

UNDERSTANDING TRADEMARK INFRINGEMENT IN KENYA

In today's competitive marketplace, a brand is often a business's most valuable asset. At the core of that brand is a trademark, which serves as a legal tool to distinguish your goods or services from those of others. When a competitor uses a trademark that is identical or confusingly similar to a registered trademark, the law on trademark infringement provides the framework for protection and enforcement.

This article examines the key elements of trademark infringement under Kenyan law, drawing on judicial decisions to illustrate how the law is applied in practice. For a more practical guide to identifying potential infringement in day-to-day operations, you can read our earlier article on the *Practical Tips on How to Spot Trademark Infringement*.

THE NATURE OF TRADEMARK INFRINGEMENT

Trade mark infringement occurs when a registered mark is used in the course of trade without the proprietor's consent. This unauthorized use involves the use of a trademark that is either identical or confusingly similar to a registered trade mark in connection with identical or related goods or services, thereby creating a likelihood of confusion among consumers.

Section 7(1) of the *Trademarks Act, Cap 506*("the Trademarks Act") provides for the proprietary nature of trademark rights by conferring upon the registered proprietor the exclusive right to use the mark in connection with the specified goods or services.

This was affirmed by the *High Court in Pharmaceutical Manufacturing Company vs Novelty Manufacturing Ltd HCCC No 746 of 1998*, where Justice Ringera stated that the registration of a trademark confers the right of exclusive use of a mark. He further clarified that infringement is a tort of strict liability, meaning the infringer's intention or motive is immaterial. The legal focus is on whether there has been unauthorized use of a registered or confusingly similar trademark in a manner likely to mislead or confuse consumers.

THE LEGAL TEST FOR TRADEMARK INFRINGEMENT IN KENYA

1. The plaintiff must be the registered proprietor

A valid claim for trademark infringement can only be brought by the person registered as the proprietor of the mark. This is because registration grants the exclusive right to use the trademark in relation to the goods or services for which it is registered. In *Weetabix Limited v Manji Food Industries Ltd [2015] eKLR*, the court underscored that trademark protection under Kenyan law is premised on valid registration. Ownership of a trademark is proved by submitting a valid certificate of registration.

2. The infringing trademark must be identical or similar to the registered trademark

The second element of trademark infringement is the likelihood of confusion. This arises where the offending mark is identical to, or so closely resembles, the registered trademark that it is likely to mislead the public. In assessing this, courts consider the overall impression created by the two marks from the perspective of the average consumer.

In *Premier Food Industries Ltd v Triclover Industries (K) Ltd [2021] eKLR*, the court emphasized that the likelihood of confusion must be assessed globally taking into account visual, aural and conceptual similarities. The analysis focuses on the dominant and distinctive elements of the marks, rather than on minor differences. Applying this approach, the court found that Triclover's lime cordial packaging bore a striking resemblance to Premier's "Peptang" lime cordial. Due to the similarity in bottle shape, label design and colour scheme, the court concluded that there was a high likelihood of consumer confusion, sufficient to establish trademark infringement

3. Use of the mark must be without authorisation

Infringement arises when a person uses a registered trademark or one that closely resembles it without the consent or authority of the proprietor. This right, protected under Section 7 of the Trademarks Act, is statutory in nature and applies irrespective of the infringer's intent or awareness.

In *Mabati Rolling Mills Limited v Royal Mabati Factory Limited [2020] KEHC 9717 (KLR)*, the court reaffirmed that liability for infringement does not depend on an intention to deceive; any unauthorized use of a registered mark by a third party constitutes infringement. In this case, the court found that, since the plaintiff was the registered proprietor of the trademarks "Versatile" and "Royal Versatile", any third party could only use the marks with the plaintiff's express permission.

Similarly, in *Unilever PLC v Bidco Oil Industries [2004] eKLR*, the court emphasized that registration grants the proprietor the exclusive right to use the mark. Any unauthorized use by a person who is not a licensee or does not have the proprietor's consent amounts to trademark infringement and may also give rise to liability under the common law tort of passing off.

4. The use is likely to cause injury or prejudice

Finally, the claimant must demonstrate that the unauthorized use of the trademark is likely to cause harm to the proprietor's commercial interests. Such harm may take the form of lost sales, erosion of brand distinctiveness, reputational damage or dilution of goodwill. In *Bakhresa Food Products (K) Ltd v Advent Ltd [2017] eKLR*, the High Court held that the similarity between the packaging of the competing beverages was likely to mislead consumers, thereby causing commercial prejudice to the claimant.

Notably, the court does not require proof of actual financial loss; it is sufficient to show a likelihood of injury or prejudice. In that case, it was submitted that the defendant's continued infringement was steadily eroding the reputation and goodwill that the plaintiff had built since registering the trademark. The court accepted that such ongoing damage, if left unchecked, would ultimately result in irreparable harm, thereby forming the basis of the infringement claim.

CONCLUSION

Trademark protection under Kenyan law is grounded in a clear legal framework that prioritizes registration, exclusivity, and the prevention of consumer confusion. For businesses, this underscores the importance of not only securing trademark registration but also actively monitoring for infringement and taking timely legal action where necessary. In a brand-driven market, safeguarding intellectual property is no longer optional, it is essential to maintaining a competitive edge and preserving consumer trust.

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

At CM Advocates LLP, our Intellectual Property & TMT Unit offers strategic, tailored support to innovators and businesses seeking to protect and enforce their intellectual property rights. With a strong presence across Kenya, Uganda, Tanzania, Rwanda, South Sudan, Zambia and Ethiopia, our team provides focused legal guidance and representation in cases of infringement of registered trademarks. Our services include:

- **Trademark protection and enforcement strategy:** We assist clients in developing proactive strategies for securing and enforcing their trademark rights, including the preparation and filing of trademark applications to establish a strong legal foundation.
- **Litigation support:** We represent clients in court to obtain injunctive relief, damages or orders for the seizure and destruction of infringing goods.
- **Border enforcement:** We liaise with anti-counterfeit and customs authorities to intercept infringing imports, especially where industrial designs are misappropriated across borders.
- **Regional enforcement:** With a regional footprint, we help enforce trademark rights beyond Kenya through coordinated regional strategies.

NEED LEGAL GUIDANCE?

For support with trademark registration, renewal or related intellectual property matters, please contact:

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