

THE TRADE MARKS BILL, 2015

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The Trade Marks Act, 2015

In exercise of the powers conferred by section 65 of the Trade Marks Act, 2015 the Cabinet Secretary makes the following Rules: -

The Trade Mark Rules, 2016

PART I- PRELIMINARY

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| Short title and commencement. | 1. | | These Rules may be cited as the Trade Mark Rules, 2016 and shall come into operation on such date as the Cabinet Secretary may, by notification in the Kenya Gazette appoint. |
| Interpretation. | 2. | (1) | In these Rules, except where the context otherwise requires “Act” means the Trade Marks Act, 2015; and “specification” means the designation of goods or services in respect of which a trade mark, or a licensee of a trade mark, is registered or proposed to be registered. |
| | | (2) | All other words and expressions used but not defined in these Rules and defined in the Act shall have the meaning assigned to them in the Act. |
| Fees. | 3. | (1) | The fees to be paid in respect of matters arising under the Act or these Rules shall be those prescribed in the First Schedule to these Rules. |
| | | (2) | Where a fee is payable in respect of filing of documents and the document is filed without the prescribed fee or insufficient fee is paid, such document shall be deemed not to have been filed for the purposes for which fee is payable under these Rules. |
| | | (3) | The Registrar may refund any fee that is un-utilized or paid in error. |
| Forms. | 4. | (1) | The Forms prescribed under the Second Schedule to these Rules shall be used in all cases to which they are applicable. |
| | | (2) | The Forms prescribed under the Second Schedule shall be used in all cases to which they are applicable, provided that a document which |

deviates from the prescribed form, is not void by reason of a deviation, which does not affect the substance of the document, unless it is calculated to mislead.

PART II: REGISTRABILITY OF TRADE MARKS

Conversion to new classification system.

5.

- (1) An application under section 6(3) of the Act to have the classification of the goods or services in respect of which the trade mark was registered adapted so that they are classified in accordance with the provisions of section 6 (2) of the Act, shall be made in Form 17, upon payment of the prescribed fee.
- (2) An application made under this rule shall be published in the Journal or Kenya Gazette in such manner as the Registrar may direct.
- (3) A person who wishes to oppose the proposed amendment shall do so by filing a notice of opposition in form TM 6, upon payment of the prescribed fee, with the Registrar within thirty days after the date of publication, upon which the provisions of rules 19 to 26 of these Rules shall apply, with necessary modifications, subject to any directions that the Registrar may issue.
- (4) The Registrar shall make the entries in the register that are necessary to give effect to a request to adapt a classification if—
 - (a) the time for filing a notice of opposition has expired without such a notice being filed; or
 - (b) a notice of opposition has been filed but the Registrar determines the opposition in favour of the registered proprietor.

Honest concurrent use.

6.

An application for registration of a trade mark that would otherwise offend against the provisions of section 5 (e), (j), (k) or (n) shall be made in Form TM 2, upon payment of the prescribed fee and shall be accompanied by a statutory declaration sworn by the applicant, indicating the extent of the honest concurrent use of the respective

trade marks in Kenya.

Cancellation of goods or services registered with respect to a mark that becomes generic.

7.

(1)

An application for cancellation of goods or services registered with respect to a mark that has become generic under the provisions of section 9 of the Act shall be made on Form TM 24, upon payment of the prescribed fee.

(2)

The provisions of rule 40 of these Rules shall apply, with necessary modifications, subject to any directions that the Registrar may issue.

Defensive trade marks.

8.

(1)

An application to the Registrar for registration of a defensive trade mark under section 12 of the Act shall be made in Form TM 2, upon payment of the prescribed fee, and shall be accompanied by a statutory declaration sworn by the applicant, indicating full particulars of the facts on which the applicant relies in support of the application.

(2)

The applicant may send with the statutory declaration, or subsequently, such other evidence as may be desired, whether after request made by the Registrar or otherwise, and the Registrar shall consider the whole of the evidence before deciding on the application.

(3)

In all other respects, these Rules shall apply to an application under this rule as they apply to applications for registration of ordinary trade marks.

(4)

Where the Registrar finds that the requirements referred to in subsection (1) are not fulfilled, the Registrar shall refuse or accept absolutely or subject to such amendments, modifications, conditions or limitations if any, as may be deemed appropriate.

PART III- REGISTRATION OF TRADE MARKS

Application for search and preliminary advice by Registrar as to distinctiveness.

9.

An application for search under section 14 (1) or preliminary advice under section 47 of the Act shall be made in Form TM 1, upon payment of the prescribed fee and shall be accompanied by duplicate

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representations of the mark.

Application for registration of a mark.

10.

(1)

An application for registration of a mark under the provisions of sections 12, 14 (2), 41 and 42 of the Act, shall be made in Form TM 2, upon payment of the prescribed fee and shall be signed by the applicant or his agent.

