

TRADE MARKS AND
INDUSTRIAL DESIGNS:
A LEGAL PRACTITIONERS PERSPECTIVE

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1. TRADE MARK

1.1 Definition

To define the word trademark, one will perhaps need to look at the definition of each word separately and apart from the other.

According to the legislative definition¹ the word trade means any type of profession or other business occupation in which a mark may be used in the manner prescribed by the (Trade Marks) Act.

According to the said Act, 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

A trade mark is then defined as a mark used or proposed to be used

- a) in relation to goods for the purpose of indicating a connection between the goods and the person having the right to the same
- b) in relation to services for the purpose of indicating a connection in the course of business between the person and the provision of those services

This definitions rank closely to the definition of a trademark under the Trade Marks Act, 1994 of the United Kingdom which defines a trade mark as:

any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

The United Kingdom definition seems to have been taken directly from the World Intellectual Property Organization (WIPO) definition of Trade Marks.

Those of you who may be followers of the sport called football or even the aficionados of Sports News on the rediffusion set may have heard commentators spew out phrases like, "The Brazilian (Ronaldo) ended his recent goal drought with a simple header at the far post after David Beckham had sent a trademark free-kick into the box."² The use of the word trademark in such instances has no relation to intellectual property but is at best grammatical and only means³ 'a characteristic' but it goes along way to show the effect of the trademarks to everyday life.

In many jurisdictions, a registered trademark may be easily identified by the use of the symbol TM or the symbol ®.

¹ The Trade Marks Act, Cap 506 of the Laws of Kenya,

² Daily Nation Monday April 11, 2005 page 37

³ Concise Oxford English dictionary defines it as a distinctive characteristic or object.

2. Main Characteristics of Trade Marks

2.1 Capacity to distinguish

A Trade Mark needs to be distinctive to qualify for consideration as a Trade Mark. Previously, only the trade representations of the Marks, or slogans or get-up or colour schemes were considered as distinctive elements. Not all slogans will for instance be deemed registrable. In a recent case in the United Kingdom, involving B&Q plc⁴, the Registry was not prepared to register the slogan 'You can do it' for, *inter alia*, financial services and information. It held that the mark was devoid of any distinctive character and was 'considered to be the kind of mark that others may wish to use during the course of trade and should be free to do so'.

In another case, this time involving WalMart Stores, Inc, the Registry would not accept that the slogan 'Our people make the difference' should be registrable for, *inter alia*, stationery and price tags. The Registry ruled that: '*... the relevant consumer seeing this mark as goods... or on a price tag, would understand the slogan as conveying a purely promotional message extolling the qualities of the staff of the undertaking which is responsible for the business in which the goods are used.*'

However there is a broadening trend in the current set up of Intellectual Property with shapes being admitted as Trade Marks as long as they are capable of distinguishing the Mark from others. The most famous shape that has been registered is the Coca Cola contour bottle. In South Africa, the Supreme Court cancelled⁵ the registration of the AUGMENTIN tablet shape trademark on grounds that registration of the tablet shape trade mark was contrary to the provisions of the (South African Trade Marks) Act as a shape of a tablet is necessary to obtain a technical result and such registration would limit the development of the industry.

Single colour, sound and smell (olfactory) trademarks have also become accepted as distinctive Trade Marks in other jurisdictions though in this country, the two are not yet recognized as registrable Trade Marks.

2.2 Graphic representation

A trademark ought to be graphically represented. Usually this is in a visual manner so that the eye may see what the Trade Mark looks like for ease of distinction and everyday use. Graphic representation however need not be necessarily in a visual manner.

⁴ 30 August 2001, Trade Marks Registry decision no 0/043/02

⁵ Beecham Group plc and SmithKline Beecham Pharmaceuticals v Triomed (Pty) Ltd and the Registrar of Trade Marks

Musical notations can qualify as representations; whilst smells may be described in terms of chemical components. Graphic representation has to be clear, precise, self-contained, easily accessible, intelligible, durable and objective⁶.

