



Intellectual Property

Monthly Newsletter

Dear Clients,

Welcome to 2017's fourth issue of IP Monthly, filled with interesting news articles and developments. We also highlight the latest law firm rankings according to the Legal 500 ranking for the year 2017. We hope that you will find the features in this newsletter informative.

Enjoy!

Important dates in April

- **2 April:** World Autism Awareness Day
- **6 April:** International Day of Sport for Development and Peace
- **7 April:** World Health Day
- **20 April:** International Day of Human Space Flight
- **22 April:** International Mother Earth Day
- **26 April:** World Intellectual Property Day

Interesting facts about April

- The name April, as theory suggests, is rooted in the Latin term *Aprilis* which is derived from the Latin *aperire* meaning "to open".
- This could be a reference to the opening or blossoming of flowers and trees, a common occurrence throughout the month of April in the northern hemisphere.
- Another theory holds that since months are often named for gods and goddess, and since Aprilis is derived from the Greek "Aphrodite," one can conclude that the month was named for the Greek goddess of love.

Historical dates in April

- **2 April 1863:** A bread riot occurred in the capital of Richmond, Virginia, as people demanded bread from a bakery wagon then wrecked nearby shops. The mob dispersed only after Confederate President Jefferson Davis made a personal plea and threatened to use force.
- **3 April 1944:** The US Supreme Court ruled 8 to 1 that African Americans cannot be barred from voting in the Texas Democratic primaries. The Court stated that discrimination against blacks violates the 15th Amendment and that political parties are not private associations.

- **6 April 1917:** Following a vote by Congress approving a declaration of war, the US entered World War I in Europe
- **11 April 1931:** Harold Washington became the first African American mayor of Chicago, receiving 51% of the vote.
- **18 April 1974:** The secretary of the United Nations warned the world could be heading for a recession caused by the underlying increase of the price of oil causing trade deficits in the western world.
- **20 April 1879:** The first mobile home (horse-drawn) was used in a journey from London to Cyprus.
- **27 April 1865:** Telegraph inventor Samuel FB Morse (1791-1872) was born in Charlestown, Massachusetts. He developed the idea of an electromagnetic telegraph in the 1830s and tapped

out his first message “What hath God wrought?” in 1844 on the first telegraph line, running from Washington, DC, to Baltimore. The construction of the first telegraph line was funded by Congress (USD 30 000) after Morse failed to get any other financial backing.

- **30 April 1789:** George Washington became the first US President as he was administered the oath of office on the balcony of Federal Hall at the corner of Wall and Broad Streets in New York City.

The Legal 500 2017 rankings

We are pleased to share news of our fantastic performance highlighted in the 2017 Legal 500 rankings for Europe Middle East & Africa. The Legal 500 is an independent legal body

which analyses the capabilities of law firms across the world by assessing the strengths of law firms in over 100 jurisdictions. These rankings are updated each year, thus giving an up-to-date version of the global market. The rankings are based on certain criteria highlighting the practice area teams providing exemplary and innovative advice to corporate counsel.

Across Bowmans, 13 practice areas were rated with some areas rated in Tier 1, 2, and 3. We are pleased to announce that Bowmans Kenya was tied for the most Tier 1 rankings in Kenya with 12 partners recognised as leaders in their fields. Commentators praised Bowmans, saying: “Bowman’s is a dominant force in cross-border transactions, including deals involving multiple African jurisdictions, and is building its profile in private equity for international as well as local funds.”

Please see below the rankings detailing each practice area and its rating.

Practice Area	Tier	Jurisdiction
Banking and Finance	Tier 1 Tier 2	Kenya South Africa
Commercial, Corporate, Mergers and Acquisitions	Tier 1	Kenya, South Africa
Dispute Resolution	Tier 2	Kenya, South Africa
Projects and Energy	Tier 2	Kenya
Competition	Tier 1	South Africa
Employment	Tier 1	Kenya, South Africa
Real Estate and Construction	Tier 1	Kenya
Investment Funds	Tier 2	South Africa
Mining	Tier 3	South Africa
Projects and Infrastructure	Tier 1	South Africa
Real Estate	Tier 3	South Africa
Shipping and Transport	Tier 1	South Africa
Tax	Tier 2	South Africa

Please click [here](#) and [here](#) for more details.