(2)

Where an application made under paragraph (1) above is a comprised of a device mark, the application shall be accompanied by seven representations of the mark.

(3)

Every application claiming priority under section 69 of the Act shall state the date of the application in the foreign state, and the applicant shall furnish a certificate by the Registrar or other registering authority of that country, or shall otherwise verify the application made or deemed to have been made therein to the satisfaction of the Registrar.

(4)

An application for registration of a trade mark that is three dimensional shall include a statement to that effect.

(5)

An application for registration of a trade mark of which colour is claimed as an element shall include a statement to that effect.

(6)

The specification of an application for registration of a trade mark for goods or services in more than one class, shall set out the classes in the same order as they appear in the classification referred to in section 6(2) of the Act.

Representation of a mark.

11.

Every application for registration of a trade mark shall contain a representation of the mark in the space provided on the application form for that purpose.

Specimens of trade marks in exceptional cases.

12.

(1)

Where a drawing or other representation or specimen cannot be submitted to the Registrar as prescribed in these Rules, a specimen or copy of the trade mark may be submitted either of full size or on a

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reduced scale, and in such form as the Registrar may deem most convenient.

- (2) The Registrar may also, in exceptional cases, deposit in the Registry of Trade Marks a specimen or copy of any trade mark which cannot conveniently be shown by a representation, and may refer thereto in the register in such manner as he may deem fit.

Series of trade marks.

13.

Where an application is made for registration of a series of trade marks under section 11 of the Act, a representation of each trade mark in the series shall be included in the application.

Transliteration and translation.

14.

(1)

Where a trade mark contains a word or words in characters other than Roman, there shall, unless the Registrar otherwise directs, be endorsed on the application form, a sufficient transliteration and translation to the satisfaction of the Registrar of each of the words, and every such endorsement shall state the language to which the word belongs and shall be signed by the applicant or his agent.

(2)

Where a trade mark contains a word or words in a language other than English, the Registrar may ask for an exact translation thereof together with the name of the language, and the translation and name, shall be endorsed and signed.

Examination of an application for registration of a trade mark.

15.

(1)

Upon receipt of an application for registration of a trade mark in respect of any goods or services, as the case may be, the Registrar shall cause a search to be made amongst the registered marks and pending applications for purposes of ascertaining whether—

- (a) in the case of an application relating to goods, there are on record for the same goods or for the same description of goods or for services or a description of services associated with the goods or goods of that description; or
- (b) in the case of application relating to services, there are on record for

the same services or for the same description of services or for goods or a description of goods associated with the services of that description,

any marks identical with the mark applied for, or which so nearly resembles it as to render the mark applied for likely to deceive or cause confusion, and the Registrar may cause the search to be renewed at any time before the acceptance of the application, but shall not be bound to do so.

(2) After a search, and consideration of the application, and of any evidence of use or of distinctiveness or of any other matter which the applicant may or may be required to furnish, the Registrar shall proceed in accordance with the provisions of section 15 (5), (6) and (7) of the Act.

(3) Where the Registrar objects to the application or, accepts the application subject to any conditions, amendments, disclaimer, modifications or limitations, the Registrar shall communicate to the applicant in writing, and, unless within ninety days from the date of the communication the applicant responds to the Registrar, the application shall be deemed to have been withdrawn.

(4) Upon consideration of the applicant's response, the Registrar shall accept the application and publish the application in accordance with the provisions of rule 17 or reject the application and inform the applicant accordingly.

Non-completion of registration.

16. (1) Where registration of a trade mark is not completed within twelve months from the date of the application the Registrar shall notify the applicant of the non-completion in writing.

(2) If after thirty days from the date when the notice was sent, or such further time as the Registrar may allow, the registration is not completed, the application shall be deemed to be abandoned.

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- Publication of an application.
17. (1) Where an application for registration of a trade mark has been approved for publication, the Registrar shall invite the applicant to pay publication fee for the application.
- (2) Upon payment of the publication fee, the Registrar shall publish:
- (a) the application number;
 - (b) the filing date of the application; and
 - (c) the information contained in Form TM 2.
- (3) For purposes of publishing a trade mark, the Registrar may, at the appropriate time, require the applicant to supply-
- (a) up to seven printed representations of the trade mark satisfactory to the Registrar; or
 - (b) such other information or means of publishing the trade mark as the Registrar requires.
- (4) The following shall apply if the application relates to a series of trade marks differing from one another in respect of the particulars provided for in section 11 of the Act—
- (a) Paragraph (3) shall apply with respect to each of the trade marks in the series; and
 - (b) the Registrar may, instead of publishing a representation of each of the trade marks in the series, include with the publication a statement describing how the trade marks differ from each other.
- Opposition.
18. (1) Any person may, within sixty days from the date of publication in the Journal or Kenya Gazette of an application for registration of a trade mark, give notice in Form TM 6 to the Registrar of opposition to the registration, upon payment of the prescribed fee.
- (2) The notice shall include a statement of the grounds upon which the opponent objects to the registration.
- (3) Where registration is opposed on the ground that the mark resembles marks already on the register, the notice shall set out—
- (a) the numbers of those other marks; and