2.3 Undertaking

There has to be a connection with the trade or services offered by the person who wishes to register a Trade Mark. The connection with goods for instance is closely linked with the production of those goods rather than mere subsequent use.

The question of undertaking is usually a thorny one when one looks at the promotional use of a trade mark.

In *Gulf Oil Corporation v Rembrandt Fabrikante en Handelaars*⁷ the court decided that the proprietor never really intended to conduct any trade in a commercial sense and that it did not sell the goods under its mark *with the object or intention of protecting, facilitating or furthering any trade in those goods*.

3. Justification for Trade Mark Protection

Trade Mark protection performs a variety of economic purposes.

3.1 Origin Function

The traditional justification for Trade Mark protection is that it allows the consumer to distinguish between competing products and services.

The origin function need not necessarily relate to the geographical origin of the goods or services, but its commercial origin. The consumer is therefore able to tell by the identification that the product originates from a certain company. For instance, when you buy the mineral water 'Dasani' you will note that it has the words '*a product of the Coca Cola Company*' displayed on the bottle.

Some people do not agree with this function as often, some consumers do not know, or are not they concerned about a products commercial origin.

3.2 Guarantee Function

Trademarks symbolize qualities associated by a consumer to certain goods and services.

⁶ Sieckmann v Deutsches Patent und Markenamt Case C-237/00 in the European Court.

⁷ Bpk 1963 (2) SA 10 (T)

This guarantee function provides the consumer with information at first glance that the product will meet their requirements for the quality or of product. If you have flu, for instance, and you want it gone quickly, you will easily settle for product identified as FLUGONE⁸. Suppose one had a headache and he or she wished to get medication that will act fast, there is a product like ACTIFAST⁹ that will lead you to the guarantee function of the Mark.

3.3 Investment Function

Many times you will note that when a new product or service is being launched, a company usually spends heavily on the advertising of the said product or service. Companies invest heavily in the promotion of their services and products and that outlay deserves protection. An example of this when there is a merger between companies as was evidenced last year when Apollo Insurance Company Limited merged with Pan African Insurance Company to form APA Insurance Company. A new company was formed; a new logo was created¹⁰; a new slogan was created¹¹ and massive presence was felt on television, newspapers, t-shirts, calendars and others. Once this presence is attained, the trademark owner has something of value and if another poaches upon the commercial magnetism of the symbol that has been created, the owner can obtain legal redress¹².

4 Legislative Sources

Kenya is a signatory to most of the International Conventions on Trade Marks. The country is now TRIPs¹³ compliant. The county is a signatory to the Paris Convention¹⁴.

The Trade Marks Act, Cap 506, governs the Trade Mark regime in Kenya. The Act has undergone several amendments to conform to worldwide trends with the most recent amendments coming into effect on 23 August 2003 vide the Legal Notice No. 146 titled the Trade Marks (Amendment) Rules 2003. Simultaneously, Legal Notice No. 145 brought into force the Madrid Protocol¹⁵ by the enactment of the Trade Marks (International Registration) Rules, 2003.

⁸ This has led to some people rightly believing that a trade mark is a merchandising psychological short cut which induces a purchaser to select what he wants, or what he has been led to believe that he wants.

⁹ Trade Mark KE/T/2001/051427

¹⁰ Trade Mark KE/T/2004/055812

¹¹ A New Dimension In Insurance, Trade Mark Application KE/T/2004/055815

¹² Dictum of Frankfurter, J in the case of *Mishawaka Rubber & Woolen Manufacturing Company v SS Kresge Co.* [316, U.S. 203]

¹³ Trade Related Intellectual Property Rights.

¹⁴ Paris Convention for the Protection of Industrial Property (concluded in 1883)

¹⁵ Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (concluded in 1989)

The new trademark law passed by our parliament also incorporated provisions relating to the protection of well-known marks as recommended by WIPO. Kenya is also a party to the Nice Agreement¹⁶ concerning the International Classification of Goods and Services for the purposes of the registration of trademarks.

