;
- (d) strike out any goods or services or classes of goods or services, as the case may be, from those in respect of which a trade mark is registered; or
- (e) enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of the trade mark.

(2) The Registrar may, on request made in the prescribed manner by a licensee of a trade mark, correct any error, or enter any change, in the name, address or description of the licensee.

(3) Any decision of the Registrar under this section shall be subject to appeal to the court.

Alteration of  
registered trade mark.

**38.** (1) The registered proprietor of a trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the Registrar may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.

(2) The Registrar may cause an application under this section to be advertised in the prescribed manner in any case where it appears to him that it is expedient so to do, and where he does so, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar in the prescribed manner of opposition to the application, the Registrar shall, after hearing the parties if so required, decide the matter.

(3) A decision of the Registrar under this section shall be subject to appeal to the court.

(4) Where leave under this section is granted, the trade mark as altered shall be advertised in the prescribed manner, unless it has already been advertised, in the form to which it has been altered, in an advertisement under subsection (2).

**39.** (1) The Minister may from time to time make such rules, prescribe such forms and generally do such things as he thinks expedient, for empowering the Registrar to amend the register, whether by making or expunging or varying entries therein, so far as may be requisite for the purpose of adapting the designation therein of the goods or classes of goods or services or classes of services in respect of which trade marks are registered to any amended or substituted classification that may be prescribed.

Adaption of entries in register to amended or substituted classification of goods.  
39 of 1962, s. 5,  
5 of 1994.

(2) The Registrar shall not, in exercise of any power conferred on him for the purpose referred to in subsection (1), make any amendment of the register that would have the effect of adding any goods or classes of goods to those in respect of which a trade mark is registered (whether in one or more classes) immediately before the amendment is to be made, or of ante-dating the registration of a trade mark in respect of any goods:

Provided that this subsection shall not have effect in relation to goods as to which the Registrar is satisfied that compliance with this subsection in relation thereto would involve undue complexity and that the addition or ante-dating, as the case may be, would not affect any substantial quantity of goods and would not substantially prejudice the rights of any person.

(3) A proposal for the amendment of the register for the purpose referred to in subsection (1) shall be notified to the registered proprietor of the trade mark affected, shall be subject to appeal by the registered proprietor to the court, shall be advertised with any modifications, and may be opposed before the Registrar by any person aggrieved on the ground that the proposed amendment contravenes subsection (2), and

the decision of the Registrar on any such opposition shall be subject to appeal to the court.

(4) (*Deleted by 39 of 1962, s. 5.*)

#### PART VII - CERTIFICATION TRADE MARKS

Certification trade marks.

**40.** (1) A mark adapted in relation to any goods to distinguish in the course of trade goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic from goods not so certified shall be registrable as a certification trade mark in Part A of the register in respect of those goods in the name, as proprietor thereof, of that person:

Provided that a mark shall not be so registrable in the name of a person who carries on a trade in goods of the kind certified.

(2) In determining whether a mark is adapted to distinguish, the court or the Registrar may have regard to the extent to which –

- (a) the mark is inherently adapted to distinguish in relation to the goods in question; and
- (b) by reason of the use of the mark or of any other circumstances, the mark is in fact adapted to distinguish in relation to the goods in question.

(3) Subject to the provisions of subsections (4), (5) and (6) of this section, and of sections 10 and 11, the registration of a person as proprietor of a certification trade mark in respect of any goods, shall, if valid, give to that person the exclusive right to the use of the trade mark in relation to those goods, and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a person authorized by him under the regulations in that behalf using it in accordance therewith, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either –

- (a) as being use as a trade mark; or
- (b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or by his authorization under the relevant regulations to use the trade

mark or to goods certified by the proprietor.

(4) The right to the use of a certification trade mark given by registration shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark in any mode, in relation to goods to be sold or otherwise traded in any place, in relation to goods to be exported to any market, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.

(5) The right to the use of a certification trade mark given by registration shall not be deemed to be infringed by the use of any such mark by any person –

(a) in relation to goods certified by the proprietor of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or another in accordance with his authorization under the relevant regulations has applied the trade mark and has not subsequently removed or obliterated it, or the proprietor has at any time expressly or impliedly consented to the use of the trade mark; or

(b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact that the goods are certified by the proprietor:

Provided that paragraph (a) shall not have effect in the case of use consisting of the application of any such mark to goods, notwithstanding that they are goods mentioned in that paragraph, if that application is contrary to the relevant regulations.

(6) Where a certification trade mark is one of two or more registered trade marks that are identical or nearly resemble each other, the use of any of those trade marks in exercise of the right to the use of that trade mark given by registration shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

(7) There shall be deposited at the office of the Registrar in respect of every trade mark registered under this section regulations for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods and to authorize the use of the

trade mark, and may contain any other provisions that the Registrar may require or permit to be inserted therein (including provisions conferring a right of appeal to the Registrar against any refusal of the proprietor to certify goods or to authorize the use of the trade mark in accordance with the regulations); and regulations so deposited shall be open to inspection in the same manner as the register.

(8) A certification trade mark shall not be assignable or transmissible otherwise than with the consent of the court.

(9) The provisions of the First Schedule shall have effect with respect to the registration of a mark under this section and to marks so registered.

#### PART VIIA - COLLECTIVE TRADE MARKS

Collective trade  
marks.  
4 of 2002.

**40A.** (1) A mark capable of distinguishing, in the course of trade, the goods or services of persons who are members of an association, from goods or services of persons who are not members of such association, shall on application in the prescribed manner, be registerable as a collective trade mark or service mark in respect of the goods or services in the name of such an association.

(2) An application for registration of a collective trade mark shall designate the mark as a collective trade mark and the application shall be accompanied by a copy of the rules governing the use of the mark.

(3) In subsection (2) “rules” means the rules made by a person under whose control the collective mark may be used.

(4) The registered owner of a collective trade mark shall notify the Registrar, in writing, of any changes made in respect of the rules governing the collective trade mark.

(5) Geographical names or other indications of geographical origin may be registered as collective trade marks or service marks.

(6) The provisions of this Act shall, except in so far as may otherwise be provided, apply to a collective trade mark or service mark.

#### PART VIIB – INTERNATIONAL APPLICATIONS

Marks registered  
under the Banjul  
Protocol and the  
Madrid Convention

**40B.** In this Part –

“The Banjul Protocol” means the Protocol on Marks adopted by the Administrative Council of ARIPO held in Banjul, The Gambia in

1993, and it includes all the amendments or revisions thereof;

and Protocol.  
4 of 2002.

“International Bureau” means the International Bureau of the World Intellectual Property Organization, established by the convention signed at Stockholm on the 14<sup>th</sup> July, 1967;

“the Madrid Convention” means the Agreement relating to the International Registration of Marks, adopted in Madrid in April, 1891;

“the Madrid Protocol” means the protocol relating to the Madrid Agreement adopted in Madrid on 27<sup>th</sup> June, 1989;

“international trade mark” means a trade mark which is entitled to be protected in Kenya under the Madrid Agreement and the Madrid Protocol.

**40C.** (1) The Minister may, in rules, make appropriate provisions to give effect, in Kenya, to the provisions of the Banjul Protocol and the Madrid Agreement and the Madrid Protocol.

Rules regarding  
regional and  
international  
applications.  
4 of 2002.

(2) The rules referred to in subsection (1) may, in particular, provide for –

- (a) the filing of applications for international registration of marks through the Institute;
- (b) the procedures to be followed where the basic application in Kenya fails or ceases to be in force;
- (c) the communication of information to ARIPO or the International Bureau;
- (d) the payment of fees in respect of applications for regional or international registration and renewals.

**40D.** (1) A trade mark in respect of which Kenya is a designated state, registered by ARIPO by virtue of the Banjul Protocol, shall have the same effect and enjoy the same protection in Kenya, as a trade mark registered under this Act, unless the Registrar communicates to ARIPO, in respect of the application, a decision in accordance with the provisions of that Protocol, that if a mark is registered by ARIPO, that mark shall have no effect in Kenya.

Applications for  
registration of marks  
under the Banjul  
Protocol.  
4 of 2002.

(2) The Institute shall act as a receiving office, for the purpose of filing an application under the Banjul Protocol, where a regional application is filed with it and the applicant is a national or a resident

of Kenya.

(3) Where there is a conflict between the provisions of this Act and the provisions of the Banjul Protocol on Marks, this Act shall prevail.

(4) The provisions of this Act with respect to legal proceedings and appeals relating to registered trade marks shall apply to international trade marks.

#### PART VIII - RULES AND FEES

Power of Minister to make rules.  
39 of 1956, Sch.,  
5 of 1994.

**41.** The Minister may make such rules, prescribe such forms and generally do such things as he thinks expedient –

- (a) for regulating the practice under this Act, including the service of documents;
- (b) for classifying goods and services for the purposes of registration of trade marks;
- (c) for making or requiring duplicates of trade marks and other documents;
- (d) for securing and regulating the publishing and selling or distributing, in such manner as the Minister thinks fit, of copies of trade marks and other documents;
- (e) generally, for regulating the business of the Registrar in relation to trade marks and all things by this Act placed under the direction or control of the Registrar.

Fees.

**42.** There shall be paid in respect of applications and registration and other matters under this Act such fees as may be prescribed by the Minister.

#### PART IX - POWERS AND DUTIES OF REGISTRAR

Preliminary advice by Registrar as to distinctiveness.

**43.** (1) The power to give to a person who proposes to apply for the registration of a trade mark in Part A or Part B of the register advice as to whether the trade mark appears to the Registrar *prima facie* to be inherently adapted to distinguish, or capable of distinguishing, as the case may be, shall be a function of the Registrar under this Act.

(2) A person who is desirous of obtaining such advice shall make application to the Registrar therefor in the prescribed manner.

(3) If on an application for the registration of a trade mark as to

which the Registrar has given advice in the affirmative, made within three months after the advice is given, the Registrar, after further investigation or consideration, gives notice to the applicant of objection on the ground that the trade mark is not adapted to distinguish, or capable of distinguishing, as the case may be, the applicant shall be entitled, on giving notice of withdrawal of the application within the prescribed period, to have repaid to him any fee paid on the filing of the application.

44. Where any discretionary or other power is given to the Registrar by this Act or the rules, he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark in question without (if duly required so to do within the prescribed time) giving to the applicant or registered proprietor an opportunity of being heard.

Hearing before exercise of Registrar's discretion.

45. (1) In all proceedings before the Registrar under this Act, the Registrar shall have power to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may, by leave of the court or a judge thereof, be enforced in the same manner as a judgment or order of the court to the same effect.

Power of Registrar to award costs.

(2) The Chief Justice may make rules in regard to the amount of and generally as to costs.

PART X - LEGAL PROCEEDINGS AND APPEALS

46. In all legal proceedings relating to a registered trade mark (including applications under section 35), the fact that a person is registered as proprietor of the trade mark shall be *prima facie* evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.

Registration to be *prima facie* evidence of validity.

47. In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided in favour of the proprietor of the trade mark, the court may certify to that effect, and if it so certifies then in any subsequent legal proceeding in which the validity of the registration comes into question the proprietor of the trade mark on obtaining a final order or judgment in his favour shall have his full costs, charges and expenses as between advocate and client, unless in the subsequent proceeding the court certifies that he ought not to have them.

Certificate of validity.

48. In all proceedings before the court under this Act, the costs of the Registrar shall be in the discretion of the court, but the Registrar shall not be ordered to pay the costs of any other of the parties.

Costs of Registrar in proceedings before court, and payment

of costs by Registrar.

Trade usage, etc., to be considered.

**49.** In any action or proceeding relating to a trade mark or trade name, the court or the Registrar shall admit evidence of the usages of the trade concerned and of any relevant trade mark or trade name or get-up legitimately used by other persons.

Registrar's appearance in proceedings involving rectification.

**50.** (1) In any legal proceeding in which the relief sought includes alteration or rectification of the register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the court.

(2) Unless otherwise directed by the court, the Registrar in lieu of appearing and being heard may submit to the court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting it or of the practice of the office of the Registrar in similar cases or of such other matters relevant to the issues, and within his knowledge as Registrar, as he thinks fit, and the statement shall be deemed to form part of the evidence in the proceeding.

Court's power to review Registrar's decision.

**51.** The court, in dealing with any question of the rectification of the register (including all applications under the provisions of section 35), shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.

Discretion of court in appeals.

**52.** In any appeal from a decision of the Registrar to the court under this Act, the court shall have and exercise the same discretionary powers as under this Act are conferred upon the Registrar.

Procedure in cases of option to apply to court or Registrar.

**53.** Where under any of the foregoing provisions of this Act an applicant has an option to make an application either to the court or to the Registrar –

- (a) if an action concerning the trade mark in question is pending, the application shall be made to the court;
- (b) if in any other case the application is made to the Registrar, he may, at any stage of the proceedings, refer the application to the court, or he may after hearing the parties determine the question between them, subject to appeal to the court.

Mode of giving evidence.

**54.** (1) In any proceeding under this Act before the Registrar, the evidence shall be given by statutory declaration in the absence of directions to the contrary, but, in any case in which the Registrar thinks it right so to do, he may take evidence *viva voce* in lieu of or in addition to evidence by declaration.

(2) Any such statutory declaration may in the case of appeal be

used before the court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

(3) In case any part of the evidence is taken *viva voce*, the Registrar shall, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as a magistrate.

**54A.** The Nice Agreement concerning the International Classification of Goods and Services for the purpose of the Registration of Trade Marks of 15 June, 1957 and all revisions thereof together with the publications of the World Intellectual Property Organization of Geneva relating to the Agreement may be received in evidence before any court or Registrar and shall be taken into account by the Registrar in relation to his duties under this Act.

Nice Agreement  
receivable in  
evidence.  
5 of 1994.

**55 and 56.** (*Repealed by 11 of 1965, s. 5.*)

PART XI - OFFENCES, AND RESTRAINT OF REGISTRATION AND  
USE OF CERTAIN MARKS

1 of 1984.

**57.** If any person makes or causes to be made a false entry in the register, or a writing falsely purporting to be a copy of an entry in the register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of an offence and liable to imprisonment for a term not exceeding five years or to a fine not exceeding ten thousand shillings, or to both such imprisonment and fine.

Falsification of  
entries in register.

**58.** (1) Any person who makes a representation-

Fine for falsely  
representing a trade  
mark as registered.

- (a) with respect to a mark not being a registered trade mark, to the effect that it is a registered trade mark; or
- (b) with respect to a part of a registered trade mark not being a part separately registered as a trade mark, to the effect that it is so registered; or
- (c) to the effect that a registered trade mark is registered in respect of any goods in respect of which it is not registered; or
- (d) to the effect that the registration of a trade mark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations entered on the register, the registration does not give that right,

shall be guilty of an offence and liable to a fine not exceeding five thousand shillings.

(2) For the purposes of this section, the use in Kenya in relation to a trade mark of the word “registered”, or of any other word referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration in the register, except-

- (a) where that word is used in physical association with other words delineated in characters at least as large as those in which that word is delineated and indicating that the reference is to registration as a trade mark under the law of a country outside Kenya, being a country under the law of which the registration referred to is in fact in force;
- (b) where that word (being a word other than the word “registered”) is of itself such as to indicate that the reference is to the last-mentioned registration; or
- (c) where that word is used in relation to a mark registered as a trade mark under the law of a country outside Kenya and in relation to goods to be exported to that country.

**58A.** In this Part-

“apply to”, in relation to goods means-

- (a) to emboss, impress, engrave, etch, stamp, write, photocopy or otherwise cause to be applied to or printed upon; or
- (b) to weave or otherwise work into; or
- (c) to annex or affix to,

such goods;

“covering” means any bottle, box, capsule, case, cask, frame, vessel, wrapper or other container or cover and includes a band label, ticket or reel;

“forged”, in relation to a registered mark, means made or falsified as described in section 58C;

“sell” includes –

- (a) to expose for sale; and

(b) to have in possession for the purpose of sale for any purpose of trade or commerce.

**58B.** (1) A trademark is applied to goods if -

Application.  
5 of 1994.

- (a) it is applied to the goods themselves; or
- (b) it is applied to a covering on, in or attached to which the goods are sold; or
- (c) the goods are placed in or around, enclosed by or annexed to any covering to which the trade mark or other mark has been applied; or
- (d) it is used in any manner likely to lead to the belief that the goods in connection with which it is used are designated by that trade mark or other mark.

(2) Goods delivered in pursuance of an offer or request made by reference to a trade mark or other mark appearing in any sign, advertisement, invoice, list, catalogue, business letter, business paper, price list or other commercial documents, for the purposes of paragraph (d) of subsection (1) are goods in connection with which the trade mark or other mark is used.

(3) A trade mark is applied in relation to services if it is used in any manner likely to lead to the belief that the services in connection with which it is used are designated by that trade mark.

(4) A registered trade mark is falsely applied to goods or in relation to services if, without the consent of the proprietor or the authority of this Act, the registered trade mark or a mark so nearly resembling it as to be likely to deceive or cause confusion is applied to the goods or in relation to the services, as the case may be.

**58C.** For the purposes of this Part, a person forges a registered trademark if-

Forgery of registered  
trade mark.  
5 of 1994.

- (a) without the consent of the proprietor of the registered trade mark or the authority of this Act, he makes that trade mark or a mark so nearly resembling that trade mark as to be likely to deceive or cause confusion; or
- (b) he falsifies a registered trade mark, whether by alteration, addition, effacement or otherwise.

**58D.** (1) Subject to subsection (2), any person who-

Prohibition of forgery

of registered trade  
mark.  
5 of 1994,  
4 of 2002.

- (a) forges a registered trade mark; or
- (b) falsely applies a registered trade mark to goods or in relation to services; or
- (c) makes a die, block, machine or other instruments, for the purpose of forging, or of being used for forging, a registered trade mark; or
- (d) disposes of, or has in his possession, a die, block, machine or other instrument for the purpose of forging or of being used for forging, a registered trade mark; or
- (e) without the consent of the proprietor of a registered trade mark-
  - (i) makes, imports or has in his possession any device for applying that registered trade mark to goods or in relation to services or representations of that trade mark; or
  - (ii) makes any reproduction, replicas or representations of that trade mark; or
  - (iii) imports any reproductions, replicas or representations of that trade mark otherwise than on goods to which they have been applied; or
- (f) makes, imports or has in his possession -
  - (i) any device for applying to any goods or in relation to any services a mark so nearly resembling a registered trade mark as to be likely to deceive or cause confusion; or
  - (ii) any reproduction, replica or representation of a mark so nearly resembling a registered trade mark as to be likely to deceive or cause confusion, for the purpose of applying it to goods or in relation to services contrary to the provisions of this Part; or
  - (iii) any covering bearing a mark so nearly resembling a registered trade mark as to be likely to deceive or cause confusion, for the purpose of using it to cover or contain, or in relation to, goods contrary to the provisions of this Part;

shall be guilty of an offence, and liable to fine not exceeding two hundred

thousand shillings or to imprisonment for a term not exceeding five years or to both.

