

**LECTURE ON
INTELLECTUAL PROPERTY AND ITS REGISTRATION PROCEDURE IN
KENYA**

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A. WHAT IS INTELLECTUAL PROPERTY?

- **The term Intellectual Property (IP) refers to creations of mind.**
- IP is categorised into
 - (a) Industrial property: which includes inventions (patents), trademarks and industrial designs; and
 - (b) Copyright: which includes literary and artistic works such as novels, poems and plays, films, musical works, artistic works such as drawings, paintings, photographs and sculptures, and architectural designs.

Rights related to copyright include those of performing artists in their performances, producers of phonograms in their recordings, and those of broadcasters in their radio and television programs.

- An owner of IP, that is, owner or creator of an invention, trade mark or copyright is granted rights, just like any other property rights, to their creations in order for them to benefit from their own work.

B. TRADE AND SERVICE MARKS

A Trade Mark is a distinctive sign which serves to distinguish the goods of a specific person or enterprise.

The same definition applies to a service mark except that as the name suggests it serves to distinguish the services of a specific person or enterprise.

For convenience purpose, I will use the term trade mark to refer to trade and service marks.

The sign may consist of one or more distinctive **words, letters, numbers, drawings or pictures, monograms, signatures, colours or combination of colours etc. The sign may consist also of combinations of any of the said elements whether rendered in two-dimensional or three dimensional form.**

Certification Mark

A certification mark helps to identify goods or services which meet a defined standard in respect of **origin, material, mode of manufacture, quality, accuracy** or other characteristic

Certification marks are owned by one person but licensed to others to identify good or services which meet the defined standard. Examples are the Kenya Bureau of Standards certification mark, certification mark for coffee products (unfortunately Kenya does not have a local certification mark for its coffee).

Distinguishing Guise

A distinguishing guise identifies the unique shape of a product or its package. If for example you manufactured chocolate moulded to look like a rabbit, you might want to register the rabbit shape as a trade mark as a distinguishing guise. A good example is the *coca-cola* bottle.

Reasons for Registering a Trade Mark

Registration of a trademark is not mandatory. One can use a mark for a certain length of time and establish his/her ownership through common law.

However it is highly advisable to register your trade mark since the system of establishing ownership through common law involves lengthy, expensive legal process.

- The most effective way of **proving ownership** of a trademark in Kenya is through registration and the burden is upon anyone challenging your rights in a mark to prove his/her rights in a dispute.
- Registration also assists in **keeping off potential infringers** who would be attempted to ride on the goodwill of your mark.
- A registered trademark is also a **valuable asset** for business expansion especially so through licensing franchises.

Trade Mark Registration Procedure

Registration is done by Kenya Industrial Property Institute (KIPI).

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

- The **name** of a company , individual or firm , represented in a special or particular manner
- The **signature** of the applicant for registration or some predecessor in his business
- An **invented word** or invented words.

Such word(s) should have no direct reference to the character or quality of the goods (for example avoid using words such best, perfect), and not being according to its ordinary signification a geographical name or a surname.

- Any other distinctive mark.

- An indication of the class in which the mark is proposed to be registered together with the specification of goods/services.

The application form for trade mark is Form TM No. 2 and when filled should contain the above particulars.

Examination

The application for trade mark is subjected to examination which involves formal examination to confirm that the right documents are filed, the relevant forms correctly filled and the required fees have been paid.

Thereafter the examiner will conduct a search to ascertain that there is no similar or closely resembling mark in the register. If there exists a similar mark from the same applicant ordinarily an association is requested.

Finally the application will be subjected to *substantive examination i.e* the mark is examined as to its distinctiveness.

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. Example Aspirin for acetylsalicylic acid declared generic in U.S., E-mail claimed by Compuserve, thermos trade mark for vacuum flask

Advertisement

If the examiner approves the trade mark for registration then it will be advertised in the KIPI Journal to allow any interested party an opportunity to raise objections to the pending application prior to registration.

An opposition must be made within 60 days of the publication date, by filing a statement of opposition.