5. The Process of Registration in Kenya

5.1 Search

The process of the Registration of Trade Marks and Service Marks usually begins with conducting of a search on the availability of the Mark for Registration. This is to simply find out if there is any similar or closely resembling Mark on the Register or if the Mark is registrable. The search process is also optional as one can file the application for the Mark without first searching.

5.2 Filing

The next stage is filing the application. Where no search has been done, this is also the first step. All that is needed is completion of the Application Form that is provided in the Trade Mark Rules. The form lists the name of the applicant, the address, the class of the goods or services; the specification of goods or services that the mark is to cover. If it is a logo, a representation of the same is attached to the application form. Under Section 65 of the Trade Marks Act, an applicant can claim priority of a Trade Mark if it has been applied for hitherto in a foreign jurisdiction. If the Mark has a claim for priority, the priority documents ought to be attached to the application.

5.3 Examination

An examination report is then prepared by the examiners at the Registry of Trade Marks. One of the examiners at the Registry of Trade Marks Mr. Sylvance Sange will be available this afternoon to discuss the case study on Trade Marks. If the application is found acceptable, a letter of acceptance will be issued with the examination report. If the application requires an amendment, for instance a disclaimer or restriction of colour the same shall need to be attended to before the matter may proceed.

5.4 Advertisement

When the Mark is accepted, the Advertisement fee is then payable to the Registrar of Trade Marks or the Government Printer.

¹⁶ 1957, revised in Stockholm 1967, Geneva 1977 and amended frequently since then.

The application is advertised in the Industrial Property Journal or the Kenya Gazette as notice to the public. Those who wish to oppose the Mark can do so at this stage. After advertisement, the Registry issues a certificate of registration at the expiry of the notice period of 60 days if no opposition is preferred against the application.

6. The Cost of Filing Trade Marks

The Official Fees payable to the Registrar of Trade Marks are found in the First Schedule in the Trade Mark Rules made under the Trade Mark Act. The Schedule lists two categories of applications; one being for foreign applicants¹⁷ in the currency of United States Dollars and the other being for local applicants in the currency of Kenya Shillings.

Advocates as Trade Mark agents are entitled to fees and their charges are found under Schedule IV of the Advocates (Remuneration) (Amendment) Order, 1997. The fee quoted under this Scale however appears very low compared to other aspects of our practice provided for under the Advocates (Remuneration) (Amendment) Order.

7. Duration of Trade Marks

The Registration period for a Trade Mark is ten years from the date of registration. The Trade Mark may be renewed for terms of ten years at the expiry of each registration period¹⁸.

8. Trade Mark vis-à-vis Passing Off

Passing off is the common law mechanism for protecting goodwill between a business and its customer. In the case of *Erven Warnick v Townend*¹⁹, Lord Diplock identified the five features that must be present in order to establish a valid cause of action for passing off. These were a) a misrepresentation b) made by a trader in the course of trade c) to prospective customers of his or ultimate consumers of goods or services supplied by him d) which is calculated to injure the business or goodwill of the trader (in the sense that this is a reasonably foreseeable consequence) and e) which causes actual damage to a business or goodwill of the trader by whom the action is brought

The main difference between passing off and infringement of registered²⁰ trade marks is that in passing off, infringement occurs when there is deceptiveness as to the origin

¹⁷ A foreign applicant is one who does not reside in Kenya and does not have a principal place of business in Kenya.

¹⁸ Applications for Renewal may be made within a period of three months from the date of the expiry of the Mark.

¹⁹ [1979] A.C. 731

²⁰ Section 5 of the Trade Marks Act makes it clear that no person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered Trade Mark.

of the goods but in registered trade marks, infringement only occurs when certain requirements have been met. The requirements are that the Mark has to be (correctly) registered, and that the defendant's use of the trademark falls under the definition of infringement.