(2) It is a sufficient defence to any charge-

(a) under subsection (1), if the person concerned proves that he acted without intent to defraud; or

(b) under paragraph (b) or (c) of subsection (1), if the person concerned proves that-

(i) in the ordinary course of his business he was employed on behalf of other persons, either to make dies, blocks, machines or other instruments for making or being used in making trade marks or, as the case may be, to apply trade marks to goods or in relation to services and that, in the case which is the subject of the charge, he was so employed by some other person and was not interested in the goods or services by way of profit or commission dependent on the sale of such goods or performance of such services; and

(ii) he took reasonable precautions against committing the offence charged; and

(iii) he had, at the time of the commission of the alleged offence, no reason to suspect that the trade mark was not genuine; and

(iv) on request made by a police officer, he gave to that police officer information in his power with respect to the person on whose behalf the trade mark was applied.

**58E.** (1) Subject to the provisions of subsection (2), any person who sells or imports any goods or performs any services to which-

(a) a forged registered trade mark is falsely applied; or

(b) a registered trade mark is falsely applied;

shall be guilty of an offence, and liable to a fine not exceeding two hundred thousand shillings or to imprisonment for a term not exceeding five years or to both.

(2) It is a defence to any charge under subsection (1) if the person concerned proves that having taken all reasonable precautions against committing an offence under this Part-

Prohibition of sale or importation of goods or performance of services with forged registered trade mark.  
5 of 1994,  
4 of 2002.

- (i) he had, at the time of the sale, no reason to suspect that the trade mark was not genuine; and
- (ii) on request made by a police officer or customs officer, he gave to that officer all the information in his power with respect to the person from whom he obtained such goods.

Aiding and abetting offence.  
5 of 1994,  
4 of 2002.

**58F.** Any person who within Kenya procures, counsels, aids, abets or is accessory to the commission outside Kenya of any offence which, if committed within Kenya would be an offence under this Part, is himself guilty of an offence and liable to a fine not exceeding two hundred thousand shillings or to imprisonment for a term not exceeding five years or to both.

Evidence.  
5 of 1994.

**58G.** (1) Any invoice or other document submitted or used by an importer or any other person in connection with the importation of goods in respect of which a prosecution is brought under this Part may be produced as evidence in any criminal proceedings without calling the person who prepared or signed it.

(2) In any prosecution for an offence under this Part, evidence that any imported goods were shipped at any port of call shall be *prima facie* evidence that those goods were grown, manufactured or produced in the country within which that port is situated.

(3) Where, in any prosecution for an offence under this Part, the consent of the proprietor of a trade mark is a relevant issue, the onus of proving the consent of such proprietor lies on the accused.

Forfeiture of goods.  
5 of 1994.

**58H.** (1) On conviction of any person for an offence under this Part, the court may, in addition to any sentence passed, declare any goods in respect of or by means of which the offence was committed to be forfeited to the Government, unless the owner of the goods or any person acting on his behalf or any other person interested in the goods shows cause to the contrary.

(2) After any goods in respect of or by means of which it is suspected an offence under this Part has been committed are seized by a police officer and no prosecution is instituted following that seizure-

- (a) the magistrate shall, on application by a police officer, cause a notice to be published in the Gazette and in a newspaper circulating in the area stating that unless cause is shown to the contrary at the time and place specified in the notice such goods will be declared forfeited; and

(b) at the time and place referred to in paragraph (a) the magistrate may, unless the owner of the goods or any person on his behalf or other person interested in the goods shows cause to the contrary declare such goods to be forfeited to the Government.

**59.** (1) Subject to an authorization by or on behalf of the International Olympic Committee, no sign consisting of or containing the Olympic symbol, as defined in the Charter of the International Olympic Committee and consisting of five interlaced rings, whether delineated in a single color or in different colors, shall be registered as a mark, or used for commercial purposes as a mark or other sign; and where such a sign has been registered as a mark that registration shall be void.

Restraint of registration and use of Olympic symbol. 1 of 1984.

(2) Nothing in subsection (1) shall prevent the use of the sign or design where it is made by the mass media for the purposes of informing the public about the Olympic movement.

(3) The Minister may, by notice in the Gazette, suspend the operation of subsection (1) during any period during which there is no agreement in force between the International Olympic Committee and the Kenya Olympic Association concerning the conditions under which authorization for the use of the Olympic symbol may be made.

(4) Notwithstanding the provisions of section 5, an interested party may institute proceedings to-

- (a) prevent the use or registration of a sign referred to in subsection (1) contrary to the provisions of that subsection;
- (b) obtain the removal from the register of a sign registered as a mark contrary to the provisions of subsection (1);
- (c) claim damages or other available civil remedy arising out of the matters referred to in paragraph (a) or (b).

## PART XII – MISCELLANEOUS

**60.** The use of a registered trade mark in relation to goods between which and the person using it any form of connexion in the course of trade subsists shall not be deemed to be likely to cause deception or confusion on the ground only that the trade mark has been, or is, used in relation to goods between which and that person or a predecessor in title of his a different form of connexion in the course of trade subsisted

Change of form of trade connexion not to be deemed to cause deception.

or subsists.

Jointly owned trade marks.

**61.** (1) Where the relations between two or more persons interested in a trade mark are such that no one of them is entitled as between himself and the other or others of them to use it except-

(a) on behalf of both or all of them; or

(b) in relation to an article with which both or all of them are connected in the course of trade,

those persons may be registered as joint proprietors of the trade mark, and this Act shall have effect in relation to any rights to the use of the trade mark vested in those persons as if those rights had been vested in a single person.

(2) Subject to subsection (1), nothing in this Act shall authorize the registration of two or more persons who use a trade mark independently, or propose so to use it, as joint proprietors thereof.

Trusts and equities.

**62.** (1) There shall not be entered in the register any notice of any trust express, implied or constructive, nor shall any such notice be receivable by the Registrar.

(2) Subject to the provisions of this Act, equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

Recognition of agents.  
4 of 2002.

**63.** (1) Where by this Act any act has to be done by or to any person in connexion with a trade mark or proposed trade mark or any procedure relating thereto, the act may, under and in accordance with the rules, be done by or to an agent of that person duly authorized in the prescribed manner.

(2) An applicant who ordinarily resides outside Kenya or has a principal place of business outside Kenya, may be represented by a trade mark agent.

(3) A person shall be qualified to act as a trade mark agent if such person-

(a) is a Kenyan citizen; and

(b) is an advocate of the High Court of Kenya; or

(c) is admitted to practise as an agent before the Institute in accordance with the provisions of the Industrial Property

Act, 2001.

No. 3 of 2001.

64. When an applicant for the registration of a trade mark or an agent does not reside or carry on business in Kenya, he shall give the Registrar an address for service in Kenya, and if he fails to do so the Registrar may refuse to proceed with the application until such address has been given.

Address for service.

65. (1) Where any person has registered or has applied for protection for any trade mark in any foreign state with the government of which the Government of Kenya has made arrangements for mutual protection of trade marks, that person or his legal representative or assignee shall be entitled to registration of his trade mark in priority to other applicants; and that registration shall have the same date as the date of application for protection in the foreign state if the application for registration is made within six months from the date of the application for protection in the foreign state:

International arrangements. 11 of 1965, s. 7.

Provided that nothing in this section shall entitle the proprietor of a trade mark to recover damages for infringements happening prior to the actual date on which his trade mark is registered in Kenya.

(2) The registration of a trade mark shall not be invalidated by reason only of the use of the trade mark in Kenya during the period of six months.

(3) The application for the registration of a trade mark under this section shall be made in the same manner as an ordinary application under this Act:

Provided that any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act.

(4) The provisions of this section shall apply only to those foreign states to which the Attorney-General has by notice in the Gazette declared them to be applicable and so long only as the notice continues in force with respect to those states.

(5) Where it is made to appear to the Minister that in any country of the Commonwealth satisfactory provision has been made for the protection of trade marks registered in Kenya, the Ministry may by notice in the Gazette apply the provisions of this section to that country with such variations or additions (if any) as may be stated in the notice.

66. Whenever the last day fixed by this Act, or by any rule for the

Provisions as to

public holidays.

time being in force, for leaving any document with or paying any fee to the Registrar falls on a Sunday or public holiday, the document may be left or the fee may be paid on the day next following the Sunday or public holiday.

Transitional provisions and savings.

**67.** The transitional provisions and savings set out in the Third Schedule shall have effect with respect to the matters therein mentioned respectively.

## FIRST SCHEDULE

(s. 40)

### CERTIFICATION TRADE MARKS

1. (1) An application for the registration of a mark under section 40 shall be made to the Registrar in writing in the prescribed manner by the person proposed to be registered as the proprietor thereof.

(2) The provisions of subsection (2) and of subsections (4) to (7) of section 20 shall have effect in relation to an application under section 40 as they have effect in relation to an application under subsection (1) of section 20.

(3) In dealing under the provisions of section 20 with an application under section 40, the court or the Registrar shall have regard to the same considerations, so far as relevant, as if the application were an application under section 20 and to any other considerations relevant to applications under section 40, including the desirability of securing that a certification trade mark shall comprise some indication that it is such a trade mark.

(4) An applicant for the registration of a mark under section 40 shall transmit to the Registrar draft regulations for governing the use thereof in accordance with subsection (7) of that section.

(5) The Registrar shall consider the application with regard to the following matters –

- (a) whether the applicant is competent to certify the goods in respect of which the mark is to be registered;
- (b) whether the draft regulations are satisfactory; and
- (c) whether in all the circumstances the registration applied for would be to the public advantage;

and may either –

- (i) refuse to accept the application; or
- (ii) accept the application, and approve the regulations either without modification and unconditionally or subject to any conditions or limitations, or to any amendments or modifications of

the application or of the regulations, which he thinks requisite having regard to any of the foregoing matters;

but, except in the case of a direction for acceptance and approval without modification and unconditionally, the Registrar shall not decide the matter without giving to the applicant an opportunity of being heard.

2. (1) When an application has been accepted, the Registrar shall, as soon as may be after acceptance, cause the application as accepted to be advertised in the prescribed manner, and the provisions of subsections (2) to (11) of section 21 shall have effect in relation to the registration of the mark as if the application had been an application under section 20:

Provided that, in deciding under the provisions of section 21, the Registrar shall have regard only to the considerations referred to in subparagraph (3) of paragraph 1 of this Schedule, and a decision under those provisions in favour of the applicant shall be conditional on the determination in his favour by the Registrar under subparagraph (2) of this paragraph of any opposition relating to any of the matters referred to in subparagraph (5) of paragraph 1.

(2) When notice of opposition is given relating to any of the matters referred to in subparagraph (5) of paragraph 1 of this Schedule, the Registrar shall, after hearing the parties, if so required, and considering any evidence, decide whether, and subject to what conditions or limitations, or amendments or modifications of the application or of the regulations, if any, registration is, having regard to those matters, to be permitted.

3. (1) The regulations deposited in respect of a certification trade mark may, on the application of the registered proprietor, be altered by the Registrar.

(2) The Registrar may cause an application for his consent to be advertised in any case where it appears to him that it is expedient so to do, and where the Registrar causes an application to be advertised, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar of opposition to the application, the Registrar shall not decide the matter without giving the parties an opportunity of being heard.

4. (1) The court may, on the application in the prescribed manner of any person aggrieved, or on the application of the Registrar, make such order as it thinks fit for expunging or varying any entry in the register relating to a certification trade mark, or for varying the deposited regulations, on the ground –

- (a) that the proprietor is no longer competent, in the case of any of the goods in respect of which the trade mark is registered, to certify those goods;
- (b) that the proprietor has failed to observe a provision of the deposited regulations to be observed on his part;
- (c) that it is no longer to the public advantage that the trade mark

should be registered; or

- (d) that it is requisite for the public advantage that, if the trade mark remains registered, the regulations should be varied;

and the Registrar shall have no jurisdiction to make an order under section 35 on any of those grounds.

(2) The Registrar shall rectify the register and the deposited regulations in such manner as may be requisite for giving effect to an order made under subparagraph (1) of this paragraph.

5. Notwithstanding anything in section 45, the Registrar shall not have any jurisdiction to award costs to or against any party on an appeal to him against a refusal of the proprietor of a certification trade mark to certify goods or to authorize the use of the trade mark.

6. A decision of the Registrar under the provisions of this Schedule shall be subject to appeal to the court.

7. The following provisions of this Act shall not have effect in relation to a certification trade mark, that is to say, section 7, section 9, section 12, sections 20 and 21 (except as expressly applied by this Schedule), subsections (4) to (8) of section 25, sections 29 to 32, section 60 and any provisions the operation of which is limited by the terms thereof to registration in Part B of the register.

## SECOND SCHEDULE

*Deleted by 11 of 1965, s. 9.*

## THIRD SCHEDULE

(s. 67)

### TRANSITIONAL PROVISIONS AND SAVINGS

*Assignments and transmissions (before appointed day) giving exclusive rights in different places in Kenya*

1. The validity of an assignment or transmission of a trade mark effected or claimed to have been effected before the appointed day, in any such case as is mentioned in subsection (6) of section 25, shall be determined as if the provisions contained in subsections (1) to (5) of that section had not been enacted.

*Saving as to retrospective provisions relating to assignments and transmissions*

2. The retrospective provisions contained in section 25 shall have effect without prejudice to any determination of the court or the Registrar that was

made before the appointed day, or to the determination of any appeal from a determination so made, or to any title acquired for valuable consideration before the appointed day.

*Association of trade marks assignable or transmissible as a whole only*

3. Where immediately before the appointed day a trade mark was registered in Part B of the register subject to a condition rendering it assignable or transmissible only as a whole with another trade mark registered in the name of the same proprietor or with two or more other trade marks so registered, and not separately, the trade marks shall be deemed to be associated trade marks, and the entries in the register relating thereto may be amended accordingly.

*Previous use of a trade mark by person becoming registered user on application made within one year of appointed day*

4. Where a person is registered as a licensee of a trade mark on an application made within one year from the appointed day, subsection (2) of section 31 shall have effect in relation to any previous use (whether before or after the appointed day) of the trade mark by that person, being use in relation to the goods in respect of which he is registered and, where he is registered subject to conditions or restrictions, being use such as to comply substantially therewith, as if such previous use had been permitted use. 7 of 2007.

*Use of trade mark for export trade before appointed day*

5. Section 34 shall be deemed to have had effect in relation to an act done before the appointed day in relation to goods or services as it has effect in relation to an act done after the appointed day without prejudice, however, to any determination of the court or the Registrar which was made before the appointed day or to the determination of any appeal from a determination so made. 5 of 1994.

*Savings in respect of the repealed Trade Marks Ordinance*

6. (1) Nothing in this Act shall be taken to invalidate the original registration of a trade mark which immediately before the appointed day was validly on the register. Cap. 293 (1948).

(2) No trade mark which was upon the register on the appointed day and which, having regard to any differences as between the provisions of this Act and the provisions of the Trade Marks Ordinance (now repealed) whether as respects limitations which may be imposed on registration or as respects any other matter, was then a registrable trade mark under that Ordinance shall be removed from the register on the ground that it was not registrable under the Ordinance in force at the date of its registration.

(3) Nothing in this Act shall subject any person to any liability in respect of any act or thing done before the appointed day to which he would not have been subject under the repealed Ordinance.

(4) Nothing in this Act shall affect any order, rule, regulation or requirement made, table of fees or certificate issued, notice, decision, determination, direction or approval given, application made, or thing done under the repealed Ordinance; and every such order, rule, regulation, requirement, table of fees, certificate, notice, decision, determination, direction, approval, application or thing shall, if in force at the appointed day, continue in force and shall, so far as it could have been made, issued, given or done under this Act, have effect as if made, issued, given or done under the corresponding enactment of this Act.

(5) Any document referring to any provision of the repealed Ordinance shall be construed as referring to the corresponding provision of this Act.

5 of 1994.

7. In this Schedule the expression “the appointed day” means-

- (a) in relation to a trade mark as defined in this Act prior to the date of commencement of the Trade Marks (Amendment) Act, 1994, 1<sup>st</sup> January, 1957; and
- (b) in relation to a trade mark and in relation to services as defined in this Act after the date of commencement of the Trade Marks (Amendment) Act, 1994, the date of commencement of that Act.

**SUBSIDIARY LEGISLATION****Rules under sections 39 and 41****THE TRADE MARKS RULES**

## ARRANGEMENT OF RULES

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- 1-Short title.
- 2-Interpretation.

*Fees and Forms*

- 3-Fees.
- 4-Forms.
- 5- (*Deleted*).

*Classifications under previous system*

- 6-Old classifications preserved.
- 7-Conversions to new classification system.
- 8- (*Deleted*).

*Documents*

- 9-Size, etc., of documents.
- 10-Signature of documents by partnerships, companies and associations.
- 11-Service of documents.

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- 12-Address.
- 13-Address for service.

*Agency*

- 14-Agency.

*Registrable Trade Marks and Preliminary Advice  
(Section 43)*

- 15-Registrable trade marks.
- 16-Flags, emblems, arms, etc.
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- 19-Name and description of goods or services on a trade mark.
- 20-Preliminary advice by Registrar as to distinctiveness.

*Application for Registration of a Trade Mark*

- 21-Form of application.
- 22-Representation of mark.
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[Subsidiary]

*Rule*

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- 26-Representations to be satisfactory.
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- 29-Transliteration and translation.
- 29A-Application to add goods or services.

*Procedure on Receipt of Application for Registration  
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- 30-Search.
- 31-Registrar's powers on application.
- 32-Objection by Registrar.
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[Subsidiary]

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L.N. 454/1959,  
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L.N. 131/1975,  
L.N. 49/1988,  
L.N. 42/1995,  
L.N. 146/2003.

## THE TRADE MARK RULES

### *Preliminary*

Short title.

1. These Rules may be cited as the Trade Marks Rules.

Interpretation.  
L.N. 42/1995,  
L.N. 146/2003.

2. In these Rules, except where the context otherwise requires-

“agent” means a person appointed as an agent under rule 14;

“the office” means the office of the Registrar;

“specification” means the designation of goods or classes of goods or the description of services or classes of services in respect of which a trade mark, or a registered user of a trade mark, is registered or proposed to be registered.

### *Fees and Forms*

Fees.

3. The fees to be paid in relation to trade marks shall be those prescribed in the First Schedule.

Forms.

4. The forms referred to herein are the forms contained in the Fourth Schedule, and those forms shall be used in all cases to which they are applicable and shall be modified as directed by the Registrar to meet other cases.

