



NETSHERIA
INTERNATIONAL



IP

BOOKLET

WWW.NETSHERIA.COM

Table of CONTENTS

1.0 INTRODUCTION	03
1.1 Background	03
1.2 Definition	03
1.3 Legal framework	04
1.3.1 Statutory framework	04
1.3.2 Institutional Framework	05
1.4 Why protect intellectual property?	07

2.0 PATENTS	08
2.1 Types of patents	09
2.2 Scope of matters that can be patented	09
2.3 Application for Patents	10
2.4 Infringement of patents	11
2.5 Defenses available against patent infringement	13
2.5 Remedies sought for patent infringement	13

3.0 TRADE MARKS	15
3.1 Categories of Trademarks	15
3.2 Registrability of a trademark	16
3.3 Registration procedure for trademarks	17
3.4 Trademark Infringement	19
3.5 How to enforce a trademark in Kenya	20
3.5.1 Passing off action	20
3.5.2 Action for passing off	21

4.0 COPYRIGHT	22
4.1 The Kenya National Rights Registry Portal	22
4.2 Importance of registration of Copyright works	23
4.3 Registration procedure for Copyrights	23
4.4 Ownership of copyright	23
4.5 Duration of copyright protection	24
4.6 Copyright infringement	24
4.6.1 Civil Action	24
4.6.2 Criminal Action	24

5.0 PLANT BREEDERS' RIGHTS	25
5.1 Application for plant breeders' rights protection in Kenya	25
5.2 Scope of rights granted by plant breeders' rights registration	26
5.3 Grant/protection duration	26
5.4 Cancellation of grant	26
5.5 Private and non-commercial use exception	26
5.6 Infringement of plant breeder rights	27

6.0 TRADITIONAL CULTURAL EXPRESSIONS/FOLKLORE	28
6.1 Traditional cultural expressions and intellectual property	29
6.2 Scope of protection of TCEs	29
6.3 Exceptions and limitations of TCE Rights	29
6.4 Duration of Grant	30
6.5 TCE regime - much ado without nothing?	30
6.6 Infringement of TCEs	31



1.0 INTRODUCTION

1.1 BACKGROUND

This booklet explores how intellectual property law can protect a wider range of subject matters. The development of intellectual property law has produced carefully balanced legal norms. For a long time, the objective has been to create laws and doctrines that both minimize the impact on the commercial market and the general free flow of ideas, while simultaneously offering sufficient legal protection to encourage the pursuit of creative and innovative endeavors. The distinction between patent, copyright, trademark law and other forms of intellectual property has become hazy due to the broad definition of what is protected by intellectual property law. This booklet shall therefore guide on each form of intellectual property in its distinct/independent way.

1.2 DEFINITION

What Is Intellectual Property?

Intellectual property is a broad categorical description for the set of intangible assets owned and legally protected by a company or individual from outside use or implementation without consent. An intangible asset is a non-physical asset that a company or person owns.

The concept of intellectual property relates to the fact that certain products of human intellect should be afforded the same protective rights that apply to physical property, which are called tangible assets.



Most developed economies have legal measures in place to protect both forms of property.

1.3 LEGAL FRAMEWORK

1.3.1 Statutory framework

The core of IP protection in Kenya is Article 40 (5) of the Constitution of Kenya, 2010. It places a mandatory obligation on the state to protect IP Rights of its citizens.

1.3.1.1 Copyright Act, No. 12 of 2001

This Act provides copyright protection for literary, musical and artistic works, audio-visual works, sound recordings and broadcasts. It outlaws certain activities that in their effect promote counterfeiting of copyrighted materials. For instance, under the Act it is a civil wrong to import pirated copies. It is also wrong to circumvent technological devices used to protect copyright rights, remove or alter electronic rights management systems and to distribute, import and broadcast copyright works without the consent of the owner. The remedies provided for under the Act include damages, injunction, and delivery up. The Act also provides for Anton Pillar orders to secure evidence before it is hidden or destroyed by the accused party.

Inspectors who have powers to enter premises, ship or aircraft to ascertain whether any infringement of the law is being committed therein enforce the Act. Police officers and officers of the board also have powers of arrest under the Act. Prosecution of cases filed in respect to crimes in committed in contravention of the Act is governed by the Criminal Procedure Code, and may be conducted by a public prosecutor or the Board.

Digital Copyright

The Copyright Act has incorporated the provisions of the two World Intellectual Property Organization (WIPO) Internet Treaties, being the WIPO Copyright Treaty (WCT) and the WIPO Performances and Phonograms Treaty (WPPT). These treaties address issues that arose with the use of copyright works in the digital environment by setting international norms aimed at preventing unauthorized access to and use of creative works on the Internet or other digital networks. The Copyright Act makes it an offence to circumvent any technical measures designed to protect copyright works or to remove any rights management information.

1.3.1.2 Industrial Property Act, 2001

The main object of this Act is to provide for the promotion of inventive and innovative activities, to facilitate the acquisition of technology through the grant and regulation of patents, utility models, technovations and industrial designs.

1.3.1.3 Trade Marks Act, Cap 506

This law provides for the protection, promotion and registration of trade marks. The Act defines a mark to include 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.

Section 15A of this Act specifically incorporates marks that are protected under the Paris



Convention for the Protection of Industrial Property 1883 or the World Trade Organization (WTO)'s Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) 1994.

Trade marks in Kenya are registered by Kenya Industrial Property Institute (KIPI) and administered by its Managing Director, who is the Registrar of Trade Marks for purposes of the Trade Marks Act. The Act has elaborate provisions against the infringement of trade mark rights.

1.3.1.4 The Madrid system of registration of Trademarks

Kenya is a member of both the Madrid Agreement Concerning the International Registration of Marks (1891) and the Protocol Relating to that Agreement (1989), and trademarks registered via this Madrid route are recognized and enforceable as if they were registered in Kenya. This Madrid system is under the ambit of WIPO and it enables Kenyan companies and entrepreneurs to protect their trademarks in multiple countries around the world by filing one application with one set of fees and designating KIPI as the receiving office.

1.3.1.5 The Seeds and Plant Varieties Act, Cap 326

This Act came into force in 1975. This law aims to regulate transactions in seeds, including provision for the testing and certification of seeds; provide guidelines for the establishment of an index of names of plant varieties and to empower the imposition of restriction on the introduction of new varieties and control the importation of seeds; provide for the grant of proprietary rights to persons breeding or discovering new varieties.

The Act also grants plant breeders in plant variety exclusive rights to produce reproductive material of the variety for commercial purposes. Any infringement thereof is actionable and the owner of the right who is entitled damages, injunction, and account for profits. It also is an offence under the Act to make false representation or give false information regarding the exercise of plant breeders' rights. This attracts either a fine not exceeding Kenya Shillings Twenty Thousand (Kshs. 20,000/-) or imprisonment of up to six months. A body corporate is liable too for any offences committed by or attributable to its officers in this regard.

1.3.1.6 Anti-Counterfeiting Act No. 13 of 2008

The Anti-Counterfeit Act was assented to on December 24th 2008. The Act establishes Anti-Counterfeit Agency (ACA) and succinctly defines and clearly delineates the scope of acts that culminate counterfeiting and counterfeited goods.

