

THE TRADE MARKS (AMENDMENT) ACT**No. 4 of 2002***Date of Assent: 19th August, 2002**Date of Commencement: 23rd August, 2002***AN ACT of Parliament to amend the Trade Marks Act****ENACTED BY** the Parliament of Kenya, as follows:-

1. This Act may be cited as the Trade Marks (Amendment) Act, 2002.

Short title.

2. The Trade Marks Act, in this Act referred to as “the principal Act”, is amended in section 2 –

Amendment of section 2 of Cap.506

- (a) by deleting the expression “registered user” wherever it occurs and substituting therefor the word “licensee”;
- (b) by inserting the following definitions in their proper alphabetical sequence –

“ARIPO” means the African Regional Industrial Property Organization;

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

“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;

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

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

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

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

No.3 of 2001

Replacement of
section 6 of
Cap.506 .

3. The principal Act is amended by repealing section 6 and replacing it with the following new section –

Registration to be in respect of particular goods or services.

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.

4. The principal Act is amended by inserting the following new section immediately after section 15 -

Amendment of section 15 of Cap.506.

Protection of well known trade marks.

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 –

- (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 goodwill 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.

5. Section 23 of the principal Act is amended –

Amendment to section 23 of Cap. 506.

(a) in subsection (1) –

(i) by deleting the word “seven” and substituting therefor the word “ten”;

(ii) by deleting the proviso.

(b) in subsection (2) –

(i) by deleting the word “fourteen” and substituting therefor the word “ten”;

(ii) by inserting the following proviso –

“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.”

- (c) by inserting the following new subsection –

“(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.

Repeal of
section 26 of
Cap.506

6. The principal Act is amended by repealing section 26.

Amendment of
section 33 of
Cap.506.

7. Section 33 of the principal Act is amended in subsection (1) by deleting the words “of an associated registered trade mark, or of the” and substituting therefor the words “of a”.

Amendment of
section 36 of
Cap.506.

8. The principal Act is amended by inserting the following new sections immediately after section 36 -

Surrender of a
registered trade
mark.

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.

(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.

Effect of
Acquiescence.

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 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.

Insertion of new Part in Cap.506.

9. The principal Act is amended by inserting the following new Parts immediately after Part VII –

PART VIIA – COLLECTIVE TRADE MARKS

Collective trade marks.

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 insofar 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 and Protocol.

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;

“International Bureau” means the International Bureau of the World Intellectual Property Organisation, established by the convention signed at Stockholm on the 14th 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 27th 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.

Rules regarding regional and international applications.

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.

(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.

Applications for registration of marks under the Banjul Protocol.

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.

(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

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apply to international trade marks.

Amendment to
section 58D of
Cap. 506

10. Section 58D of the principal Act is amended in subsection (1) by deleting the words “ten thousand” and substituting therefor the words “two hundred thousand”

Amendment of
section 58E of
Cap. 506

11. Section 58E of the principal Act is amended in subsection (1) by deleting the words “ten thousand” and substituting therefor the words “two hundred thousand.”

Amendment of
section 58F of
Cap. 506

12. Section 58F of the principal Act is amended in subsection (1) by deleting the words “ten thousand” and substituting therefor the words “two hundred thousand.”

Amendment to
section 63 of
Cap. 506.

13. Section 63 of the principal Act is amended by renumbering the existing provision as subsection (1) and inserting the following new subsections –

(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.

Amendment of section 58 of No.3 of 2001.

14. Section 58 of the Industrial Property Act, 2001 is amended in subsection (2) by deleting the words “by the owner of the patent or with his express consent.”