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- (b) references to the Journals or Kenya Gazettes in which those other marks were published.
- (4) The notice shall be accompanied by a duplicate, which the Registrar shall forthwith send to the applicant.
- Counter-statement. 19. (1) The applicant shall respond to the notice of opposition by filing a counter statement in Form TM 7 in duplicate, setting out the grounds on which he relies as supporting his application, upon payment of the prescribed fees, within forty-two days from the date of receipt of the notice of opposition.
- (2) Upon receipt of the counter-statement the Registrar shall serve the duplicate copy to the opponent.
- Evidence support opposition. in of 20. (1) Within forty-two days after the receipt of the duplicate counter-statement, the opponent shall file with the Registrar such evidence by way of statutory declaration as desired to be adduced in support of the opposition, in duplicate.
- (2) Upon receipt of the statutory declaration and duplicate the Registrar shall serve the duplicate to the applicant.
- Evidence support application. in of 21. (1) Within forty-two days after the receipt of the statutory declaration of the opponent, the applicant shall file with the Registrar such evidence by way of statutory declaration as desired to be adduced in support of the application, in duplicate.
- (2) Upon receipt of the statutory declaration and duplicate, the Registrar shall forthwith send the duplicate to the opponent.
- Evidence in reply by opponent. 22. (1) Within thirty days after the receipt of the statutory declaration of the applicant, the opponent may file with the Registrar evidence, by way of statutory declaration, confined strictly to matters in reply, in duplicate.

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		(2)	Upon receipt of the statutory declaration and duplicate the Registrar shall forthwith send the duplicate to the applicant.
Further evidence.	23.		No further evidence shall be filed by the applicant or the opponent, but the Registrar may at any time give leave to either the applicant or the opponent to file any evidence upon making an application in Form TM 8, upon payment of the prescribed fee.
Abandonment of application or opposition.	24.		If the applicant or opponent fails to furnish the required counter-statement or evidence in support within the period prescribed by rules 19, 20 and 21, the application or opposition, as the case may be, shall be deemed to be abandoned and the Registrar may make an award of costs.
Exhibits.	25.	(1)	Where there are exhibits to declarations filed in opposition proceedings, copies or impressions of such exhibits shall be served on the other party on their request and at their expense, or, if such copies or impressions cannot conveniently be furnished, the originals shall be left with the Registrar in order that they may be open to inspection.
		(2)	The original exhibits shall be produced at the hearing unless the Registrar otherwise directs.
Hearing.	26.	(1)	Upon completion of the evidence, the Registrar shall give notice to the parties of a date for hearing the arguments in the case.
		(2)	An appointment shall be for a date at least fourteen days after the date of the notice, unless the parties consent to a shorter notice.
		(3)	Within seven days from the receipt of the notice any party who intends to appear shall notify the Registrar in Form TM 9, upon payment of the prescribed fee.
		(4)	A party who receives notice and who does not, within seven

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days from the receipt thereof, so notify the Registrar in Form TM 9, may be treated as not desiring to be heard and the Registrar may act accordingly.

Certificate
Registration.

of 27.

(1)

Upon entry of a trade mark in the Register of Trade Marks under the provisions of section 15(4) of the Act, the Registrar shall issue a certificate of registration to the registered proprietor on Form TM 10, upon payment of prescribed registration fee.

(2)

Where the certificate of registration issued is with respect to a collective or a certification trade mark, a copy of the regulations governing the use of the respective trade mark shall be attached.

(3)

In the case of an application which the Registrar accepts upon the applicant having filed a written consent to the proposed registration of the registered proprietor of another trade mark or another applicant for registration, the entry in the register shall state that it is “By Consent” and shall give the number of the previous registration or the application for registration.

Renewal
registration.

of 28.

(1)

At any time not more than ninety days before the expiration of the last registration of a trade mark, the registered proprietor shall make an application for renewal of the trade mark in Form TM 11, upon payment of the prescribed fee.

(2)

The Registrar shall record renewal of the trade mark and issue a certificate of renewal to the registered proprietor.

(3)

Where the registered proprietor does not file an application for renewal within ninety days prior to the due date for renewal, the Registrar shall notify the registered proprietor in writing of the approaching expiration.

(4)

If at the date of the expiration of the last registration of a mark the renewal fee has not been paid, the Registrar shall advertise the fact in the Journal or Kenya Gazette, and, if within thirty

days after that publication the renewal fee in Form TM 11, together with the additional prescribed late renewal fee, is received, registration of the mark may be renewed without removing the mark from the register.