The Act penalizes counterfeiting and offences under the Act include a prison term of up to five years and/or to a fine not less than three times the value of the prevailing retail price of the goods in case of a first conviction. In case of a second or subsequent conviction, the prison term is 15 years and the fine is not less than five times the value of the prevailing retail price of the goods. It is noteworthy that the fine is not pegged on a fixed amount but on the prevailing retail value of the legitimate goods. 10% of the fines imposed by the court for offences under the Act shall award to the complainant, 40% to the government of Kenya and 50% to ACA.

1.3.1.7 Protection of Traditional Knowledge and Cultural Expressions Act 2016



The Act aims 'to provide a framework for the protection and promotion of traditional knowledge and cultural expressions' in Kenya, giving effect to Articles 11, 40 and 69(1)(c) of the Constitution of Kenya 2010. It vests 'ownership' of Traditional Knowledge (TK) on local and traditional communities, and recognizes individuals or organizations entrusted with the custody or protection of TK in accordance with customary law and practices. It employs the notion of 'ownership' as applied in IP, which may be elusive and quite problematic in the case of TK, where holders of TK are custodians rather than owners. Again, it confers both moral and economic sui generis rights akin to IPRs on 'owners' and 'holders' of TK (or in their absence, a state agency).

1.3.2 Institutional Framework

1.3.2.1 The Kenya Industrial Property Institute (KIPI)

This institute/body is established under Section 3 of the Industrial Property Act 2001. KIPI is the main implementation and administration agency for industrial property in Kenya. It liaises with other national, regional and transnational intellectual property offices, patent offices and international organizations that are involved in industrial property protection. KIPI's mandate includes: considering applications for and granting industrial property rights; screening technology transfer agreements and licenses; providing to the public industrial property information for technological and economic development; and promoting inventiveness and innovativeness in Kenya.

The Industrial Property Act also establishes the Industrial Property Tribunal to deal with cases of infringement.

1.3.2.2 The Kenya Copyright Board (KECOBO)

This is established under Section 3 of the Copyright Act. The Board's main functions include, directing, co-ordinate and overseeing the implementation of laws and international treaties and conventions to which Kenya is a party and which relate to copyright and other rights recognized by this Act and ensure the observance thereof.

1.3.2.3 Kenya Plant Health Inspectorate Services (KEPHIS)

The Kenya Plant Health Inspectorate Service (KEPHIS) was established under the State Corporations Act through the Legal Notice 305 of 1996. The Legal Notice consolidated the roles undertaken by KARI and the Ministry responsible for Agriculture and made KEPHIS responsible for Plant Health, Seed, Plant variety, and agro-inputs quality issues in Kenya.

The KEPHIS Act Number 54 of 2012 enhanced operations in plant health and quality of inputs and produce in Kenya. It was designated as the National Plant Protection Organization, the National Designated Authority on Seed Quality, and the National Plant Breeders Rights Office.

1.3.2.4 The Anti-Counterfeit Agency (ACA)

The Anti-Counterfeit Act establishes the Anti-Counterfeit Agency (ACA) with the mandate to administer anti-counterfeiting policy and law in Kenya. The Agency has three main functions. It enforces the provisions of the Anti-Counterfeit Act; enlightens and informs the public on counterfeiting issues and combats counterfeiting in Kenya. The Act is viewed as giving ACA "teeth to bite" in the fight against the proliferation of counterfeit products in Kenya.



1.4 WHY PROTECT INTELLECTUAL PROPERTY?

Intellectual property is a category of assets that are intangible. This means that they cannot be held and do not necessarily have a physical presence. These assets are created using human intellect. Intellectual property can take many forms and includes things like artwork, symbols, logos, brand names, and designs, among others.

- I. **Competitive advantage** - Extracting value from intellectual property and preventing others from deriving value from it is an important responsibility of any company or individual. Although it is an intangible asset, intellectual property can be far more valuable than an individual's or company's physical assets. It can represent a competitive advantage and, as a result, is fiercely guarded and protected by the companies that own the property.
- II. **Accounting and planning function** - Some intangible assets, such as patents, are recorded as property because they have an expiration date. These assets are recognized by a numerical value through the process of amortization. Amortization is an accounting method that decreases the value of an intangible asset over a set period of time. This process helps the company to reduce its income by expensing a set amount each year for tax purposes as the useful life of the intangible asset winds down.

For example, a patent might only have 20 years before it is registered as public domain. A company would assign a total value to the patent. Each year for 20 years, the patent would be expensed or amortized by the same amount by dividing the total value by 20 years. Each year the amortized asset amount would reduce the company's net income or profit for tax purposes. However, intellectual property that is considered to have a perpetual life, such as a trademark, is not amortized since it does not expire.

- III. **Income generation** - Being able to control and license your Intellectual Property opens up different revenue streams and ways of operating, whilst enabling you to maintain control of and build your reputation.
- IV. **Raising capital** - Like any other property, Intellectual Property can be used as security to raise funds to fuel growth in your business.
- V. **Reputational trump card** - Creating and subsequently licensing one's intellectual property is cause for prestige to the individual or corporation, which in turn boosts the creator's reputation.

FORMS OF INTELLECTUAL PROPERTY

Have a brilliant new concept that you are sure will make you a fortune? There is a crucial step any inventor or artist should take before taking it to market: protecting it with a patent, trademark, or copyright from the government.

All three provide a legal shield against copycats trying to make a buck off your idea; however, each designation applies to a specific type of intellectual property, so it is important to know the differences.



2.0 PATENTS

A patent is an exclusive right granted for an invention. Invention is defined as a 'solution to a specific problem in the field of technology', and the invention may be, or may relate to, a product or a process that provides a new way of doing something or offers a new technical solution to a problem in the field of technology.

Patents offer exclusive rights for a specific period of time, in which the patent owner has the right to prevent or stop others from commercially exploiting the patented invention. Patent protection means that the invention cannot be commercially made, used, distributed, imported or sold by others without the patent owner's consent. The exclusive rights provide incentives for the patent holder to undertake further research and development. Without patent protection, many people might not take the risks of investing their time and money to devise new products. It is important that new products become available on the market continuously; otherwise without them the economy would quickly stagnate.

A patent describes new aspect of a technology in clear and specific terms and is available for anyone to read. Patents are made public specifically to promote the sharing of knowledge. As such they are important resources for entrepreneurs, researchers, inventors, academics and others who need to keep up with development in their fields.

A patent safeguards an original invention for a certain period of time. By granting the right to produce a product without fear of competition for the duration of the patent, an incentive is provided for companies or individuals to continue developing innovative new products or services.



2.1 TYPES OF PATENTS

There are three types of patents: utility patents, plant patents, and design patents.

2.1.1 Utility patent

A utility patent covers the creation of a new or improved product, process, or machine. Also known as a “patent for invention,” it bars other individuals or companies from making, using, or selling the creation without consent. Utility patents are good for up to 20 years after the patent application is filed but require the holder to pay regularly scheduled maintenance fees.

While most people associate patents with machines and appliances, they can also apply to software, business processes, and chemical formulations such as in pharmaceutical products.