5. (*Deleted by L.N. 146/2003, s.3*)

### *Classifications Under Previous System*

Old classifications preserved.  
L.N. 146/2003.

6. (1) This rule applies with respect to a trade mark registered for goods or services classified in accordance with a classification system that has been amended or replaced since those goods or services were classified.

(2) The goods or services described in paragraph (1) are not required to be reclassified in accordance with the new classification system unless application is made under rule 7.

Conversions to new classification system.  
L.N. 146/2003.

7. (1) The registered proprietor of a trade mark described in rule 6 (1) may apply to have the classification of the goods or services in respect of which the trade mark was registered adapted so that they are classified in accordance with section 6 (2) of the Act.

(2) An application under this rule shall be made to the Registrar in form TM 43.

[Subsidiary]

(3) The registrar shall determine what amendment he proposes to make in relation to an application under this rule and shall notify the applicant of that proposal as required under section 39 (3) of the Act.

(4) The advertisement of the proposed amendment required under section 39 (3) of the Act shall be made in the Journal or the Kenya Gazette.

(5) A person who wishes to oppose the proposed amendment shall do so by filing a notice of opposition with the Registrar within thirty days after the date of advertisement.

(6) The notice of opposition shall be in form TM 44 and shall be filed in duplicate.

(7) The notice of opposition shall be accompanied by a statement, in duplicate, showing how the proposed amendment would be contrary to section 39 (2) of the Act.

(8) The Registrar shall send the duplicate copies of the notice of opposition and the accompanying statement to the applicant.

(9) The applicant may file a counter-statement with the Registrar setting out fully the grounds on which the applicant contests the opposition.

(10) The counter-statement shall be in form TM 7 and shall be filed in duplicate within thirty days after the applicant receives the notice of opposition.

(11) The Registrar may allow or require evidence to be adduced and, if the Registrar so decides, rules 49 to 52 shall apply, with necessary modifications, subject to any directions given by the Registrar.

(12) Before deciding the matter, the Registrar shall give the parties an opportunity to be heard if either party requests it.

(13) If a party requests an opportunity to be heard, the Registrar shall give notice to the parties of a date when he will hear the arguments in the case.

(14) An appointment shall be for a date at least fourteen days after the date of the notice, unless the parties consent to a shorter notice.

(15) Within seven days after the receipt of the notice a party who intends to appear shall so notify the Registrar in form TM 8.

(16) A party who receives notice and who does not, within seven days after the receipt of the notice, notify the Registrar in form TM 8 that he intends to appear, may be treated as not desiring to be heard and the Registrar may act accordingly.

(17) The Registrar shall make the entries in the Register that are necessary to give effect to a request to adapt a classification if-

[Subsidiary]

- (a) the time for filing a notice of opposition has expired without such a notice being filed; or
- (b) a notice of opposition has been filed but the Registrar has decided to allow the request.

(18) If the Registrar makes an entry under paragraph (17) he shall also enter the date when that entry was made.

(19) No entry under this rule shall affect the period of registration of a trade mark or when it may be renewed.

8. (*Deleted by L.N. 146/2003, s.4*)

#### *Documents*

Size, etc., of documents.  
L.N. 42/1995.

9. Subject to any other directions that may be given by the Registrar, all applications, notices, counter-statements, papers having representations affixed or other documents authorized or required by the Act or these Rules to be made, left or sent, at or to the office or with or to the Registrar or the court, shall be on strong non-absorbent paper of a size approximately 297 mm. by approximately 210 mm., and shall have on the left hand part thereof a margin of not less than 35 mm.

Signature of documents by partnerships, companies and associations.

10. (1) A document purporting to be signed for or on behalf of a partnership shall contain the names of all the partners in full and shall be signed by all the partners or by any qualified partner stating that he signs on behalf of the partnership, or by any other person who satisfies the Registrar that he is authorized to sign the document.

(2) A document purporting to be signed for or on behalf of a body corporate shall be signed by a director or by the secretary or other principal officer of the body corporate, or by any other person who satisfies the Registrar that he is authorized to sign the document.

(3) A document purporting to be signed for or on behalf of an association of persons may be signed by any person who appears to the Registrar to be duly qualified.

Service of documents.

11. (1) All applications, notices, statements, papers having representations affixed or other documents authorized or required by the Act or these Rules to be made, left or sent, at or to the office, or with or to the Registrar or the court or any other person, may be sent through the post by a prepaid or official paid letter.

(2) Any application or any document so sent shall be deemed to have been made, left or sent at the time when the letter containing the same would be delivered in the ordinary course of post; and in proving the sending it shall be sufficient to prove that the letter was properly addressed and put into the post.

[Subsidiary]

*Address*

12. (1) Where any person is by the Act or these Rules bound to furnish the Registrar with an address, the address given shall in all cases be as full as possible, for the purpose of enabling any person easily to find the place of trade or business of the person whose address is given. Address.

(2) The Registrar may require the address to include the name of the street and the plot number in the street of the premises.

13. (1) The Registrar may require an applicant, opponent or agent, or a registered proprietor or registered user of a trade mark, who does not reside or carry on business within Kenya to give an address for service within Kenya, and that address may be treated as the actual address of that person for all purposes connected with the matter in question. Address for service.

(2) Any registered proprietor or registered user of a trade mark, or any person about to be registered as such, may give in form TM 32 an address for service for entry in the register, and such address may be entered by the Registrar.

(3) All applications in form TM 32 under this rule shall be signed by the applicant for registration or the registered proprietor or registered user, as the case may be, or by an agent expressly authorized by him for the purpose of such an application, unless in exceptional circumstances the Registrar otherwise allows.

(4) In any case in which no address for service is entered in the register, the Registrar may treat the trade or business address of the registered proprietor or registered user as therein entered as his address for service for all purposes connected with the registration.

(5) Any written communication addressed to a party or person as aforesaid at an address given by him, or treated by the Registrar, as his address for service shall be deemed to be properly addressed.

(6) The Registrar, at any time that a doubt arises as to the continued availability of an address for service entered in the register, may request the person for whom it is entered, by letter addressed to his trade or business address in the register, to confirm the address for service, and if within three months of making such a request the Registrar receives no confirmation of that address he may strike it off the register.

*Agents*

14. (1) Except as otherwise required by these Rules, any application, request or notice which is required or permitted by the Act or these Rules to be made or given to the Registrar or the court, and all other communications between an applicant or a person making such a request or giving such a notice and the Registrar, or the court, and between the registered proprietor or a registered user of a trade mark and the Registrar or the court or any other Agency.

[Subsidiary]

person, may be signed, made or given by or through an agent.

(2) Any such applicant, person making request or giving notice, proprietor or registered user may appoint an agent to act for him in any proceeding or matter before or affecting the Registrar or the court under the Act and these Rules by signing and sending to the Registrar or the court, as the case may be, an authority to that effect in form TM 1 or in such other written form as the Registrar or the court may deem sufficient.

(3) In case of such appointment, service upon the agent of any document relating to the proceeding or matter shall be deemed to be service upon the person so appointing him, all communications directed to be made to that person in respect of the proceeding or matter may be addressed to the agent, and all attendances upon the Registrar relating thereto may be made by or through the agent.

(4) In any particular case the Registrar may require the personal signature or presence of an applicant, opponent, proprietor, registered user or other person.

*Registrable Trade Marks and Preliminary Advice (Section 43)*

Registrable  
trade marks.

15. (1) The Registrar may refuse to accept any application for the registration of a mark upon which any of the following appear-

- (a) the words "Patent", "Patented", "Registered", "Registered Design", "Copyright", "Entered at Stationer's Hall" or "To counterfeit this is a forgery", or words to similar effect;
- (b) representations of the Head of State of any foreign state, or any colourable imitation thereof;
- (c) the words "Red Cross", or "Geneva Cross", and representations of the Geneva and other crosses in red, or of the Swiss Federal cross in white on a red ground or silver on a red ground, or such representations in a similar colour or colours.

(2) Where there appears in a trade mark the registration of which is applied for a representation of a cross in any colour, not being one of those mentioned in subparagraph (c) of paragraph (1), the Registrar may require the applicant as a condition of acceptance to undertake not to use the cross device on red, or in white on a red ground or silver on a red ground, or in any similar colour or colours.

Flags, emblems,  
arms, etc.

16. Representations in any form of any of the following, or any device so nearly resembling them as to be likely to lead to mistake, may not appear on trade marks the registration of which is applied for-

- (a) without the written permission of the competent authority, any specified emblem, specified likeness or specified name within the meaning of section 2 of the National Flag, Emblems and Names

Cap. 99.

[Subsidiary]

Act;

- (b) without the written permission of the competent authority, any honour or award, or any title or abbreviation of a title thereof, created by the President;
- (c) any armorial bearing, insignia or flag of any foreign state or international intergovernmental organization;
- (d) any honour or award, or any title or abbreviation of a title thereof, of any foreign state;
- (e) any title or abbreviation thereof of any international intergovernmental organization.

17. Where a representation in any form of the armorial bearings, insignia, orders of chivalry, decorations or flags of any city, borough, town, place, society, body corporate, institution or person appears on a mark, the Registrar, before proceeding to register the mark, may require to be furnished with a consent to the registration and use of those emblems from such official or other person as appears to the Registrar to be entitled to give consent, and in default of that consent he may refuse to register the mark.

Arms of city, etc.

18. Where the name or representation of any person appears on a trade mark, the Registrar may require, before proceeding to register the mark to be furnished with consent from him or, in the case of a person recently dead, from his legal representatives, and in default of that consent he may refuse to register the mark.

Living persons or persons recently dead.

19. (1) Where the name or description of any goods or the name or description of any services appears on a trade mark the Registrar may refuse to register such mark in respect of any goods or services, as the case may be, other than the goods or services so named or described.

Name and description of goods or services on a trade mark. 42 of 1995.

(2) Where the name or description of any goods or the name or description of any services appears on a trade mark, and the name or description in use varies, the Registrar may permit the registration of the mark for these and other goods or services, as the case may be, and in that case the applicant shall state in his application that the name or description will be varied when the mark is used upon goods or services covered by the specification other than the named or described goods or services.

20. (1) A person who proposes to apply for the registration of a trade mark in relation to goods or services may apply to the Registrar for advice as to whether the trade mark appears to the Registrar *prima facie* to be inherently adapted to distinguish the goods or services within the meaning of section 12 of the Act or to be inherently capable of distinguishing the goods or services within the meaning of section 13 of the Act.

Preliminary advice by Registrar as to distinctiveness. 42 of 1995, L.N. 146/2003.

(1A) An application under paragraph (1) shall be in form TM 27 and shall be accompanied by duplicate representations of the trade mark.

## [Subsidiary]

(2) A notice of withdrawal of an application for the registration of a trade mark given under subsection (3) of section 43 of the Act for the purpose of obtaining repayment of any fee paid on the filing of the application shall be given in writing within two months from the date of the notice of the Registrar's objection.

*Application for Registration of a Trade Mark*

Form of application.  
L.N. 42/1995,  
L.N. 146/2003.

21. (1) An application to the Registrar for registration of a trade mark shall be in form TM 2 and shall be signed by the applicant or his agent.

(2) Every application claiming priority under section 65 of the Act shall state the date of the application in the United Kingdom or foreign state, and the applicant shall furnish a certificate by the Registrar or other registering authority of that country, or shall otherwise verify the application made or deemed to have been made therein to the satisfaction of the Registrar.

(3) In the case of an application for registration in respect of all the goods or services included in a class, or of a large variety of goods or services, the Registrar may refuse to accept the application unless he is satisfied that the specification is justified by the use of the mark which the applicant has made, or intends to make if it is registered.

(4) An application for registration of a trade mark that is three dimensional shall include a statement to that effect.

(5) An application for registration of a trade mark of which colour is claimed as an element shall include a statement to that effect.

(6) An application for registration of a trade mark that includes a word without regard to its graphical form shall include a statement to that effect.

(7) The specification of an application for registration of a trade mark for goods or services in more than one class, shall set out the classes in the same order as they appear in the classification referred to in section 6 (2) of the Act.

Representation of  
mark.

22. (1) Every application for the registration of a trade mark shall contain a representation of the mark in the space provided on the application form for that purpose.

(2) Where the representation exceeds the space in size, the representation shall be mounted upon linen, tracing cloth or such other material as the Registrar may consider suitable; part of the mounting shall be affixed in the space and the rest may be folded.

23. *(Deleted by L.N. 146/2003, s.7).*

24. *(Deleted by L.N. 146/2003, s.7).*

Separate applications.

25. Applications for the registration of the same mark in different classes

shall be treated as separate and distinct applications, and in all cases where a trade mark is registered under the same official number for goods or services in more than one class, whether on conversion of the specification under rule 6 or otherwise, the registration in respect of the goods or services included in each separate class shall be deemed to be a separate registration for all the purposes of the Act.

[Subsidiary]  
L.N. 42/1995.

26. The Registrar, if dissatisfied with any representation of a mark, may at any time require another representation satisfactory to him to be submitted before proceeding with the application.

Representations to be satisfactory.

27. (1) Where a drawing or other representation or specimen cannot be given as prescribed in these Rules, a specimen or copy of the trade mark may be sent either of full size or on a reduced scale, and in such form as the Registrar may think most convenient.

Specimens of trade marks in exceptional cases.

(2) The Registrar may also, in exceptional cases, deposit in the office a specimen or copy of any trade mark which cannot conveniently be shown by a representation, and may refer thereto in the register in such manner as he may think fit.

28. If application is made for the registration of a series of trade marks under section 24 (3) of the Act, a representation of each trade mark in the series shall be included in the application.

Series of trade marks.  
L.N. 146/2003.

29. (1) Where a trade mark contains a word or words in characters other than Roman, there shall, unless the Registrar otherwise directs, be endorsed on the application form, a sufficient transliteration and translation to the satisfaction of the Registrar of each of the words, and every such endorsement shall state the language to which the word belongs and shall be signed by the applicant or his agent.

Transliteration and translation.  
L.N.146/2003.

(2) Where a trade mark contains a word or words in a language other than English, the Registrar may ask for an exact translation thereof together with the name of the language, and the translation and name, if he so requires, shall be so endorsed and signed.

29A. (1) The proprietor of a registered trade mark may apply to the registrar to add goods or services to the goods or services in respect of which the trade mark is registered, including goods or services in an additional class or classes.

Application to add goods or services.  
L.N.146/2003.

(2) An applicant for the registration of a trade mark may apply to the Registrar to amend the application to add goods or services to the goods or services in respect of which the trade mark would be registered, including goods or services in an additional class or classes.

(3) An application under this rule shall be in form TM 55.

(4) These Rules shall apply, with necessary modifications, with respect to an application under this rule as though it were an application for registration of a trade mark.

## [Subsidiary]

*Procedure on Receipt of Application for Registration of a Trade Mark*

Search.  
L.N. 42/1995.

30. Upon receipt of an application for the registration of a trade mark in respect of any goods or services, as the case may be, the Registrar shall cause a search to be made amongst the registered marks and pending applications for the purpose of ascertaining whether-

- (a) in the case of an application relating to goods, there are on record for the same goods or for the same description of goods or for services or a description of services associated with the goods or goods of that description; or
- (b) in the case of application relating to services, there are on record for the same services or for the same description of services or for goods or a description of goods associated with the services of that description;

any marks identical with the mark applied for, or which so nearly resemble it as to render the mark applied for likely to deceive or cause confusion, and the Registrar may cause the search to be renewed at any time before the acceptance of the application, but shall not be bound to do so.

Registrar's powers on application.

31. After a search, and consideration of the application, and of any evidence of use or of distinctiveness or of any other matter which the applicant may or may be required to furnish, the Registrar may accept the application absolutely, or he may object to it, or he may express his willingness to accept it subject to such conditions, amendments, disclaimer, modifications or limitations as he may think right to impose.

Objection by Registrar.  
L.N. 42/1995,  
L.N. 146/2003.

32. If the Registrar objects to the application, he shall inform the applicant of his objections in writing, and unless within ninety days the applicant applies for a hearing or makes a considered reply in writing to those objections he shall be deemed to have withdrawn his application.

Conditions by Registrar.  
L.N. 42/1995,  
L.N. 146/2003.

33. (1) If the Registrar is willing to accept the application subject to any conditions, amendments, disclaimer, modifications or limitations, he shall communicate his willingness to the applicant in writing, and, if the applicant objects to the conditions, amendments, disclaimer, modifications or limitations, he shall within ninety days from the date of the communication apply for a hearing or communicate his considered objections in writing, and if he does not do so he shall be deemed to have withdrawn his application.

(2) If the applicant does not object to the conditions, amendments, disclaimer, modifications or limitations, he shall within thirty days from the date of receipt of the Registrar's communication notify the Registrar in writing, and alter his application accordingly.

Decision of Registrar.  
L.N. 42/1995,  
L.N. 146/2003.

34. (1) The decision of the Registrar, at a hearing under rule 32 or rule 33, or without a hearing if the applicant has duly communicated his considered objections or considered reply, in writing, and has stated that he does not desire to be heard, shall be communicated to the applicant in writing, and if the applicant

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objects to the decision he may within thirty days from the date of receipt of the decision by applying in form TM 4, require the Registrar to state in writing the grounds of, and the materials used by him in arriving at, his decision.

(2) In a case where the Registrar makes any requirements to which the applicant does not object, the applicant shall comply therewith before the Registrar issues the statement in writing; and the date when the statement is sent to the applicant shall be deemed to be the date of the Registrar's decision for the purpose of appeal.

35. The Registrar may call on an applicant to insert in his application such disclaimer as the Registrar may think fit, in order that the public generally may understand what the applicant's rights, if his mark is registered, will be.

Disclaimer.

*Defensive Trade Marks*

36. (1) An application to the Registrar for registration of a defensive trade mark under section 30 of the Act shall be in form TM 2 and shall be accompanied by a statement of case setting forth full particulars of the facts on which the applicant relies in support of his application, verified by a statutory declaration made by the applicant or some other person approved for the purpose by the Registrar.

Application under s.30 of the Act. L.N. 146/2003.

(2) The applicant may send with this declaration, or subsequently, such other evidence as he may desire to furnish, whether after request made by the Registrar or otherwise, and the Registrar shall consider the whole of the evidence before deciding on the application.

(3) In all other respects, and where they are appropriate and it is not otherwise stated, these Rules shall apply to such applications as they apply to applications for the registration of ordinary trade marks.

*Certification Trade Marks*

37. An application to the Registrar for registration of a certification trade mark under section 40 of the Act shall be in form TM 2.

Application under s. 40 of the Act. L.N. 146/2003.

38. These Rules shall apply to applications under rule 37 as they apply to applications for the registration of ordinary trade marks, except that the applicant shall not be deemed to have abandoned his application if in the circumstances of rule 32 or rule 33 he does not apply for a hearing or reply in writing.

Authorization to proceed.

