

How to Enforce your Trade Mark in Kenya

The two ways of enforcing a trade mark is by an action in passing off or an action against infringement. The difference between these two is that an action against infringement is taken against a person who violates trade mark rights in relation to a registered trade mark while an action in passing off relates to unregistered trademarks. An action against infringement of a trade mark is easier since registration is proof that the registered proprietor has the exclusive right to exploit the mark while for an action in passing off; the offended person has to prove that passing off of his product has caused an injury to his/her goodwill. A registered owner does not have to prove that any damage has been occasioned by infringement for the offending person to be stopped from continuing with the infringement.



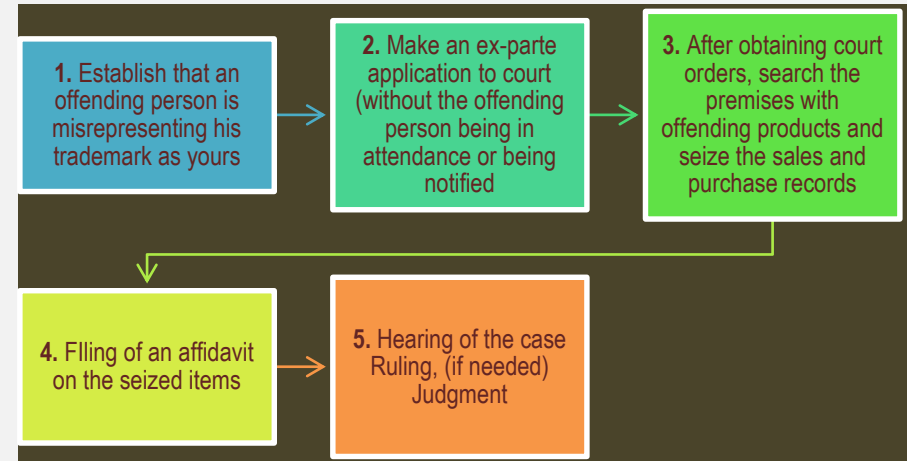
To prove that a person has passed off his goods or services as another's, the Courts look at whether there is goodwill in the get-up (the visual appearance) of those goods and services and a misrepresentation that is likely to deceive the consumers of those good or services to think that the aggrieved person supplied them. The Courts will also consider if there was damage to the goodwill caused by that erroneous belief. For infringement, the court has to look at whether the offending persons' product is strikingly similar as to deceive or confuse the public or consumers of these products with those of the aggrieved person.

It is important to note that there are two types of passing off. In the first one, the goods are counterfeit (let's call it type A) while in the other type the products are violations of unregistered trademarks (let's call it type B passing off). Counterfeits use similar trademarks while in passing off, the marks are confusingly or deceptively similar. Goods which are an infringement of a trade mark and type B of passing off are usually different in packaging if the consumers and the general public are keen observers of the appearance/feel of the product. Even keen observers might not be alert and end up being confused/deceived by the visual appearance/ contours of a product. Infringement of a trademark and type B of passing off is usually done openly by legitimate businesses while counterfeiting (type a passing off) is done under wraps.

The first step that an aggrieved person should take is to get a court order for searching the premises of an offending person where the offending products

are stored, together with sales and purchase records. Once the offending products are found together with the sales records, they are seized and are to be used as evidence because on a successful claim of infringement or passing off, the courts can give an order stopping the offending person from selling the product under that trade mark, an order for monetary compensation of the owner of the trade mark, an order for the offending person to surrender the profits obtained in respect of the passed off/ infringed products or any combination of those remedies.

The Trademark Litigation Process in Kenya



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