2.1.2 Plant patents

A plant patent protects a new and unique plant's key characteristics from being copied, sold, or used by others. It is also good for 20 years after the application is filed. The plant must be asexually reproducible with reproduction being genetically identical to the original and performed through methods such as root cuttings, bulbs, division, or grafting and budding.

2.1.3 Design patent

A design patent, on the other hand, applies to the unique look of a manufactured item. Take, for example, an automobile with a distinctive hood or headlight shape. These visual elements are part of the car's identity and may add to its value; however, without protecting these components with a patent, competitors could potentially copy them without legal consequences.

2.2 SCOPE OF MATTERS THAT CAN BE PATENTED

Inventions in any field of technology can be patented. In general, any device, substance, method or process can be patented. Any new or improved product or process in the following broad sections of technology can be patented so long as they meet the requirements of the law.

- i. Human necessities, including: agriculture, foodstuffs; tobacco; personal or domestic articles; health; life-saving; amusement.
- ii. Performing operations including: transporting, separating, mixing, shaping, printing, microstructural technology; nanotechnology
- iii. Chemistry and metallurgy
- iv. Textiles, paper and other flexible materials
- v. Fixed constructions including: building, earth or rock drilling and mining
- vi. Mechanical engineering; lighting; heating; weapons; blasting, engines and pumps
- vii. Physics
- viii. Electricity

The following are not regarded as inventions and are excluded from patent protection by law:

- i. Discoveries, scientific theories and mathematical methods
- ii. Schemes, rules or methods for doing business
- iii. Methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practised in relation thereof, except products for use in any such methods
- iv. Mere presentation of information



- v. Public health related methods of use or uses of any molecule or other substance for the prevention or treatment of any disease which may be designated as a serious health hazard or as a life-threatening disease.
- vi. Non-Functional details of shape, configuration, pattern or ornamentation
- vii. Plant varieties, but not parts thereof or products of biotechnological processes.
- viii. Inventions contrary to public order, morality, public health and safety, principles of humanity, and environmental conservation.

2.3 APPLICATION FOR PATENTS

There are two types of patent applications, a provisional application and a complete application. A provisional application gives you the earliest possible priority date and signals your intention to file a complete application within the next 12 months. You are required to file a complete application within one year from the date you filed the provisional application and the complete application. If you do not file a complete application as indicated, the provisional application is considered withdrawn.

A patent application should contain the following elements:

- i. a request on Form IP 3;
- ii. a detailed description of the invention;
- iii. one or more claims;
- iv. one or more drawings (where necessary); and
- v. an abstract

2.3.1 Request

Where the patent application is filed on paper, the request must be made on a printed form (Form IP 3) to be filled in with the required information. A filled in sample and a blank copy of the Form IP3 are available here.

2.3.2 Description

The description should disclose the invention in full, clear, concise and exact terms as to enable any person skilled in the field of the invention to evaluate and understand it.

The description should have the following heading:

- i. title of the invention,
- ii. technical field to which the invention relates
- iii. Background information of the invention
- iv. Brief description of the drawings (where drawings are necessary)
- v. Detailed description of the invention

2.3.3 Claims

The claim or claims should define the matter for which protection is sought and should be clear and concise and fully supported by the description. In defining the matter for which protection is sought, claims should set out the technical features that are necessary to define the subject matter of the invention.

With respect to the technical features of the invention, the claims should not refer to the description or drawings. In particular they should not rely on references such as, "as described in part.....of



the description, or "as illustrated in figure..... of the drawing".

The claims be should be numbered consecutively in Arabic numerals, for example, 1,2,3 and so on.

2.3.4 Drawings

Drawings should comply with the following:

- i. They should not be colored;
- ii. The lines should be well-defined and drawn with the aid of drafting instruments;
- iii. The drawings should be such that all details can be distinguished without difficulty when the drawings are reproduced at two thirds their actual size;
- iv. Cross sections should be indicated by hatching that does not impede the clear reading of the reference signs and reading lines;

If the drawings show a feature mentioned in the description, that feature should be denoted in the drawings by a reference sign and that reference sign should be used throughout the application to denote that feature.

2.3.5 Abstract

The abstract should contain the title of the invention, and it is basically a summary of the disclosure of the invention as defined in the description. The summary should indicate the technical field to which the invention relates and the principal use or uses of the invention.

The abstract should be drafted in a way that it can be used efficiently for searching in the relevant technical field and so that it is possible for a reader to assess, from the abstract, whether the description should be consulted.

The abstract should not include statements about the merits or value of the invention or about uses that are speculative.

Where applicable, the abstract should include the formula that best characterizes the invention. The abstract should not contain more than one hundred and fifty words.

2.3.6 Duration of registration procedure

If the process goes smoothly, it takes an average of two years to obtain a patent in Kenya.

2.3.7 Grant, validity term and maintenance fees

The grant fee should be paid to the Patent Office before the patent is granted. Patents are valid for 20 years from the filing date. Annual maintenance fees fall due on the anniversary of the filing date and should be paid in advance before the due date. Late payment is possible within a grace period of six months after the due date upon payment of the corresponding surcharge.

The process for applying for patent protection is quite complex. This is why you may wish to obtain advice from a lawyer with experience in patent law.

2.4 INFRINGEMENT OF PATENTS

A patent is considered to be an exclusive monopoly right as it excludes others from using, selling, distributing the invention of innovators. Patent Infringement is illegal as it violates the exclusive right of



the patent holder. It is crucial for individuals and companies to be aware of patent laws and the consequences of patent infringement.

2.4.1 Direct Infringement

Direct infringement is a most common and obvious form of patent infringement. When a third party without the permission of the patent holder:

When a third party without the permission of the patent holder:

- i. Commercially uses the invention.
- ii. Reproduces the invention.
- iii. Import a protected idea/ invention in India.
- iv. Selling patented inventions.
- v. Offer to sell patented inventions.

Direct infringement can either be intentional or unintentional during the term of patent. Only requirement to be fulfilled is the performance of a substantially deceptive function of an invented product without obtaining a legal license from the owner for the usage.

2.4.2 Literal Infringement

Literal infringement is a type of direct infringement in which each and every element or composition protected by either product or process patent is copied, in other words, a replica of the original product is used, manufactured, sold or imported.

2.4.3 Non-Literal infringement

Non-literal infringement is also recognized by the name of Doctrine of Equivalence. In this type of infringement, the alleged invention has to pass through the "Triple Identity Test". This means when an invention is similar to the patented invention hence performing significantly the same function, in the same way and producing the same result, may even differentiate in name, shape or form, that invention will be said to have caused non-literal infringement of the previously patented invention.

2.4.4 Indirect infringement

Indirect infringement occurs when a third party supports, contributes or promotes the direct infringement. The infringement can either be accidentally or knowingly.

2.4.5 Induced infringement

Induced infringement involves willful aiding of the infringing process, with or without any intention to infringe. In either case, the infringer shall be held liable for infringement. The aiding can be in the form of:

- i. Assisting in manufacturing of the product.
- ii. Assembling the patented product without proper license.
- iii. Providing instructions to third parties on production of product.
- iv. Printing the instructions of patented items and selling them.
- v. Licensing plans or processes.