39. (1) The applicant shall send to the Registrar, with his application or when required by the Registrar, a case setting out the grounds on which he relies in support of his application together with draft regulations for governing the use of the mark, all in duplicate.

Case, draft regulations. L.N. 146/2003.

(2) The Registrar may communicate to the applicant any observations he may have to make on the sufficiency of the case or the suitability of the draft regulations and the applicant may modify either of those documents.

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Regulations and application to be open to inspection.

40. If the Registrar decides to accept the application the regulations for governing the use of the mark approved by the Registrar, as well as the form of application, shall be open to public inspection.

Registrar's refusal.

41. If the Registrar decides to refuse to accept the regulations or to accept the regulations subject to conditions, limitations, amendments or modifications, he shall inform the applicant of his objections in writing and shall, if required, hear the applicant.

*Advertisement of Application*

Advertisement of application.  
L.N. 146/2003.

42. (1) An application for the registration of a trade mark shall be advertised in the Journal or Kenya Gazette in such manner as the Registrar may direct.

(1A) If an application that has been advertised under paragraph (1) is withdrawn, the withdrawal shall be advertised in the Journal or Kenya Gazette in such manner as the Registrar may direct.

(2) In the case of an application with which the Registrar proceeds only after the applicant has lodged the written consent to the proposed registration of the registered proprietor of another trade mark or another applicant, the words "By Consent" shall appear in the advertisement.

(3) If no representation of the trade mark is included in the advertisement of the application, the Registrar shall refer in the advertisement to the place or places where a specimen or representation of the trade mark is deposited for exhibition.

Representations or information from applicant.  
L.N. 146/2003.

43. For the purpose of advertising a trade mark, the Registrar may, at the appropriate time, require the applicant to supply-

- (a) up to ten printed representations of the trade mark satisfactory to the Registrar; or
- (b) such other information or means of advertising the trade mark as the Registrar requires.

Advertising of series of trade marks.  
L.N. 146/2003.

44. The following shall apply if the application relates to a series of trade marks differing from one another in respect of the particulars mentioned in section 24 (3) of the Act-

- (a) rule 43 shall apply with respect to each of the trade marks in the series; and
- (b) the Registrar may, instead of advertising a representation of each of the trade marks in the series, include with the advertisement a statement describing how the trade marks differ from each other.

Advertisements

45. Advertisements under section 21 (10) and 38 (2) and (4) of the

Act shall be made in the same manner as advertisements of applications for registration and rules 42 to 44 and rule 45A shall apply with necessary modifications.	[Subsidiary] under s.21(10) and 38 (2), (4) of the Act. L.N. 146/2003.
45A. Before an advertisement relating to an application is published, the applicant shall pay the costs of the advertisement.	Costs of advertisement. L.N.146/2003.
<i>Opposition to Registration</i>	
46. Any person may, within sixty days from the date of any advertisement in the Journal or Kenya Gazette of an application for registration of a trade mark, give notice in form TM 6 to the Registrar of opposition to the registration.	Opposition. L.N. 146/2003.
47. (1) The notice shall include a statement of the grounds upon which the opponent objects to the registration.	Notice of opposition. L.N. 146/2003.
(2) If the registration is opposed on the ground that the mark resembles marks already on the register, the notice shall set out-	
(a) the numbers of those other marks; and	
(b) references to the Journals or Kenya Gazettes in which those other marks were advertised.	
(3) The notice shall be accompanied by a duplicate, which the Registrar shall forthwith send to the applicant.	
48. Within forty-two days from the receipt of the duplicate the applicant shall send to the Registrar a counter-statement in form TM 7 setting out the grounds on which he relies as supporting his application.	Counter-statement. L.N. 146/2003.
(2) The applicant shall also set out what facts, if any, alleged in the notice of opposition he admits.	
(3) The counter-statement shall be accompanied by a duplicate.	
(4) Upon receipt of the counter-statement and duplicate the Registrar shall forthwith send the duplicate to the opponent.	
49. (1) Within forty-two days after the receipt of the duplicate counter-statement, the opponent shall leave with the Registrar such evidence by way of statutory declaration as he desires to adduce in support of his opposition.	Evidence in support of opposition. L.N. 146/2003.
(2) The statutory declaration shall be in duplicate.	
(3) Upon receipt of the statutory declaration and duplicate the Registrar shall forthwith send the duplicate to the applicant.	
50. (1) Within forty-two days after the receipt of the statutory declaration of the opponent under rule 49, the applicant shall leave with the Registrar such	Evidence in support of application.

**[Subsidiary]**

L.N. 146/2003.

evidence by way of statutory declaration as he desires to adduce in support of his application.

(2) The statutory declaration shall be in duplicate.

(3) Upon receipt of the statutory declaration and duplicate the Registrar shall forthwith send the duplicate to the opponent.

Evidence in reply by opponent.

L.N. 146/2003.

51. (1) Within thirty days after the receipt of the statutory declaration of the applicant under rule 50, the opponent may leave with the Registrar evidence, by way of statutory declaration, confined strictly to matters in reply.

(2) The statutory declaration shall be in duplicate.

(3) Upon receipt of the statutory declaration and duplicate the Registrar shall forthwith send the duplicate to the applicant.

Further evidence.

52. No further evidence shall be left on either side, but, in any proceedings before the Registrar, he may at any time give leave to either the applicant or the opponent to leave any evidence upon such terms as to costs or otherwise as he may think fit.

Abandonment of application or opposition.

L.N. 146/2003.

52A. If the applicant or opponent fails to furnish the required counter-statement or evidence in support within the times prescribed by rules 48 to 50, the application or opposition, as the case may be, shall be deemed to be abandoned and the Registrar may proceed to make an award of costs.

Exhibits.

53. (1) Where there are exhibits to declarations filed in an opposition, copies or impressions of such exhibits shall be sent to the other party on his request and at his expense, or, if such copies or impressions cannot conveniently be furnished, the originals shall be left with the Registrar in order that they may be open to inspection.

(2) The original exhibits shall be produced at the hearing unless the Registrar otherwise directs.

Hearing.

54. (1) Upon completion of the evidence, the Registrar shall give notice to the parties of a date when he will hear the arguments in the case.

(2) An appointment shall be for a date at least fourteen days after the date of the notice, unless the parties consent to a shorter notice.

(3) Within seven days from the receipt of the notice any party who intends to appear shall so notify the Registrar in form TM 8.

(4) A party who receives notice and who does not, within seven days from the receipt thereof, so notify the Registrar in form TM 8, may be treated as not desiring to be heard and the Registrar may act accordingly.

55. (*Deleted by L.N.146/2003, s. 24*).

Security for costs.

56. Where a party giving notice of opposition or an applicant sending

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a counter-statement after receipt of a copy of such a notice neither resides nor carries on business in Kenya, the Registrar may require him to give security, in such form as the Registrar may deem sufficient, for the costs of the proceedings before the Registrar, for such amount as to the Registrar may seem fit, and at any stage in the opposition proceedings may require further security to be given at any time before his decision in the case.

57. In the event of an opposition being uncontested by the applicant, the Registrar in deciding whether costs should be awarded to the opponent shall consider whether proceedings might have been avoided if reasonable notice had been given by the opponent to the applicant before the notice of opposition was lodged.

Costs in uncontested case.

58. (*Deleted by L.N.146/2003, s.25*).

#### *Non-Completion*

59. (1) Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar shall in form TM 9A give notice in writing to the applicant at his trade or business address of the non-completion, but if the applicant has authorized an agent for the purpose of the application he shall instead send the notice to the agent and shall send a duplicate thereof to the applicant.

Non-completion of registration.

(2) If after fourteen days from the date when the notice was sent, or such further time as the Registrar may allow, the registration is not completed, the application shall be deemed to be abandoned.

#### *Entry in the Register, and Associated Marks*

60. (1) As soon as may be after the expiration of sixty days from the date of the advertisement in the Journal or Kenya Gazette of any application for the registration of a trade mark, the Registrar shall, subject to any opposition and the determination thereof, and subject to the provisions of subsection (1) of section 22 of the Act, and upon payment of the prescribed fee, enter the trade mark in the register.

Entry in register.  
L.N. 42/1995.  
L.N. 146/2003.

(2) The entry of a trade mark in a register shall give the date of registration, the goods or services in respect of which it is registered together with the particulars of the trade, business, profession, occupation or other description of the proprietor, particulars of any undertakings of the proprietor entered on the form of application, particulars affecting the scope of the registration or the rights conferred by the registration, and such other particulars as are prescribed.

(3) In the case of an application which the Registrar accepts only after the applicant has lodged the written consent to the proposed registration of the registered proprietor of another trade mark or another applicant for registration, the entry in the register shall state that it is "By Consent" and shall give the number of the previous registration or the application for registration.

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Notations indicating association no longer of any effect.

L.N. 146/2003.

61. A notation in the Register included as a result of a trade mark having been associated with another trade mark under section 26 of the Act before that section was repealed is of no effect.

Death of applicant before registration.

62. In case of the death of any applicant for the registration of a trade mark after the date of his application and before the trade mark applied for has been entered in the register, the Registrar, after the expiration of the prescribed period of advertisement and the determination of any opposition to the application, may, on being satisfied of the applicant's death, enter in the register, in place of the name of the deceased applicant, the name, address and description of the person owning the trade mark, on ownership being proved to the satisfaction of the Registrar.

Certificate of registration.

L.N. 146/2003.

63. Upon the registration of a trade mark the Registrar shall issue to the applicant a certificate in form TM 10A, and shall affix thereto a copy of the mark.

### *Renewal*

Renewal of registration.

L.N. 146/2003.

64. (1) At any time not more than ninety days before the expiration of the last registration of a trade mark, any person may leave at the office a fee for the renewal of the registration of the mark in form TM 10, and, if he is not the registered proprietor, shall sign a statement on the form that he is directed by the registered proprietor to pay the fee (if such be the case) and shall give his address.

(2) Before taking any further step, the Registrar may either-

- (a) require the person leaving the fee to furnish within ten days an authority to pay the fee signed by the registered proprietor, and if he does not furnish that authority may return the fee and treat it as not received; or
- (b) communicate with the registered proprietor stating that the fee has been received and that the registration will in due course be renewed.

Notice before removal of trade mark from register.

L.N. 146/2003.

65. At a date not less than thirty days and not more than sixty days before the expiration of the last registration of a mark, if no fee in form TM 10 has been received, the Registrar shall notify the registered proprietor in writing of the approaching expiration.

Second notice.

L.N. 146/2003.

66. At a time not less than fourteen days and not more than thirty days before the expiration of the last registration of a mark, the Registrar may, if no renewal fee has been received, send a notice in writing to the registered proprietor at his trade or business address as well as at his address for service, if any.

Advertisement of non-payment.

67. If at the date of the expiration of the last registration of a mark the renewal fee has not been paid, the Registrar shall advertise the fact forthwith in the Journal or Kenya Gazette, and, if within one month after that advertisement

<p>the renewal fee in form TM 10, together with the additional prescribed late renewal fee, is received, he may renew the registration without removing the mark from the register.</p>	<p>[Subsidiary] L.N. 146/2003.</p>
<p>68. If, at the expiration of thirty days after the advertisement under rule 67, the fees referred to in that rule have not been paid, the Registrar may remove the mark from the register as of the date of the expiration of the last registration, but he may, upon payment of the renewal fee in form TM 10 together with the additional prescribed restoration fee, restore the mark to the register if satisfied that it is just to do so, and upon such conditions as he may think fit to impose.</p>	<p>Removal of trade mark from Register. L.N. 146/2003.</p>
<p>69. Where a trade mark has been removed from the register, the Registrar shall cause to be entered in the register a record of the removal and of the cause thereof.</p>	<p>Record of removal of mark.</p>
<p>70. Upon the renewal or restoration and renewal of a registration, a notice to that effect shall be sent to the registered proprietor and the renewal or restoration and renewal shall be advertised in the Journal or Kenya Gazette.</p>	<p>Notice and advertisement of renewal and restoration. L.N. 146/2003.</p>
<p><i>Assignments and Transmissions</i></p>	
<p>71. A person who becomes entitled by assignment or transmission to a registered trade mark may apply, in form TM 14, to the Registrar to register his title.</p>	<p>Application for entry of assignment or transmission. L.N. 146/2003.</p>
<p>72. <i>(Deleted by L.N.146/2003, s.34).</i></p>	
<p>73. (1) An application under rule 71 shall contain the name, trade or business address and description of the person claiming to be entitled and shall be accompanied by a copy of the instrument, if any, under which the person claims.</p>	<p>Particulars to be stated in application. L.N. 146/2003.</p>
<p>(2) The full names of all the partners in a partnership shall be given in the body of the application.</p>	
<p>(3) The Registrar may in any case require and retain an attested copy of any instrument produced for inspection in proof of title, but that copy shall not be open to public inspection.</p>	
<p>74. If the person applying for registration of his title does no claim under any document or instrument which is capable in itself of furnishing proof of his title, he shall, unless the Registrar otherwise directs, either upon or with the application, state a case setting forth the full particulars of the facts upon which his claim to be proprietor of the trade mark is based, and showing that the trade mark has been assigned or transmitted to him; and if the Registrar so requires, the case shall be verified by a statutory declaration.</p>	<p>Case accompanying application. L.N. 146/2003.</p>
<p>75. The Registrar may call on any person who applies to be registered as proprietor of a registered trade mark for such proof or additional proof of</p>	<p>Proof of title.</p>

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title as he may require for his satisfaction.

Application for entry of assignment without goodwill.  
L.N. 42/1995,  
L.N. 146/2003.

76. (1) An application under rule 71 relating to an assignment on or after the appointed day of a trade mark in respect of any goods or services shall state-

(a) whether the trade mark was, at the time of the assignment, used in a business in any of those goods or services, as the case may be; and

(b) whether the assignment was made otherwise than in connexion with the goodwill of that business;

and, if both those circumstances subsisted, the applicant shall leave with the Registrar a copy of the Registrar's directions to advertise the assignment, obtained upon application under subsection (7) of section 25 of the Act and rule 80 of these Rules, and such proof, including copies of advertisements or otherwise, as the Registrar may require that his directions have been fulfilled; and if the Registrar is not satisfied that the directions have been fulfilled, he shall not proceed with the application.

(2) For the purposes of section 32(4) of the Act, the period within which a corporation may be registered as the subsequent proprietor shall be six months after the date of advertisement of the registration in the Journal or Kenya Gazette.

Entry in register.  
L.N. 42/1995.

77. When the Registrar is satisfied as to the title of the person claiming to be registered, he shall cause him to be registered as proprietor of the trade mark in respect of the relevant goods or services, and shall enter in the register his name, trade or business address and description and particulars of the assignment or transmission.

Separate registrations.  
L.N. 42/1995,  
L.N. 146/2003.

78. Where, pursuant to an application under rule 71, and as the result of a division and separation of the goods or services of a registration or a division and separation of places or markets, different persons become registered separately under the same official number as subsequent proprietors of a trade mark, each of the resulting separate registrations in the names of those different persons shall be deemed to be a separate registration for all the purposes of the Act.

Registrar's certificate of approval as to certain assignments and transmissions.  
L.N. 146/2003.

79. (1) Any person who desires to obtain the Registrar's certificate under subsection (5), or his notification of approval under subsection (6), of section 25 of the Act shall send to the Registrar, with his application in form TM 39 or 40, as the case may be, a statement of case in duplicate setting out the circumstances, and a copy of any instrument or proposed instrument effecting the assignment or transmission.

(2) The Registrar may call for any evidence or further information that he may consider necessary, and the statement of case shall be amended if required to include all the relevant circumstances, and shall if required be verified by a statutory declaration.

(3) The Registrar, after hearing if so required the applicant and any other

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person whom the Registrar may consider to be interested in the transfer, shall consider the matter and issue a certificate thereon or a notification in writing of approval or disapproval thereof, as the case may be.

(4) Where a statement of case is amended, two fair copies thereof in its final form shall be left with the Registrar.

(5) The Registrar shall seal a copy of the statement of case in its final form to the certificate or notification.

80. (1) An application to the Registrar under subsection (7) of section 25 of the Act shall be made by the assignee in form TM 41, and shall state the date on which the assignment was made.

Registrar's directions for advertisement of assignment without goodwill of trade mark in use.  
L.N. 146/2003.

(2) The application shall give particulars of the registration in the case of a registered trade mark, and, in the case of an unregistered trade mark, shall show the mark and give particulars of the registered trade mark that has been assigned therewith in accordance with sub-section (3) of section 25.

(3) The Registrar may call for any evidence or further information, and if he is satisfied with regard to the various matters he shall issue directions in writing with respect to the advertisement of the assignment.

(4) The Registrar may refuse to consider such an application in a case to which subsection (6) of section 25 applies unless his approval has been obtained under the said subsection and a reference identifying the Registrar's notification of approval is included in the application.

(5) (*Deleted by L.N.146/2003, s.40*).

#### *Alteration of Address*

81. (1) A registered proprietor or registered user of a trade mark whose trade or business address is changed so that the entry in the register is rendered incorrect shall forthwith request the Registrar in form TM 17 to make the appropriate alteration of the address in the register, and the Registrar shall alter the register accordingly if he is satisfied in the matter.

Alteration of address in register.

(2) A registered proprietor or registered user of a trade mark whose address for service in Kenya entered in the register is changed, whether by discontinuance of the entered address or otherwise, so that the entry in the register is rendered incorrect, shall forthwith request the Registrar in form TM 32 to make the appropriate alteration of the address in the register, and the Registrar shall alter the register accordingly if he is satisfied in the matter.

(3) A registered proprietor or registered user of a trade mark whose registered trade or business address or address for service is altered by a public authority, so that the changed address designates the same premises as before, may make the request to the Registrar, but in that case no fee shall be payable, and if he does so he shall leave therewith a certificate of the alteration given by the authority; and if the Registrar is satisfied as to the facts of the case he

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shall alter the register accordingly.

(4) In the case of the alteration of the address of a person entered in the register as the address for service of more than one registered proprietor or registered user of trade marks, the Registrar may, on proof that the address is the address of the applicant and if satisfied that it is just to do so, accept an application from that person in form TM 32 amended so as to suit the case for the appropriate alteration of the entries of his address as the address for service in the several registrations, particulars of which shall be given in the form, and may alter the entries accordingly.

(5) All applications under this rule in form TM 32 shall be signed by the registered proprietor or the registered user, as the case may be, or by an agent, expressly authorized by him for the purpose of such an application, unless in exceptional circumstances the Registrar otherwise allows.

*Applications to the Registrar for Rectification*  
(Sections 29, 30, 35 and 36)

Application to rectify or remove a trade mark from the register.  
L.N. 146/2003.

82. (1) An application to the Registrar under any of the sections 29, 30, 35 and 36 of the Act for the making, expunging or varying of any entry in the register shall be made in form TM 25 and shall be accompanied by a statement setting out fully the nature of the applicant's interest, the facts upon which he bases his case and the relief which he seeks.