Intellectual Property Rights News Brief

How to identify and handle Intellectual Property scams – report by the China Intellectual Property Rights SME help desk

Introduction

With an increase in the awareness of Intellectual Property in China and the necessity of Intellectual Property in China, foreigners must ensure that they hire local Chinese agencies to assist them in filing for registration, attending to trademark or patent matters such as prosecution, invalidation and renewal among others. This has in turn led to an increase in the number of local businesses offering IP services to the foreign businesses. The major challenge, however, is that the quality and level of services offered by the practitioners differ and the language barrier and lack of sufficient translation of key information on obtaining IP rights and registration procedures has made it easy for some agencies to take advantage of the situation and devise various scams to trick foreign companies.

How to identify typical IP scams

One of the common types of scams is known as a ‘threat’ from a third party. This type of scam is effected by sending an email to the foreign company stating that “XX (referring to a certain trademark agency) warns that the company’s trademark or company’s name will be registered by a third party in China (or occasionally from abroad) either as a trademark or a company name, or an ‘online’ trademark.

The e-mails further state that failure to respond to it will be regarded as consent to the filing of the trademark application and that the company will be unable to use the mark in China henceforth. Upon receipt of such message, a foreign company experiences anxiety as they face the potential loss of its long owned brand in the huge market in China. The uninformed company may opt to believe the email and follow the guidance in the email to contact the sender.

Features of email scams include:

- I. Unsolicited approach: the email is sent to a general mailbox of the foreign company or an email address widely used for marketing;
- II. Company name of the agency is usually vague: it lacks strong identity and may in some occasions sound like a unit of the Chinese government authority such as the China patent and trade office.
- III. Language of the email: the wording used in the email is intended to create the illusion that the registration will be granted and the targeted foreign company will be blocked.

Generally, the two reasons for doubting any IP scam e-mail or unsolicited approach include:

- I. There is no government authority that has the obligation to monitor application status, market status for specific trademarks or domain names or domain names (IP rights and private rights). The specific monitoring work should ideally be carried out by law firms contracted to carry out the registration process.

- II. A registrar or other private entity does not have an incentive to proactively contact a foreign company on IP registrations or assets if it has already stated that it is working for another company with conflicting interests. If the agency purporting to assist a foreign company in the IP procedures states that it received the application requesting it to register the similar or identical trademark/ domain name as the foreign company’s by a third party, then the agency should not be trusted and is unqualified for handling registration processes. A qualified formal agency is bound by regulations to maintain confidentiality of client’s information. By releasing confidential client information, the illegal agency is in breach of regulations and therefore must not be trusted to carry out IP registrations.

The second type of IP scam is the ‘empty promise’, where the agency promises to complete the trademark registration within a shorter time period. The reality is that at the China Trademark Office, all applications are transferred to examiners in five examination departments and there is no guarantee that a trademark will be registered within a specific time.

The third form of IP scam is the ‘fee cheating’, where the agency charges separately for different service items for instance, the Notice for Accepting the Registration which is issued by the China Trademark Office upon acceptance of the application as well as formal registration of the certificate. These documents are included in the official application fee and should not be charged as an extra fee for obtaining these files.

The fourth form of IP scam is the 'blind filing', which entails the offering of rush services without completing thorough search and registration risk assessments. This may lead to significant loss of time and resources as there may be opposition actions instituted against foreign companies and would be overlooked by the illegal agencies.

Where to find the right information

It is always advisable to first seek guidance from the official website of the relevant IP administration. The official websites generally give clear information on the official fee schedules and procedures required to be followed in order to register a trademark. Unfortunately, foreign companies have minimal

information relating to the relevant Chinese IP administrations, their portfolios and contacts. This in turn has led to unscrupulous agencies impersonating such authorities for online dealings. As a result, a simple internet search will often lead uninformed persons to unofficial (fake) websites.