2.4.6 Contributory infringement

Contributory infringement is a kind of indirect infringement in which the infringer sells or supplies the parts of a product used exclusively to manufacture the patented products. The infringer is held liable



even if he does not actively participate in the manufacturing process.

2.4.7 Willful infringement

Willful infringement occurs when someone disregards the patent invention voluntarily. The burden of proof in this case lies on the patent holder. The infringer can take the defense of legal opinion thoroughly in writing. Three step process for willful infringement are:

- i. Knowledge about the patented invention,
- ii. Good faith belief that the infringer would not be liable for patented invention,
- iii. Infringer's belief is reasonable.

If the willful infringement is proved, the court can order strong deterrents (3 to 4 times of actual damage), inclusive of court costs, lawyer's fees etc.

2.5 DEFENSES AVAILABLE AGAINST PATENT INFRINGEMENT

- i. **Estoppel:** Estoppel is a legal principle that can be used as a defense against a claim of patent infringement. The principle of estoppel states that a person cannot assert a right that they have previously renounced or abandoned. In the context of patent infringement, estoppel can be used as a defense when the patent holder has made statements or taken actions that indicate that they do not believe the accused party is infringing their patent. For example, if the patent holder has licensed the accused party to use the patented invention or has allowed the accused party to use the patented invention for a significant period of time without asserting their patent rights, the patent holder may be stopped from later claiming that the accused party is infringing their patent.
- ii. **License:** A license is a legally binding agreement between the patent owner and another party, in which the patent owner grants the other party permission to use the patented invention in exchange for some form of compensation. In the context of a patent infringement claim, a license defense argues that the accused product or process is being used under a license or other agreement with the patent owner that permits the use. This means that the accused party has a right to use the patented invention, and therefore cannot be held liable for infringing the patent.
- iii. **Plaintiff is not entitled to sue:** The plaintiff who is claiming patent infringement does not have the legal right to bring a lawsuit for the infringement. This defense can be raised for a variety of reasons, such as lack of standing, assignment of the patent, invalidity of the patent, statute of limitations, or a settlement or licensing agreement. For example, if the patent has been assigned to someone else, the original owner is no longer entitled to sue for infringement and the new owner must bring the lawsuit instead. Similarly, if the patent is found to be invalid, the plaintiff is not entitled to sue for infringement as they do not have a valid patent to enforce.

2.6 REMEDIES SOUGHT FOR PATENT INFRINGEMENT

- i. **Injunction:** In the context of patent infringement, an injunction is a court order that requires the infringing party to stop making, using, selling, or importing the infringing product. It is a preventative measure that aims to preserve the value of the patent and prevent further harm to the patent holder. To obtain an injunction, the patent holder must prove that their patent is valid and that it has been infringed upon by the defendant. Injunction is of three kinds:



- ii. **Temporary Injunction:** It is a kind of temporary remedy that is provided before the final verdict of the case. It is used to preserve the status quo of the patent holder. Moreover, they are likely to succeed in their lawsuit and will suffer irreparable harm if the infringing activity is allowed to continue.
- iii. **Permanent injunction:** It is a kind of permanent remedy that is granted when the case is finally decided by the court. It requires the infringing party to stop the infringing activity permanently. The court may also award monetary damages, such as compensation for any profits that the infringing party has made as a result of the infringing activity. To obtain a permanent injunction, the patent holder must file a lawsuit and prove that their patent is valid and that it has been infringed upon by the defendant. However, obtaining a permanent injunction can be a complex and time-consuming process, and the patent holder must have strong evidence to support their claim.
- iv. **Ex-parte injunction:** An ex-parte injunction is a provisional remedy that is used in urgent situations and is granted without a hearing. It is a powerful remedy for patent infringement, but it must be used with caution, as it may result in harm to the defendant if it is later found to be unjustified. It is typically used in urgent situations where the plaintiff needs immediate relief and there is not enough time for a full hearing.
- v. **Damages:** Damages is a remedy for patent infringement that compensates the patent holder for any harm that they have suffered as a result of the infringing activity. Damages may be awarded in the form of monetary compensation, such as compensation for any lost profits or other financial losses that the patent holder has suffered. The main objective of damages is to compensate for the loss or injury that happened to the plaintiff.
- vi. **Seizure, forfeiture or destruction:** Courts may decree that the items determined to be infringing should be taken into custody, forfeited, or disposed of as deemed appropriate.





3.0 TRADE MARKS

Unlike patents, a trademark protects words and design elements that identify the source of a product. Brand names and corporate logos are primary examples. A service mark is similar, except that it safeguards the provider of a service instead of a tangible good. The term “trademark” is often used in reference to both designations.

Trademarks refer to logos, words, symbols, colors, or sounds that are distinctive to your business. Brands are built using consistent identifiers; therefore, trademarks are effective tools for marketing and building trust among consumers.

Some examples of trademark infringement are fairly straightforward. You'll probably run into trouble if you try to bottle a beverage and call it Coca-Cola or even use the famous wave from its logo since both have been protected for decades.

However, a trademark actually goes a bit further, prohibiting any marks that have a “likelihood of confusion” with an existing one. Therefore, a business can't use a symbol or brand name if it looks similar, sounds similar, or has a similar meaning to one that's already on the books, at least if the products or services are related. If the trademark holder believes there's a violation of these rights, it may decide to sue.

3.1 CATEGORIES OF TRADE MARKS

- i. an ordinary trade mark



- ii. a certification trade mark
- iii. a defensive trade mark
- iv. a collective trade mark (if a collective trade mark is applied for a copy of the rules governing the use of the trade mark must accompany this application)

3.1.1 Distinguishing guise

A distinguishing guise identifies the unique shape of a product or its package. If for example one manufactures chocolate mold to look like a rabbit, one might want to register the rabbit shape as a trade mark as a distinguishing guise.

3.1.2 Certification mark

A certification mark helps to identify goods or services which meet a defined standard. Certification marks are owned by one person but licensed to others to identify good or services which meet the defined standard. Examples are the wool mark used on clothing that are 100% pure wool, or the Kenya Bureau of Standards certification mark.

3.1.3 Service mark

A Service Mark is a sign which serves to distinguish services of an industrial or a commercial enterprise or a group of such enterprises. The sign may consist of either of the characteristics named above in trademarks.

3.1.4 Product Marks

These are those marks that relate to identification of specific goods.

3.1.5 Well-known marks

These are marks that are considered to be well known in the market and as a result, benefit from stronger protection. Examples of well-known marks include Toyota, Mercedes Benz, Microsoft, YouTube, Facebook, Google, Sony, Unilever, Samsung, Yahoo, etc.

3.1.6 Disclaimers

A disclaimer is a statement indicating that a certain word or portion of a trade mark is not protected. This means that it is possible to have in your trade mark parts or words that are generic or commonly used in the trade for those products with the understanding that you have no monopoly over it and thus no right to bar others from using those words under Sec 17 of the Trade Marks Act.

An example here would be, assuming one applies for the trade mark 'Pamoja Mineral Water'; the disclaimer would cover the words 'mineral water'. Having a disclaimer does not however mean that you can never use the disclaimed portion as part of your mark.

Other additional information including, translations, transliterations, marks in series, colour limitation, priority claim, 2D or 3D marks are a requirement where need be when filing for a trade mark.