- (5) If, at the expiration of thirty days after the publication under paragraph (4), the renewal and late renewal fees have not been paid, the Registrar may remove the mark from the register as of the date of the expiration of the last registration, but may, upon payment of the renewal fee in Form TM 11 together with the additional prescribed restoration fee, restore the mark to the Register if satisfied that it is just to do so, and upon such conditions as the Registrar may deem fit to impose.
- (6) Where a trade mark has been removed from the Register, the Registrar shall record the removal and the cause of removal in the Register.
- (7) Upon the renewal or restoration and renewal of a registration, a notice to that effect shall be sent to the registered proprietor and the renewal or restoration and renewal shall be published in the Journal or Kenya Gazette.

PART IV- REGISTERED TRADE MARKS AS OBJECT OF PROPERTY

Application entry assignment transmission.

for of or

- 29. (1) A person who becomes entitled by assignment or transmission to a registered trade mark may apply, in Form TM 12, to the Registrar to register the title, upon payment of the prescribed fee.
- (2) An application under this rule shall contain the name, trade or business address and description of the person claiming to be entitled and shall be accompanied by a deed of assignment, duly stamped under the Stamp Duty Act, or any other instrument that indicates the grounds on which the applicant claims to be

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entitled as the proprietor of the trade mark.

(3) The Registrar may in any case require and retain an attested copy of any instrument produced for inspection in proof of title, but that copy shall not be open to public inspection.

(4) If the person applying for registration of the title does not claim under any document or instrument which is capable in itself of furnishing proof of his title, the person shall file a statutory declaration setting forth the full particulars of the facts upon which the claim to be proprietor of the trade mark is based, and indicating that the trade mark has been assigned or transmitted accordingly.

(5) The Registrar may call on any person who applies to be registered as proprietor of a registered trade mark for such proof or additional proof of title as may be required.

Application for entry of assignment without goodwill.

30.

An application under rule 29 relating to an assignment of a trade mark in respect of any goods and services shall state-

(a) whether the trade mark was, at the time of the assignment, used in a business in any of those goods or services, as the case may be; and

(b) whether the assignment was made otherwise than in connection with the goodwill of that business,

and, if both those circumstances subsisted, then the applicant shall file with the Registrar a copy of the Registrar's directions to advertise the assignment, obtained upon application under section 29 (7) and rule 34, and such proof, including copies of publications or otherwise, as the Registrar may require that the directions have been fulfilled and if the Registrar is not satisfied that the directions have been fulfilled, the application for assignment shall not proceed to registration.

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- Entry in register. 31. When the Registrar is satisfied as to the title of the person claiming to be registered, the Registrar shall cause the person to be registered as proprietor of the trade mark in respect of the relevant goods or services, and shall enter in the register the name, trade or business address of the person and description and particulars of the assignment or transmission.
- Separate registrations. 32. Where, pursuant to an application under rule 29, and as the result of a division and separation of the goods or services of a registration or a division and separation of places or markets, different persons become registered separately under the same official number as subsequent proprietors of a trade mark, each of the resulting separate registrations in the names of those different persons shall be deemed to be a separate registration for all the purposes of the Act.
- Registrar's certificate of approval as to certain assignments and transmissions. 33. (1) Any person who desires to obtain the Registrar's certificate or a notification of approval under section 29 (6) of the Act shall file with the Registrar, with his application in Form TM 13, upon payment of the prescribed fee, a statutory declaration setting out the circumstances, and a copy of any instrument or proposed instrument effecting the assignment or transmission.
- (2) The Registrar may request for any evidence or further information that may be necessary, and the statutory declaration shall be amended if required to include all the relevant circumstances.
- (3) The Registrar, after hearing if so required the applicant and any other person whom the Registrar may consider to be interested in the transfer, shall consider the matter and issue a certificate thereon or a notification in writing of approval or disapproval thereof, as the case may be.

Drafting Instructions for the Trade Marks Rules

Registrar's directions for publication of assignment without goodwill of trade mark in use.

34. (1) An application to the Registrar under section 25 (7) of the Act shall be made by the assignee in Form TM 14, upon payment of the prescribed fee and shall state the date on which the assignment was made.
- (2) The application shall give particulars of the registration in the case of a registered trade mark, and, in the case of an unregistered trade mark, shall show the mark and give particulars of the registered trade mark that has been assigned therewith in accordance with section 25(3).
- (3) The Registrar may call for any evidence or further information, and if satisfied with regard to the various matters shall issue directions in writing with respect to the publication of the assignment.
- (4) The Registrar may refuse to consider such an application in a case to which section 25 (6) applies unless approval has been obtained under the section and a reference identifying the Registrar's notification of approval is included in the application.

Attachment of a registered trade mark.