(2) The application shall be accompanied by a copy of the application and a copy of the statement and the Registrar shall forthwith transmit the copies to the registered proprietor.

Further procedure.  
L.N. 146/2003.

83. Rules 48 to 57 shall apply with respect to the further proceedings relating to an application in form TM 25, with necessary modifications and with the following specific modifications-

(a) references to the applicant shall be deemed to be references to the registered proprietor and references to the opponent shall be deemed to be references to the person making the application under rule 25;

(b) the Registrar shall not rectify the register or remove the mark from the register merely because the registered proprietor has not filed a counterstatement.

Intervention by third parties.

84. (1) Any person other than the registered proprietor alleging interest in a registered trade mark in respect of which an application is made in form TM 25 may apply to the Registrar in form TM 26 for leave to intervene, stating thereon the nature of his interest, and the Registrar may refuse or grant leave, after hearing (if so required) the parties concerned, upon such conditions and terms as he may deem fit.

(2) Before dealing in any way with the application for leave to intervene the Registrar may require the applicant to give an undertaking to pay such costs as in the circumstances he may award to any party.

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*Surrender of a Registered Trade Mark*

84A. (1) An application to surrender a registered trade mark under section 36A (1) of the Act shall be made to the Registrar- Application to surrender.

(a) in form TM 21, if the surrender is for all of the goods or services in respect of which the trade mark is registered; or

(b) in form TM 22, if the surrender is for some of the goods or services in respect of which the trade mark is registered.

(2) An application under paragraph (1) shall-

(a) set out the name and address of each person who has a registered interest in the trade mark; and

(b) include a certification by the proprietor that each person referred to in subparagraph (a) either-

(i) has been given notice of the proposed surrender at least ninety days before the application is made; or

(ii) is not affected by the surrender or has consented to it.

(3) After making the appropriate entries in the Register, the Registrar shall publish a notice of the surrender in the Journal or Kenya Gazette.

*Applications for Alteration of the Register by Correction, Change, Cancellation or Striking out Goods or for Entry of Disclaimer, Memorandum or Note (Section 37 (1))*

85. (1) An application to the Registrar under subsection (1) of section 37 of the Act for the alteration of the register by correction, or change or for the entry of a disclaimer or memorandum, may be made by the registered proprietor of the trade mark or by such person as may satisfy the Registrar that he is entitled to act in the name of the registered proprietor. Application under section 37 (1). L.N. 42/1995, L.N. 146/2003.

(2) An application under paragraphs (a), (b) or (e) of section 37 (1) of the Act shall be in form TM 17, TM 19, TM 20, TM 23 or TM 32, as may be appropriate.

(3) An application under paragraph (c) or (d) of section 37 (1) of the Act shall be made in accordance with rule 84A.

(4) For greater certainty, form TM 20 may be used to change the name of the registered proprietor if the registered proprietor merges with another corporation and the corporation resulting from the merger has a different name.

86. In the case of an application as in rule 85, the Registrar may require Evidence. such evidence by statutory declaration or otherwise as he may think fit as to

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the circumstances in which the application is made.

Advertisement of  
certain applications.  
L.N. 146/2003.

87. Where application is made in form TM 23 to enter a disclaimer or memorandum relating to a trade mark, the Registrar, before deciding upon such application, shall advertise the application in the Journal or Kenya Gazette in order to enable any person desiring so to do to state, within thirty days of the advertisement, any reasons in writing against the making of the entry of the disclaimer or memorandum.

Certificates of  
validity to be noted.  
L.N. 146/2003.

88. Where the court has certified under section 47 of the Act with regard to the validity of a registered trade mark, the registered proprietor thereof may request the Registrar in form TM 47 to add to the entry in the register a note that the certificate of validity has been granted in the course of the proceedings, which shall be named in the form; an office copy of the certificate shall be sent with the request, and the Registrar shall so note the register and publish the note in the Journal or Kenya Gazette.

*Applications to Alter Registered Trade Marks*

Alteration of  
registered mark.  
L.N. 146/2003.

89. Where a person desires to apply under section 38 of the Act that his registered trade mark may be added to or altered, he shall make his application in writing in form TM 24.

Advertisement before  
decision.  
L.N. 146/2003.

90. (1) The Registrar shall consider the application and shall, if it appears to him to be expedient, advertise the application in accordance with rule 45 and rules 43, 44 and 45A shall apply with necessary modifications.

(2) Any person may, within thirty days after the date of the advertisement of the application, give notice in form TM 6 to the Registrar of opposition to the application and rules 47 to 57 shall apply with necessary modifications.

(3) The Registrar shall send the duplicate notice, and the duplicate of any further statement of objections, to the applicant, and the provisions of rules 48 to 57 shall apply *mutatis mutandis* to the further proceedings thereon; and in any case of doubt any party may apply to the Registrar for directions.

Decision of Registrar.  
L.N. 146/2003.

91. If the Registrar decides to allow the application he shall add to or alter the mark in the register, and if the mark so added to or altered has not been advertised under rule 90 he shall advertise it in the Journal or Kenya Gazette, and in any case shall insert in the Gazette a notification that the mark has been altered.

Advertisement.  
L.N. 146/2003.

92. If the Registrar is of the opinion that an advertisement describing the addition or alteration to the trade mark would not likely be understood by persons interested in the matter, the Registrar may make a requirement under rule 43.

*Court Orders for Rectification of Certification Trade Mark Entries and Regulations*

Rectification of

93. An application on any of the grounds mentioned in paragraph 4 of the First Schedule to the Act, made by an aggrieved person to the court

for an order expunging or varying an entry in the register of or relating to a certification trade mark, or varying the relevant deposited regulations, shall be made in form TM 35 and shall include full particulars of the grounds on which the application is made.

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certification trade  
mark entries by the  
court.

#### *Alteration of Certification Trade Mark Regulations*

94. (1) An application by the registered proprietor of a certification trade mark for an alteration of the deposited regulations shall be made in form TM 34.

Alteration of  
regulations.  
L.N. 146/2003.

(2) Where the Registrar causes such an application to be advertised, the time within which any person may give notice to the Registrar of opposition to the application shall be thirty days from the date of the advertisement.

#### *Collective Trade Marks*

94A. (1) An application to the Registrar for registration of a collective trade mark under section 40A (1) of the Act shall be in form TM 2.

Application for  
registration.  
L.N. 146/2003.

(2) These Rules shall apply, with necessary modifications, to an application for registration of a collective trade mark as they apply to an application for an ordinary trade mark.

#### *Registered Users*

95. An application to the Registrar for the registration under section 31 of the Act of a person as a registered user of a registered trade mark shall be made by that person and the registered proprietor in form TM 48.

Application for entry  
of registered user.

96. (1) The entry of a registered user in the register shall state the date on which it was made; and in addition to the trade or business address of the registered user it may include an address for service, if an application by him in form TM 32 therefor has been approved.

Entry and  
notification.  
L.N. 146/2003.

(2) A notification in writing of the registration of a registered user shall be sent to the registered proprietor of the trade mark, to the registered user and to every other registered user whose name is entered in relation to the same registration of a trade mark, and shall be inserted in the Journal or Kenya Gazette.

97. An application by the registered proprietor of a trade mark for the variation of the registration of a registered user of that trade mark under paragraph (a) of subsection (8) of section 31 of the Act shall be made on form TM 49, and shall be accompanied by a statement of the grounds on which it is made and, where the registered user in question consents, by the written consent of that registered user.

Registered  
proprietor's  
application to vary  
entry.

98. An application by the registered proprietor or any registered user of a trade mark for the cancellation of the registration of a registered user of that trade mark under paragraph (b) of subsection (8) of section 31 of the Act shall be made in form TM 50, and shall be accompanied by a statement of the

Application by  
registered proprietor  
or user to cancel  
entry.

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grounds on which it is made.

Application by any person to cancel entry.

99. An application by any person for the cancellation of the registration of a registered user under paragraph (c) of subsection (8) of section 31 of the Act shall be made in form TM 51, and shall be accompanied by a statement of the grounds on which it is made.

Notification and hearing.  
L.N. 146/2003.

100. The Registrar shall notify in writing applications under rules 97, 98 and 99 to the registered proprietor and each registered user (not being the applicant) under the registration of the trade mark.

(2) Any person so notified who intends to intervene in the proceedings shall, within thirty days of the receipt of the notification, give notice to the Registrar in form TM 52 to that effect, and shall send therewith a statement of the grounds of his intervention; and the Registrar shall thereupon send copies of such notice and statement to the other parties, so that the intervention may be known to the applicant, the registered proprietor, the registered user whose registration is in suit and any other registered user who intervenes.

(3) Any such party may, within such time or times as the Registrar may appoint, leave evidence in support of his case, and the Registrar, after giving the parties an opportunity of being heard, may accept or refuse the application or accept it subject to any conditions, amendments, modifications or limitations as he may think right to impose.

Registered user's application to correct error or enter change.  
L.N. 42/1995,  
L.N. 146/2003.

101. (1) Applications under subsection (2) of section 37 of the Act shall be made in form TM 17, TM 19, TM 20 or TM 32, as may be appropriate, by a registered user of a trade mark, or by such person as may satisfy the Registrar that he is entitled to act in the name of a registered user; and the Registrar may require such evidence by statutory declaration or otherwise as he may think fit as to the circumstances in which the application is made.

(1A) For greater certainty, form TM 20 may be used to apply to change the name of a registered user if the registered user merges with another corporation and the corporation resulting from the merger has a different name.

(2) In case of the registration of a registered user for a period, in accordance with paragraph (d) of subsection (4) of section 31 of the Act, the Registrar shall cancel the entry of the registered user at the end of the period.

(3) Where some or all of the goods or services are struck out from those in respect of which a trade mark is registered, the Registrar shall at the same time strike them out from those specifications of registered users of the trade mark in which they are comprised.

(4) The Registrar shall notify every cancellation or striking out under this rule to the registered users whose permitted use is affected thereby and the registered proprietor of the trade mark.

*Extension of Time*

Extension of time.

102. (1) The Registrar may extend, on such conditions as he may specify,

the time for doing any act or taking any proceedings under these Rules.

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(2) The Registrar may not extend a time expressly provided in the Act, other than the period prescribed under subsection (6) or (7) of section 25 of the Act.

(3) A time limit may not be extended for a period exceeding ninety days, except for a time period prescribed by rule 76 which may be extended for a period not exceeding six months.

(4) An application to the Registrar for an extension of time under paragraph (1) shall be in form TM 53 and shall be filed with the Registrar.

(5) The application shall state the grounds on which the application is based.

(6) An application for an extension of time may be made even though the time has already expired.

(7) The application shall be dealt with upon such notice, and in accordance with such procedures, as the Registrar may direct.

#### *Discretionary Power*

103. Before exercising adversely to any person any discretionary power given to the Registrar by the Act or these Rules, the Registrar shall, if so required, hear that person thereon. Hearing.

104. An application for a hearing shall be made within thirty days from the date of notification by the Registrar of any objection to an application or the date of any other indication that he proposes to exercise a discretionary power. Application for hearing.  
L.N. 146/2003.

105. (1) Upon receiving such application, the Registrar shall give the person applying fourteen days' notice of a time when he may be heard. Notice of hearing

(2) Within seven days from the date when the notice would be delivered in the ordinary course of post, the person applying shall notify the Registrar whether or not he intends to be heard on the matter, and if he intends to appear he shall file form TM 8 and pay the prescribed fee thereon.

106. The decision of the Registrar in the exercise of any such discretionary power shall be notified to the person affected. Notification of decision.

#### *Power to Dispense with Evidence*

107. Where under these Rules a person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Registrar, or at the office, and it is shown to the satisfaction of the Registrar that from any reasonable cause that person is unable to do the act or thing, or to sign the document, or to make the declaration, or that the document or evidence cannot be produced or left, the Registrar may, upon the production Dispensing with evidence.

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of such other evidence, and subject to such terms as he may think fit, dispense with any such act or thing, signature, declaration, document or evidence.

*Amendments*

Amendments of documents.  
L.N. 146/2003.

108. (1) Any document or drawing or other representation of a trade mark may be amended, and any irregularity in procedure which in the opinion of the Registrar may be excused without detriment to the interests of any person may be corrected, if the Registrar thinks fit, and on such terms as he may direct.

(2) An application under paragraph (1) to amend a document or drawing or other representation shall be in form TM 19.

*Certificates*

Certificates by Registrar.

109. (1) The Registrar may give a certificate, other than a certificate under section 22 of the Act, as to any entry, matter or thing which he is authorized or required by the Act or these Rules to make or do, upon receipt of a request therefor in form TM 30 from any person who, if the Registrar thinks fit so to require, can show an interest in the entry, matter or thing to his satisfaction.

(2) Except in a case falling under rule 111, the Registrar shall not be obliged to include in the certificate a copy of any mark, unless he is furnished by the applicant with a copy thereof suitable for the purpose.

Marks registered without limitation of colour.

110. Where a mark is registered without limitation of colour, the Registrar may grant a certificate of its registration for the purpose of obtaining registration abroad either in the colour in which it appears upon the register or in any other colour or colours.

Certificates for use in obtaining registration abroad.

111. (1) Where a certificate of registration of a trade mark is issued for use in obtaining registration abroad, the Registrar shall include in the certificate a copy of the mark, and may require the applicant for the certificate to furnish him with a copy of the mark suitable for the purpose, and if the applicant fails to do so may refuse to issue the certificate.

(2) The Registrar may state in the certificate such particulars concerning the registration of the mark as to him seem fit, and may omit therefrom reference to any disclaimers appearing in the register; but in the last-mentioned case the certificate shall be marked "For use in obtaining registration abroad only".

*Declarations*

Person before whom declaration is to be taken.

112. The statutory declarations required by the Act and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows-

- (a) if made in the Commonwealth, before any court, judge or justice of the peace, or any officer authorized by law to administer an oath for the purpose of a legal proceeding;
- (b) if made outside the Commonwealth, before a Kenya Consul or Vice-Consul, or other person exercising the functions of a Kenya

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Consul, or a notary public, or before a judge or magistrate.

113. Any document purporting to have affixed, impressed or subscribed thereto or thereon the seal or signature of any person authorized by rule 112 to take a declaration in testimony that the declaration was made and subscribed before him may be admitted by the Registrar without proof of the genuineness of the seal or signature or of the official character of the person or his authority to take the declaration.

Presumption as to seal of officer taking declaration.

#### *Search*

114. (1) Any person may request the Registrar to cause a search to be made in respect of specified goods and services to ascertain whether any mark is on record that resembles a trade mark provided by the person.

Searches.  
L.N. 42/1995,  
L.N. 146/2003.

(1A) An application under paragraph (1) shall be in form TM 27 and shall be accompanied by duplicate representations of the trade mark.

(2) The Registrar shall cause such a search to be made and the person making the request to be informed of the result thereof.

#### *Copies*

115. A person who wishes to obtain a copy of a document kept by the Registrar shall use form TM 54.

Copies of documents.  
L.N. 146/2003.

116. (*Deleted by L.N. 146/2003, s.61*).

#### *Appeals to the Court*

117. When a person intends to appeal to the court, the appeal shall be made by motion in the usual way, and no such appeal shall be entertained unless notice of motion is given within sixty days from the date of the decision appealed against or within such further time as the Registrar shall allow.

Appeal to court.

#### *Applications to and Orders of the Court*

118. Every application to the court under the Act shall be served on the Registrar.

Applications to court.

119. (1) Where an order has been made by the court in any case under the Act, the person in whose favour the order has been made, or such one of them if more than one, as the Registrar may direct, shall forthwith leave at the office an office copy of the order, together with form TM 46, duly completed, if required.

Order of court.

(2) The register may, if necessary, thereupon be rectified or altered by the Registrar.

120. Whenever an order is made by the court under the Act, the Registrar may, if he thinks that the order should be made public, publish it in the Journal or Kenya Gazette.

Publication of order of court.  
L.N. 146/2003.

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*Submission of Documents in Electronic Form*

Submission of  
electronic documents.  
L.N. 146/2003.

121. A document submitted to the Registrar in electronic form shall be deemed to have been submitted in accordance with these Rules on the day the electronic form is submitted if, within thirty days after that submission, the document is submitted to the Registrar in paper form in accordance with these Rules together with any applicable fee required under these Rules.

## FIRST SCHEDULE

(r.3) L.N. 146/2003.

## FEES

*Notes:*

1. A foreign fee is payable if the person paying the fee or on whose behalf the fee is being paid does not reside in Kenya and does not have a principal place of business in Kenya.
2. A series of trade marks under section 24 (3) of the Act shall be deemed to be a single trade mark for the purpose of calculating fees, except where otherwise indicated.