The applicant will be invited by KIPI to file his reply and this will trigger a process akin to court proceedings culminating with the Registrar making a ruling that is binding. Any dissatisfied party can file an appeal through the High court.

Registration

If there is no opposition to the trade mark after the statutory 60 days period from the date of advertisement, or if an opposition has been decided in the applicants favour, the application will be registered and the Institute will issue a Certificate of Registration.

The date of registration of a trademark is the date of filing the application for registration.

Duration of Trade Mark Registration

A trade mark registration is valid for ten (10) years from the date of filing the application and renewable for a further period of 10 years from the date of its expiry upon payment of a renewal fee (currently Kshs. 4,000 and USD 200 for local and foreign applicants respectively).

Official Registration Costs

Local Applicant – Approximately Kshs. 10,000.

Foreign Applicant – Approximately USD 470.

Regional and International System Of Registration

ARIPO System

The Banjul Protocol on trademarks provides for the filing of a single trade mark application at the (African Regional Intellectual Property Organisation (ARIPO)

office, currently in Harare, Zimbabwe, to cover any member state designated by the applicant.

The member states are **Botswana, the Gambia, Ghana, Kenya, Lesotho, Malawi, Mozambique, Namibia, Sierra Leone, Somalia, Sudan, Swaziland, Tanzania, Uganda, Zambia and Zimbabwe.**

Among the member states of ARIPO, the countries that have acceded to the Protocol, are: **Botswana, Namibia, Lesotho, Swaziland, Malawi, Tanzania, Uganda, and Zimbabwe.** Although Kenya is a member of ARIPO it has not acceded to the Protocol.

With the exception of Zimbabwe and Botswana, none of the territories that have acceded to the Protocol have amended their National Legislation in order to recognise ARIPO registrations. With respect to Zimbabwe the new law has not yet come into force.

Due to the fact that the National Laws of most of the contracting states do not yet give recognition to an ARIPO registration, it is recommended that separate applications be filed in each country.

Madrid System

The Madrid system for the international registration of marks (the Madrid system) established in 1891 functions under the Madrid Agreement (1891), and the Madrid Protocol (1989). It is administered by the International Bureau of WIPO located in Geneva, Switzerland.

The Madrid system offers a trademark owner the possibility to have his trademark protected in several countries by simply filing one application directly with his own

national or regional trademark office (members of the Madrid Union, Kenya being one of them).

An international mark so registered is equivalent to an application or a registration of the same mark effected directly in each of the countries designated by the applicant.

This international system simplifies greatly the subsequent management of the trademark, since it is possible to record subsequent changes or to renew the registration through a single procedural step. Further countries may be designated subsequently.

Cost

The method of determining the fee is complex and the International Bureau has a fee calculator for determining this. The fee varies depending on the nature of the mark, color, if the applicant is from a least developed country (10% discount is granted), number of classes the mark is proposed to be registered etc.

C. PATENT (INVENTION)

A patent is an exclusive right granted for an **invention**.

The invention can be a **product** or a **process**.

The product or process provides a new way of doing something, or offers a new technical solution to a problem.

In order to be patentable, the invention must fulfil the following conditions

- It must be of **practical use**;
- it must show an element of **novelty**, i.e some **new characteristic** which is not known in the **body of existing knowledge** in its technical field.

This body of existing knowledge is called "**prior art**".
The invention must show an **inventive step** which could not be deduced by a person with average knowledge of the technical field.

- Lastly, its subject matter must be accepted as "patentable" under law.

Under Kenyan law the following are not patentable:

1. Discoveries of natural substance.
2. Scientific theories and mathematical methods.
3. Schemes e.g. investment, methods of bookkeeping or insurance schemes.
4. Commercial methods e.g. credit or stock methods
5. Computer programs
6. Rules for playing games (the games equipment may be patentable).
7. Methods for medical treatment (as opposed to medical products);
8. Public Health related methods of use or uses of any molecule or other substances whatsoever used for the prevention or treatment of any disease which the Minister responsible for matters relating to health

may designate as a serious health hazard or as a life threatening disease.