35. (1) An attachment order in respect of a registered trade mark shall be made on Form TM 15, upon payment of the prescribed fee and shall be served on the Registrar for endorsement in the register, and copies of the order shall be served on the registered proprietor.
- (2) Proof of service on the registered proprietor shall be filed with the Registrar.
- (3) An endorsement of attachment may be removed from the register on a request made to the Registrar on Form TM 15, accompanied by proof to the satisfaction of the Registrar that the attachment may be removed.
- (4) Copies of the order and Form TM 15 shall be served on all interested parties appearing on the register.

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Hypothecation of a registered trade mark.

36. (1) The hypothecation of a registered trade mark by a deed of security shall be endorsed in the register upon application on Form TM 16, accompanied by the deed of security, upon payment of the prescribed fee.
- (2) The application shall be served on the registered proprietor and any other person recorded in the register as having an interest in the trade mark, and proof of service shall be filed with the Registrar.
- (3) The endorsement of the hypothecation may be removed from the register on application to the Registrar on Form TM 16, accompanied by such proof of the termination of the hypothecation.
- (4) Copies of the Form TM 16 and the proof of service shall be served on all interested parties appearing from the register.

Licences.

37. (1) An application to the Registrar for registration under section 31 of the Act of a person as a licensee of a registered trade mark shall be made by the registered proprietor in Form TM 18, upon payment of the prescribed fee.
- (2) The entry of a licensee in the Register shall state the date on which it was made.
- (3) An application by the registered proprietor of a trade mark for the variation of the registration of a licensee of that trade mark under section 31(8) (a) of the Act shall be made on Form TM 19, upon payment of the prescribed fee and shall be accompanied by a statement of the grounds on which it is made and, where the licensee in question consents, by the written consent of that licensee.
- (4) An application by the registered proprietor or any licensee of a trade mark for cancellation of the registration of a licensee of that trade mark under section 31(8) (b) of the Act shall be made in Form TM 20, upon payment of the prescribed fee and shall be accompanied by a statement of the grounds on which it is made.
- (5) An application by any person for the cancellation of the registration

of a licensee under section 31(8) (b) of the Act shall be made in Form TM 21, upon payment of the prescribed fee and shall be accompanied by a statement of the grounds on which it is made.

(6) Any person notified under the provisions of section 31 (9) of the Act and who intends to intervene in the proceedings shall, within thirty days of the receipt of the notification, give notice to the Registrar in Form TM 22 to that effect, upon payment of the prescribed fee and shall send therewith a statement of the grounds of his intervention; and the Registrar shall thereupon send copies of such notice and statement to the other parties, so that the intervention may be known to the applicant, the registered proprietor, the licensee whose registration is in suit and any other licensee who intervenes.

(7) Any such party may, within such time or times as the Registrar may appoint, leave evidence in support of his case, and the Registrar, after giving the parties an opportunity of being heard, may accept or refuse the application or accept it subject to any conditions, amendments, modifications or limitations as he may think right to impose.

Licensee's application to correct error or enter change.

38. (1) Applications under section 37(2) of the Act shall be made in Form TM 25, TM 5, TM 26, TM 27 or TM 28, as may be appropriate, by a licensee of a trade mark and the Registrar may require such evidence by statutory declaration or otherwise as he may deem fit as to the circumstances in which the application is made.

(2) For greater certainty, Form TM 26 may be used to apply to change the name of a licensee if the licensee merges with another corporation and the corporation resulting from the merger has a different name.

(3) In case of the registration of a licensee for a period in accordance section 31 of the Act the Registrar shall cancel the entry of the licensee at the end of the period.

- (4) Where some or all of the goods or services are struck out from those in respect of which a trade mark is registered, the Registrar shall at the same time strike them out from those specifications of licensees of the trade mark in which they are comprised.
- (5) The Registrar shall notify every cancellation or striking out under this rule to the licensees who are affected and the registered proprietor of the trade mark.

PART V-SURRENDER, RECTIFICATION AND CORRECTION OF REGISTER

- Application to surrender a registered trade mark.
39. (1) An application to surrender a registered trade mark under section 34(1) of the Act shall be made to the Registrar in Form TM 23, upon payment of the prescribed fee.
- (2) An application filed under this rule shall -
- (a) indicate if the surrender is for all of the goods or services, or for some of the goods or services in respect of which the trade mark is registered;
- (b) set out the name and address of each person who has a registered interest in the trade mark; and
- (c) include a certification by the proprietor that each person referred to in subparagraph (b) either—
- (i) has been given notice of the proposed surrender at least ninety days before the application is made; or
- (ii) is not affected by the surrender or has consented to it.
- (3) After making the appropriate entries in the Register, the Registrar shall publish a notice of the surrender in the Journal or Kenya Gazette.
- Application to rectify or remove a trade mark from the register.
40. (1) An application to the Registrar under any sections 12, 35 or 36 of the Act for the making, expunging or varying of any entry in the register shall be made in Form TM 24, upon payment of the prescribed fee and shall be accompanied by a statement setting out fully the nature

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of the applicant's interest, the facts upon which he bases his case and the relief sought.