<i>Description of fee</i>	<i>Local Fee Ksh</i>	<i>Foreign Fee US\$</i>	<i>Corresponding form.</i>
REGISTRATION OF TRADE MARKS			
1. Application fee for an application to register a trade mark			TM 2
for the first class	4,000	200	
for each subsequent class	3,000	150	
2. Fee for filing a notice of opposition to an application to register a trade mark			TM 6
for the first class	5,000	250	
for each subsequent class	4,000	200	
3. Fee for filing a counter statement			TM 7
for the first class	4,000	200	
for each subsequent class	3,000	150	
4. Fee for registration of a trade mark under r. 60(1)			
for the first class	2,000	150	
for each subsequent class	1,500	100	

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<i>Description of fee</i>	<i>Local Fee Ksh</i>	<i>Foreign Fee US\$</i>	<i>Corresponding form.</i>
<i>ADDITION OF GOODS OR SERVICES</i>			
5. Application fee for an application, under r. 29A, to add goods or services with respect to a registered trade mark or application to register a trade mark, for each class	3,000	150	TM 55
<i>RENEWAL</i>			
6. Fee for renewal of a registration of a trade mark under r. 64(1), 67 or 68			TM 10
for the first class	4,000	200	
for each subsequent class	3,000	150	
7. Additional fee, under r. 67, for renewal within thirty days after advertisement of non-renewal	3,000	150	
8. Restoration fee, under r. 68, for restoration of registration after removal from register	5,000	250	
<i>ASSIGNMENT OF TRADE MARKS</i>			
9. Application fee for an application, under r. 71, to register an assignment or transmission, for each trade mark assigned or transmitted			TM 14
for the first class	3,000	150	
for each subsequent class	2,000	100	
10. Application fee for an application, under r. 79(1), for a certificate under s. 25(5) of the Act relating to the validity of a proposed assignment, for each trade mark			TM 39
for the first class	3,000	150	

[Subsidiary]

<i>Description of fee</i>	<i>Local Fee Ksh</i>	<i>Foreign Fee US\$</i>	<i>Corresponding form.</i>
for each subsequent class	2,000	100	
11. Application fee for an application, under r.79 (1), for approval under s. 25 (6) of the Act of a proposed assignment or transmission			TM 40
for each trade mark to which the proposed assignment or transmission would relate	500	50	
12. Application fee for an application, under r. 80(1), for directions under s. 25(7) of the Act with respect to the advertisement of an assignment, for each trade mark			TM 41
for the first class	6,000	300	
for each subsequent class	5,000	250	
REGISTERED USERS			
13. Application fee for an application, under r. 95, to register a person as a registered user of a registered trade mark, for each trade mark			TM 48
for the first class	6,000	300	
for each subsequent class	5,000	250	
14. Application fee for an application, under r.97, to vary the registration of a person as a registered user of a registered trade mark under s. 31(8)(a) of the Act, for each trade mark			TM 49
for the first class	5,000	250	
for each subsequent class	4,000	250	

[Subsidiary]

<i>Description of fee</i>	<i>Local Fee Ksh</i>	<i>Foreign Fee US\$</i>	<i>Corresponding form.</i>
15. Application fee for an application, under r.98, to cancel the registration of a person as a registered user of a registered trade mark under s. 31(8)(b) of the Act, for each trade mark			TM 50
for the first class	5,000	250	
for each subsequent class	4,000	200	
16. Application fee for an application, under r. 99, to cancel the registration of a person as a registered user of a registered trade mark under s. 31(8)(c) of the Act, for each trade mark			TM 51
for the first class	5,000	250	
for each subsequent class	4,000	200	
17. Fee for filing, under r. 100(2), a notice of intention to intervene in proceedings relating to an application under s. 31(8) of the Act	3,000	150	TM 52
CONVERSION OF OLD CLASSIFICATIONS			
18. Application fee for an application, under r. 7(2), to adapt the classification of goods and services in respect of which a trade mark is registered	1,000	50	TM 43
19. Fee for filing a notice of opposition, under r. 7(6), to an application, under r. 7(2), to adapt a classification	5,000	250	TM 44

[Subsidiary]

<i>Description of fee</i>	<i>Local Fee Ksh</i>	<i>Foreign Fee US\$</i>	<i>Corresponding form.</i>
RECTIFICATION AND CORRECTION OF THE REGISTER			
20. Application fee for an application, under r. 81(2), 85(2) or 101(2), to alter the trade or business address of the proprietor or a registered user, for each trade mark			TM 17
for the first class	2,000	100	
for each subsequent class	1,000	50	
21. Application fee for an application, under r. 13(2), 81(2), 85(2) or 101(2), to enter or change an address for service	no fee	no fee	TM 32
22. Application fee for an application, under r. 82(1) and section 29, 30, 35 or 36 of the Act, for the making, expunging or varying of an entry in the register, for each trade mark			TM 25
for the first class	6,000	300	
for each subsequent class	5,000	250	
23. fee for filing an application for leave to intervene, under r. 84(1), in relation to an application under r. 82(1) and section 29, 30, 35 or 36 of the Act	3,000	150	TM 26
24. Application fee for an application, under r. 84A(1), to surrender a trade mark			
for some goods and services	1,000	50	TM 21
for some goods and services	1,000	50	TM 22

[Subsidiary]

<i>Description of fee</i>	<i>Local Fee Ksh</i>	<i>Foreign Fee US\$</i>	<i>Corresponding form.</i>
25. Application fee for an application, under r. 85(2) or 101 (2), to make a correction to the Register for which a fee is not otherwise specified, for each trade mark			TM 19
for the first class	2,000	100	
for each subsequent class	1,000	50	
26. Application fee for an application, under r. 85(2) or 101 (2), to change the name or description of the proprietor or a registered user			TM 20
for the first trade mark	3,000	150	
for each additional trade mark	500	50	
27. Application fee for an application, under r. 85(2), to enter a disclaimer or memorandum under s. 37 (1) (e) of the Act	500	20	TM 23
28. Fee for request, under r. 88, to add, to the register, a note that a certificate of validity has been granted			TM 47
for the first registration certified	1,000	50	
for each additional registration certified in the same certificate	500	50	

[Subsidiary]

<i>Description of fee</i>	<i>Local Fee Ksh</i>	<i>Foreign Fee US\$</i>	<i>Corresponding form.</i>
29. Application fee for an application, under r. 89, for leave to add to or alter a trade mark under s. 38 of the Act, for each trade mark			TM 24
for the first class	4,000	200	
for each subsequent class	3,000	150	
30. Fee for filing a notice of opposition, under r. 90(2), to an application, under r. 89, to add to or alter a trade mark	5,000	250	TM 6
31. Application fee for an application to the court, under r. 93, relating a to a certification trade mark	6,000	300	TM 35
32. Fee for a notice, under r. 119 (1), of a court order relating to alteration or rectification of register	1,000	50	TM 46
HEARINGS AND DECISIONS			
33. Fee for filing a notice of intention to appear at a hearing, for each trade mark			TM 8
for the first class	4,000	200	
for each subsequent class	3,000	150	
34. Fee for a request to the Registrar to state grounds of a decision and the materials used in arriving at the decision	4,000	200	TM 4

[Subsidiary]

<i>Description of fee</i>	<i>Local Fee Ksh</i>	<i>Foreign Fee US\$</i>	<i>Corresponding form.</i>
<b>COSTS</b>			
35. On filing a bill of costs for taxation, for every ten pages or part thereof	2,000	100	
36. On issue of a notice of taxation	1,000	50	
37. On application for service of a notice of taxation together with a bill of costs	1,000	50	
38. On application for a certificate of taxation	1,000	50	
<b>MISCELLANEOUS</b>			
39. Fee for appointing an agent, under r. 14(2), to act in a proceeding or matter before or affecting the Registrar	1,000	50	TM 1
40. Fee for preliminary advice of the Registrar under r.20 (1)			TM 27
for the first class	3,000	150	
for each subsequent class	2,000	100	
41. Fee for making a request under r. 109(1) for a certificate (other than a certificate of registration under section 22 of the Act)			TM 30
If the certificate relates to a trade mark			
for the first class	3,000	150	
for each subsequent class	2,000	100	
If the certificate does not relate to a trade mark	3,000	150	

[Subsidiary]

<i>Description of fee</i>	<i>Local Fee Ksh</i>	<i>Foreign Fee US\$</i>	<i>Corresponding form.</i>
42. Application fee for an application, under r. 94 (1), for alteration of deposited regulations relating to a certification trade mark			TM 34
a. for the alteration of the regulations relating to one certification trade mark	3,000	150	
b. for the alteration of identical or substantially identical regulations relating to another certification trade mark, for each such additional certification trade mark	500	50	
43. Application fee for an application, under r. 102, for an extension of time, other than an extension of time prescribed by rule 76			TM 53
(a). extension not exceeding 30 days	1,000	50	
(b). extension exceeding 30 days but not exceeding 60 days	2,000	100	
(c). extension exceeding 60 days	3,000	150	
44. Application fee for an application, under r. 102, for an extension of time prescribed by rule 76			TM 53
(a). extension not exceeding two months	1,000	50	
(b). extension exceeding two months but not exceeding four months	2,000	100	
(c). extension exceeding four months	3,000	150	

[Subsidiary]

<i>Description of fee</i>	<i>Local Fee Ksh</i>	<i>Foreign Fee US\$</i>	<i>Corresponding form.</i>
45. Application fee for an application, under r. 108, to amend a document or drawing or other representation, for each trade mark			TM 19
for the first class	2,000	100	
for each subsequent class	1,000	50	
46. Fee for search under r. 114			TM 27
for the first class	2,000	100	
for each subsequent class	1,000	50	
47. Fee for inspecting the Register or any notice, opposition, or decision relating to an application to rectify the Register, for each quarter hour	200	10	
48. Fee to search among the representations of trade marks, for each quarter hour or part thereof	1,000	10	
49. Fee for copies for judgments, orders or other documents used in a proceeding before the Registrar, per page	20	1	TM 54
for other documents, per document	500	10	
additional fee for certification, per document	1,000	50	

**SECOND SCHEDULE** - (Deleted by L.N. 146/2003, s.65).

**THIRD SCHEDULE** - (Deleted by L.N. 146/2003, s.65).

FOURTH SCHEDULE

(r.4) L.N. 146/2003.

FORMS

FORM TM 1

APPOINTMENT OF AN AGENT

(Rule 14 (2))

Name and address of person appointing agent	
Name and address of agent	
Matter in respect of which agent is appointed	

I, the person identified above, have appointed the above agent to act on my behalf in the matter described above, and request that all communications relating thereto be sent to the agent at his/their address given above.

I revoke all previous authorizations in respect of the same matter.

Dated ..... at .....

Signature .....

FORM TM 2

L.N. 146/2003.

APPLICATION FOR REGISTRATION OF A TRADE MARK

(rules 21 (1), 36 (1), 37, 94A (1))

1. Trade Mark:

Note: One representation of the trade mark must be set out in the above box.

[Subsidiary]

L.N. 146/2003.

2. Application is hereby made for registration of the above trade mark as (check one):

a trade mark other than a trade mark listed below

a certification trade mark

a defensive trade mark (if a defensive trade mark is applied for a statement of case and statutory declaration as required under r. 36 (1) must accompany this application)

a collective trade mark (if a collective trade mark is applied for a copy of the rules governing the use of the trade mark must accompany this application)

3. \*

<i>Class</i>	<i>Goods/Services</i>

4. Additional information, if any\* .....  
.....  
.....

5. Proposed proprietor

Name: .....

Trade or business address: .....  
.....

Trading style (if any): .....

\*Applicant may use separate sheet where necessary

Date: .....

Signature: .....

To: The Registrar of Trade Marks.

FORM TM 3 - (Deleted by L.N. 146/2003, s.65 (b)).

FORM TM 4

FEE
Sh. 60

REQUEST FOR STATEMENT OF GROUNDS OF DECISION

IN THE MATTER OF (a) ..... (a) Here insert words and number identifying the matter or proceeding.

The Registrar is hereby requested to state in writing the grounds of his decision, dated the ..... day of ....., 19 ....., and the materials used by him in arriving at the decision.

Dated this ..... day of ....., 19 .....

(b)..... (b) Signature.

To: The Registrar of Trade Marks,  
P. O. Box 30031,  
Nairobi.

If the Registrar has made any requirement to which the Applicant does not object, the Applicant shall comply therewith before the Registrar issues the ground of his decision. (See rule 34.)

FORM TM 5 - (Deleted by L.N. 146/2003 s.65 (b)).

L.N. 146/2003.

FORM TM 6

NOTICE OF OPPOSITION TO APPLICATION

(Rules 46, 90 (2))

In the matter of the following application:

Application Number: .....

Applicant: .....

.....

.....

Name and address of objector:

.....

.....

Address for service of objector: .....

[Subsidiary]

.....  
.....  
.....  
.....

I, the objector named above, give notice that I oppose the above application.  
The following is a statement of the grounds upon which I object:

.....  
.....  
.....  
.....  
.....  
.....  
.....  
.....

Date: .....  
Signature: .....  
To: The Registrar of Trade Marks.  
Note: This notice must be filed in duplicate.

FORM TM 7

FEE
Sh. 30

FORM OF COUNTER-STATEMENT

*(To be submitted in duplicate)*

IN THE MATTER OF an Opposition No. ....

to Application No. ....

I [We] .....  
the applicant[s] for Registration of the above Trade Marks, hereby give notice  
that the following are the grounds on which I [we] rely as supporting my [our]  
application:

.....  
.....  
.....

I [We] admit the following allegations in the notice of opposition:

.....  
.....  
.....

Address for service in Kenya in these proceedings:

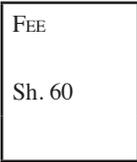
[Subsidiary]

Dated this .....day of ....., 20 .....

(a) ..... (a) Signature.

To: The Registrar of Trade Mark
P O Box 30031,
Nairobi.

FORM TM 8



NOTICE TO THE REGISTRAR OF ATTENDANCE AT HEARING

I [We] (a) ..... (a) Here insert name and address.
of .....
hereby give notice that the hearing of the arguments in the case of:

- (b) (1) Opposition No. .... to Application for registration of a Trade Mark No. .... (b) Strike out words here that are not applicable, so as to state ONE of the cases (1) to (5) only.
(2) Application that the entry in the Register in respect of Trade Mark No. .... may be removed.
(3) ..... may be amended by alteration of or addition to the Trade Mark.
(4) ..... may be amended by a conversion of the specification of goods.
(5) ..... may be amended otherwise than by any change in the mark or of the specification on conversion.

which, by the Registrar's Notice to me [us] dated the ..... day of ....., 20....., is fixed for ..... a.m. or p.m. at the Registrar's Office on the ..... day of ....., 19....., will be attended by me [us] or by some person on my [our] behalf.

Dated this ..... day of ....., 20 ..... (c) ..... (c) Signature.
(d) ..... (d) Address.

To: The Registrar of Trade Marks,
P. O. Box 30031,
Nairobi.

[Subsidiary]

FORM TM 9 - (Deleted by L.N. 146/2003, s.65(d)).

FORM TM 9A

NOTICE OF NON-COMPLETION OF REGISTRATION

No. ....

The Registrar, as required by section 22 (3) of the Trade Marks Act and rule 59 of the Trade Marks Rules (copies of which are printed on the back hereof), has to point out that the registration of the trade mark, in respect of which your application numbered as above was made on the ..... day of ....., 20....., has not been completed by reason of your default. Unless it is completed within fourteen days from this date the application will be treated as abandoned.

Dated this ..... day of ....., 20 .....

To .....  
.....  
.....

The Office of the Registrar of Trade Marks,  
P. O. Box 30031,  
Nairobi

[P.T.O.]

[Back]

Section 22 (3)

Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.

Rule 59

(1) Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar shall in form TM 9A give notice in writing to the applicant at his trade or business address of the non-completion, but if the applicant has authorized an agent for the purpose of the application he shall instead send the notice to the agent and shall send a duplicate thereof to the applicant.

(2) If after fourteen days from the date when the notice was sent, or such further time as the Registrar may allow, the registration is not completed, the application shall be deemed to be abandoned.

FORM TM 10

L.N. 146/2003.

RENEWAL OF REGISTRATION OF TRADE MARK

(rules 64 (1), 65, 67, 68)

Name and address of person leaving the registration fee:

.....  
.....  
.....

I, the person described above, leave the prescribed registration fee for the renewal of the following trade mark:

Trade Mark No. ....

Registered proprietor: .....

.....

I am (check one)

the registered proprietor of the trade mark

not the registered proprietor of the trade mark but have been directed by the registered proprietor to pay the fee

The notice of renewal should be sent to the following address:\*

.....  
.....  
.....

Date: .....

Signature: .....

To: The Registrar of Trade Marks.

\*The person completing the form to provide name of addressee.

[Subsidiary]  
L.N. 146/2003.

FORM TM 10A

CERTIFICATE OF REGISTRATION OF TRADE MARK

(rule 63)

Trade Mark:



Registration details:

Part of Register trade mark is registered in: A or B .....

Trade Mark No. ....

Class or classes: .....

Goods/Services: .....

Registered proprietor: .....

Effective date of registration: .....

The trade mark shown above has been registered under the Trade Marks Act.

The registration expires on .....

Sealed at my direction.

Date: .....

Signature of Registrar: .....

FORM TM 11 - (*Deleted by L.N. 146/2003, s.65(f)*).

FORM TM 12 - (*Deleted by L.N. 146/2003, s.65(f)*).

FORM TM 13 - (*Deleted by L.N. 146/2003, s.65(f)*).

L.N. 146/2003.

FORM TM 14

REQUEST TO REGISTER ASSIGNMENT OR TRANSMISSION

(rule 71)

In the matter of Trade Mark No. ....

Class: .....

Person entitled, by assignment or transmission, to trade mark:

Name: .....

Trade or business address: .....

.....

Trading style (if any): .....

[Subsidiary]

I, the person described above, request that I be registered as the proprietor of the trade mark described above.

Particulars of instrument of assignment or transmission or statement of case:  
.....  
.....

*(If an instrument is described above, a copy of it shall accompany the application.)*

(If the trade mark is assigned, the following questions must be answered.)

1. At the time of the assignment, was the trade mark used in a business in the goods or services to which the trade mark relates?

yes       no

2. Was the assignment made otherwise than in connection with the goodwill of the business described in item 1 above:

yes       no

(If the answer to both of questions 1 and 2 above is yes, the applicant is required to leave the copy and proof required under rule 76 (1).)

Date: .....

Signature: .....

Signature of current registered proprietor (optional): .....

To: The Registrar of Trade Marks.

FORM TM 15 - *(Deleted by L.N. 146/2003, s.65(h)).*

FORM TM 16 - *(Deleted by L.N. 146/2003, s.65(h)).*

FORM TM 17

L.N. 146/2003.

REQUEST TO ALTER TRADE OR BUSINESS ADDRESS IN REGISTER

(rules 81 (1), 85 (2), 101 (1))

In the matter of Trade Mark No. ....

Name and address of person making the request:  
.....  
.....

[Subsidiary]

I am

the registered proprietor of the trade mark described above

a registered user of the trade mark described above

I request that my trade or business address, as shown in the Register in relation to the trade mark described above, be changed to the following:

.....  
.....  
.....

Date:

.....

Signature: .....

To: The Registrar of Trade Marks.

FORM TM 18 - (*Deleted by L.N. 146/2003, s.65(j)*).

L.N. 146/2003.

FORM TM 19

APPLICATION TO CORRECT CLERICAL ERROR IN REGISTER  
OR TO AMEND DOCUMENT, ETC

(rules 85 (2), 108 (2))

This is an application

to correct a clerical error in the Register for Trade Mark No. ....

to amend Application No. ....

[Subsidiary]

[ ]

to amend another document or drawing or other representation

(specify: .....)

Name and address of applicant:

.....  
.....  
.....

Description of correction or amendment:

.....  
.....  
.....

Date: .....

Signature: .....

To: The Registrar of Trade Marks.

L.N. 146/2003.

FORM 20

APPLICATION TO CHANGE NAME OR DESCRIPTION IN REGISTER

(rules 85 (2), 101 (1))

In the matter of Trade Mark No. ....

I am

[ ]

the registered proprietor of the trade mark described above

[ ]

a registered user of the trade mark described above

Currently my name and description are shown in the Register in the relation to the trade mark described above as follows:

.....  
.....

I request that my name and/or description, as shown in the Register in relation

[Subsidiary]

to the trade mark described above, be changed to the following:  
.....  
.....

Description of circumstances in which name or description has changed:  
.....  
.....

Date: .....

Signature: .....

To: The Registrar of Trade Marks.

L.N. 146/2003.

FORM TM 21

APPLICATION TO SURRENDER TRADE MARK FOR ALL  
GOODS AND SERVICES

(rule 84A (1) (a))

In the matter of Trade Mark No. ....