Outlined below is a list of major IP administrators in China:

IP Type	IP Authority	Abbreviations	List of agencies and registrars	Searchable database
Trademark	China Trademark Office www.sbj.saic.gov.cn	CTMO	http://sbsq.saic.gov.cn:9080/tmoas/agentInfo/getAgentDljg.xhtml	http://sbj.saic.gov.cn/sbcx/
Domain Name	China Internet Network Information Centre www.cnnic.com.cn	CNNIC	http://www.cnnic.com.cn/jczyfw/CNym/cnzcfwigcx/cnzcjg.ndsq/201206/t20120614_28273.htm http://www1.cnnic.cn/syjszcl/List/201210/t20121011_36680.htm http://purveyor.cnnic.cn/purveyor.query/cn_purveyor.jsp	http://www1.cnnic.cn/
Patents	State Intellectual Property Office http://english.sipo.gov.cn	SIPO	http://dlgl.sipo.gov.cn/txnqueryAgent.do http://dlgl.sipo.gov.cn/txnqueryAgencyOrg.do	http://www.pss-system.gov.cn/sipopublicsearch/portal/app/home/declare.jsp
Copyright	Copyright Protection Centre http://ccopyright.com.cn/cpcc/index.jsp	CPC	N/a	N/a
IP recordal with customs	General Administration of Customs in China www.customs.gov.cn	GACC	N/a	http://www.customs.gov.cn/zscqbh/main.html?page=04

Next steps

The Chinese government has taken steps towards eradicating illegal patent agencies by putting in place laws and rules to address these concerns. For instance, the current law of China has inserted clauses prohibiting illegal agencies. Local authorities are also taking action by prohibiting illegal agencies from making online patent applications as the online platform can only be accessed by qualified agencies. The authorities have further raised public awareness on the scams through their websites.

Upon receipt of unsolicited messages regarding IP registrations, foreign companies are required to avoid making a response and advised to verify the authenticity of the agency. One may thereafter ignore the email or report it to the local AIC which is responsible for tackling business frauds. Clients are thus advised to use official websites and select qualified agencies to conduct their IP registrations and other related matters.

Source: This synopsis was prepared based on the guidelines by the China IPR SME Helpdesk- www.china-iprhelpdesk.eu

To view the guideline, please click [here](#).

Developments in the intellectual property arena

Trademarks

3M hits Chinese company with patent, TM and copyright claim

US conglomerate 3M has sued a Chinese company in a US court alleging patent, trademark and copyright infringement. It alleged that Phoenix Automotive Refinishing, along with California-based K2 Concepts, has

sold infringing automotive paint-spraying products. The claim was filed at the US District Court for the Central District of California on Wednesday, 5 April. 3M sells the PPS Paint Preparation System, which includes a “disposable liner and lid with a built-in filter that improves and simplifies the mixing, use and clean up required when painting with a gravity-fed spray gun”. According to the claim, Phoenix has imported into the US and sold lids and liners that use 3M’s technology, and has used copyrighted 3M photos and the PPS marks in its marketing materials.

To read this story click [here](#).

Source: WIPR

Kylie Jenner takes on ‘Kylee’ TM, suspends own appeal

Reality TV star Kylie Jenner has suspended her appeal against the rejection of the mark ‘Kylie Jenner’ while she fights another battle. Jenner opposed the trademark ‘Kylee’, which was filed by Mimo Clothing back in 2011. The trademark is registered for class 25, which includes clothing and accessories. On 22 March 2017, Jenner filed an opposition to the mark, alleging that it was confusingly similar to the ‘Kylie Jenner’ marks for classes 3, 14, 18, 25, 35 and 41.

To read this story click [here](#).

Source: WIPR

Japan grants colour trademarks

While the Japan Patent Office has been open to the registration of colours alone, unaccompanied by any script (colour per se marks), since April 2015 (along with holograms, sounds or motions), this was the first successful registration of such marks.

The two successful applications were both for brands that are household names in Japan – the colours red, orange and green for 7-11, and blue,

white and black for Tombow erasers (a popular Japanese brand of erasers).

A partner at Jones Day in Tokyo, described these decisions as “positive signs” and although the decision came as a surprise on the 7-11 colour per se mark, as the colours red, orange and green are associated with 7-11 usually only in conjunction with the boxed-in number 7 bisected by the “eleven” text, and do not by themselves necessarily remind people of the brand.

To read this story click [here](#).

Source: Managing Intellectual Property

Hallmark sues rival in trademark claim

The US-based card manufacturer’s licensing arm Hallmark has sued a greetings card business for trademark infringement. Hallmark filed its suit against Dickens at the US District Court for the Eastern District of New York on Monday, 10 April.

