

LEGAL NOTICE NO. 146

THE TRADE MARKS ACT

(Cap. 506)

IN EXERCISE of the powers conferred by sections 36A, 39 and 41 of the Trade Marks Act, the Minister for Trade and Industry makes the following Rules:—

THE TRADE MARKS (AMENDMENT) RULES, 2003

Citation.

1. These Rules may be cited as the Trade Marks (Amendment) Rules, 2003.

L.N. 575/1956.

2. Rule 2 of the Trade Marks Rules, in these Rules referred to as “the principal Rules”, is amended by repealing the definition of “agent” and substituting therefore the following new definition —

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

3. Rule 5 of the principal Rules and the heading preceding that rule are deleted.

4. Rules 6, 7 and 8 of the principal Rules and the heading preceding those rules are deleted and the following new rules and heading substituted therefor:

Classifications under previous system

Old classifications preserved.

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.

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.

(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 —

- (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.

5. Rule 20 (1) of the principal Rules is deleted and the following new paragraphs substituted therefor —

Preliminary advice by Registrar as to distinctiveness.

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.

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

6. Rule 21 of the principal Rules is amended—

(a) by deleting paragraph (1) and substituting therefor the following new paragraph —

Form of application.

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.

(b) in paragraph (2), by deleting the words “section 67 of the Act” and substituting therefor the words “section 65 of the Act”;

(c) by inserting, at the end, the following new paragraphs —

(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.

7. Rules 23 and 24 of the principal Rules are deleted.

8. Rule 28 of the principal Rules is deleted and the following new rule substituted therefor—

Series of trade marks.

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.

9. Rule 29 of the principal Rules is amended by deleting the words “and on each of the accompanying forms TM 3”.

10. The principal Rules are amended by adding the following new rule and heading immediately after rule 29 —

Application to add goods or services.

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.

(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.

11. Rule 32 of the principal Rules is amended by deleting the words “three months” and substituting therefor the words “ninety days”.

12. Rule 33 of the principal Rules is amended—

- (a) in paragraph (1), by deleting the words “three months” and substituting therefor the words “ninety days”;
- (b) in paragraph (2), by deleting the words “one month” and substituting therefor the words “thirty days”.

13. Rule 34 (1) of the principal Rules is amended by deleting the words “one month” and substituting therefor the words “thirty days”.

14. Rule 36 (1) of the principal Rules is deleted and the following new paragraph substituted therefor—

Application under s.
30 of the Act.

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.

15. Rule 37 of the principal Rules is deleted and the following new rule substituted therefor—

Application under s.
40 of the Act.

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.

16. Rule 39(1) of the principal Rules is deleted and the following new paragraph substituted therefor —

Case, draft
regulations.

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.

17. Rule 42 of the principal Rules is amended by deleting paragraphs (1) and (1A) and substituting therefor the following new paragraphs—

Advertisement of
application.

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.

18. Rules 43, 44, 45 and 45A of the principal Rules are deleted and the following new rules substituted therefor—

Representations or
information from
applicant.

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.

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 under s. 21(1) and 38(2), (4) of the Act.

45. Advertisements under sections 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.

Costs of advertisement.

45A. Before an advertisement relating to an application is published, the applicant shall pay the costs of the advertisement.

19. Rule 46 of the principal Rules is amended by deleting the words "in the Gazette" and substituting therefor the words "in the Journal or Kenya Gazette".

20. Rule 47 (2) of the principal Rules is deleted and the following new paragraph substituted therefor—

(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.

21. Rule 48 of the principal Rules is amended by inserting the following new paragraph after paragraph (3)—

(4) Upon receipt of the counter-statement and duplicate the Registrar shall forthwith send the duplicate to the opponent.

22. Rules 49, 50 and 51 of the principal Rules are deleted and the following new rules substituted therefor—

Evidence in support of opposition.

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.

(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.

Evidence in support of application.

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 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.

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.

23. Rule 52A of the principal Rules is amended by striking out the words "rules 48 to 52" and substituting the words "rules 48 to 50".

24. Rule 55 of the principal Rules is deleted.

25. Rule 58 of the principal Rules is deleted.

26. Rule 60(1) of the principal Rules is amended by deleting the words "in the Gazette" and substituting therefor the words "in the Journal or Kenya Gazette" and by deleting the words "in Form TM 9".

27. Rule 61 of the principal Rules is deleted and the following new rule substituted therefor —

Notations indicating association no longer of any effect.

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.

28. Rule 63 of the principal Rules is amended by deleting the words "which may be a representation thereof supplied by the applicant under rule 23".

29. Rule 64(1) of the principal Rules is amended by deleting the words "three months" and substituting therefor the words "ninety days".

