



PASSING OFF UNDER KENYAN LAW

In the competitive world of commerce, a business's reputation and brand identity are among its most valuable assets. When another entity seeks to exploit that reputation by presenting its goods or services in a manner likely to deceive the public into believing they originate from or are associated with an established brand, the law offers recourse through the doctrine of passing off.

Passing off refers to a misrepresentation by one party that leads, or is likely to lead, consumers to believe that their goods or services originate from, or are associated with, another business. It is designed to protect the goodwill a business has built over time and to guard against unfair competition.

In Kenya, passing off is actionable as a tort and forms part of the broader framework of unfair competition. This article outlines the legal foundation of passing off in Kenya, the elements required to establish a claim, and the remedies available to parties seeking to protect their brand identity and reputation.

THE LEGAL BASIS FOR PASSING OFF IN KENYA

Where a trademark is unregistered, the proprietor may still seek protection under the common law tort of passing off. This right is expressly preserved under [Section 5 of the Trade Marks Act \(Cap. 506\)](#), which states that

“nothing in the Act shall be deemed to affect rights of action against any person for passing off goods.”

Accordingly, the owner of an unregistered trademark may file a passing off claim against a third party who misrepresents their goods or services in a manner likely to mislead the public.

THE ELEMENTS OF A PASSING OFF CLAIM

The foundational elements of passing off were articulated in the English case of [Reckitt & Colman Products Ltd v Borden Inc & Others \[1990\] R.P.C. 34](#). The court identified three essential components of a passing off action:

1. Goodwill

To succeed in a passing off claim, the claimant must establish the existence of goodwill or reputation in their goods or services. This goodwill must be associated in the minds of the public with a particular identifying feature, such as a trade name, brand, packaging or overall get-up, that distinguishes the claimant's goods or services from those of others in the market.

The nature of this proprietary right was defined in the case of [HP Bulmer Ltd v Bolinger SA \[1978\] RPC 79](#) as follows: “A man who engages in commercial activities

may acquire a valuable reputation in respect of the goodwill in which he deals or of the services which he performs or of his business as an entity. **The law regards such reputation as an incorporeal piece of property, the integrity of which the owner is entitled to protect.**"

This definition affirms that goodwill is not merely an abstract concept, but a legally recognized form of property deserving of protection. Its value lies in the ability to attract and retain customers, and it forms the foundation of a passing off claim. Without it, the claimant cannot demonstrate that the defendant's conduct has interfered with a proprietary interest recognized by law.

2. Misrepresentation

The claimant must demonstrate that the defendant made a misleading representation that leads, or is likely to lead, the public to believe that the defendant's goods or services originate from, or are in some way associated with, the claimant.

Misrepresentation is not limited to identical copying. It may arise where the overall presentation of a product or service is sufficiently similar to cause confusion among consumers. The focus is on the effect of the defendant's conduct on the ordinary purchaser, not on whether the defendant intended to deceive.

This principle was addressed in [Strategic Industries Limited v Solpia Kenya Limited \[2019\] KEHC 10209 \(KLR\)](#), where the court held that: ***"In dealing with a case of passing off, the test that the court is required to apply is whether the mark has sufficient similarity with the overall appearance... that would cause confusion to the ordinary customer."*** The court in this case emphasized that confusion need not stem from exact imitation but from the likelihood of similarity, a broader standard that captures the reality of how consumers perceive products in day-to-day transactions.

3. Damage

The claimant must demonstrate that they have suffered, or are likely to suffer harm as a direct result of the defendant's misrepresentation. This damage may take various forms, including loss of sales, dilution or erosion of goodwill or injury to business reputation.

In preventive actions (*quia timet*), it is not necessary to prove actual loss; rather, the claimant must establish a real and imminent likelihood of damage if the misrepresentation remains unchecked. The rationale is to prevent harm before it materializes, especially where the continued use of the offending mark threatens to mislead consumers and undermine the claimant's market position.

In [Strategic Industries Limited v Solpia Kenya Limited \[2019\] KEHC 10209 \(KLR\)](#), the court affirmed that damage (actual or probable) is a necessary component of the tort of passing off. The court stressed that the claimant must go beyond proving the existence of confusion; they must show that such confusion has already impacted, or is likely to impact, their commercial interests.

THE REMEDIES OF PASSING OFF UNDER KENYAN LAW

Where a claimant proves a case of passing off, Kenyan courts may grant various remedies to prevent further harm and protect the claimant's commercial interests. The key remedies include:

- a. **Injunctions** – To restrain the defendant from continuing the misrepresentation and prevent further harm to the claimant's goodwill.
- b. **Damages** – Monetary compensation for actual loss, such as lost sales, reputational harm or corrective advertising expenses.
- c. **Account of profits** – An order requiring the defendant to surrender profits gained from the misrepresentation, to prevent unjust enrichment.
- d. **Delivery up or destruction** – The court may order the surrender or destruction of infringing goods, packaging or materials bearing the deceptive get-up.

HOW CM ADVOCATES LLP'S IP & TMT UNIT CAN SUPPORT YOU

At CM Advocates LLP, our Intellectual Property and TMT Unit offers strategic legal support to businesses seeking to protect their brand identity, market reputation and goodwill from unfair competition and misrepresentation. Whether you are responding to an instance of brand misappropriation or seeking to proactively safeguard your rights, our team is equipped to support you through the entire dispute process.

Our services in this area include:

- **Advisory on brand protection and risk assessment:** We help clients assess potential vulnerabilities to passing off and advise on the practical steps to strengthen legal protection, including the use of distinctive get-ups and proper documentation of brand use.
- **Litigation support:** We represent clients in initiating or defending passing off claims before Kenyan courts. We prepare pleadings, collect supporting evidence of goodwill, misrepresentation and damage, and present the case with clarity and commercial sensitivity.
- **Evidence development:** We work with clients to compile persuasive evidence of goodwill and market confusion, essential elements in proving passing off, including customer testimony, sales data and market surveys.
- **Cross-border coordination:** Where brand misuse spans multiple jurisdictions, we coordinate with our regional partners to align enforcement strategies across East Africa and within ARIPO member states.

NEED LEGAL GUIDANCE?

For support with the registration, enforcement or related intellectual property matters, please contact:

Contact Person & Contributor



Mercy Chore

Associate Advocate,
IP & TMT Unit
mchore@cmadvocates.com

www.cmadvocates.com

Or reach our Corporate Commercial Practice Team at:
commercial@cmadvocates.com



I&M Bank House, 7th Floor, 2nd Ngong' Avenue Off Ngong' Road
Upperhill, Community | P.O BOX 22588-00505, Nairobi, Kenya
Email: law@cmadvocates.com

Disclaimer; This publication is for informational purposes only and does not constitute legal advice.
For tailored legal support, please consult our team.