The greetings card company argued that Dickens infringed and diluted its trademark, competed unfairly and committed deceptive trade practices under New York General Business Law section 349.

To read this story click [here](#).

Source: WIPR

Trademarks for public domain can be accepted says court

Trademarking artwork that is in the public domain does not contravene public policy or the principles of morality, according to the Court of Justice of the European Free Trade Association States (EFTA Court). The EFTA Court has jurisdiction over European Free Trade Association states which are also parties to the European Economic Area Agreement—Iceland, Liechtenstein and Norway. Handed down on Thursday, April 6 2017,

the decision resulted from a request for an advisory opinion from Oslo Municipality concerning the interpretation of Directive 2008/95/EC. The case stemmed from the expiration of copyright protection for a number of artworks situated around Oslo.

To read this story click [here](#).

Source: WIPR

Patents

Royalty-free Android licence launches in aid of 'patent peace'

A cross-licence patent agreement centring on Android technology and Google applications has been launched to provide "patent peace" within the Android system. The agreement, called Pax, allows members to grant each other royalty-free patent licences. Google and eight other companies, including Samsung and LG have helped to launch the programme. Google has helped develop Pax in order to provide "balanced patent solutions". Jamie Rosenberg, vice president, business and operations, Android and Google Play, said that the "community-driven clearinghouse, developed together with our Android partners", ensures that innovation and consumer choice – not patent threats – will continue to be key drivers of the company's Android ecosystem.

To read this story click [here](#).

Source: WIPR

English High Court backs unwired planet in Huawei FRAND claim

The English High Court backed licensing company Unwired Planet in its patent dispute with Chinese technology business Huawei. Back

in March 2014, Unwired Planet sued Huawei, Samsung and Google, alleging infringement of six UK patents. Five of these were claimed to be standard-essential patents (SEPs) for various telecommunications standards, such as 3G and 4G. The European Telecommunications Standards Institute's policy requires that a patentee declaring patents as standard – essential commits to licensing those patents on fair, reasonable and non-discriminatory (FRAND) terms. After proceedings began, in April 2014 Unwired Planet made an open offer to the defendants to license its entire global portfolio (SEPs and non-SEPs). However, Huawei, Samsung and Google denied infringement, argued that the patents were invalid and counterclaimed for revocation.

To read this story click [here](#).

Source: WIPR

Facebook's Oculus hit with virtual reality patent suit

Techno View IP, a California-based technology licensing company, has hit Oculus, Facebook's virtual reality subsidiary, with a patent infringement claim. The lawsuit filed on 6 April 2017 at the US District Court for the District of Delaware, alleged that Oculus had incorporated a competitor's technology into its Rift headset. Manuel Rafael Gutierrez Novelo is the inventor of the technology and CEO of virtual reality headset maker ImmersiON-VRelia. Techno View IP licenses the patent from ImmersiON-Vrelia. The Rift is designed to allow people to enter an immersive computer-generated environment such as a computer game or a movie scene.

To read this story click [here](#).

Source: WIPR

Forever 21 Wins first round in fenty for Puma copying lawsuit

Forever 21 has won the first round in the lawsuit that Puma filed against it in March for allegedly infringing its copyright, patent, and trademark rights in three of the footwear designs from its Fenty collection. In addition to seeking permanent injunctive relief, which would bar the fast fashion giant from selling the shoes at issue indefinitely, Puma asked the court last Wednesday to issue a temporary restraining order, which would serve to force Forever 21 to immediately cease all sales of the shoes.

On 7 March 2017, Judge Philip S. Gutierrez of the US District Court for the Central District of California ruled against Puma, refusing to grant the temporary restraining order ("TRO"), as Puma did "not show that they are without fault in creating the crisis requiring ex party relief."

To read this story click [here](#).

Source: *The Fashion Law*

Skechers continues to wage war with Nike over Flyknit patents

Nike and Skechers have been going head-to-head in legal proceedings non- since Nike filed a patent infringement suit against Los Angeles-based Skechers in January 2016. In its suit, Nike alleged that Skechers "Burst, Women's Flex Appeal, Men's Flex Advantage, Girl's Skech Appeal, and Boy's Flex Advantage" shoe styles infringe at least eight of its design patents, all of which relate to Nike's best-selling Flyknit shoes. The sportswear giant further alleged that the "overall appearance of the designs of [its] patents and the corresponding designs of Skechers' infringing shoes are substantially the same."