(2) The application shall be accompanied by a copy of the statement and the Registrar shall forthwith transmit the copies to the registered proprietor.

(3) The provisions of rules 19 to 26 of these Rules shall apply with respect to the proceedings relating to an application in Form TM 24, with necessary modifications and with the following specific modifications-

- (a) references to the applicant shall be deemed to be references to the registered proprietor and references to the opponent shall be deemed to be references to the person making the application under this rule;
- (b) the Registrar shall not rectify the Register or remove the mark from the Register merely because the registered proprietor has not filed a counter-statement.

(4) Any person other than the registered proprietor alleging interest in a registered trade mark in respect of which an application is made in Form TM 24, may apply to the Registrar in Form TM 22, upon payment of the prescribed fee, for leave to intervene, stating thereon the nature of his interest, and the Registrar may refuse or grant leave, after hearing, if so required, the parties concerned, upon such conditions and terms as the Registrar may deem fit.

(5) Prior to dealing in any way with the application for leave to intervene, the Registrar may require the applicant to give an undertaking to pay such costs that may be awarded to any party.

Application under section 37(1).

41. (1) An application to the Registrar under section 37(1) of the Act for the alteration of the Register by correction or change, or for the entry of a disclaimer or memorandum, may be made by the registered proprietor of the trade mark, upon payment of the prescribed fee.

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- (2) An application under paragraphs (a), (b), (e) or (f) of section 37(1) of the Act shall be in Form TM 25, TM 5, TM 26, TM 27 or TM 28, as may be appropriate.
- (3) Where an application is made in Form TM 28 to enter a disclaimer or memorandum relating to a trade mark, the Registrar, before deciding upon such application, shall advertise the application in the Journal or Kenya Gazette in order to enable any person desiring so to do to state, within thirty days of the publication, any reasons in writing against the making of the entry of the disclaimer or memorandum.
- (4) An application under paragraph (c) or (d) of section 37(1) of the Act shall be made in accordance with rule 39.
- (5) For greater certainty, Form TM 26 may be used to change the name of the registered proprietor if the registered proprietor merges with another corporation and the corporation resulting from the merger has a different name.
- (6) In an application under this rule, the Registrar may require such evidence by statutory declaration or otherwise as he may deem fit as to the circumstances under which the application is made.

Alteration of
address in Register
under section 37.

- 42. (1) A registered proprietor or licensee of a trade mark who alters his address may apply to the Registrar, on Form TM 25 upon payment of the prescribed fee, to record such alteration on the Register and upon consideration of the application, the Registrar shall alter the Register.
- (2) A registered proprietor or licensee of a trade mark whose address for service in Kenya entered in the register is changed, whether by discontinuance of the entered address or otherwise, so that the entry in the register is rendered incorrect, shall forthwith request the Registrar in Form TM 28 to make the appropriate alteration of the address in the register, and upon consideration of the application, the

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Registrar shall alter the Register.

- (3) A registered proprietor or licensee of a trade mark whose registered trade or business address or address for service is altered by a public authority, so that the changed address designates the same premises as before, may make the request to the Registrar in Form TM 25, accompanied by a certificate of the alteration given by the authority, with no fee payable, and upon consideration of the application, the Registrar shall alter the Register.

- (4) In the case of the alteration of the address of person entered in the register as the address for service of more than one registered proprietor or licensee of trade marks, the Registrar may, on proof that the address is the address of the applicant and if satisfied that it is just to do so, accept an application from that person in Form TM 28 amended so as to suit the case for the appropriate alteration of the entries of his address as the address for service in the several registrations, particulars of which shall be given in the form, and may alter the entries accordingly.

- (5) All applications under this rule in Form TM 25 shall be signed by the registered proprietor or the licensee, as the case may be, or by an agent, expressly authorized by him for the purpose of such an application, unless in exceptional circumstances the Registrar otherwise allows.

Alteration of a registered mark.

43. (1) An application to add to or alter a registered trade mark under section 38 of the Act shall be made in Form TM 29 upon payment of the prescribed fee.
- (2) The Registrar shall consider the application and shall, if it appears to him to be expedient, publish the application in accordance with rule 17, upon payment of the prescribed fee.

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(3) Any person may, within thirty days after the date of the publication of the application, give notice in Form TM 6 to the Registrar of opposition to the application, upon payment of the prescribed fee and rules 19 to 26 shall apply with necessary modifications.

Application to add goods or services.

44. (1) The proprietor of a registered trade mark may apply to the Registrar to add goods or services to the goods or services in respect of which the trade mark is registered, including goods or services in an additional class or classes.

(2) An applicant for the registration of a trade mark may apply to the Registrar to amend the application to add goods or services to the goods or services in respect of which the trade mark would be registered, including goods or services in an additional class or classes.