3.2 REGISTRABILITY OF A TRADEMARK

In order for a trade mark (other than a certification mark) to be registrable in Kenya, under the Trade Marks Act (Cap 506) it must contain or consist of at least one of the following essential particulars: -



- i. The name of a Company, Individual or Firm, represented in a special or particular manner
- ii. The signature of the applicant for registration or some predecessor in his business
- iii. An invented word or invented words;
- iv. A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname.
- v. Any other distinctive mark.

3.2.1 Who can register a Trademark?

An individual, a company, a partnership, a society, a co-operative or any lawful association can apply for a trade mark provided they meet the requirements of the Trade Marks Act. For a foreign applicant the application must be processed by a local Agent.

3.2.2 Nice Classification:

The marks are classified in accordance with the "International Classification of Goods and Services" which, as regards Registration of Marks, means the classification in accordance with the Nice Agreement of the 15th June, 1957, (as revised and amended from time to time), establishing an international classification of goods and services (the Nice Classification -currently in the 13th edition.)

3.2.3 Spectrum of Distinctiveness:

Not all marks are registrable per se. Certain requirements are to be adhered to. The more distinctive a mark is the less infringed and such marks which are suggestive, arbitrary and coined or fanciful.

Generic marks are not protected while descriptive marks may be protected if the same meets the threshold of examination.

Note: symbols such as ®, SM or TM are used only when the mark is registered under the Act.

3.3 REGISTRATION PROCEDURE FOR TRADEMARKS

3.3.1 Preliminary Search

During registration of a trademark, the applicant should conduct a search to establish whether the mark is registrable or not and whether the proposed registration adheres to the regulations of the Trademarks Act. The Search is not mandatory but is advisable to determine whether there is probability of registration.

3.3.2 Application for Registration

Once there is a confirmation that the mark is available for registration in a particular/various class(es), the next step would be to apply for registration of the mark.

A person claiming to be the proprietor of a trade mark, used or proposed to be used by him, and who is desirous of registering it applies for registration vide form TM 2 in the Trade Marks Act. This application is usually accompanied by seven (7) representations of the mark.

Foreign applicants are required to file through an agent and thus the application should be accompanied by the form of authorization Form TM 1 in the Act or the power of attorney duly completed and signed and must have a duty stamp affixed on it.



The application should also be accompanied by form TM 32 in the Act for entry of the address of service in Kenya. The applicant is required to file a separate application for each mark in each different class. However, one can apply for registration of a mark in different classes.

3.3.3 Examination

Examination time: 5 months.

Once the Application for registration is received, it then proceeds for examination. The mark will undergo three types of examination which usually take an average of four months.

(a) Formality examination: this involves finding out whether the right documents are filed, whether the forms included are properly filled, and the required fees is appropriately paid. It is necessary that the class should be checked against the specification and confirm that the name, description and address of the Applicant is clearly written.

(b) Search: A Search is conducted to ascertain that there is no similar or closely resembling mark is on the register, otherwise the present application can be refused on that ground. If there exists a similar mark from the same applicant ordinarily an association is requested. **(Time required to complete the search: 8 days.)**

(c) Substantive examination: During substantive examination, the mark is examined as to its distinctiveness. Normally the applicant is requested to remove non distinctive matter and descriptive elements. Where removal of such matter may result in the loss of the identity or substantially affect the main features of the mark entry of disclaimer is normally requested. Letters, Numerals, geographical names, names of places, names of communities, general representation of human beings, words or figures common in the respective trade are normally disclaimed. Logos, emblems, flags and Marks of International Organizations are normally not registrable by anybody else except the respective Organizations or one authorized by them to do so. Generic names of products are also not registrable.

Once the examination is complete KIPI will then communicate to the applicant or the Agent of the approval or disapproval. In case of approval, the mark proceeds to advertisement. In case of disapproval, one may appeal against the decision or abandon the application.

3.3.4 Advertisement and Opposition

Opposition period: 60 days

If the Registrar is satisfied that the Trademark is registrable after conducting substantive examination, the Trademark shall be advertised in the KIPI Journal, which is published monthly. Any interested party with valid grounds may proceed to raise an objection, by filing a statement of opposition, if they are opposed to registration of the Trademark.

Sample Trademark advertisement on the KIPI Journal, 2024:-

“NOTICE is given that any person who has grounds of opposition to the Registration of any of the trademarks advertised herein according to these classes may within sixty (60) days from the date of this Journal, lodge a notice of opposition on form TM. No. 6 (in duplicate) together with a fee of Ksh.5,000/= (local opponent) or US\$ 250 (foreign opponent). The period of lodging the notice of opposition may be extended by the Registrar as he deems fit and upon such terms as he may direct. Any request for such extension should be made to the Registrar



to reach him before the expiry of the period allowed. Formal opposition should not be lodged until after a reasonable notice has been given in writing to the applicant for registration to afford him any opportunity of withdrawing his application before the expense of preparing the notice of opposition is incurred. Failure to give such notice will be taken into account in considering any application by an opponent for an order for costs if the opposition is uncontested by the applicant. Representations of the marks advertised herein can be seen at the Trade Marks Registry, Kenya Industrial Property Institute, KIPI Centre, Kabarsiran Avenue Off Waiyaki Way, Lavington, Nairobi.”

If the application is opposed, the registration process is halted and opposition proceedings are commenced. If no objection is raised after 60 days from the date of advertisement, the Trademark shall be registered, and a Certificate of Registration issued to the applicant.

3.3.5 Registration

If there is no opposition to the trademark after the statutory 60 days period from the date of advertisement, or if an opposition has been decided in the applicant's favor, the application will be registered, and the Institute will issue a Certificate of Registration and enter the registration. The date of the certificate of registration of a trademark is always duplicated to conform with the date the application was made.

Time from filing to registration: 12 months.

3.3.6 Duration of a registered Trademark in Kenya

A registered trademark in Kenya is protected for a period of 10 years from the date of registration in Kenya. Six months prior to the expiry of the 10 years, the Registrar shall notify the Trademark owners in writing of the impending expiry date.

Renewal application can be made within: 90 days before expiry.

Renewal duration: 10 years.

3.4 TRADEMARK INFRINGEMENT

The infringement may occur through the use of the trademark on promotional material, offering goods and services under the trademark. An infringement means that the violator will have an unfair business advantage over your business by stirring confusion in the market amongst your loyal customers. This jeopardizes the loyalty and trust of your customers as well as the integrity of your brand.

The provisions relating to trademark infringement focus upon three main objectives of the person using the registered trademark but is not the registered proprietor of such trademark. The objectives are as follows:

- i. Damaging the reputation and uniqueness of the registered mark
- ii. The intention of usage of a trademark, despite knowledge that such usage is unlawful.
- iii. Having the dishonest intention of gaining unfair advantage from the usage.

Furthermore, trademark infringement can be occasioned by an advertisement. The advertisement should take unfair advantage of the registered trademark as well as damage its reputation and



uniqueness.

What should you do if you discover that someone is using your trademark without permission?

You can send a cease-and-desist letter or a demand letter, demanding that the infringing party stop using your name, logo, symbol, or any letter attached to your business. Depending on the extent of the breach, you can also ask them to compensate you for the infringement.

