

TOUGHEES VS. SHUPAVU:

THE COURT'S VERDICT ON
GOODWILL VS. REGISTERED IP
RIGHTS



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“Made strong to last long” — but does brand strength hold up in court without formal protection? This alert explores the delicate balance between brand goodwill and the enforceability of intellectual property rights (IP Rights), as illustrated by a recent High Court decision.

We delve into how judicial interpretation can tip the scales when IP rights remain unregistered—and what this means for brand owners operating in Kenya's legal landscape. Most people who have been through the Kenyan education system are very familiar with the popular Toughées school shoes. In fact, many school-going children have at one point owned a pair of Toughées. Out of this number, a significant percentage have by themselves or with a guardian, bought these shoes directly from a Bata retail store anywhere in the country. It was akin to a crowning moment on the first day of school in a new term, adorned in crisp and freshly pressed uniform and clean white or grey socks, to be able to slip into a new pair of black or brown Toughées, feeling on top of the world. We all have that one picture somewhere!

Indeed, Honourable Mong'are of the High Court of Kenya recognized the goodwill that has been built in Kenya among consumers over the last over fifteen (15) years by Bata specifically for the brand name Toughées. This, a holding from its determination in *Bata Brands SA another v Umoja Rubber Products Limited* (Commercial Case 501 of 2017) 2025 KEHC5186 (KLR). Bata accused Umoja of passing off its school shoes called Shupavu as Toughées, arguing that they were

identical or confusingly similar in design, and thus, caused reduced sales of Toughées for Bata. The High Court recognized that indeed, the brand name Toughées has built a lasting impression on the Kenyan market. However, it took the stance that Toughées and Shupavu do not possess the same get-up from their design and even then, the Toughées design was not unique nor registered to Bata.

The Court further reasoned that with the goodwill that has been built by Bata for the brand name Toughées, any reasonable person can easily tell the design of the school shoes and where to find them, ultimately rejecting Bata's argument of passing off. An important reminder from this decision is to register your intellectual property so as to secure its legal protection, and seek expert advice while at it.

From the court's decision, one may ask if there would have been a different outcome if the Toughées shoe design had been registered. Registration offers legal protection and forms the foundation for enforcing your rights and maximising your intellectual property's value. For the most part, unregistered intellectual property is unprotected intellectual property.

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