Other differences between an action for infringement of a Trademark and an action for passing off are: -

- a) a passing off action is based on injury to goodwill and not solely on a monopoly vested in the complainant
- b) passing off is wider as it extends to the imitation of get up
- c) passing off protects reputable merchandise or business not new business having no goodwill as yet
- d) the Trade Marks Act excuses bona fide infringement whilst good faith is immaterial in passing off actions which seek injunctions
- e) for purposes of restraining passing off, registration of the defendant's mark is immaterial.

A plaintiff residing outside Kenya and carrying on no direct business in Kenya can still succeed in an action for passing off.

The Courts in Kenya have seemed to set a very high degree in the test and degree of resemblance in proving an action for passing off. In *Cut Tobacco Limited v British American Tobacco*²¹, the court held that: there can be no proprietary rights in any colour²²... evidence needs to be tendered to show that the get up is likely to deceive the cigarette buying public that they are buying a (rival) packet cigarette.

The court was inclined to the idea that colour schemes may run across a certain field. The red colour in cigarette packaging is associated in Kenya with stronger brands of cigarettes whereas the white colour is associated with milder brand of cigarettes or cigarettes with lesser nicotine or tar content.

Similar arguments have been used by potential passing off agents in the fields of tea packaging (yellow and green) or cooking fat packaging (blue and white).

On the contrary in *Libertel Groep BV v Benelux-Merkenbureau*²³, the European Court held that a colour per se was under certain conditions capable of constituting a trade mark, and could, in respect of certain goods and services, have distinctive character.

²¹ Civil Appeal No. 126 of 2000 involving the Sportsman and Horseman cigarettes

²² On the contrary, a number of companies have managed to get single colour trade mark registrations eg:
- the colour green, applied to the exterior surface of filling stations, for petrol and service stations in the name of BP;
- the color brown for transport services in the name of UPS
- the colour turquoise, applied to the visible surfaces of products and the frontage of bank premises, for banking services and cheque books in the name of Barclays Bank;

²³ Case C-104/01

In this case, the issue was whether an application to register another colour with connotations in Northern Ireland, the colour orange, should be granted.

It is correct that applications to register single colours as trade marks should be examined very carefully, because these registrations can have a significant impact on competition²⁴. There are, however, undeniably cases where a particular colour has come to be so much associated with a single enterprise that it is a badge of origin. In such a case, the use of that colour by a competitor would clearly cause confusion, and we can see no reason why in those circumstances a well-defined and carefully limited trade mark application should not be allowed.

Some of you might recall the war in the advertisements that raged between KenCell²⁵ (now Celtel) and Safaricom²⁶ whereby KenCell had registered the trademark *Yes!* and Safaricom would ask consumers questions about the reliability of the Safaricom network and give the answer using the *Yes!* trademark.

To some extent, comparative advertising will fall under infringement unless it can be shown that: it is in accordance with honest business practices, is with due cause and has not taken unfair advantage of, or is detrimental to, the distinctive character of the mark.

9. Dealings In Trade Marks

9.1 Licensing

A proprietor of a trademark may license another user to use the Trade Mark without there being a devolution of title. This is what usually happens when multinationals like Coca Cola enter into franchise agreements with the Kenyan Bottling Plants. Apart from drawing Licensee Agreements, legal practitioners may also file applications²⁷ for the recordals of such licenses at the Registry of Trade Marks.

9.2 Assignments

As property, trademarks are capable of being assigned from one party to another. The assignor gives up the rights to the trade marks as there is devolution of title to the assignee. Assignments may be made with goodwill or without goodwill. Other than from drawing the Deeds of Assignment, legal practitioners may also file applications for the recordals of assignments at the Registry of Trade Marks. Before filing at the Registry of Trade Marks, the Deed of Assignment has to be duly stamped.

