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THE OVERLAP BETWEEN TRADEMARK RIGHTS AND BUSINESS NAME REGISTRATION IN KENYA

1. Introduction

The growth of Kenya's commercial landscape has brought business name registration and trademark protection into conflict. Although these concepts are often used interchangeably, they are governed by distinct legal regimes and confer different rights.

Business names are administrative identifiers used for regulatory and entity identification purposes, whereas trademarks are proprietary intellectual property rights that confer exclusive protection over distinctive signs used to distinguish goods or services in trade. The lack of integration between these two systems has created a regulatory gap that frequently results in disputes involving brand ownership, infringement and passing off.

This article examines the legal distinction between business names and trademarks, the structural gaps between the Business Registration Services ("BRS") and the Kenya Industrial Property Institute ("KIPI") systems and how Kenyan courts have resolved competing claims over commercial identity.

2. The legal distinction between business names and trademarks

A business name is an administrative identifier under which different forms of business entities operate, including sole proprietorships, partnerships and companies.

A trademark, by contrast, is a proprietary intellectual property right protected under the [Trade Marks Act \(Cap 506\)](#) ("the Trademarks Act"). It functions to distinguish the goods or services of one business from another and grants the registered proprietor exclusive enforceable rights.

Accordingly, business name registration does not prevent trademark infringement, nor does it confer ownership of brand identity in a proprietary sense.

3. The regulatory gap between BRS and KIPI

The conflict between business names and trademarks is largely a product of Kenya's dual registration system.

The BRS registers business and company names based on name availability and similarity. KIPI on the other hand conducts substantive examination of trademarks, assessing distinctiveness and potential conflict before registration.

As the two systems operate independently, a business name may be registered at the BRS even where an identical or similar trademark already exists at KIPI. This structural separation is the primary source of "name-mark" conflicts in Kenya.

3.1 The statutory mechanisms addressing the conflict

To address this gap, the [Companies Act, No. 17 of 2015](#) empowers the Registrar of Companies to intervene



where a registered company name conflicts with a trademark.

Under Section 49(1)(c), the Registrar must consider whether a proposed name incorporates a registered trademark. Where infringement is identified, Section 58 allows the Registrar to direct the company to change its name.

Failure to comply within the prescribed period may lead to administrative striking-off of the company. This provides trademark owners with an effective administrative remedy through the BRS system.

3.2 Protection of prior business name use

The Trade Marks Act balances trademark exclusivity through Section 10, which preserves rights arising from prior bona fide use of a mark or name.

This doctrine ensures that a person who has used a name in good faith in the course of trade before the registration of a competing trademark may continue to use it, notwithstanding the later registration. It operates as an equitable safeguard within the first-to-file system, preventing the displacement of established commercial goodwill and recognising prior market presence as a relevant factor in determining enforceable rights.

4. The judicial approach to resolving business name and trademark conflicts

4.1 Supremacy of Registered Marks

The case of [*Agility Logistics Limited & 2 Others vs. Agility Logistics Kenya Limited \[2012\] eKLR*](#) centered on a legal battle over the name “Agility,” where global logistics giants sued a local Kenyan firm for trademark infringement and passing off. Although the local company had registered its business name in 2008, shortly before the international group registered its trademarks in Kenya in 2009, the court found that the local firm was trying to ride on the global reputation of the “Agility” brand. The judge noted a significant gap in Kenyan law, where the Companies Act (before the 2015 amendment) and the Trademarks Act operated in silos, allowing two different entities to register the same name under different registries.

Ultimately, the High Court ruled in favor of the plaintiffs, granting a permanent injunction to stop the Kenyan company from using the name. The court prioritized trademark protection over company name registration, concluding that the defendant's use of the name in the same industry would inevitably confuse the public and damage the plaintiffs' established goodwill.

4.2 Protection of prior users

The ruling in [*Paksons Enterprises Limited v Kipkoech t/a Paksons Agroveterinary Solutions & another \[2024\] KEHC 15435 \(KLR\)*](#) the court reaffirmed the protection of prior users under Section 10 of the Trade Marks Act.

Although the plaintiff owned a registered trademark, the defendant had used the business name earlier and in good faith. The court held that prior continuous use could defeat an infringement claim, particularly where no deceptive branding was established.

5. Practical implications for businesses

The persistent friction between the BRS and KIPI registries necessitates a holistic approach to brand protection. Treating business name registration as a substitute for trademarks is a commercial error that leaves a brand's most valuable intangible asset exposed. The following are the best practices for the entrepreneurs and legal Practitioners.

- a) **Integrated search strategy;** before adopting any brand name, entrepreneurs should conduct official searches at both KIPI and BRS. This ensures the name is available for both entity registration and proprietary protection.
- b) **Simultaneous registration;** whenever possible, the business name and core trademark should be filed concurrently. This dual-track approach secures the legal persona and the brand identity from day one.
- c) **Strategic classification;** applicants should map their current and near-future business models to the NICE classes with precision. Failure to protect a brand in service classes or relevant goods-classes can create loopholes for competitors.
- d) **Active policing and enforcement;** registration is only the beginning. Trademark owners must monitor the Industrial Property Journal for infringing applications and the BRS for conflicting company names.
- e) **Utilizing administrative remedies;** for company-name infringements, trademark owners should consider the Section 58 of the Companies Act BRS petition as a faster, more cost-effective alternative to High Court litigation.

6. Conclusion

The distinction between trademark rights and business name registration in Kenya reflects a separation between administrative business identity and proprietary brand protection, with conflicts arising



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from the independent operation of the BRS and KIPI systems. Effective brand protection therefore requires early and integrated registration strategies across both regimes, ensuring that commercial identities are both properly constituted and legally secured.

How we can assist

At CM Advocates LLP, we recognize that the current regulatory landscape, split between the Business Registration Service (BRS) and the Kenya Industrial Property Institute (KIPI), creates a systemic Name-Mark gap. Our specialized IP and Technology practice is designed to bridge this gap, ensuring your brand is not just registered, but fortified. We provide the technical expertise and the strategic foresight to turn your commercial identity into a legally enforceable asset, comprising of the following strategic solutions:

a) Comprehensive Inter-Registry Due Diligence- We conduct coordinated searches across both the Business Registration Service (BRS) and the Kenya Industrial Property Institute (KIPI) to identify potential conflicts before incorporation or registration, minimizing the risk of infringement and name disputes.

b) Administrative Petitions- We assist clients in pursuing statutory remedies before the Registrar, including applications for compulsory name changes, offering efficient alternatives to lengthy court proceedings.

c) Trademark Monitoring and Brand Protection -We actively monitor the Industrial Property Journal and file oppositions against conflicting marks to prevent dilution of your brand and protect your market reputation.

d) IP Audits and Due Diligence- We assist businesses with IP valuation, ownership verification, and portfolio compliance during mergers, acquisitions, restructurings, and internal reviews.

e) Strategic Enforcement- We enforce brand rights through administrative action before BRS and KIPI, court injunctions, and collaboration with the Anti-Counterfeit Authority (ACA) against counterfeit goods and brand misuse.

If you would like to discuss how best to protect your innovation or require assistance with any intellectual property matter, please contact the contributor below or reach out to our Intellectual Property and Technology team at tmtpractice@cmadvocates.com.

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