30. Rule 65 of the principal Rules is amended by deleting the words "one month" and substituting therefor the words "thirty days" and by deleting the words "two months" and substituting therefor the words "sixty days".

31. Rule 66 of the principal Rules is amended by deleting the words "one month" and substituting therefor the words "thirty days".

32. Rules 67 and 68 of the principal Rules are deleted and the following new rules substituted therefor—

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 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.

Removal of trade mark from Register.

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.

33. Rule 70 of the principal Rules is amended by deleting the words "in the Gazette" and substituting therefor the words "in the Journal or Kenya Gazette".

34. Rules 71 and 72 of the principal Rules are deleted and the following new rule substituted therefor—

Application for entry of assignment or transmission.

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.

35. Rule 73 (1) of the principal Rules is deleted and the following new paragraph substituted therefor—

Particulars to be stated in application.

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.

36. Rule 74 of the principal Rules is amended—

- (a) by deleting the words "Where in the case of an application in form TM 14 or form TM 15" and substituting therefor the word "If"; and
- (b) by deleting the words "in form TM 16".

37. Rule 76 of the principal Rules is amended—

- (a) in paragraph (1), by deleting the words "or rule 72"; and

- (b) by deleting paragraph (2) and substituting therefor the following new paragraph—

(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.

38. Rule 78 of the principal Rules is amended by deleting the words “or rule 72”.

39. Rule 79 of the principal Rules is amended—

- (a) in paragraph (1), by deleting the words “form TM 39, 40 or 29” and substituting therefor the words “form TM 39 or 40”;
- (b) in paragraph (2), by deleting the word “by” and substituting therefor the word “be”.

40. Rule 80(5) of the principal Rules is deleted.

41. Rule 82(2) of the principal Rules is deleted and the following new paragraph substituted therefor —

(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.

42. Rule 83 of the principal Rules is deleted and the following new rule substituted therefor —

Further procedure.

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.

43. The principal Rules are amended by adding the following new rule and heading immediately after rule 84 —

Surrender of a Registered Trade Mark

**Application to
surrender.**

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

- (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.

44. Rule 85 of the principal Rules is amended —

- (a) in paragraph (1), by deleting the words “change, cancellation or striking out any goods or services or classes of goods or services” and substituting therefor the words “or change”;
- (b) by deleting paragraph (2) and substituting therefor the following new paragraphs —

(2) An application under paragraphs (a), (b) or (c) 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.

45. Rule 87 of the principal Rules is amended by deleting the words “in the Gazette” and substituting therefor the words “in the Journal or Kenya Gazette” and by deleting the words “one month” and substituting therefor the words “thirty days”.

46. Rule 88 of the principal Rules is amended by deleting the

words "in the Gazette" and substituting therefor the words "in the Journal or Kenya Gazette".

47. Rule 89 of the principal Rules is amended by deleting the words "and shall furnish the Registrar with four copies of the mark as it will appear when so added to or altered".

48. Rule 90 of the principal Rules is amended by deleting paragraphs (1) and (2) and substituting therefor the following new paragraphs —

Advertisement before decision.

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.

49. Rule 91 of the principal Rules is amended by deleting the words "in the Gazette" wherever it appears and substituting therefor the words "in the Journal or Kenya Gazette".

50. Rule 92 of the principal Rules is deleted and the following new rule substituted therefor—

Advertisement.

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.

51. Rule 94(2) of the principal Rules is amended by deleting the words "one month" and substituting therefor the words "thirty days".

52. The principal Rules are amended by adding the following new rule and heading immediately after rule 94—

Collective Trade Marks

Application for registration.

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.

(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.

53. Rule 96 (2) of the principal Rules is amended by deleting the words "in the Gazette" and substituting therefor the words "in the Journal or Kenya Gazette".

54. Rule 100 (2) of the principal Rules is amended by deleting the words "one month" and substituting therefor the words "thirty days".

55. Rule 101 of the principal Rules is amended—

(a) by inserting the following new paragraph immediately after paragraph (1)—

(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.

(b) in paragraph (2), by deleting the words "section 32 of the Act" and substituting therefor the words "section 31 of the Act".

56. Rule 102 of the principal Rules is deleted and the following new rule substituted therefor—

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.

(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.

57. Rule 104 of the principal Rules is amended by deleting the words "one month" and substituting therefor the words "thirty days".

58. Rule 108 of the principal Rules is amended by renumbering that rule as paragraph (1) and inserting the following new paragraph—

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

59. Rule 114 (1) of the principal Rules is deleted and the following new paragraphs substituted therefor —

Searches.

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.