9. Mere presentation of information.
10. Non Functional details of shape, configuration, pattern or ornamentation
11. Plant and animal varieties, but not parts thereof or products of biotechnological processes.
12. Inventions contrary to public order, morality, public health and safety, principles of humanity, and environmental conservation.

Nature of Patent right?

A patent provides **protection** for the invention to the **owner** of the patent. The protection is granted for a limited period, which is 20 years under the Kenyan law.

Patents are not renewable and after its expiry it enters the public domain to enable other people exploit it commercially while at the same time work on the patent thereby improving it.

Patent protection means that the invention cannot be commercially **made, used, distributed or sold** without the patent owner's **consent**.

The patent owner **may give permission** to, or **license**, other parties to use the invention on mutually agreed terms.

The owner may also **sell** the right to the invention to someone else, who will then become the new owner of the patent.

Reasons for grant of patent.

Patents provide **incentives** to inventors by offering them **recognition** for their **creativity** and **material reward** for their marketable inventions. These incentives encourage **innovation**, which assures that the **quality of human life** is continuously enhanced.

Confidentiality of patent before filing a patent application

It is important to file a patent application before publicly disclosing the details of the invention. In general, any invention which is made public before an application is filed would be considered prior art.

The applicant's public disclosure of the invention prior to filing a patent application would prevent him/her from obtaining a valid patent for that invention, since such invention would not comply with the novelty requirement.

If it is inevitable to disclose your invention to, for example, a potential investor or a business partner, before filing a patent application, such a disclosure should be accompanied by a confidentiality agreement.

However a disclosure of a patent is not taken into consideration if it occurred more than twelve months before the filing date and if it was by reason or in consequence of:

1. acts committed by the applicant or his predecessor in title; or
2. an evident abuse committed by a third party in relation to the applicant or his predecessor in title.

Procedure for Patent Registration

The first step in securing a patent is the filing of a **patent application** with KIPI.

The patent application generally contains:

- the request (Form IP 3)
- the specification containing the following:-
 - ✓ the title of the invention, as well as an indication of **its technical field**;

- ✓ the background and a **description** of the invention, in clear language and enough detail that an individual with an average understanding of the field could use or reproduce the invention.
- ✓ **visual materials, if any**, such as drawings, plans, or diagrams to better describe the invention.
- ✓ **"claims"**, that is, information which determines the extent of protection sought by the patent.
- ✓ **“abstract”**, it includes the title of the invention; and a summary of the disclosure included in the description. It indicates the technical field to which the invention relates and the principal use(s) of the invention. It merely serves the purpose of technical information.

Publication of Application

The application for grant of a patent is published in the KIPI Journal as soon as possible after the expiration of **eighteen months** from the filing date.

Substantive Examination

Where an application for a patent satisfies the formal requirements, the applicant is notified and is required to submit, **within three years** from the filing date of the application, a request for the examination of the application.

An examination of the application is carried out check out whether the invention in respect of which the application is made is patentable.

Grant of Patent

Unless an application is rejected, a patent is granted and issued to the applicant together with a certificate of grant of a patent. Every patent granted is registered, and is, as soon as reasonably practicable, published in the the Industrial Property Journal.

Costs

The official fee for registering a patent where the claims are not more than 10 is approximately Kshs. 15,000 or USD 750 for local and foreign applicants respectively.

One has to factor additional cost, that is, patent annuity fees which is for maintaining a patent. The fee is first due 12 months from the date of filing the patent application and thereafter after every 12 months until its expiry on the 20th year.

The first annuity fee is Kshs. 2,000/- (local applicant) or USD 300 (foreign applicant) and increases every year up to Kshs. 50,000 (local applicant) or USD 2,500 (foreign applicant) on the 20th year.

Regional Patents

Regional patent application

ARIPO is empowered by the Harare Protocol on Patents and Industrial Designs to grant patents and to register utility models and industrial designs on behalf of contracting states.