(3) An application under this rule shall be made in Form TM 30 upon payment of the prescribed fee.

(4) These Rules shall apply, with necessary modifications, with respect to an application under this rule as though it were an application for registration of a trade mark.

PART VI- CERTIFICATION AND COLLECTIVE TRADE MARKS

Application under sections 41 and 42 of the Act.

45. (1) An application to the Registrar for registration of a certification or a collective trade mark under sections 41 and 42 of the Act shall be in Form TM 2, upon payment of the prescribed fee.

(2) These Rules shall apply to applications under this rule as they apply to applications for registration of ordinary trade marks, except that the applicant shall not be deemed to have withdrawn the application where in the circumstances of rule 15 (3), no application is made for a hearing or reply in writing.

Admission of user.

46. (1) An application for directions from the Registrar for admission to an entity under paragraph 13 of the Second and Third Schedules of the

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Act shall be made in Form TM 31, upon payment of the prescribed fee.

- (2) An application under paragraph (1) shall be accompanied by evidence of:-
- (a) compliance with the regulations governing the use of the collective or certification mark; and
 - (b) prior attempts to obtain admission.

Alteration of regulations.

of 47.

- (1) An application by the registered proprietor of a certification or a collective trade mark for an alteration of the regulations governing the use of the mark shall be made in Form TM 32, upon payment of the prescribed fee.
- (2) Where the Registrar causes an application under this rule to be published, any person may, within thirty days after the date of the publication of the application, give notice in Form TM 6 to the Registrar of opposition to the application, upon payment of the prescribed fee and rules 19 to 26 shall apply with necessary modifications.

Application for security for costs.

48.

PART VII- POWERS AND DUTIES OF REGISTRAR

An application for security for costs shall be made in Form TM 8, upon payment of the prescribed fee.

Certificate for use in legal proceedings.

49.

PART VIII – LEGAL PROCEEDINGS AND APPEALS

An application for a certificate for use in legal proceedings under section 52 of the Act shall be made in Form TM 33 upon payment of the prescribed fee.

Certificates Registrar.

by 50.

PART IX - GENERAL PROVISIONS

- (1) The Registrar may give a certificate, other than a certificate under section 22 of the Act, as to any entry, matter or thing which he is authorized or required by the Act or these Rules to make or do, upon receipt of a request therefor in Form TM 33 from any person who, if

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the Registrar deems fit so to require, can show an interest in the entry, matter or thing to his satisfaction, upon payment of the prescribed fee.

(2) Any person who requires priority documents for purposes of an application in a convention country under the provisions of section 69(4) of the Act shall apply to the Registrar in Form TM 33, upon payment of the prescribed fee.

Address
service.

for

51.

(1) The Registrar may require an applicant, opponent or agent, or a registered proprietor or licensee of a trade mark, who does not reside or carry on business within Kenya to give an address for service within Kenya, and that address may be treated as the actual address of that person for all purposes connected with the matter in question.

(2) Any registered proprietor or licensee of a trade mark, or any person about to be registered as such, may give in Form TM 28 an address for service for entry in the register, and such address may be entered by the Registrar.

(3) All applications in Form TM 28 under this rule shall be signed by the applicant for registration or the registered proprietor or licensee, as the case may be, or by an agent expressly authorized by him for the purpose of such an application, unless in exceptional circumstances the Registrar otherwise allows.

(4) In any case in which no address for service is entered in the register, the Registrar may treat the trade or business address of the registered proprietor or licensee as therein entered as his address for service for all purposes connected with the registration.

(5) Any written communication addressed to a party or person as aforesaid at an address given by him, or treated by the Registrar, as his address for service shall be deemed to be properly addressed.

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(6) At any time that a doubt arises as to the continued availability of an address for service entered in the register, the Registrar, may request the person for whom it is entered, by letter addressed to his trade or business address in the register, to confirm the address for service, and if within ninety days of making such a request the Registrar receives no confirmation of that address he may strike it off the register.

Death of applicant before registration.

52.

In case of the death of any applicant for registration of a trade mark after the date of the application and before the trade mark applied for has been entered in the Register, the Registrar, after the expiration of the prescribed period of publication and the determination of any opposition to the application, may, on being satisfied of the applicant's death, enter in the Register, in place of the name of the deceased applicant, the name, address and description of the person owning the trade mark, on ownership being proved to the satisfaction of the Registrar.

Agency.

53.

(1) Except as otherwise required by these Rules, any application, request or notice which is required or permitted by the Act or these Rules to be made or given to the Registrar or the court, and all other communications between an applicant or a person making such a request or giving such a notice and the Registrar, or the court, and between the registered proprietor or a licensee of a trade mark and the Registrar or the court or any other person, may be signed, made or given by or through an agent.

