

# The Trade Marks (Amendment) Act, 1994

No. 5 of 1994

*Date of Assent: 28th July, 1994*

*Date of Commencement: by Notice*

An Act of Parliament to amend the Trade Marks Act to provide for the registration of service marks and for matters connected therewith

*Enacted by the Parliament of Kenya as follows:—*

## *Short Title and Commencement*

1. This Act may be cited as the Trade Marks (Amendment) Act, 1994 and shall come into operation on a date to be appointed by the Minister by notice in to Gazette. *Amendment of Section 2 of Cap. 506*

2. Section 2 of the Trade Marks Act, in this Act referred to as “the principal Act,” is amended—

(a) by deleting from subsection (1) the definitions of “mark” and “trade mark” and inserting the following new definitions—

“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;

“certification trade mark” means a mark registered or deemed to have been registered under section 40;

“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 registered user 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;

(b) by inserting in subsection (1) the following new definitions in their proper alphabetical sequence—

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

“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 practise in the particular department of learning or science with which such body is concerned;

“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;

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

(c) by deleting subsection (2) and inserting the following—

(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 service.

*Amendment of Section 5 of Cap. 506*

3. Section 5 of the principal Act is amended by deleting the words “goods as the goods of another person”.

*Replacement of Section 6 of Cap. 506*

4. Section 6 of the principal Act is deleted and replaced by the following new section—

*Registration of to be in Respect of Particular Goods or Services*

6. A trade mark must be registered in respect of particular goods or services and any question arising as to the class within which any goods or services fall shall be determined by the Registrar.

*Amendment of Section 7 of Cap. 506*

5. Section 7 of the principal Act is amended—

(a) by deleting subsection (1) and inserting the following new subsection—

(1) Subject to the provisions of this section, and of sections 10 and 11, the registration (whether before or after 1st 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) 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 registered user 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 registered user 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 registered user of the trade mark.

(b) by inserting after the words “to any market” in subsection (2) the words “or services for use or available for acceptance in any place or country”;

(c) by adding at the end of subsection (3) the following new paragraphs—

(c) in relation to services to which the proprietor of the trade mark or a registered user 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 registered user 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 registered user of the trade mark, where the proprietor or registered user 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 right 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.

*Amendment of Section 8 of Cap. 506*

6. Section 8 of the principal Act is amended—

- (a) by deleting from subsection (1) all the words from “in respect of any goods” to “as if the registration had been in Part ‘A’ of the register” and substituting “if valid gives to that person the same right”;
- (b) by adding at the end of subsection (2) the words “or in respect of services that a person having the right either as proprietor or as registered user to use the trade mark is connected in the course of business with the provision of the services”.

*Amendment of Section 9 of Cap. 506*

**7.** Section 9 of the principal Act is amended by deleting subsection (1) and inserting the following—

(1) Where, by a contract in writing made with the proprietor or a registered user 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.

*Amendment of Section 12 of Cap. 506*

**8.** Section 12 of the principal Act is amended by adding at the end of subsection (2) the words “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”.

*Amendment of Section 13 of Cap. 506*

**9.** Section 13 of the principal Act is amended by adding at the end of subsection (1) the words “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”.

*Amendment of Section 15 of Cap. 506*

**10.** Section 15 of the principal Act is amended—

- (a) by deleting from subsection (1) all words after “identical with” and substituting “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.”
- (b) by adding in subsection (3) after the words “description of goods” the words “or in respect of the same services or description of services”.

*Amendment of Section 17 of Cap. 506*

**11.** Section 17 of the principal Act is amended by adding in paragraph (b) after the words “the trade” the words “or to the provision of services of that description”.

*Amendment of Section 18 of Cap. 506*

**12.** Section 18 of the principal Act is amended—

(a) in subsection (1) by—

(i) adding after the words “article or substance” at the end of the first paragraph the words “or of some activity”;

(ii) adding the following further proviso—

(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 use in relation to services with the provision of which the proprietor or a registered user of the trade mark is connected in the course of business;

(b) in subsection (2) by deleting the words “paragraph (i) or paragraph (ii) of:” and adding in paragraphs (a), (b) and (c) (i) after the words “of the same description” the words “or of the activity in question”.

*Amendment of Section 23 of Cap. 506*

**13.** Section 23 of the principal Act is amended by adding in proviso (i) of subsection (4) after the words “trade use” the words “or business use”.