²⁴ Hans Muhlberg

²⁵ Kencell Communications Limited

²⁶ Safaricom Limited

²⁷ formerly called Registered User applications.

10. Challenges for Trade Mark Protection and Practice.

There are many challenges that face trademark owner and practitioners in this field face. These include:-

10.1 Lack of interlink between Registries

At this moment in time, when one applies for a trade mark, the Registrar of trade Marks does not consult with other registries (especially the Registrar of Companies) on the availability of the Trade Mark. It is therefore possible that one might run into problems when he realizes that he or she has registered a trademark yet somebody else has registered a company with a similar name.

This problem has already arisen in other jurisdictions. In *Glaxo PLC v Glaxowellcome Ltd*²⁸, the Lightman J granted a *quia timet* injunction on the grounds of passing off.

10.2 Promotional Use of Trade Marks

The so-called 'promotional use' of a trademark is a challenge in the sense that in instances where a particular trademark is being used for promotional purposes in a field removed from the main trade of the proprietor, a trademark registration for the former would be vulnerable to an expungement attack on the basis of non-use. This would be the position if the mark were not applied with the object of promoting trade in those (secondary) goods. This principle can be illustrated further by having regard to the British decision in *Kodiak Trade Mark*²⁹.

As a legal practitioner, one of the things that one would have advised a client to do would have been to associate trademarks but this was removed with the coming into force of multi-class applications in the aforementioned amendments to our Act.

10.3 The reach of the IPJ

Advertisement of Trade Marks can now be done in the Journal or in the Kenya Gazette. Previously, all Trademark applications were advertised in the Gazette,

²⁸ 1996 FSR 388. The Defendant had registered "Glaxowellcome" as a company name when he realized that a merger was planned between Glaxo PLC and Wellcome PLC. The Defendant wrote to the Plaintiff demanding Pounds 10,000 for the company name.

²⁹ 1990 FSR 49. Kodak obtained a registration for Kodak in relation to clothing. This registration was attacked on the basis that it had not been used. The evidence established that Kodak had had T-shirts, sports jackets, ties, etc manufactured and then sold them to, *inter alia*, its representatives. This clothing featured slogans such as: 'Do it. Use Kodak film and plates'. They were not sold through normal retail channels. The court considered the latter fact, in conjunction with the size and the number involved, to signify that the Kodak trade mark on the clothing would not be taken to be the trade mark of the clothing itself, but of the business being advertised on it. Consequently, there was no *bona fide* use of the mark.

published by the Government Printer. The Government Printer was very slow in the publishing of the advertisements as the Gazette carried all the official announcements and notices. Space for Trade Marks advertisements was very limited thus the need to clear the backlog by having a Trade Marks Journal. The Journal has also carried our advertisements for colour applications unlike the Gazette.

However, the circulation of the Journal is much lower than that of the Gazette. The question to ponder is whether the proprietors of Trade Marks or their Agents (read Advocates) are getting these notices so as to take appropriate action in form of oppositions. There is a big opportunity for Advocates to maintain a 'Trade Mark Watch' over their clients Trade Marks.

10.4 Need for a specialized bench for Intellectual Property issues

There have been interesting decisions by the Judiciary in respect of claims for Trade Mark infringement and passing off in Kenya. This being a fairly recent and fast growing branch of the law, it is imperative that the Bench keeps up with the modern trends so that the genuine owners of Trade Marks do not end up feeling that the Kenyan Courts are not protecting their rights as they should. The Judiciary should organize courses for the Bench so that they are able to make informed decisions since these decisions are followed in detail by the multinational companies that have filed Trade Marks in Kenya and wish to know their level of protection.

10.5 Slow branding

There is also general lack of the branding craze in this country. This therefore means that whilst there are for instance many slogans that companies have come up with, few of them get to the Registrar's office. Save for a few, even Law Firms have not tried to brand themselves and register their Service Marks at the Registry.