Class: .....

Name of registered proprietor: .....

Trade or business address: .....

Description of trade mark: .....

I, the proprietor of the trade mark described above, apply to surrender the trade mark in respect of all the goods or services in respect of which it is registered.

Names and addresses of persons with a registered interest in the trade mark:  
.....  
.....  
.....

Attached to this application is a certification by the proprietor that each person with a registered interest listed above either –

(i) has been given notice of the proposed surrender at least ninety days before the application is made; or

(ii) is not affected by the surrender or has consented to it.

Date: .....

Signature: .....

To: The Registrar of Trade Marks

[Subsidiary]

FORM TM 22

L.N. 146/2003.

APPLICATION TO SURRENDER TRADE MARK FOR SOME GOODS AND SERVICES

(rule 84A (1) (b))

In the matter of Trade Mark No. ....

Class: .....

Name of registered proprietor: .....

Trade or business address: .....

Description of trade mark: .....

I, the proprietor of the trade mark described above, apply to surrender the trade mark in respect of the following goods or services:

.....  
.....  
.....

Names and addresses of persons with a registered interest in the trade mark:

.....  
.....  
.....

Attached to this application is a certification by the proprietor that each person with a registered interest listed above either –

- (i) has been given notice of the proposed surrender at least ninety days before the application is made; or
- (ii) is not affected by the surrender or has consented to it.

Date: .....

Signature: .....

To: The Registrar of Trade Marks.

FORM TM 23

L.N. 146/2003.

APPLICATION TO ENTER DISCLAIMER OR MEMORANDUM IN REGISTER

(rule 85 (2))

[Subsidiary]

In the matter of Trade Mark No. ....

Name of registered proprietor: .....

Trade or business address:.....

I am the registered proprietor of the trade mark described above.

I request that the following disclaimer or memorandum be entered in the Register in relation to the trade mark described above:

.....  
.....

.....  
.....

Date: .....

Signature: .....

To: The Registrar of Trade Marks.

L.N. 146/2003.

FORM TM 24

APPLICATION TO ADD TO OR ALTER REGISTERED TRADE MARK

(rule 89)

In the matter of Trade Mark No. ....

Name of registered proprietor: .....

Trade or business address:

.....

I am the registered proprietor of the trade mark described above.

I request that the trade mark described above be added to or altered in the following particulars:

.....  
.....  
.....

so that the new trade mark shall appear as follows:

[Subsidiary]

[Empty rectangular box for drawing or description]

Date: .....

Signature: .....

To: The Registrar of Trade Marks.

FORM TM 25

L.N. 146/2003.

APPLICATION FOR THE MAKING, EXPUNGING OR VARYING OF AN ENTRY IN THE REGISTER

(rules 82 (1), 84 (1))

In the matter of Trade Mark No. ....

Name of registered proprietor: .....

Trade or business address:

.....

Name and address of applicant:

.....  
.....  
.....

I apply for the making, expunging or varying of an entry in the Register in relation to the trade mark described above in the following manner:

.....  
.....  
.....

This application is accompanied by the statement required under rule 82 (1).

(If the applicant is not the registered proprietor of the trade mark a copy of this application and the statement required under rule 82 (1) is required under rule 82 (2))

Date: .....

Signature: .....

To: The Registrar of Trade Marks.

[Subsidiary]  
L.N. 146/2003.

FORM TM 26

APPLICATION FOR LEAVE TO INTERVENE IN PROCEEDINGS FOR THE  
MAKING, EXPUNGING OR VARYING OF AN ENTRY IN THE REGISTER

(rule 84 (1))

In the matter of Trade Mark No. ....

Name of registered proprietor: .....

Trade or business address:  
.....

Name and address of applicant:  
.....  
.....  
.....

I apply for leave to intervene in the proceedings relating to the making,  
expunging or varying of an entry in the Register in relation to the trade mark  
described above.

My interest in the trade mark is as follows:  
.....  
.....  
.....

Address for service in Kenya for these proceedings:  
.....  
.....

Date: .....

Signature: .....

To: The Registrar of Trade Marks.

L.N. 146/2003.

FORM TM 27

REQUEST FOR SEARCH UNDER RULE 114/APPLICATION FOR  
PRELIMINARY ADVICE AS TO DISTINCTIVENESS

(rules 114 (1A), 20 (1A))

PART 1-REQUEST FOR SEARCH

*(to be completed in all cases)*

Name and address of person making the request:  
.....

[Subsidiary]

.....  
.....

I hereby request that a search be made in respect of goods and services in the following classifications:

.....  
.....  
.....

to ascertain whether any mark is on record that resembles the trade mark, duplicate representations of which are attached to this request.

PART 2 - APPLICATION FOR PRELIMINARY ADVICE

(to be completed if making a request under rule 20 (1A))

I propose to apply for the registration of a trade mark, duplicate representations of which are attached to this application, in relation to goods and services in the classifications described above in Part 1.

Proposed proprietor

Name: .....

Trade or business address: .....  
.....

Trading style (if any):.....  
.....

I hereby apply for advice as to whether the trade mark appears to the Registrar *prima facie* to be inherently adapted to distinguish the goods or services within the meaning of section 12 of the Act or to be inherently capable of distinguishing the goods or services within the meaning of section 13 of the Act.

Date: .....

Signature: .....

To: The Registrar of Trade Marks.

FORM TM 28 - (Deleted by L.N. 146/2003, s.65(1)).

FORM TM 29 - (Deleted by L.N. 146/2003, s.65(1)).

FORM TM 30

[Subsidiary]

REQUEST FOR CERTIFICATE OTHER THAN UNDER SECTION 22 OF THE ACT

(rule 109 (1))

Name and address of person making the request:

.....  
.....  
.....

I hereby request a certificate as to the following:

.....  
.....  
.....

Date: .....

Signature: .....

To: The Registrar of Trade Marks.

FORM TM 31 - (Deleted by L.N. 146/2003, s.65(n))

L.N. 146/2003.

FORM TM 32

APPLICATION TO ENTER OR ALTER ADDRESS FOR SERVICE

(rules 13, 81, 85 (2), 101 (1))

Name and address of applicant:

.....  
.....  
.....

Description of registration or application to which application relates:

.....  
.....  
.....

I request, for the registration or application described above, that the following be entered as my address for service or that my existing address for service be altered so that it reads as follows:

.....  
.....  
.....

Date: .....

Signature: .....

To: The Registrar of Trade Marks.

[Subsidiary]

FORM TM 33 - (Deleted by L.N. 146/2003, s.65(p)).

FORM TM 34

L.N. 146/2003.

APPLICATION FOR ALTERATION OF DEPOSITED REGULATIONS  
RELATING TO CERTIFICATION TRADE MARK

(rule 94 (1))

In the matter of Trade Mark No. ....

Name of registered proprietor: .....

Trade or business address: .....

I, the registered proprietor, apply for an alteration of the deposited regulations relating to the certification trade mark described above in the following manner:

.....  
.....  
.....

Date: .....

Signature: .....

To: The Registrar of Trade Marks.

FORM TM 35

FEE  
Sh. 60

APPLICATION TO THE COURT FOR AN ORDER EXPUNGING OR VARYING  
AN ENTRY IN THE REGISTER RELATING TO A CERTIFICATION  
TRADE MARK OR VARYING THE DEPOSITED REGULATIONS

(Section 40 and First Schedule – Rule 93)

*(To be accompanied by a copy and a Statement of Case in duplicate)*

IN THE MATTER OF Certification Trade Mark No. ....

registered in the name of ..... in Class .....

I [We] (a) .....

(a) Here state full name and address.

.....

[Subsidiary]

being [an] aggrieved person[s] hereby apply for an order of the court that:

(b) Strike out either paragraph that is not applicable.

1. (b) The Entry in the Register in respect of the above-mentioned

Trade Mark may be (c) expunged [or varied in the following manner .....]

(c) Strike out one of these lines.

2. (b) The deposited Regulations governing the use of the above-mentioned Trade Mark may be varied in the following manner .....

The grounds of my [our] application are as follows: .....

Address for service in Kenya in these proceedings: .....

Dated this ..... day of ....., 20.....

(d) Signature.

(d) .....

To: The Registrar,  
The High Court,  
Nairobi.

To: The Registrar of Trade Marks,  
P. O. Box 30031,  
Nairobi.

FORM TM 36 - (Deleted by L.N. 146/2003, s.65(r)).

FORM TM 37 - (Deleted by L.N. 146/2003, s.65(r)).

FORM TM 38 - (Deleted by L.N. 146/2003, s.65(r)).

[Subsidiary]

FORM TM 39

FEE  
1st Sch.,  
item 8

APPLICATION FOR THE CERTIFICATE OF THE REGISTRAR UNDER SECTION  
25 (5) AND RULE 79 WITH REFERENCE TO A PROPOSED ASSIGNMENT OF  
A REGISTERED TRADE MARK

*(To be accompanied by a Statement of Case in duplicate and a copy of  
the proposed assignment)*

IN THE MATTER OF Trade Marks[s] No. [s] .....  
.....registered in the name of .....  
.....  
in Class[es] .....

Application is hereby made by (a) .....  
of .....  
being the Registered Proprietor[s] of the above-numbered registered  
Trade Mark[s], for the Registrar's Certificate under section 25(5) with  
reference to a proposed assignment of the registered Trade Mark[s] No.[s]  
..... to (b) .....  
.....  
of .....  
in circumstances that are stated fully in the accompanying Statement of Case.

(a) Here insert the  
name and trade or  
business address  
of the registered  
proprietor.

(b) Here insert the  
name and trade or  
business address  
of the proposed  
assignee.

Dated this ..... day of ....., 20.....

(c) Signature. ....

To: The Registrar of Trade Marks,  
P. O. Box 30031,  
Nairobi.

[Subsidiary]

FORM TM 40

FEE  
1st Sch.,  
item 8a

APPLICATION FOR THE APPROVAL BY THE REGISTRAR UNDER SECTION 25 (6) AND  
RULE 79 OF A PROPOSED ASSIGNMENT, OR OF A TRANSMISSION (ON OR AFTER  
THE APPOINTED DAY), OF A TRADE MARK RESULTING IN EXCLUSIVE RIGHTS IN  
DIFFERENT PERSONS FOR DIFFERENT PARTS OF KENYA

*(To be accompanied by a Statement of Case in duplicate and a Copy  
of the Instrument proposed for the Assignment or effecting the  
Transmission)*

\*To be struck  
out in the case of  
unregistered trade  
marks.

IN THE MATTER OF [a]Trade Mark[s]

\*Registered under No.[s] .....

in Class[es] .....

the property of .....

†Strike out either  
paragraph (1) or  
paragraph (2).

.....

(a) Insert here the  
name and trade or  
business address of  
the proprietor.

Application is hereby made by:

†(1) (a) .....

of .....

(b) Strike out either if  
not applicable.

the Proprietor of the Trade Mark[s] shown in the accompanying Statement of  
Case (b) [registered in his name] [and used by him] in respect of the following  
goods .....

(c) Insert here the  
names and trade or  
business addresses  
of the proposed  
assignee or  
assignees.

*for approval by the Registrar* of a proposed assignment of the Trade

Mark[s] to (c) .....

..... of .....

in respect of the following goods .....

(d) Insert the name of  
the place in Kenya.

to be sold or otherwise traded in in (d) .....

..... [and to (c) .....

of .....

in respect of the following goods ..... to be sold

or otherwise traded in in (d) .....] in circumstances that are

[Subsidiary]

stated fully in the accompanying Statement of Case.

†(2) (e) .....  
of .....  
who claims that the Trade Mark[s] shown in the accompanying Statement of  
Case was [were], in respect of the following goods, namely:  
.....  
.....  
and on the (f) ..... day of ....., 20 .....  
transmitted to (g) him [or to (h) .....  
of .....  
(who was his predecessor in title)] by or from (i) .....  
.....  
of.....  
by whom the Trade Mark was then used in respect of the following goods,  
namely ..... all in circumstances  
that are stated fully in the accompanying Statement of Case, for approval by  
the Registrar of the aforesaid transmission.

(e) Here insert the name and trade or business address of the person who claims a transmission to him.  
(f) Insert here the date of the transmission which must not precede the appointed day.  
(g) Strike out the words that are not applicable.  
(h) Insert here the name and trade or business address of the predecessor in title, if any.  
(i) Insert here the name and address of the person who transmitted.

Dated this ..... day of ....., 20.....

(j) .....

(j) Signature.

To: The Registrar of Trade Marks,

P. O. Box 30031,

Nairobi.

[Subsidiary]

FORM TM 41

FEE  
1st Sch.,  
item 8b

APPLICATION TO THE REGISTRAR UNDER SECTION 25 (7) AND RULE 80 FOR  
DIRECTIONS FOR THE ADVERTISEMENT OF AN ASSIGNMENT OF TRADE MARKS  
OTHERWISE THAN IN CONNEXION WITH THE GOODWILL OF THE BUSINESS

(To be accompanied by a duplicate)

(a) Here insert the name and trade or business address of the assignee (applicant).

Application is hereby made by (a) .....  
.....  
of .....  
for the Registrar's Directions with respect to the advertisement of an assignment to him [them] of the following Trade Marks otherwise than in connexion with the goodwill of the business in which they were used at the time of assignment, namely –

(1) Registered Trade Marks:	Goods in respect of which
Registration Number    Class	the Mark has been used
(b)	and is assigned

(b) Additional Marks and numbers may be given in a signed schedule on the back of the form.

all of which are or were registered in the name of (c) .....  
..... of .....  
..... who is the assignor.

(c) Here insert the name and trade or business address of the proprietor (assignor).

(2) Unregistered Trade Marks (d), all being Marks used in his business at the time of the assignment in respect of the goods stated below by (c).....  
.....  
of .....  
who is the assignor:

Representation of Mark	Goods in respect of which the
(b)	Mark has been used and is
	assigned

(d) Only those unregistered trade marks passing by the one assignment and used in the same business and for the same goods as those for which one or more of the registered marks may be stated here.

The date of assignment was the ..... day of ..... 20 .....

The instrument effecting the assignment is sent herewith, together with a copy thereof.

It is suggested that advertisement shall be directed as follows, namely, in .....

Dated this ..... day of ....., 20 .....

(e) Signature.

(e) .....

To: The Registrar of Trade Marks,  
P. O. Box 30031,  
Nairobi.

FORM TM 42 - (Deleted by L.N. 146/2003, s.65(r)).

FORM TM 43

L.N. 146/2003.

APPLICATION TO ADAPT CLASSIFICATION SO THAT IT IS IN ACCORDANCE WITH SECTION 6 (2) OF THE ACT

(rule 7 (2))

In the matter of Trade Mark No. ....

Class: .....

Name of Registered Proprietor: .....

Trade or business address: .....

Address for service: .....

I, the proprietor of the trade mark described above, apply to have the classification of the goods or services in respect of which the trade mark is registered adapted so that they are classified in accordance with section 6 (2) of the Act.

Current classification:

.....  
.....  
.....

Proposed classification in accordance with section 6 (2) of the Act:

.....  
.....  
.....

Date: .....

Signature: .....

To: The Registrar of Trade Marks.

[Subsidiary]

L.N. 146/2003.

FORM TM 44

NOTICE OF OPPOSITION TO APPLICATION TO HAVE CLASSIFICATION ADAPTED

(rule 7 (6))

In the matter of Trade Mark No. ....

Class: .....

Name of Registered Proprietor: .....

Name and address of objector:

.....  
.....  
.....

Address for service of objector: .....

I, the objector named above, give notice that I oppose the application for the adaptation of the classification of the goods or services in respect of which the trade mark described above is registered.

This notice of objection is accompanied by a statement, in duplicate, showing how the amendment proposed by the Registrar would be contrary to section 39 (2) of the Act.

Date: .....

Signature: .....

To: The Registrar of Trade Marks.

Note: This notice must be filed in duplicate.

FORM TM 45 - (Deleted by L.N. 146/2003, s.65(t)).

[Subsidiary]

FORM TM 46

FEE  
Sh. 20

NOTICE OF ORDER OF COURT FOR ALTERATION OR RECTIFICATION OF REGISTER OF TRADE MARKS

(Rule 119)

IN THE MATTER OF the Trade Mark No. ....  
registered in Class .....in the name of .....

Notice is hereby given to the Registrar that, by an Order of the Court made on the ..... day of ....., 20 ....., it was directed that .....

.....  
.....  
.....

An office copy of the Order of the Court is enclosed herewith.

Dated this ..... day of ....., 20 .....  
(a) .....

(a) To be signed by the person interested or his agent.

To: The Registrar of Trade Marks,  
P. O. Box 30031,  
Nairobi.

\_\_\_\_\_

FORM TM 47

FEE  
1st Sch.,  
item 7

REQUEST TO THE REGISTRAR FOR ENTRY ON THE REGISTER AND ADVERTISEMENT OF A NOTE OF A CERTIFICATE OF VALIDITY BY THE COURT UNDER SECTION 47

(Rule 88)

IN THE MATTER OF Trade Mark[s] No. [s] .....  
registered in Class ..... in the name of .....

[Subsidiary]

.....

(a) Here state the name and address of the registered proprietor.

I [We] (a) .....

.....

.....

.....

(b) Here state the nature of the proceedings with the names of the parties to them, in which the certificate was given.

hereby request the Registrar to add to the above-numbered entry [entries] of a Trade Mark in the Register, and to advertise in the Gazette a note that in (b)

.....

.....

the Court certified that the validity of the said registration[s] came into question and was decided in favour of the proprietor of the Trade Mark in the terms of the accompanying office copy of the certificate of validity.

Dated this ..... day of ....., 20.....

(s) Signature

(c) .....

To: The Registrar of Trade Marks,  
P. O. Box 30031,  
Nairobi.

[Subsidiary]

FORM TM 48

FEE  
1st Sch.,  
items 6, 6a

APPLICATION FOR REGISTRATION OF REGISTERED USER

*(To be accompanied by a Statement of Case giving particulars and stating as required by section 31 (4), verified by a Statutory Declaration made by the Proprietor, or by some person authorized to act on his behalf and approved by the Registrar)*

Application is hereby made by (a) .....

.....

.....

who is [are] the registered proprietor[s] of Trade Mark[s] No.[s]

.....(b) registered in Class ..... in respect of

(c) ..... that (d).....

of (e) .....

..... trading as (f) .....

.....

who hereby joins in the application, may be registered as a registered user of

the above-numbered registered Trade Mark[s] in respect of (g)

.....

subject to the following conditions or restrictions: (h) .....

.....

(i) The proposed permitted use is to end on the .....

day of ....., 20 .....

The proposed permitted use is without limit of period.

(j) .....

To: The Registrar of Trade Marks,  
P. O. Box 30031,  
Nairobi.