(2) Any such applicant, person making request or giving notice, proprietor or licensee may appoint an agent to act on their behalf in any proceeding or matter before the Registrar or the court under the Act and these Rules by signing and sending to

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- Cap 480.
- (3) In case of such appointment, service upon the agent of any document relating to the proceeding or matter shall be deemed to be service upon the person so appointing him, all communications directed to be made to that person in respect of the proceeding or matter may be addressed to the agent, and all attendances upon the Registrar relating thereto may be made by or through the agent.
- Extension of time. 54. (1) The Registrar may extend, on such conditions as he may specify, the time for doing any act or taking any proceedings under these Rules.
- (2) The Registrar may not extend a time expressly provided in the Act, other than the period prescribed under section 25 (6) of the Act.
- (3) An application for an extension of time under this rule shall be filed with the Registrar in Form TM 34, upon payment of the subscribed fee.
- (4) The application shall state the grounds on which the application is based.
- (5) An application for an extension of time may be made even though the time has already expired.
- (6) The application shall be dealt with upon such notice, and in accordance with such procedures, as the Registrar may direct.
- Application for hearing. 55. (1) An application for a hearing shall be made in Form TM 8, upon payment of the prescribed fee, within thirty days from the date of notification by the Registrar of any objection to an application or the date of any other indication that he proposes to exercise a discretionary power.

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(2) Where the application for hearing is made in pending opposition proceedings or proceedings to rectify the Register, the application shall be served on the other respective party in the proceedings who shall be given a chance to respond to the application.

(3) The Registrar shall subsequently fix the application for hearing and the provisions of rule 26 shall apply with the necessary modifications.

Dispensing with evidence. 56.

Where under these Rules a person is required to do any act or thing, or to sign any document, or to make any declaration on their behalf of or of any body corporate, or any document or evidence is required to be produced to or left with the Registrar, or at the office, and it is shown to the satisfaction of the Registrar that from any reasonable cause that person is unable to do the act or thing, or to sign the document, or to make the declaration, or that the document or evidence cannot be produced or left, the Registrar may, upon the production of such other evidence, and subject to such terms as he may deem fit, dispense with any such act or thing, signature, declaration, document or evidence.

Amendment of documents. 57. (1)

Any document or drawing or other representation of a trade mark may be amended, and any irregularity in procedure which in the opinion of the Registrar may be excused without detriment to the interests of any person may be corrected, if the Registrar deems fit, and on such terms as the Registrar may determine.

(2) An application under paragraph (1) to amend a document or drawing or other representation shall be in Form TM 5, upon payment of the prescribed fee.

Person before whom declaration is to be taken. 58.

The statutory declarations required by the Act and these Rules, or used in any proceedings thereunder, shall be made and subscribed as

follows—

- (a) if made in the Commonwealth, before any court, judge or justice of the peace, or any officer authorized by law to administer an oath for the purpose of a legal proceeding;
- (b) if made outside the Commonwealth, before a Kenya Consul or Vice-Consul, or other person exercising the functions of a Kenya Consul, or a notary public, or before a judge or magistrate.

Presumption as to seal of officer taking declaration.

59.

Any document purporting to have affixed, impressed or subscribed thereto or thereon the seal or signature of any person authorized by rule 58 to take a declaration in testimony that the declaration was made and subscribed before him may be admitted by the Registrar without proof of the genuineness of the seal or signature or of the official character of the person or his authority to take the declaration.

Copies of document.

of

60.

A person who wishes to obtain a copy of a document that is kept in the custody of the Registrar shall make an application in Form TM 35, upon payment of the prescribed fee.

Appeal to the court.

61.

When a person intends to appeal to the court, the appeal shall be made by way of notice of motion and no such appeal shall be entertained unless the notice of motion is filed within sixty days from the date of the decision appealed against or within such further time as the Registrar shall allow.

Applications to and order of court.

62.

(1)

Every application to the court under the Act shall be served on the Registrar.

(2)

Where an order has been made by the court in any case under the Act, the person in whose favour the order has been made, or such one of them if more than one, as the Registrar may direct, shall forthwith leave with the Registrar an office copy of the order,

			together with Form TM 36, upon payment of the prescribed fee.
		(3)	The Registrar shall comply with the order of the court.
Publication order of court.	of	63.	Whenever an order is made by the court under the Act, the Registrar may, if upon having considered that the order should be made public, publish the order in the Journal or Kenya Gazette.
Submission electronic documents.	of	64.	A document submitted to the Registrar in electronic form shall be deemed to have been submitted in accordance with these Rules on the day the electronic form is submitted if, within thirty days after that submission, the document is submitted to the Registrar in paper form in accordance with these Rules together with any applicable fee required under the Rules.
Procedure inspection documents.	for of	65.	Any person may apply in Form TM 37, upon payment of the prescribed fee, to inspect the Register, regulations governing the use of a certification or a collective trade mark or any other document in the custody of the Registrar.