Applications for the grant of patents or the registration of utility models and industrial designs may be filed either directly with the ARIPO office or with the industrial property office of a contracting state.

The application is subject to payment of the prescribed fees.

An applicant may be represented by an attorney, agent or legal practitioner who has the right to represent applicants before the industrial property office of any Contracting State.

International Patent Application

Patent Co-operation Treaty (PCT)

An application for a patent made through a treaty called the Patent Co-operation Treaty (PCT), administered by the World Intellectual Property Organization (WIPO) in Geneva provides standardized international filing procedure.

Under the PCT, you may file a patent application in over 100 member countries through, a single application filed in Kenya. This procedure is simpler than filing separate applications and enables you to defer costs.

Only nationals and residents of Kenya can file under the PCT in Kenya.

D. INDUSTRIAL DESIGNS

An industrial design is the **ornamental** or **aesthetic** aspect of an article.

Industrial designs are applied to a wide variety of products of industry: from technical and medical instruments to watches, jewellery, and other luxury items; from housewares and electrical appliances to vehicles and; from textile designs to leisure goods.

To be protected under Kenyan laws, an industrial design must appeal to the eye.

This means that an industrial design is primarily of an aesthetic nature, and does not protect any technical or functional features of the article to which it is applied.

Industrial Designs excluded from protection under Kenyan law

- Works of sculpture, architecture, painting, engraving, enameling, embroidery, photography and any other design of purely artistic nature.
- Designs which consist of solely in a change in the colour of designs already known.
- Designs whose features **are functional** i.e correspond to or are determined by functions to be performed by the products.
- Industrial designs that are contrary to public order or morality.

Reasons for protecting Industrial Design

Industrial designs are what make an article **attractive** and **appealing**; hence, they add to the **commercial value** of a product and **increase its marketability**.

When an industrial design is protected, the **owner** - the person or entity that has registered the design - is assured an exclusive right against **unauthorized copying or imitation of the design** by third parties. This helps to ensure a fair return on investment.

An effective system of protection also benefits **consumers and the public at large**, by promoting fair competition and honest trade practices, encouraging creativity, and promoting more aesthetically attractive products.

Protecting industrial designs helps **economic development**, by encouraging creativity in the industrial and manufacturing sectors.

Procedure for protecting industrial designs

In Kenya, an industrial design must be registered in order to be protected.

- For an industrial design to be registrable, it must be "**new**".

An industrial design is deemed to be new if it has not been disclosed to the public, anywhere in the world, by publication in tangible form or, in Kenya by use or in any other way, prior to the filing date.

However a disclosure of the industrial design is not taken into consideration if it occurred more than twelve months before the filing date and if it was by reason or in consequence of:

3. acts committed by the applicant or his predecessor in title; or
 4. an evident abuse committed by a third party in relation to the applicant or his predecessor in title.
- The term of protection for Industrial Design is five years, with the possibility of renewal of two consecutive periods of 5 years.

Requirements for Registration

1. A completed application form (form IP 27)
2. Two identical specimens of the design
3. drawings, photographs or other graphic representations of the article embodying the industrial design and an indication of the kind of products for which the industrial design is to be used
4. the prescribed application fee.

5. Where the applicant is not the creator, the request must be accompanied by a statement justifying the applicant's right to the registration of the industrial design
6. a power of attorney, where the applicant is represented by an agent;

The purpose of the representations is to present an accurate and complete picture of the design to be registered and to identify those features of the design which are novel and for which protection is sought. The representations, therefore, comprise two elements:

- a series of views of the article and
- a statement of novelty.

Cost

The official fee for registration is approximately Kshs. 12,000 for a local applicant and USD 450 for a foreign applicant.

The official fee for renewing industrial design is Kshs. 10,000 (for local applicant) and USD 500 (for foreign applicant).

E. Other IP rights related to Patents and Industrial Designs

Utility Models

A utility model is an exclusive right granted for an invention, which allows the right holder to prevent others from commercially using the protected invention, without his authorization, for a limited period of time. Utility models are sometimes referred to as "petty patents" or "innovation patents."