If they ignore your cease-and-desist letter, you have the option to file a lawsuit in a court of law to stop the infringement of your trademark. If you can demonstrate that the infringing party profited from your trademark and that the infringement caused financial hardship for your business, the court will order that they compensate you. A good trademark lawyer can also help you file under a certificate of urgency to get an injunction that immediately stops the third party from infringing on your trademark.

3.5 HOW TO ENFORCE A TRADEMARK IN KENYA

Under the Trademarks Act, no person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark, but nothing in this Act shall be deemed to affect rights of action against any person for passing off or the remedies in respect thereof.

The two ways of enforcing a trade mark is by an action in passing off or an action against infringement. An action against infringement is taken against a person who violates trade mark rights in relation to a registered trade mark while an action in passing off relates to unregistered trademarks.

3.5.1 Passing off action

In the case of *Strategic Industries Limited v Solpia Kenya Limited* [2019] EKLK, the law of passing off can be summarized in one short general proposition; no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the following elements which the Plaintiff in such an action has to prove in order to succeed:

- a) He must establish a goodwill or reputation or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying “get up”(whether it consists simply of a brand name or a trade description, or the individual features of labelling or packing) under which his particular goods or services are offered to the public, such that the get up is recognized by the public as distinctive specifically of the Plaintiff’s goods or services.
- b) He must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the Plaintiff. Whether the public is aware of the Plaintiff’s identity as the manufacturer or supplier of the goods or services is immaterial, as long as they are identified with a particular source which is in fact the Plaintiff. For example, if the public is accustomed to rely upon a particular brand name in purchasing goods of a particular description, it matters not at all that there is little or no public awareness of the identity of the proprietor of the brand name.
- c) He must demonstrate that he suffers or, in a quia timet action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source



of the defendant's good or services is the same as the source of those offered by the Plaintiff".

3.5.1.1 Remedies for passing off

If you are successful in a passing off claim, there are several remedies available. You can:

- i. apply for an injunction to prevent the business from using your trade mark or goodwill
- ii. apply to have the infringing goods destroyed
- iii. sue for damages or seek account for lost profit
- iv. request an inquiry to establish loss

3.5.1.2 Passing off defences

You may encounter different defences if you pursue a claim for passing off. For example, the defendant may argue that:

- i. the mark in question is not distinctive
- ii. the mark is generic
- iii. they have used carefully and honestly their own name
- iv. you don't have goodwill in the mark
- v. you have given consent or encouraged the use of the mark
- vi. you can't demonstrate damage or loss

The law on passing off is complicated. Claims can be hard to prove and taking action can be expensive, as the evidential burden of proof is solely on the trade mark owner.

3.5.2 Action for passing off

The first step that an aggrieved person should take is to get a court order for searching the premises of an offending person where the offending products are stored, together with sales and purchase records. Once the offending products are found together with the sales records, they are seized and are to be used as evidence because on a successful claim of infringement or passing off, the courts can give an order stopping the offending person from selling the product under that trade mark, an order for monetary compensation of the owner of the trade mark, an order for the offending person to surrender the profits obtained in respect of the passed off/ infringed products or any combination of those remedies.



4.0 COPYRIGHT

Copyrights protect “original works of authorship,” such as writings, art, architecture, and music. For as long as the copyright is in effect, the copyright owner has the sole right to display, share, perform, or license the material.

One notable exception is the “fair use” doctrine, which allows some degree of distribution of copyrighted material for scholarly, educational, or news-reporting purposes. Technically, you don’t have to file for a copyright to have the piece of work protected. It’s considered yours once your ideas are translated into a tangible form, such as a book, music, or published research.

As a general rule, the author retains ownership of copyright privileges, even if the material is published by another company. There is an important exception to this rule, though. Materials you create for your employer as part of your job requirements, for example, contributions to a podcast the company publishes, are usually considered “works for hire.” The employer, not you, retains the copyright. If there’s a gray area, you can try to negotiate with the publisher over copyright ownership prior to creating the piece; just be sure to get it in writing.

4.1 THE KENYA NATIONAL RIGHTS REGISTRY PORTAL

This is the central repository collating details pertaining to ownership of various copyright works. This portal is used by copyright holders allowing them to register and view/download copyright certificates. The portal allows rights holders of the following types of work: music, video, spoken word, literary works,



etc.

Copyright protection is vested in the work once it is in a concrete form without need for registration. This position is observed worldwide. The Kenya Copyright Board is however required under the Copyright Act to maintain a data bank of authors and their works by registering copyright works. This registration is voluntary. Non-registration does not deny authors any rights under the Copyright Act.

4.2 IMPORTANCE OF REGISTRATION OF COPYRIGHT WORKS

- Acts as a public record of authors/owners.
- The certificate of registration acts as evidence of ownership of copyright in a court of law in case of a dispute.
- The certificate of registration may in future be used as collateral in a bank or any other lending institution in case one wants to borrow funds.
- It makes it easy to commercialize copyright i.e. in case of licensing or assignment.
- It makes it easy for IP auditors to identify the different IP rights owned by a corporate.

4.3 OWNERSHIP OF COPYRIGHT

The first ownership of a copyright work vests in the person who creates it. However, copyright like any other moveable property can be transferred through sale, licenses and testamentary disposition. Under the law of Copyright ;

1. In the case of two authors, the two shall be known as the joint authors of the work.
2. In the case of works created for hire or works created under a contract of employment, unless otherwise stated in a contract, the employer or the person who commissioned the work shall be the owner of the work.
3. In the case of a film, the principal director and the film producer are joint authors and first owners of the copyright (and the economic rights). Similar provisions to those referred to above, apply where the director is employed by someone.
4. In the case of a sound recording the author and first owner of copyright is the record producer, in the case of a broadcast, the broadcaster; and in the case of a published edition, the publisher.
5. Copyright in material produced by a government department belongs to the Government.

4.4 DURATION OF COPYRIGHT PROTECTION

The length of time a copyright work is protected will depend on the category or type of work.

4.4.1 Literary, musical or artistic work other than photographs

Copyright in the above works lasts for the period of the life of the author plus fifty years.

4.4.2 Audio-visual works and photographs

Fifty years from the end of the year in which the work was either made, first made available to the public, or first published, whichever date is the latest.



4.4.3 Sound recordings

Fifty years after the end of the year in which the recording was made.

4.4.4 Broadcasts

Fifty years after the end of the year in which the broadcast took place.

NB: Once the term of protection of copyright expires, the work falls into the public domain.

4.5 COPYRIGHT INFRINGEMENT

Infringement occurs if a person other than the author or someone authorized by him/her does any of the following acts: reproduction, translation, adaptation, performance, sale or hire of the work. These rights are exclusive domain of the author/owner.

4.5.1 Civil Action

Under the Copyright Act, the author of infringed works may pursue civil action against the infringing person and is entitled, under the Act to:

- i. Injunctions to stop the infringing action
- ii. Damages for losses suffered or account of profits
- iii. Seizure of infringing copies by way of an Anton Pillar orders.

The court, where it determines an infringement has taken place, may order for the destruction of the infringing items or disposal in any other manner that it may deem fit.