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

60. Rule 115 of the principal Rules and the headings preceding that rule, are deleted and the following new rule and heading substituted therefor —

Copies

Copies of documents.

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

61. Rule 116 of the principal Rules and the heading preceding that rule are deleted.

62. Rule 120 of the principal Rules is amended by deleting the words "in the Gazette" and substituting therefor the words "in the Journal or Kenya Gazette".

63. The principal Rules are amended by adding the following new rule and heading immediately after rule 120 —

Submission of documents in electronic form

Submission of
electronic documents.

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.

64. The First Schedule to the principal Rules is deleted and the following new Schedule substituted therefor —

FIRST SCHEDULE

r. 3

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	
ADDITION OF GOODS OR SERVICES			
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
RENEWAL			
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	
ASSIGNMENT OF TRADE MARKS			
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	

<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	
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	
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	200	
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	

<i>Description of fee</i>	<i>Local Fee KSh</i>	<i>Foreign Fee US\$</i>	<i>Correspond- ing form.</i>
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
RECTIFICATION AND CORRECTION OF THE REGISTER			
20. Application fee for an application, under r. 81(1), 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

<i>Description of fee</i>	<i>Local Fee KSh</i>	<i>Foreign Fee US\$</i>	<i>Correspond- ing form.</i>
24. Application fee for an application, under r. 84A (1), to surrender a trade mark			
for all goods and services	1,000	50	TM 21
for some goods and services	1,000	50	TM 22
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			
for the first class	2,000	100	TM 19
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			
for the first trade mark	3,000	150	TM 20
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			
for the first registration certified	1,000	50	TM 47
for each additional registration certified in the same certificate	500	50	
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			
for the first class	4,000	200	TM 24
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 to a certification trade mark	6,000	300	TM 35

<i>Description of fee</i>	<i>Local Fee KSh</i>	<i>Foreign Fee US\$</i>	<i>Corresponding form.</i>
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
COSTS			
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	
MISCELLANEOUS			
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	

<i>Description of fee</i>	<i>Local Fee KSh</i>	<i>Foreign Fee US\$</i>	<i>Correspond- ing 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	
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	

<i>Description of fee</i>	<i>Local Fee KSh</i>	<i>Foreign Fee US\$</i>	<i>Correspond- ing form.</i>
49. Fee for copies			TM 54
for judgements, orders or other documents used in a proceeding before the Registrar, per page	20	1	
for other documents, per document	500	10	
additional fee for certification, per document	1,000	50	

65. The principal Rules are amended by deleting the Second Schedule and the Third Schedule.

66. The Fourth Schedule to the principal Rules is amended —

(a) by deleting forms TM 1 and TM 2 and substituting the following new 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.

Datedat.....

Signature

FORM TM 2

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.

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.

(b) by deleting forms TM 3 and TM 5;

(c) by deleting form TM 6 and substituting therefor the following new form —

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:

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.

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:

(f) by deleting forms TM 11, TM 12 and TM 13;

(g) by deleting form TM 14 and substituting therefor the following new form —

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):

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.

(h) by deleting forms TM 15 and TM 16;

(i) by deleting form TM 17 and substituting therefor the following new form—

FORM TM 17

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:

.....
.....

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.

- (j) by deleting form TM 18;
- (k) by deleting forms TM 19, TM 20, TM 21, TM 22, TM 23, TM 24, TM 25, TM 26, TM 27 and substituting therefor the following new forms—

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.

to amend another document or drawing or other representation (specify:

Name and address of applicant:

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

Description of correction or amendment:

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

Date:

Nature:

Signature: The Registrar of Trade Marks.

FORM TM 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 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.

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.

FORM TM 22

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

APPLICATION TO ENTER DISCLAIMER OR MEMORANDUM IN REGISTER

(rule 85 (2))

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.

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:

Date:

Signature:

To: The Registrar of Trade Marks.

FORM TM 25

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.

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.

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:

.....

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.

(l) by deleting forms TM 28 and TM 29;

(m) by deleting form TM 30 and substituting therefor the following new form—

FORM TM 30

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.

(n) by deleting form TM 31;

(o) by deleting form TM 32 and substituting therefor the following new form—

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.

(p) by deleting form TM 33;

(q) by deleting form TM 34 and substituting therefor the following new form—

FORM TM 34

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.

(r) by deleting forms TM 36, TM 37, TM 38 and TM 42;

(s) by deleting forms TM 43 and TM 44 and substituting therefor the following new forms—

FORM TM 43

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.

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.

(t) by deleting form TM 45;

(u) by adding the following new forms immediately after form TM 52—

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.

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 of 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.

Dated the 8th August, 2003.

MUKHISA KITUYI,
Minister for Trade and Industry.