The main differences between utility models and patents are the following:

- The requirements for acquiring a utility model are less stringent than for patents. While the requirement of "novelty" is always to be met, that of "inventive step" or "non-obviousness" is absent.
- Protection for utility models is often sought for **innovations of a rather incremental character** which may not meet the patentability criteria.

The invention gives **some utility, advantage, environmental benefit, saving or technical effect** not available in Kenya. It includes micro-organisms or other self-replicable material, products of genetic resources, herbal as well as nutritutional formulation which gives new effects.

- The term of protection for utility models is shorter than for patents i.e 10 years without the possibility of extension or renewal.
- There is no requirement for examination as to substance prior to registration. This means that the registration process is often significantly simpler and faster.
- Utility models are much cheaper to obtain and to maintain.
- Utility model protection can only be obtained for certain fields of technology and only for products but not for processes.

Utility models are considered particularly suited for SMEs that make "minor" improvements to , and adaptations of, existing products. Utility models are primarily used for mechanical innovations.

A utility model application may be converted to a patent application and vice versa.

The cost of registering a utility model is Kshs. 7,500 (for local applicant)/ USD 400 (for foreign applicant).

Just like patents utility models are subject to payment of annuity fees the cost being Kshs. 1,000/- (local applicant)/USD 50 (foreign applicant) for the first year after grant and Kshs. 2,000 (local applicant) and USD 100 for the 10th year.

Technovations

This is a **solution** to a **specific problem** in a field of technology, proposed by an employee of an enterprise. The solution is for use by that enterprise and relates to the activities of the enterprise. At the time of the proposal the solution is not actively in use by the enterprise.

A technovation certificate is granted by the enterprise to an employee provided that his duties do not comprise making and proposing technovations unless the degree of creative contribution inherent in the technovation exceeds that which is normally required of an employee having the said duties.

The employee may apply to KIPi to have his technovation certificate registered with them upon paying the sum of Kshs. 1,000/-.

F. COPYRIGHT

Copyright refers to those rights given to creators for their literary and artistic works.

Works eligible for copyright protection

The works that are eligible for copyright protection under the Kenyan law are:

- **literary works** such as novels, stories, poems, plays, reference works, newspapers and computer programs; databases; films,
- **musical works** such as musical compositions;
- **artistic works** such as paintings, drawings, photographs and sculpture, works of architecture in form of buildings or models, maps, plans and diagrams, works of artistic craftsmanship, pictorial woven tissues and articles applied to handicraft and industrial art;
- **audio visual works** such as videotapes, videograms
- **sound recordings** such as audio cds, audio tapes
- **broadcasts.** A broadcast is not eligible for copyright until it has been broadcast

Nature of Copyright

Copyright comprises economic and moral rights.

The original creators, including their heirs, have the exclusive **right to use or authorize others to use** their work on agreed terms. The creator of a work can prohibit or authorize:

- its reproduction in various forms, such as printed publication or sound recording;
- its public performance, as in a play or musical work;
- recordings of it, for example, in the form of compact discs, cassettes or videotapes;
- its broadcasting, by radio, cable or satellite;
- its translation into other languages, or its adaptation, such as a novel into a screenplay.
- Importation

Given the nature of creative works i.e they require mass distribution, communication and financial investment for their dissemination (for example, books, songs); the creators often sell the rights to their works to individuals or companies best able to market the works in return for payment. These payments are often made dependent on the actual use of the work, and are then referred to as **royalties**. These are economic rights.

These economic rights have a time limit. Under the Kenyan law the term of protection is of 50 years.

On the other hand **moral rights**, is the right to claim authorship of a work, and the right to oppose changes to it that could harm the creator's reputation.

The creator - or the owner of the copyright in a work - can enforce rights administratively and in the courts, by inspection of premises for evidence of production or possession of illegally made - "pirated" - goods related to protected works. In Kenya this is done by the help of the police, Kenya Beaurue of Standards inspectors and Kenya Revenue Authority officials. The owner may obtain court orders to stop such activities, as well as seek damages for loss of financial rewards and recognition.