*Amendment of Section 25 of Cap. 506*

**14.** Section 25 of the principal Act is amended—

(a) by deleting subsections (1), (2) and (3) and substituting the following new subsections—

(1) A registered trade mark is assignable and transmissible either in connection with the goodwill of a business or not.

(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;

(b) by deleting from subsection (4) the words “of goods” and “the goods” and substituting the words “of goods or services to be performed” and “the goods or services to be performed” respectively;

(c) by inserting in the proviso to subsection (4) immediately after the words “or otherwise traded in” the words “or services to be performed”;

(d) by inserting in subsection (5) after the words “any goods” the words “or services” and also after the words “of the goods” the words “or services”;

(e) by inserting in subsection (6) immediately after the words “or otherwise traded in,” wherever they occur the word “or services to be performed”.

*Amendment of Section 28 of Cap. 506*

**15.** Section 28 of the principal Act is amended—

(a) by inserting in subsection (1) after the words “of the goods” the words “or services”;

(b) by inserting in subsection (3) after the words “title to a trade mark” the words “except as between the parties to the document or instrument.”

*Amendment of Section 29 of Cap. 506*

**16.** Section 29 of the principal Act is amended—

(a) by inserting in subsection (1) after the word “goods” wherever it occurs the words “or services”;

(b) by deleting the proviso to subsection (1) and inserting the following new proviso—

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 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, 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;

(c) by inserting in subsection (2) after the word “goods” the words “or services”;

(d) by inserting in paragraph (b) of subsection (2) immediately after the words “or otherwise traded in,” the words “or services to be performed”;

(e) in subsection (3) by deleting all the words after “in the trade” and substituting “or in relation to particular services and not to any intention to abandon the trade mark to which the application relates”.

*Amendment of Section 31 of Cap. 506*

**17.** Section 31 of the principal Act is amended—

(a) by deleting subsection (1) and inserting the following new subsection—

(1) Subject to the provisions of this section, a person other than the proprietor of a trade mark may be registered as a registered user 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 registered user thereof in respect of which for the time being the trade mark remains registered and he is registered as a registered user, 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;

(b) by inserting in paragraphs (b) and (c) of subsection (4), subsection (5), paragraph

(a) of subsection (8) and in subsection (10) respectively after the word “goods” the words “or services”.

*Amendment of Section 32 of Cap. 506*

**18.** Section 32 of the principal Act is amended by inserting in subsection (1), paragraphs (a) and (b) thereof immediately after the word “goods” the words “or services to be performed”.

*Replacement of Section 34 of Cap. 506*

**19.** The principal Act is amended by repealing section 34 and inserting the following new section—

*Use of Trade Mark for Export Trade*

**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.

*Amendment of Section 37 of Cap. 506*

**20.** Section 37 (b) of the principal Act is amended by deleting from subsection (1), paragraph (d) and substituting the following new paragraph—

(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

*Amendment of Section 39 of Cap. 306*

**21.** Section 39 of the principal Act is amended by inserting in subsection (1) after the words “goods or classes of goods” the words “or services or classes of services”.

*Amendment of Section 41 of Cap. 506*

**22.** Section 41 of the principal Act is amended by inserting in paragraph (b) after the word “goods” the words “and services”

*Insertion of New Section 54A in Cap. 506*

**23.** The principal Act is amended by inserting immediately after section 54 the following new section—

*Nice Agreement Receivable in Evidence*

**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.

*Amendment of Part XI of Cap. 506*

**24.** Part XI of the principal Act is amended by inserting immediately after section 58 the following new sections—

*Interpretation of Terms in Part XI*

**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 or for any purpose of trade or commerce.

#### *Application*

**58B.**—(1) A trade mark is applied to goods if—

- (a) it is applied to the goods themselves; or
  - (b) it is applied to a covering on, in or attached 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.
- (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.

#### *Forgery of Registered Trade Mark*

**58C.** For the purposes of this Part, a person forges a registered trade mark if—  
*Prohibition of Forgery of Registered Offences Trade Mark*

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

- (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 ten 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.

*Prohibition of Sale or Importation of Goods or Performance of Services with Forged Registered Trade Mark*

**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 ten 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—

(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*

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

#### *Evidence*

**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*

**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.

#### *Amendment of Third Schedule to Cap. 506*

**25.** The Third Schedule to the principal Act is amend—

(a) by deleting paragraph 5 thereof and inserting the following new paragraph—

**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.

(b) by adding the following new paragraph after paragraph 6—

**7.** In his 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, 1st 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.