There should be sensitization to everybody that branding is the key to business success. All that the person has to do in respect of branding is to ask four questions. *Is it distinctive? Is it memorable? Is it positive? Is it easy to recall?* Next, the name or slogan should be registered to offer maximum protection.

10.6 Cybersquatting

Cybersquatting is the word given to the scenario that arises when someone, frequently a private individual, registers valuable trade marks as domain names for the objective of selling to the trade mark owner the entitlement to the domain name. In other jurisdictions for instance the United States, the courts have showed willingness to apply intellectual property rights to the internet. In the United Kingdom, the courts have been flexible with their interpretation of passing off, so that it now covers those who threaten to sell a domain name. Future passing off is now a term

that has been coined by the Courts and may be used by trademark owners in claims against cybersquatters.

10.7 Accession to the Madrid Protocol

With the accession to the Madrid Protocol, it is now possible for owners of trademarks in other countries to protect their trademarks in Kenya without necessarily involving the Kenyan trademark agents in such designations to the country. The natural consequence is that trade mark practice by legal practitioners in Kenya especially in respect to the international applications might go down considerably as the owners will need not instruct the Kenyan agents to register trade marks on their behalf.

10.8 Trade Marks for Specific Events

There are times when an event is organized to happen once. This could be in respect of a seminar; conference or sports tournament for instance the quadrennial FIFA World Cup tournaments have all had logos registered as Trade Marks. At times, even creators of motion pictures have trademarked their titles³⁰. The renewal of such trademarks might not be necessary as they are one-off events. Noting also that the delay at a registry may lead to the scenario where the trademark is published after the event has already been held; registries might need to put in place a mechanism for speedy publication. In case of opposition proceedings being filed against such Marks, the delay might be such that infringement proceedings might not be viable at the time of the holding of the event.

11. INDUSTRIAL DESIGN

11.1 Definition

An Industrial Design is the ornamental and aesthetic aspect of a useful article. Such particular aspect may depend on the shape, pattern or color of the article. The design must appeal to the sense of sight. Moreover, it must be reproducible by industrial means; this is essential purpose of the design and is why the design is called "industrial".

According to the legislative definition³¹ an industrial design means any composition of lines or colours or any three dimensional form, whether or not associated with lines or colours: provided that such composition or form gives a special appearance to a

³⁰ Critical Assignment starring Michael Power is a registered trademark SM 3144

³¹ The Industrial Property Act, 2001 of the Laws of Kenya, Section 84

product of industry or handicraft and can serve as a pattern for a product of industry or handicraft.

12. Main Characteristics of Industrial Designs

12.1 Novelty

An industrial design has to be new³². To this effect, a Statement of Novelty has to accompany the application for an industrial design. Novelty refers to material details and matters; thus the industrial designer must have applied further skill and labour of a draftsman like nature to qualify under the novelty requirement.

An industrial design is deemed new if it has not been disclosed to the public, anywhere in the world, by publication in tangible form or by use prior to the filing date. A cursory glance at the Industrial Property Journal edition dated 31st March 2005 on page 7 shows among the Industrial Designs Registered, a cloth hanger³³. Whilst cloth hangers have been in existent, this particular one shows distinct features not usually found on the old hangers.

13. Registration of Industrial Designs

13.1 Filing

To file³⁴ an application for Industrial Design, the applicant or their agents will complete the Form of Application Form³⁵ that is found in the Industrial Property Regulations. The form lists the name and address of the applicant; what the article is to be applied to; representations of the design; any declaration of priority; the statement of inventorship and the statement of novelty.

13.2 Examination

The Industrial Design examiner then prepares an examination report. The examiner will consider if the application appears to be new. An application will be rejected if it is contrary to public order or morality³⁶ or if the application is protected under the Copyright Act, 2001. If the application requires an amendment, the same shall be attended to before the matter may proceed for publication.