In April 2016, Skechers began heavily retaliating against the Portland-based sportswear giant by filing a number of petitions with the US Patent Trial and Appeal Board (“PTAB”) to invalidate a handful of Nike’s design patents, many of which are central to the lawsuit. In fact, Skechers has been devoting significant efforts to dismantling Nike’s arsenal of design patents in connection with the Flyknit design.

To read this story click [here](#).

Source: *The Fashion Law*.

Federal circuit remands part of Samsung’s USD 15.7 million patent ruling

The US Court of Appeals for the Federal Circuit remanded part of a patent suit earlier this week, meaning that Samsung may not have to pay the full USD 15.7 million in damages to Rembrandt Wireless. In the ruling handed down on 17 April 2017, the Federal Circuit’s disagreed with the district court’s denial of Samsung’s motion based on the marking statute, so it remanded the issue. Under the marking statute – 35 USC, section 287 – a patent owner who makes/ sells a product covered by a patent must mark that product with all applicable patent numbers. However, the Federal Circuit affirmed the other decisions made by the district court – namely, its claim construction and denial of Samsung’s motions for judgment as a matter of law on obviousness and damages.

To read this story click [here](#).

Source: *World IP Review*

Copyright

Puma files patent, copyright, trade dress suit against Forever 21 over Rihanna shoes

On the heels of reports that Forever 21 is offering lookalike versions of footwear from Rihanna’s Fenty line for Puma, the German sportswear giant has slapped

the copycat retailer with a design patent, trade dress, and copyright infringement lawsuit. According to Puma’s suit, which was filed late last week in the US District Court for the Central District of California, the Los Angeles-based fast fashion brand has copied three of the most prominent footwear designs from Rihanna’s collection for Puma in attempts to “trade on the substantial goodwill of Puma, Rihanna, and the Fenty shoes.”

Puma has also landed a preliminary victory in its battle against British fast fashion chain Topshop in connection with a number of the Fenty footwear designs. As noted in the Forever 21 lawsuit, Puma recently “obtained an injunction against a retailer, Top Shop, in Germany preventing it from selling knock-offs of the Fenty Shoes.”

To read this story click [here](#).

Source: *The Fashion Law*

Copyright claim against Ed Sheeran’s ‘Photograph’ dismissed

A district judge has dismissed a copyright claim brought by two US musicians over singer Ed Sheeran’s hit “Photograph”. Judge James Selna of the US District Court for the Central District of California, Southern Division dismissed with prejudice the copyright claim brought by Martin Harrington and Thomas Leonard on April 10 2017. In June last year, it was reported that Sheeran had been named in a copyright infringement claim by Harrington and Leonard. The two argued that Sheeran’s song had similar elements to their track “Amazing.”

To read this story click [here](#).

Source: *WIPR*

WWE sues BitTorrent users in copyright claim

World Wrestling Entertainment (WWE) Studios Finance has sued a group of BitTorrent users in a copyright

infringement claim. WWE filed its suit at the US District Court for the District of Connecticut on Thursday, 6 April, alleging that the defendants, who are unidentified, infringed and vicariously infringed its copyright.

According to the suit, the defendants used the BitTorrent protocol to “unlawfully acquire, reproduce, and distribute” a film called *Eliminators*”.

To read this story click [here](#).

Source: *WIPR*

Counterfeits

Trump signs executive order on trade and counterfeits

US President Donald Trump has signed an executive order to “promote the efficient and effective administration” of US trade laws. Trump signed the order on “establishing the enhanced collection and enforcement of antidumping and countervailing duties, and violations of trade and customs laws”, on 31 March 2017. According to a release by the White House, within 90 days of the order the secretary of Homeland Security, through the commissioner of the US Customs and Border Protection (CBP), will develop and implement a strategy for combating violations of US trade and customs laws. The order will also ensure the “timely and efficient enforcement of laws” protecting IP rights owners from the importation of counterfeit goods.