4.5.2 Criminal Action

The right holder may also choose to pursue criminal action against the infringer. The criminal sanctions include:

- i. Maximum fines of up to Kshs 800,000/
- ii. Maximum custodial sentence of up to 10 years.
- iii. Both fines and custodial sentences.

Criminal and civil actions are non-exclusive and may proceed concurrently.



5.0 PLANT BREEDERS' RIGHTS

Breeders' rights shall be granted for a fixed period of twenty years from the date of the grant, except in respect of trees and vines where the said period shall be twenty-five years from the date of the grant.

5.1 APPLICATION FOR PLANT BREEDERS' RIGHTS PROTECTION IN KENYA

Under the current Plant Variety Protection regime in Kenya, there are specific laid down conditions that must be fulfilled in respect of the applicant and the plant variety to which the application relates. The Seeds and Plant Varieties Act states that an applicant for plant breeders' rights must be the person who bred or discovered the plant variety concerned, or his successor in title. The discovery dimension marks one of the major differences between the PBRs and the patents system, in that one of the fundamental principles of patent law is in the protection of inventions, not discoveries.

For an applicant for plant breeders' rights to be granted protection over a plant variety, the variety must comply with the rules prescribed under Schedule Four, Part II of the Act. The variety shall be:

- i. sufficiently distinguishable by one or more important morphological, physiological or other characteristics from any other variety whose existence is a matter of common knowledge at the time of the application, whatever may have been the origin, artificial or natural, of the initial variation from which it resulted;
- ii. sufficiently varietal pure;
- iii. sufficiently uniform or homogenous having regard to the particular features of its sexual



- iv. reproduction or vegetative propagation;
- v. stable in its essential characteristics, that is to say, it must remain true to its description
- vi. after repeated reproduction or propagation or, where the application prescribes a
- vii. particular cycle of reproduction or multiplication, at the end of each cycle.

5.2 SCOPE OF RIGHTS GRANTED BY PLANT BREEDERS' RIGHTS REGISTRATION

The holder of plant breeders' rights in a new plant variety shall have the exclusive right to do, and to authorize others to do, the following:

- i. production or reproduction
- ii. conditioning for the purpose of Propagation
- iii. offering for sale
- iv. selling or other marketing
- v. exporting
- vi. importing
- vii. stock the variety for any of the above purposes

5.3 GRANT/PROTECTION DURATION

The period for exercising plant breeders' rights shall not exceed 20 years, for all types of crops except in respect of trees and vines where the said period shall be twenty-five years from the date of the grant. For the rest of the crops, the period should not be less than 15 years. This period commences on the day that the grant of the plant breeders' rights takes effect.

5.4 CANCELLATION OF GRANT

There is provision for cancellation of plant breeders' rights, the responsibility for such a cancellation falling under the authority of the minister. This can occur if the minister is satisfied that information submitted in the application for the grant of the rights, by the applicant or on behalf of the applicant in connection with the application, was incorrect, or if facts have been discovered which, if known before the grant, would have resulted in the grant being refused on the grounds that it did not meet conditions for protection.

5.5 PRIVATE AND NON-COMMERCIAL USE EXCEPTION

The Seeds and Plant Varieties Act provides for an important exemption to the exercise of plant breeders' rights. The Act stipulates that in so far as the production and stocking for production of the propagating material for which plant breeders' rights have been granted is undertaken solely for research purposes or for developing new varieties in the breeder's own nursery, this shall not be deemed to be at variance with the exclusive right of the holder of a plant breeder's rights.

The regulatory framework for plant variety protection in Kenya follows the system of first to apply.



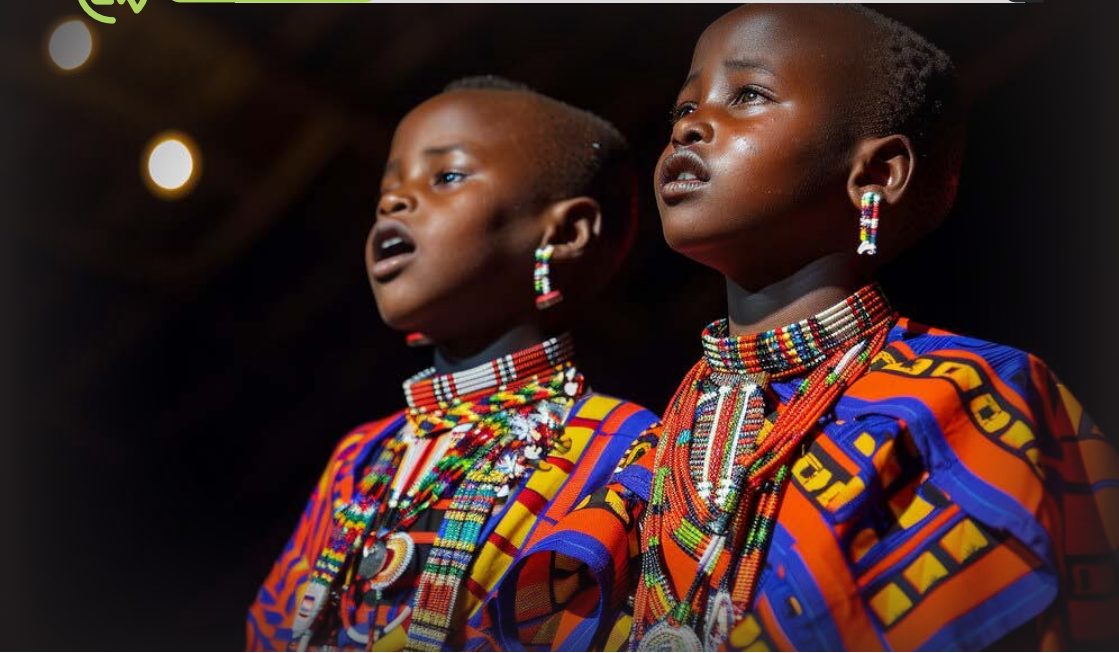
5.6 INFRINGEMENT OF PLANT BREEDER RIGHTS

Infringement of rights to a plant breeder lies in anti-counterfeiting legislation. Kenya's anti-counterfeiting legislation, the Anti-Counterfeit Act (2008), extends its scope of policing from trademark infringement and copyright piracy to patents and PBRs. Availability of this option is premised upon the owner of PBRs having taken out the right, both in Kenya and beyond, as long as the goods and subject matter of infringement are in Kenya.

Section 2 of the Anti-Counterfeit Act defines counterfeiting as actions against goods protected by intellectual property rights, a term which again is defined broadly to include PBRs. Similar to seed certification laws, the anti-counterfeiting legislation shifts the burden of policing the market from the owner of the intellectual property rights to the state. Inspectors under the anti-counterfeiting law as well as the seed laws have immense powers in their enforcement action. They can inspect places, premises or vehicles, where goods that are reasonably suspected of being counterfeit or infringing goods are found; and, even remove such goods from the market.

Finally, it is worth noting that in both situations, enforcement action may be initiated either by a complaint by the owner of an intellectual property right or by the state through relevant agencies, such as the national revenue authority or seed regulator.





6.0 TRADITIONAL CULTURAL EXPRESSIONS/FOLKLORE

Traditional cultural expressions (TCEs), also called "expressions of folklore", may include music, dance, art, designs, names, signs and symbols, performances, ceremonies, architectural forms, handicrafts and narratives, or many other artistic or cultural expressions.

