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## USE YOUR TRADE MARK OR LOSE IT

### Introduction

This article is the first part of a three-part series on the 'use your trade mark or lose it' topic. Over the coming months, we will publish two additional series that will cover different questions or aspects on the requirement by law by brand owners to use their registered brands and the consequences of failure to do so. In this first article, we briefly examine the legal requirement of use, its rationale and the implications of non-use.

### Is the Use of a Trade Mark By a Brand Owner Optional?

There is no expressly stated mandatory provision in the law requiring a brand owner to manufacture and sell the goods or offer the services covered by its registered brand to the public. The fact that it is mandatory is implied both by the definition of a 'trade mark' under the Trade Marks Act (the 'Act') by making reference to a 'sign', 'mark' etc. used to distinguish goods or services of one company in the course of trade mark from the similar goods or services of another company. A similar inference can also be drawn under Section 29 of the Act on the consequences of cancellation from the register of a registered trade mark for non-use.

### Function of a Trade Mark

A trade mark serves as a unique identifier that distinguishes goods and services of a specific enterprise from those of its competitors in the market for the benefit of both the brand owners and consumers. It instills order, predictability and brand identity in commerce. By way of an example, the law

prohibits others from using company X's registered trade mark or a trade mark which, on comparison, can be regarded as too close to it as to confuse or deceive consumers as to who is the actual brand owner of the goods or services covered by the brand. This right is however not absolute. Most jurisdictions have imposed an obligation on trade mark owners to use their registered brands.

The requirement to use a registered trade mark prevents hoarding of brands which limits competition and stifles innovation. It also regulates instances where brand owners register brands which in the first place they have no intention to use or discontinue their use in commerce at some point and at the same time continue to enjoy the benefit of legal protection to stop competitors for using the same brands. ***In a nutshell, the law aims at avoiding a 'graveyard' of brands.***

### The Consequence of Non-use

Most jurisdictions require registered trade marks to be used continuously for a specific period of time, typically between 3 to 5 years. Failure to use the mark continuously within the specified period or longer may lead to third parties seeking to have such a trade mark to be removed from the register. Third parties who could bring such removal proceedings mostly would be competitors in the same business segment who are interested in using either an identical or a substantially similar brand to the already registered brand that the owner has not put into commercial use. This can have significant consequences for trade mark owners who fail to use their marks.

In Kenya, a registered trade mark may be taken off the register. Under Section 29 of the Act if it was either registered without any *bonafide* intention to use it or that there has been no *bonafide* use of the trade mark in relation to the goods or services for which it was registered for a continuous period of 5 years or longer.

Some jurisdictions like the United States require the trade mark owner to furnish proof of use of the mark before registering it or to file an intent to use the mark in the future., Additionally, the trade mark owner will also at specific periodic intervals post-registration be required to file a statement and evidence of use of the registration. Further, as a condition of renewing the registration when the term of protection of registration expires, the owner will be required to provide proof of use of the trade mark.

## Conclusion

The requirement to use a registered trade mark is an essential aspect of Kenya trade marks law and also many other jurisdictions, ensuring that goods and services by brand owners continue to be offered to consumers.

By understanding the rationale behind non-use provisions and the consequences of failing to use a registered trade mark as required by law, business owners can take steps to protect their brands, avoid the risks of their removal from the register and from having to defend costly expungement proceedings

In our next article in this series, we will examine the expungement process, defenses by a brand owner against an action by a third party to expunge a registered brand and what use of a brand the law considers to be sufficient use.

If you have any questions arising from this article, you can contact our intellectual property law team lead partner Patrick Ikimire at [Pkimire@Kapstrat.com](mailto:Pkimire@Kapstrat.com)



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