To read this story click [here](#).

Source: *WIPR*

Large amount of consumer tech is counterfeit, OECD report finds

Nearly 20% of mobile phones and 25% of video game consoles sold internationally are counterfeit, and the numbers are rising, according to a report by the Organisation for Economic Cooperation and Development (OECD). The report, Trade in Counterfeit ICT Goods, defines counterfeit as a trademark violation, a fake product packaged to look like real thing. The report found China to be the leading source of counterfeit information and communication technology (ICT) goods and United States technology to be hardest hit. The OECD is the organisation of wealthier nations. The report details complex ways counterfeiters produce and ship these products to avoid detection, often through a maze of ports and with the fake labels added in a different country from manufacturing.

To read this story click [here](#).
To read the full OECD report click [here](#).

Source: *IP – Watch*

Counterfeiting and piracy-stamping it out

It has long been known that counterfeiting and piracy (respectively the infringement of trademarks and copyright, together known as intellectual property, or IP) make up a vast global business. But a report published by the OECD suggests that, despite the advent of such high-tech counter-measures, it is far bigger than previously thought. The last such survey by the club of 34 mostly rich countries was in 2008. Updated the next year with data from 2007, it put the value of cross-border trade in fakes at USD 250 billion, or 1.8% of the total for all goods. The latest report estimates that by 2013 those figures had risen to USD 461 billion, and 2.5%.

Some increase was predictable: global trade has recovered since the financial crisis, and it is natural that illicit commerce should too. The report's lead author stated that he had not expected the rise in percentage terms to be so high. In part, it could be thanks to better data.

To read this story click [here](#).

Source: *The Economist*

Gucci grabs USD 9 million verdict in counterfeiting claim

Gucci America, the US arm of the luxury brand, has secured a USD 9 million verdict and a permanent injunction against online counterfeiters. On 17 April 2017 the Judge at the US District Court for the Southern District of Florida signed the final default judgment. Gucci was awarded USD 100 000 in damages for each of the 89 defendants' infringement, with another USD 110 000 awarded against eight of those defendants. The infringing domain names were also transferred to Gucci.

The luxury brand had brought its claim in late December last year, alleging counterfeiting and trademark infringement, false designation of origin, cybersquatting, and unfair competition.

To read this story click [here](#).

Source: *WIPR*

General News

IP law and policy after Brexit

At this year's conference to be held on 20 April 2017, expert speakers from across the UK will consider the future of IP policy, law and regulation. The programme covers a range of

IP matters in the UK post-Brexit, and the possibility of further devolution to the Scottish Government. Gill Grassie (Partner, Brodies LLP) returns as conference chairman.

To read this story click [here](#).

Source: *The IPKat*

UN Development Programme calls for reform of IP and investor protection regimes

A United Nations Development Programme report released places of importance on transforming global institutions, and establishing fair trade and investment rules. The report calls for global reform of the intellectual property rights regime and investor protection regime. In addition, the report ranks countries on their human development level, putting Norway first followed by Australia and Switzerland.

The Human Development Report 2016 "Human Development for Everyone," launched in Stockholm, is the latest in a series of global Human Development Reports published by the UN Development Programme (UNDP).

To read this story click [here](#).

Source: *The IP Watch*

Now you can fly drones inside Apple stores

Just in case selfie sticks weren't enough, flying robots are now equipped to take photos. Beginning 12 April 2017, you can try one right inside an Apple store. Zero Zero Robots announced that its autonomous camera drone, the Hover Camera Passport, is now available exclusively on Apple.com and in Apple stores in several countries. "We're thrilled to bring autonomous flying photography

into the hands of consumers who are excited by truly innovative technology that impact their everyday lives," said founder and CEO of Zero Zero Robotics, in a statement. "By selling in Apple, we want more customers to capture their memories in a near-effortless way through breath-taking perspectives that can only be achieved through Hover Camera Passport."

To read this story click [here](#).

Source: ZD Net

Our work

In the month of April we have:

- Filed approximately 30 trademark applications across East Africa;
- Assisted with approximately 80 trademark renewals, recordals of mergers, changes of names and assignments of trademarks;
- Filed five renewal of patent annuity; and
- Been instructed on three passing off/counterfeit matters.

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