- i. Traditional cultural expressions:
- ii. may be considered as the forms in which traditional culture is expressed;
- iii. form part of the identity and heritage of a traditional or indigenous community;
- iv. are passed down from generation to generation.

"Traditional knowledge" means any knowledge—

(a) originating from an individual, local or traditional community that is the result of intellectual activity and insight in a traditional context, including know-how, skills, innovations, practices and learning, embodied in the traditional lifestyle of a community; or

(b) contained in the codified knowledge systems passed on from one generation to another including agricultural, environmental or medical knowledge, knowledge associated with genetic resources or other components of biological diversity, and know-how of traditional architecture, construction technologies, designs, marks and indications.

TCEs are integral to the cultural and social identities of indigenous and local communities, embody know-how and skills, and transmit core values and beliefs.



6.1 TRADITIONAL CULTURAL EXPRESSIONS AND INTELLECTUAL PROPERTY

For many communities, TCEs, traditional knowledge and associated genetic resources form part of a single integrated heritage. Yet, because TCEs raise some particular legal and policy questions in intellectual property (IP), they receive a distinct focus in many national and regional IP laws and in WIPO's work.

TCEs can sometimes be protected by existing systems, such as copyright and related rights, geographical indications, appellations of origin and trademarks. For example, contemporary adaptations of folklore are copyrightable, while performances of traditional songs and music may come under the WIPO Performances and Phonograms Treaty and Beijing Treaty on Audiovisual Performances. Trademarks can be used to identify authentic indigenous arts, as the Maori Arts Board in New Zealand, Te Waka Toi, has done.

Their protection is related to the promotion of creativity, enhanced cultural diversity and the preservation of cultural heritage. The owners and holders of traditional knowledge shall have the right to protection of that knowledge. Every community shall have the exclusive right to—

- i. authorize the exploitation of their traditional knowledge; and
- ii. prevent any person from exploiting their traditional knowledge without their prior informed consent.

In addition to all other rights, remedies and action available, the owners shall have the right to institute legal proceedings against any person who exploits traditional knowledge without the owner's permission. Every community shall make and adopt its community rules prescribing the procedures for the authorization of the exploitation of their traditional knowledge. The rules shall be submitted to the county government during the registration of traditional knowledge.

6.2 SCOPE OF PROTECTION OF TCEs

Protection shall be extended to traditional knowledge that is—

- i. generated, preserved and transmitted from one generation to another, within a community, for economic, ritual, narrative, decorative or recreational purposes;
- ii. individually or collectively generated;
- iii. distinctively associated with or belongs to a community; and
- iv. integral to the cultural identity of community that is recognized as holding the knowledge through a form of custodianship, guardianship or collective and cultural ownership or responsibility, established formally or informally by customary practices, laws or protocols.

6.3 EXCEPTIONS AND LIMITATIONS OF TCE RIGHTS

The protection of traditional knowledge or cultural expressions shall—

- i. not restrict or hinder the normal usage, development, exchange, dissemination and transmission of traditional knowledge or cultural expressions by members of a particular community within the traditional and in accordance with the customary law and practices of that community;



- ii. extend only to uses of traditional knowledge or cultural expressions taking place outside their commercial gain or not; and
- iii. be subject to such other exceptions as may be necessary to address the needs of noncommercial use, including teaching and research for educational purposes, personal or private use, criticism or review, reporting of current events, use in the course of legal proceedings, the making of recordings and reproductions of traditional knowledge or cultural expressions for inclusion in an archive or inventory exclusively for the purposes of safeguarding knowledge or cultural heritage, and incidental uses.

A user of traditional knowledge or cultural expressions shall obtain prior informed consent and sufficiently acknowledge the owners by expressly mentioning them or the geographical place from which the traditional knowledge or cultural expressions originated, in the course of use.

The use of traditional knowledge or cultural expressions should be compatible with fair practice, the relevant community's customary laws, protocols and practices and the relevant community shall be acknowledged as the source of the traditional knowledge or cultural expressions, and such use shall not be offensive to the relevant community.

6.4 DURATION OF GRANT

Rights in TK are conferred without formalities and exist in perpetuity as long as the subject matter complies with the requirements for protection.

6.5 TCE REGIME - MUCH ADO WITHOUT NOTHING?

It is noteworthy that TCEs regime is inconclusive at the of publication of this manual. Some of the issues occasioning dilemma in the law on TCEs include;

While the county and national governments are charged with the responsibility of establishing TK databases, the role of communities in that regard is not clear. Equally, it is not apparent who 'owns' the databases once established and the documented TK. Is it the communities or the county or national government? Likewise, the law fails to address the role of customary laws and traditional governance structures (like TJS) in the protection of TK.

Further, the law treats TK as a natural resource that 'belongs to the people of Kenya' collectively, like land in Kenya, raising inter alia the question as to who should be rewarded for creativity. Likewise, benefits from protection of TK are framed as primarily local (for communities in Kenya) and national (for Kenya as a nation state), as is the case with other forms of real property, essentially undermining or ignoring the creative contributions of local communities as envisaged in the National Policy on Culture and Heritage, 2009. Benefits from TK protection ought to be derived by communities that have developed the TK, unless the community is not identifiable or if the TK is so widespread and it is impossible to identify a specific community. In the later cases, the benefits might not necessarily be derived by one community.



6.6 INFRINGEMENT OF TCES

Enforcement of folklore is a grey area which makes it difficult to resolve infringement claims. section 38(1) of the Protection of Traditional Knowledge And Cultural Expressions Act allows holders of TK and CEs to institute civil proceedings. Section 40 adds that disputes may be resolved through mediation, Alternative Dispute Resolution (ADR) or through application of customary laws and protocols.

Disputes between holders and third parties are complex as they entail legal as well as cultural and ethical questions. Use of TK or TCEs that violate a community's religious or sacred beliefs may be graver than violation that causes financial loss. Remedy through litigation in domestic courts would therefore be unsatisfactory. Further, for disputes between communities with different cultural beliefs and customary laws but sharing the same TK and TCEs, even customary laws would be inadequate to arrive at a common ground on competing claims. For instance, the Samburu and Maasai who share a number of their cultural artifacts, knowledge and expressions.

There is a grey area under Section 7(6) Protection of Traditional Knowledge and Cultural Expressions Act on whether concurrent claims by communities would be resolved by KECOBO or the county government. There is also no mention of an appeal mechanism or even review of such determinations.

AUTHOR

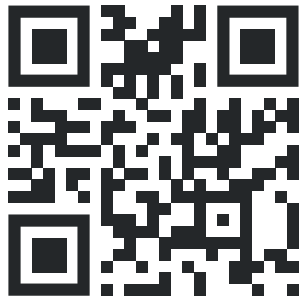


Eileen Chepkorir
Trainee Advocate



NETSHERIA
INTERNATIONAL

SCAN ME



I & M Bank House 5th Floor,
2nd Ngong Avenue,

p P.O. BOX 102 – 00202
Upper Hill, Nairobi, Kenya

m +254 110 662 952

e info@netsheria.com,
law@netsheria.com