Subject of Copyright Protection

Copyright protection extends only to expressions, and not to ideas, procedures, methods of operation or mathematical concepts as such.

Rights related to copyright

These are rights that have evolved from copyrighted works, and provide similar, although often more limited rights to:

- performing artists (such as actors and musicians) in their performances;

- producers of sound recordings (for example, cassette recordings and compact discs) in their recordings;
- broadcasting organizations in their radio and television programs.

Is there need to register copyright?

Copyright itself does not depend on official procedures. A created work is considered protected by copyright as soon as it exists.

However, under the current Kenyan law, there is provision for registration of copyright with the Copyright Board of Kenya the purposes of:-

1. maintaining a record of copyright works
2. enabling the Copyright Board of Kenya establish and maintain an effective data bank on authors and their works; and
3. publicizing the rights of owners of works.

The official fee for registration is Kshs. 600

Management of Copyright

Copyright owners benefit only when their works are used and they are paid for the use. In order to use works of a copyright owner one has to contact the right owner.

However for certain types of works and other subject matter, you can get permission from a collective management organization.

Collective management organizations license use of works and other subject matter that are protected by copyright and related rights whenever it is impractical for right owners to act individually. Examples of such organisations in Kenya are:-

- Music Copyright Society of Kenya- its functions include to collect royalties on behalf of its members and members of its affiliate societies, around the world for distribution to its members.
- KOPIKEN - licenses the reproduction of copyright-protected materials against payment of fees whenever it is impractical for rightsholders (authors and publishers) to license and collect fees individually.

Fair Dealing

The law permits one to use limited portions of a copyright holders work without seeking their permission, provided that the copyright holder is acknowledged as the owner. This is known as “fair dealing”.

Under Kenyan law it is permissible to use limited portions of a work, including quotes, for purposes such as news reporting and private personal use or educational purposes in institutions registered under the Education Act (Cap 211).

However fair dealing does not apply to computer program.

The law nevertheless provides that a person who is in lawful possession of a computer program may do any of the following acts without the authorization of the software owner:-

- to make copies to correct errors; or
- to make back-up copy; or
- for purposes of testing a program to detect its suitability for the person’s use
- to decompile the program, covert the program into a version expressed in different programming language, code, notation for the purpose of obtaining information needed to enable the program to operate with other program.

Debate on whether computer programs should be protected under copyright or patents regime.

There has been debate on the above subject matter and this arises because of the nature of software, i.e it possesses several elements that make it fall within different categories of IP. If one takes the definition that a software is a set of instructions to a computer initially set a as a source code which are expressed in written form, then it follows that software is logically eligible for copyright protection as artistic work.

However for a software to operate in a computer it must be converted to an object code through the process of compilation. Herein lies the problem because in the end source code of a computer program, while completely different from that of another program, may yet have the same function and produce a similar set of instructions that achieve a similar result. This is the basis of the debate in support of the patentability of software. Other reasons advanced for not patenting copyright relate to policy considerations, that is, the patent system is expensive and lengthy which may create a burden for the small start-up firms that produce some of the most important software innovations.

For more detailed arguments on the subject please visit the following link www.wipo.int/.../wipo_unido_smes_msk_07_www_73624.pdf

G. IPR AND THE PROPOSED CONSTITUTION

The current constitution does not have specific provisions with respect to IPR.

However under the proposed constitution there are specific provisions relating to promotion of IPR.

Article 11(2) (c) requires the state to *"promote the intellectual property rights of the people of Kenya"*.

The above provision is covered under the heading '**culture**' requiring the state to promote all forms of national and cultural expression.

Parliament is expected to pass legislation to ensure that communities receive compensation or royalties for use of their culture or cultural heritage.

Article 40(5) of the proposed Constitution specifically provides that *"the state shall support, promote and protect the intellectual property rights of the people of Kenya"*.

This is a departure from the current constitution which provides for general provision protecting persons against deprivation of property.

END

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