13.3 Publication

³² Section 86 (1) of the Industrial Property Act, 2001

³³ Design Number 370 and owned by Kenpoly Manufacturers Limited (name of the inventor Samir Chandaria)

³⁴ Rule 47(2) of the Industrial Property Regulations, 2002

³⁵ Form IP 27

³⁶ Section 86 (4) of the Industrial Property Act, 2001

The application is published in the Industrial Property Journal or the Kenya Gazette as notice to the public. Those who wish to oppose the Mark can do so at this stage. After advertisement, the Institute issues a certificate of registration at the expiry of the notice period of 60 days if no opposition is preferred against the application.

14. The Cost of Filing Industrial Designs

The Official Fees payable to the Managing Director of the Kenya Industrial Property Institute are found in the Second Schedule to the Industrial Property Regulations, 2002 made under the Industrial Property Act, 2001. This Schedule also lists two categories of applications; one being for foreign applicants in the United States Dollars and the other for local applicants in Kenya Shillings. The Advocates (Remuneration) (Amendment) Order, 1997 makes no mention of the fees that Advocates as Industrial Design Agents may charge their industrial designer clients.

15. Duration of Industrial Designs

The Registration period for an Industrial Design is five years from the date of registration. The Industrial Design may be renewed³⁷ for only two terms of five years each following which the design enters the public domain.

16. Trade Mark vis-à-vis Industrial Designs

Both trademark applications and industrial design application go through the rigours of registration by making the applications and letting the examiners make a decision on whether the applications may proceed for publication (also called advertisement). Opposition periods then follow after which the certificates of registration are issued.

Trade Marks do not have a period in which they fall automatically into the public domain whereas the grant of an industrial design will lapse at the end of the fifteen years.

Trade Marks are created by persons whom the applicant does not name in his application whereas the creator of the industrial design has to be named and has to be a natural person. For instance, the popular slogan Just Do It used by Nike Inc.³⁸ was coined by Dan Wieden but as far as the application for the trademark is concerned, the proprietor will be Nike Inc., which commissioned the advertising agency Wieden & Kennedy for the creation of the slogan and trademark for their athletic shoes.

³⁷ Section 88 (2) of the Industrial Property Act, 2001

³⁸ The swash logo in class 25 for footwear, clothing and headgear is Trade Mark KE/T/2002/052544

In both cases, the trademarks and industrial designs can be transmitted by way of assignment in respect of all the rights in it.

Unlike trademarks, compulsory licenses may be granted over an industrial design on the ground that the design is not being applied to such an extent as is reasonable in the circumstances of the case.

17. Conclusion

Trade Marks and Industrial Designs are important aspects of legal practice under the umbrella of Intellectual Property Law. It is important for legal practitioners to acquaint themselves with this aspect since it is clear that for a very long time to come, trademarks and industrial designs will continue to play an important role in our society.

New companies and business enterprises shall be formed and new products and services will always be brought into the market by such new companies or by the existing companies; the legal practitioner has to position himself or herself to tap into this growing area.

As it is now, there are still many business enterprises especially the local ones who have yet to grasp the importance of protecting their trademarks and service marks. Most institutions including universities³⁹, colleges⁴⁰, hospitals, schools and many others have their own identity, badges or motto. This needs to be protected so that in the event of infringement, one may have recourse by bringing a claim on infringement against anyone who makes profits from where he has not sown.

The process of registration is not difficult, the cost is very minimal and yet the advantages of registration of trademarks and industrial designs are so vast.

It should be the aim of all those who have attended this Seminar to go out there and one year from today be proud to declare that they have successfully registered a trademark or an industrial design at the Kenya Industrial Property Institute or acted on behalf of a client in passing off proceedings or trade mark infringement proceedings.

Just do it!

Thank you.

³⁹ Trade Mark KE/T/2004/055544 is a logo of Moi University and includes the motto Foundation of Knowledge

⁴⁰ Trade Mark KE/T/2003/055399 is a logo of Tec Institute of Management

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