*Note.- A request for the entry of an address for service of the registered user may be made free in form TM 32 if it accompanies this form.*

(a) Here insert full name, trade or business address and description of the registered proprietor(s).

(b) Additional numbers may be given in a signed schedule on the back of the form.

(c) Here insert the specification in the Register.

(d) Here insert the full name, description and nationality of the individual, firm or body corporate proposed as registered user. The names of all partners must be given in full. In the case of a body corporate brief particulars of the kind and country of incorporation should be stated.

(e) Here insert the full trade or business address of the proposed registered user.

(f) Here insert trading style, if any.

(g) Here insert designation of goods (which must be comprised within the specification).

(h) Write "none" if there are no conditions or restrictions.

(i) Strike out the words that are not applicable.

(j) Signature.

[Subsidiary]

FORM TM 49

FEE  
1st Sch.,  
items 6b, 6c

APPLICATION BY THE REGISTERED PROPRIETOR OF A TRADE MARK FOR VARIATION  
OF THE REGISTRATION OF A REGISTERED USER THEREOF WITH REGARD TO THE  
GOODS OR THE CONDITIONS OR RESTRICTIONS

(Section 31(8) (a) and Rule 97)

*(To be accompanied by a Statement of the Grounds for the application  
and the written consent (if given) of the Registered User)*

(a) Here insert the full name, description and trade or business address of the registered proprietor. Application is hereby made by (a) .....

(b) Additional numbers may be given in a signed schedule on the back of the form. the proprietor of Trade Mark[s] No. [s] (b) .....

(c) Here insert the specifications in the Register. registered in Class ..... in respect of (c) .....

(d) Here insert the full name, description and trade or business address of the registered user. that the registration of (d).....

(e) Here insert the goods in respect of which the user is registered. as a registered user of the above-numbered Trade Mark[s] in respect of (e) .....

(f) Here state in terms the manner in which it is requested that the entry should be varied. may be varied in the following manner: (f) .....

(g) Signature. Dated this ..... day of ....., 20 .....  
(g) .....

To: The Registrar of Trade Marks,  
P. O. Box 30031,  
Nairobi.

[Subsidiary]

FORM TM 50

FEE  
1st Sch.,  
items 6d, 6e

APPLICATION BY THE REGISTERED PROPRIETOR OF A TRADE MARK OR BY ANY OF THE REGISTERED USERS OF THE TRADE MARK FOR THE CANCELLATION OF ENTRY OF A REGISTERED USER THEREOF

(Section 31(8) (b) and Rule 98)

(To be accompanied by a Statement of the Grounds for the application)

Application is hereby made by (a) .....  
.....  
being (b) the Registered Proprietor [a Registered User] of Trade Mark[s] No. [s] ..... (c) registered in Class .....  
in respect of (d) .....  
.....  
for the cancellation of the entry under the above-mentioned registration[s] of (e) .....  
.....  
as a registered user of the Trade Mark[s] in respect of (f) .....  
.....  
.....

(a) Here insert the full name, description and trade or business address of the applicant(s).

(b) Strike out the words that are not applicable.

(c) Additional numbers may be given in a signed schedule on the back of the form.

(d) Here insert the specification in the Register.

(e) Here insert the full name, description and trade or business address of the registered user whose entry is sought to be cancelled.

(f) Here insert goods in respect of which that registered user is entered.

(g) Signature.

Dated this ..... day of ....., 20 .....  
(g) .....

To: The Registrar of Trade Marks,  
P. O. Box 30031,  
Nairobi.

[Subsidiary]

FORM TM 51

FEE  
1st Sch.,  
items 6f, 6g

APPLICATION FOR CANCELLATION OF ENTRY OF A REGISTERED USER OF A TRADE MARK

(Section 31 (8) (c) and Rule 99)

(a) Additional numbers may be given on a signed schedule on the back of this form.

*(To be accompanied by a Statement of the Grounds for the application)*

(b) Here insert the name, trade or business address and description of the registered proprietor as entered in the Register.

IN THE MATTER OF Trade Mark[s] No. [s] ..... (a)  
registered in Class ..... in the name of (b) .....

(c) Here insert the name and address of the applicant for cancellation.

Application is hereby made by (c) .....

(d) Here insert the name, trade or business address and description of the registered user as entered in the Register.

whose address for service in Kenya in these proceedings is .....

(e) Here insert the goods in respect of which the registered user is entered.

for the cancellation of the entry under the above-mentioned registration[s] of (d) .....

(f) Here insert one or more of the sub-paragraph (c) of section 31 (8) numbered (i), (ii), (iii).

as the registered user thereof in respect of (e) .....

The grounds of this application, particulars of which are given in detail in the accompanying statement of case, are (f) .....

Dated this ..... day of ....., 20.....

(g) Signature.

(g) .....

To: The Registrar of Trade Marks,  
P. O. Box 30031,  
Nairobi.

FORM TM 52

FEE Sh. 10
---------------

[Subsidiary]

NOTICE TO THE REGISTRAR UNDER SECTION 31(9) AND RULE 100 OF  
 INTENTION TO INTERVENE IN PROCEEDINGS FOR THE VARIATION OR  
 CANCELLATION OF AN ENTRY OF A REGISTERED USER OF A TRADE  
 MARK

*(To be accompanied by a Statement of the Grounds for Intervention)*

IN THE MATTER OF a Trade Mark No. ....  
 registered in Class ..... in the name of (a) .....

(a) Insert here the name of the registered proprietor.

.....

and

IN THE MATTER OF a registration of (b) .....

(b) Insert here the name and trade or business address of the registered user.

.....

thereunder as a Registered User of the Mark.

\_\_\_\_\_

In reply to the Registrar's Notification, dated the .....  
 day of ....., 20....., notice is hereby given of my intention to  
 intervene in the proceedings in the above matter.

My address for service in Kenya for the purpose of these proceedings  
 is:

.....  
 .....

Dated this ..... day of ....., 20 .....

(c) Signature.

(c) .....

To: The Registrar of Trade Marks,  
 P. O. Box 30031,  
 Nairobi.

[Subsidiary]

L.N. 146/2003.

FORM TM 53

APPLICATION FOR EXTENSION OF TIME

(rule 102 (4))

This is an application for an extension of time.

Name and address for service of applicant:

Description of the matter with respect to which the time relates:

Extension sought:

Grounds on which the application is based:

Names and addresses of other parties:

Date: .....

Signature: .....

Extension granted:

.....  
 .....  
 .....

Signature of Registrar: .....

Date: .....

FORM TM 54

ORDER FORM FOR COPY OF DOCUMENT

(rule 115)

Name and address of person seeking copy:
--

I wish to obtain a copy of a document of the following type (tick the relevant box):

a judgment or order of the Registrar or other document used in a proceeding before the Registrar.

another document

Description of document:

.....

.....

I wish to have the copy of the document certified (tick the relevant box):

yes

no

Date: .....

Signature: .....

To: The Registrar of Trade Marks.

[Subsidiary]

L.N. 146/2003.

FORM TM 55

APPLICATION TO ADD GOODS OR SERVICES TO A TRADE MARK OR APPLICATION

(rule 29A (3))

In the matter of Trade Mark No .....or Application No: .....

Class: .....

Name or registered proprietor/applicant: .....

Trade or business address: .....

I, the proprietor or applicant of the trade mark or application described above, apply to add the following goods or services to those in respect of which the trade mark is or would be registered.

Description of goods or services:

.....  
.....  
.....  
.....

Date: .....

Signature: .....

To: The Registrar of Trade Marks.

[Subsidiary]

**Application of section 65 to Foreign States under subsection (4) of that section** L.N. 37/1967,  
L.N. 134/1975.

Algeria	Madagascar
Argentina	Malawi
Australia	Malta
Austria	Mauritania
Belgium	Mexico
Brazil	Monaco
Bulgaria	Morocco
Cameroon	Netherlands
Canada	New Zealand
Central African Republic	Niger
Chad	Nigeria
Congo (Brazzaville)	Norway
Cuba	Philippines
Cyprus	Poland
Czechoslovakia	Portugal
Dahomey	Rumania
Denmark	San Marino
Dominican Republic	Senegal
Egypt	South Africa
Finland	Spain
France	Sri Lanka
Gabon	Sweden
Germany (Democratic Republic of)	Switzerland
Germany (Federal Republic of)	Syria
Greece	Tanzania
Haiti	Togo
Holy See	Trinidad and Tobago
Hungary	Tunisia
Iceland	Turkey
Indonesia	Uganda
Iran	Union of Soviet Socialist Republics
Ireland	United Kingdom of Great Britain and Northern Ireland
Israel	United States of America
Italy	Upper Volta
Ivory Coast	Uruguay
Japan	Vietnam
Jordan	Yugoslavia
Laos	Zaire
Lebanon	Zambia
Liechtenstein	
Luxembourg	

[Subsidiary]

L.N. 145/2003. THE TRADE MARKS (INTERNATIONAL REGISTRATION) RULES,  
2003

## ARRANGEMENT OF RULES

### PART I – PRELIMINARY

- 1-Citation.
- 2-Definitions.
- 3-Forms.
- 4-Fees.
- 5-Institute to be office for Kenya.

### PART II - APPLICATION IN KENYA FOR INTERNATIONAL REGISTRATION

- 6-Application.
- 7-Examination and forwarding by Institute.

### PART III - INTERNATIONAL APPLICATIONS DESIGNATING KENYA

- 8-Application of Part.
- 9-Initial examination.
- 10-Applicant's rights on refusal after initial examination.
- 11-Opposition.
- 12-Refusal to be in accordance with treaty, etc.
- 13-Partial refusal.
- 14-Supplementary Register.
- 15-Extracts from Register.
- 16-Effects of international registration.

### PART IV-TRANSFORMATION OF INTERNATIONAL REGISTRATION TO A KENYAN REGISTRATION

- 17-Application of Part.
- 18-Application to transform to Kenyan registration.
- 19-Automatic registration.
- 20-Continuation of unfinished proceedings.

### PART V- PENDING APPLICATIONS

- 21-Pending applications.

### SCHEDULES

- First Schedule-Forms.
- Second Schedule-Fees.

[Subsidiary]

THE TRADE MARKS (INTERNATIONAL REGISTRATION)  
RULES, 2003

L.N. 145/2003.

## PART I - PRELIMINARY

1. These Rules may be cited as the Trade Marks (International Registration) Rules, 2003. Citation.

2. In these Rules, unless the context otherwise requires - Definitions.

“applicable treaty” means whichever between the Madrid Agreement or the Madrid Protocol which applies to the registration;

“international registration” means registration with the International Bureau under the Madrid Agreement or the Madrid Protocol;

“Trade Marks Rules” means the rules of that name made under the Act;

3. The forms set out in the First Schedule shall be the prescribed forms for the purposes of these Rules. Forms.

4. The prescribed fees for purposes of these Rules shall be as set out in the Second Schedule. Fees.

5. The Institute shall be the office for Kenya for the purpose of the Madrid Agreement and the Madrid Protocol and, in carrying out that function, the Institute shall comply with the Madrid Agreement and the Madrid Protocol and the regulations made under those treaties. Institute to be office for Kenya.

## PART II - APPLICATION IN KENYA FOR INTERNATIONAL REGISTRATION

6. (1) A person who is a proprietor of a registered trade mark, or who has applied for the registration of a trade mark, may file an application for international registration of the trade mark with the Institute if, under the applicable treaty, the person is entitled to do so. Application.

(2) An application under paragraph (1) shall be made in accordance with the applicable treaty and shall be accompanied by the prescribed fee payable to the Institute and the applicable fees under the applicable treaty.

7. (1) The Institute shall examine the application for international registration and, if it complies with the requirements under the applicable treaty, forward the application together with the applicable fees, if any, to the International Bureau. Examination and forwarding by Institute.

(2) The expenses incurred by the Institute in forwarding the application to the International Bureau shall be met by the applicant.

[Subsidiary]

PART III - INTERNATIONAL APPLICATIONS DESIGNATING KENYA

- Application of part. 8. This Part shall apply with respect to an application for international registration of a trade mark that requests the extension of protection to Kenya.
- Initial examination. 9. Upon being notified of an application by the International Bureau, the Institute shall examine the application and either -
- (a) notify the International Bureau that protection for the trade mark is refused if there are grounds for doing so under the applicable treaty; or
  - (b) advertise the application in accordance with the Trade Mark Rules.
- Applicant's rights on refusal after initial examination. 10. (1) If the Institute notifies the International Bureau, under rule 8 (a), that protection for the trade mark is refused the applicant shall have the same remedies under the Trade Marks rules as he would have if the application was an application thereunder made directly to the Institute.
- (2) If, as a result of the applicant pursuing his remedies under paragraph (1), the refusal is withdrawn, the Institute shall advertise the application under rule 9 (b).
- Opposition. 11. (1) Any person may, within sixty days of the advertisement of an application under rule 9 (b), give notice to the Registrar of opposition to the intended registration.
- (2) The Registrar shall, upon receiving a notice of opposition under this Rule, give notice of the same to the International Bureau, indicating the main grounds contained therein.
- (3) The provisions of the Trade Marks Rules shall, with necessary modifications, apply to a notice served under this rule.
- (4) If it is determined, based on grounds under the applicable treaty, that the trade mark should be refused protection, the Institute shall notify the International Bureau that protection for the trade mark is refused.
- Refusal to be in accordance with treaty, etc. 12. In refusing protection for a trade mark under rule 8 (a) or 10 (3), the Institute shall act in accordance with the applicable treaty and the regulations under that treaty.
- Partial refusal. 13. If protection is refused with respect to some, but not all, of the goods or services for which protection is sought, this Part shall apply, with necessary modifications, as though there were two applications, one with respect to the goods or services for which protection was refused and one with respect to the goods or services for which protection was refused.
- Supplementary 14. (1) The Registrar shall maintain a Register to be known as the

[Subsidiary]

Supplementary Register (International) for the purpose of recording, all international trade marks registered under these Rules together with the names and addresses of their proprietors. Register.

(2) The provisions of the Trade Marks Rules in relation to the Register maintained thereunder shall, with necessary modifications, apply to the Supplementary Register maintained under this Rule.

15. (1) Any person may request the Registrar to cause a search to be made in the Supplementary Register maintained under rule 14 in respect of specified goods or services and may request for extracts thereof or copies of other documents maintained by the Registrar. Extracts from Register.

(2) Requests under this rule for a search and for extracts from the Supplementary Register or copies of other documents, shall be in Forms TM 27 and TM 54 of the Trade Marks Rules respectively.

16. (1) A trade mark that has been internationally registered, the protection of which has been extended to Kenya, shall have the same effect and enjoy the same protection as specified in section 7 of the Act in relation to trade marks registered under Part A of the Register maintained under that section. Effects of international registration.

(2) Paragraph (1) does not apply if protection for the trade mark is refused under rule 8 (a) or 10 (3) or, if protection is refused with respect to some, but not all, of the goods or services to which the trade mark relates, paragraph (1) does not apply with respect to those goods or services.

(3) A trade mark described in paragraph (1) may be -

- (a) taken off the Register under section 29 of the Act;
- (b) cancelled under section 30(4) of the Act;
- (c) expunged or varied under section 35 of the Act; or
- (d) expunged or varied under section 36 of the Act.

(4) The Trade Mark Rules shall apply, with necessary modifications, for the purposes of paragraph (3).

PART IV - TRANSFORMATION OF AN INTERNATIONAL REGISTRATION TO A KENYAN REGISTRATION

17. (1) This Part applies if the international registration of a trade mark registered under the Madrid Protocol is cancelled at the request of the office where the basic registration was made if, before being cancelled - Application of Part.

- (a) the protection of the trade mark was extended to Kenya;
- (b) the extension of the protection of the trade mark to Kenya was requested and had not been refused but the time for giving

## [Subsidiary]

notification of such a refusal under the applicable treaty had not expired; or

- (c) the extension of the protection of the trade mark to Kenya was requested and refused but the proprietor's remedies to challenge that refusal had not yet been exhausted.

(2) In this rule, "basic registration" means the registration of a trade mark in a country, other than Kenya, upon which the international registration is based.

Application to transform to Kenyan registration.

18. (1) The proprietor of an internationally registered trade mark which is cancelled may apply to have the international registration transformed to a Kenyan registration.

(2) An application under paragraph (1) shall be made to the Registrar in form TM (International) 1.

Automatic registration.

19. If an application for a transformation is made in the circumstances described in rule 13 (1) (a), the application to transform the international registration shall be granted and the trade mark shall be registered.

Continuation of unfinished proceedings.

20. If an application for a transformation is made in the circumstances described in subparagraph (b) or (c) of rule 13 (1), the application to transform the international registration shall be dealt with under the Trade Marks Rules as though it were an application under those Rules subject to the following -

- (a) If the international application had been advertised under rule 8 (b), that advertisement shall be deemed to have been an advertisement of the application under the Trade Marks Rules;
- (b) Any steps or proceedings taken under these Trade Marks Rules with respect to the extension of protection to Kenya before the international registration was cancelled shall be deemed to have been taken with respect to the transformation application and any such proceedings that have not been completed shall be continued under the Trade Marks Rules.

## PART V - PENDING APPLICATIONS

Pending applications.

21. (1) Any international registration in respect of which an application is pending before the institute at the time of the coming into operation of these Rules shall -

- (a) where the period of notice prescribed under the applicable treaty has expired, be entered into the register maintained under Rule 14; and
- (b) where the period referred to in subparagraph (a) has not expired, be examined by the Registrar in accordance with these Rules.

(2) Any person with an objection to any registration under sub-paragraph  
(a) may apply for rectification of that register under Rule 16 (3).

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**FIRST SCHEDULE**

(r.3)  
FORM TM (International) 1  
Rule 14 (2)

THE TRADE MARKS ACT  
(Cap. 506)

APPLICATION TO HAVE INTERNATIONAL REGISTRATION  
TRANSFORMED INTO KENYAN REGISTRATION

1. Trade Mark:

*(One representation of the trade mark shall be set out in the above box)*

2. Application is hereby made for the transformation of the registration of the above trade mark into a Kenyan registration.

3. Classification: .....

    Goods/Services: .....

    Proprietor: .....

    Trade or business address: .....

    Trading style: .....

4. Additional information where necessary: .....

    Date: .....

    Signature: .....

To: The Registrar of Trade Marks.

## SECOND SCHEDULE

(r.4)

## FEES

<i>Description of Fee</i>	<i>Local Fee KSh</i>	<i>Foreign Fee US\$</i>	<i>Corresponding form</i>
1. On handling an application for International registration, in addition to the fees under the applicable treaty	1,000	-	
2. On filing an application for transformation under Rule 18.	-	100	TM 1 (International)

Notes:

1. A foreign fee is payable if the person paying the fee or on whose behalf the fee is being paid does not reside in Kenya and does not have a principal place of business in Kenya.

